



SOUTH EAST ASIA FOODS, INC.,
Petitioner,

-versus-

GREEN GOLD GOURMET FOODS,
INCORPORATED,
Respondent-Registrant.

}
} **IPC No. 14-2011-00084**
} Petition for Cancellation:
} Reg. No. 4-2004-0011237
} Date Issued: 10 March 2006
} **TM: "SUKA PINAKURAT AND**
} **DEVICE"**
}

X-----X

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 286 dated November 05, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 05, 2014.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



SOUTH EAST ASIA FOODS, INC.,
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- versus -

GREEN GOLD GOURMET FOODS INC.,
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IPC No. 14-2011-00084
Petition for Cancellation:

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Date Issued: 10 March 2006

Trademark: "SUKA PINAKURAT AND
DEVICE"

Decision No. 2014 - 286

DECISION

SOUTH EAST ASIA FOODS, INC.¹ ("Petitioner") filed a petition for cancellation of Trademark Registration No. 4-2004-0011237. The registration, issued to GREEN GOLD GOURMET FOODS INC.,² ("Respondent-Registrant"), covers the mark "SUKA PINAKURAT AND DEVICE" for use on "vinegar" under Class 30 of the International Classification of goods³.

The Petitioner anchors its petition on Section 123.1 (j) of Republic Act No. 8293 or the Intellectual Property Code of the Philippines ("IP Code"). According to the Petitioner, "Pinakurat" is a descriptive term and is thus not entitled to trademark protection. Further, the Petitioner alleges, among other things, that:

"1. The term *kurat* or *pinakurat* immediately signals to consumers that the vinegar which bears such term has a 'shocking' or "surprising" characteristic.

"2. Prior registration of 'Suka Pinakurat and Device' by Del Rosario (assignor of Green Gold) did not perfect any trademark right over the term 'Pinakurat', as used on *vinegar*."

In support of the petition, the Petitioner submitted the following pieces of evidence:

1. Print out of Application No. 4-2010-500127 filed on 29 January 2010 for the trademark DATU PUTI PINOY KURAT SPICED TUBA VINEGAR AND DEVICE (*Exhibit "A"*);
2. Copies of Official Action Papers Nos. 02 and 05 of the Bureau of Trademarks (*Exhibits "B" and "C"*);
3. Certificate of Registration No. 4-2004-011237 for the trademark SUKA PINAKURAT AND DEVICE (*Exhibit "D"*);
4. Print outs of USPTO webpages for PINAKURAT (*Exhibit "E" and "F"*);
5. Print out of webpage of sukapinakurat (*Exhibit "G"*); and,
6. Judicial Affidavit of Lalaine Gonzalez-Camina (*Exhibit "H"*).

- 1 A corporation duly organized and existing under the laws of the Republic of the Philippines, with principal address at 12th Floor, Centerpoint Condominium, Garnet Road corner Julia Vargas Avenue, Ortigas Center, Pasig City.
- 2 A corporation duly organized and existing under the laws of the Republic of the Philippines, with address at Purok 3, Puga-an, Iligan City, Lanao del Norte.
- 3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

The Respondent-Applicant filed its Verified Answer with Motion to Dismiss on 16 August 2011, specifically denying the allegations stated in the Verified Opposition and averring the following special and affirmative defenses:

“a. Petitioner is barred by Prescription;;

“b. The word ‘Pinakurat’ is a noun, not an adjective;

“c. Assuming arguendo that the averments made by the Petitioner are true and accurate, they do not make the word ‘Pinakurat’ descriptive but rather merely suggestive, which allows registration;

“d. Assuming arguendo that ‘Pinakurat’ is an adjective and is descriptive, it does not describe the quality or characteristic of the goods on which it is used-vinegar, and has never been germane to the product-vinegar;

“e. Assuming arguendo the word ‘Pinakurat’ is descriptive of the product-vinegar, it is still entitled to registration based on the ‘Doctrine of Secondary Meaning.’

The Respondent-Applicant's evidence consists of the following:

1. Print out of DATU PUTI PINOY KURAT SPICED TUBA VINEGAR AND DEVICE with Application No. 4-2010-500127 (*Exhibit “1”*);
2. Print out of DATU PUTI PINAKURAT SPICED TUBA VINEGAR AND DEVICE with Application No. 4-2009-012184 (*Exhibit “2”*);
3. Print out of DATU PUTI PINAKURAT SPICED TUBA VINEGAR AND DEVICE with Application No. 4-2009-012183 (*Exhibit “3”*);
4. Judicial Affidavit of Dr. Luvizminda Cagas-Dela Cruz (*Exhibit “4”*);
5. Certification dated 02 August 2011 issued by the Provincial Director of Department of Trade and Industry regarding the registration of the business name GREEN GOLD GOURMET FOOD PRODUCTS (*Exhibit “5”*);
6. Photocopy of “COOK The Culinary Lifestyle Magazine” dated September 2002 (*Exhibit “6”*);
7. Secretary’s Certificate dated 10 August 2011 (*Exhibit “7”*); and,
8. Judicial Affidavit of Reinard Donn C. Stuart Del Rosario of Green Gold Gourmet Foods, Inc. (*Exhibit “8”*).

The case was scheduled for mediation conference on 20 September 2011. After it was declared a failure of mediation for refusal of the parties to mediate, the case was then after set for preliminary conference and the same was terminated.

Should the Respondent-Registration for the mark SUKA PINAKURAT AND DEVICE be cancelled?

Sec. 123.1 (j) of R. A. No. 8293, relied upon by the Petitioner, provides, in part, that a mark cannot be registered if it:

x x x

(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services.

The above-quoted provision expresses the prohibition on registration of what is known as descriptive mark. Aptly, a term is descriptive if, as understood in its normal and natural sense, it "forthwith conveys the characteristics, functions, qualities or ingredients or a product to one who has never seen it and does not know what it is," or "if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods," or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination.⁴

There is no dispute that the word PINAKURAT, which forms part of the Respondent-Registrant's mark, was derived from the Cebuano dialect "kurat". "Kurat", as translated in the application, means shocked, frightened or surprised. Thus, it is the Petitioner's position that the use of the word PINAKURAT immediately signals to consumers that the food products which bear such mark have a "shocking" or "surprising" characteristic. According to the Petitioner, as applied for the product vinegar, the term suggests the characteristic of spiciness.⁵

The words "shocking" has been defined as something causing a feeling of surprise and dismay while "frightened" as to drive or force by arousing fear. These words characterize or express the feeling of a person. When applied to food items, these terms do not readily convey the characteristic, quality or ingredients of a product. Thus, the use of the word PINAKURAT for processed, dried/dehydrated and powdered meat, seafoods, fruits and vegetables; condiments, sauces, spices does not readily convey an immediate idea as to the ingredients or qualities of the products. As correctly pointed out by the Respondent-Registrant, it requires a certain degree of imagination and perception to establish a link between the term and the products on which it is used.

At most, the word PINAKURAT may be considered merely as suggestive of the characteristic of the goods. Suggestive terms are those which, in the phraseology of one court, require "imagination, thought and perception to reach a conclusion as to the nature of the goods." Such terms, "which subtly connote something about the product," are eligible for protection in the absence of secondary meaning. While suggestive marks are capable of shedding "some light" upon certain characteristics of the goods or services in dispute, they nevertheless involve "an element of incongruity," "figurativeness," or "imaginative effort on the part of the observer."⁶

In this regard, this Bureau finds merit in the arguments raised by the Respondent-Registrant, to wit:⁷

"5. x x x 'Pinakurat' does not immediately signal to consumers that the product has 'shocking' or 'surprising' characteristic. In fact the word 'Pinakurat' is not even germane to the product-vinegar. Neither is there a casual relationship between the words 'Suka' and 'Pinakurat'.

x x x

"13. Assuming arguendo that the averments made by the Petitioner are true and accurate, they do not make the word 'Pinakurat' descriptive but rather merely suggestive, which allows registration;

As admitted by Petitioner in paragraph 10 of the Petition, it would take some thinking to arrive at a conclusion to relate the word 'Pinakurat' to being spicy or pinaanghang, to wit:

*Thus one **thinks** of a spicy or pinaanghang vinegar when one sees the term*

4 Societe Des Produits Nestle S. A. v. Court of Appeals, G. R. No. 112012, 04 April 2001.

5 Par. 8, Page 16 of Petition.

6 Societe Des Produits Nestle, S. A., supra.

7 Respondent-Applicant's Position Paper, pages 15-19.

'Pinakurat' thereon. While pinakurat's direct English or Tagalog Translation is not spicy or pinaanghang, it does immediately indicate such quality or characteristic of the subject goods.

Clearly as admitted by Petitioner, Pinakurat is not the direct translation of spicy or pinaanghang. Finding this link in one's mind would take a lot of imagination and thinking which would not necessarily be the same for every person. Therefore the trademark 'Suka Pinakurat' does not readily give away the kind of goods the product it covers. It is capable of allowing consumers to trace and recall its originator or manufacturer.

In *Kraft Foods Philippines, Inc. vs Columbia International food products, Inc.* IPC No. 14-2008-00247 decided February 22, 2011, the Honorable Office distinguished descriptive marks from suggestive marks:

x x x

"14c. Assuming arguendo that 'Pinakurat' is an adjective and is descriptive, it does not describe the quality or characteristic of the goods on which it is used-vinegar, and has never been germane to the product-vinegar;

Mass Hermanos, S.A. v. Director of Patents, G.R. No. L-3952, December 29, 1953 teaches us that not every general or generic term will be denied registration, but only that generic term that declares the 'genus' or kind of the particular goods advertised or vended.

Dog's Paw is certainly a generic term-it can but it would not for that reason be unregistrable as the trademark of a candy bar.

According to Dr. Luzminda Cagas-dela Cruz, a renowned linguistics, English and Literature professor at the Mindanao State University-Iligan Institute of Technology (MSU-IIT), *the word, 'Pinakurat', is not germane to the product – vinegar. Neither is there a direct and casual relation between the words, 'Suka' and 'Pinakurat'. In fact it does not add sense or any meaning to the product. 'Pinakurat' only received association with vinegar, by way of secondary meaning, after actual use and registration of 'Suka Pinakurat'.*"

Accordingly, this Bureau finds that the Respondent-Registrant's trademark registration is not falling within the definition of descriptive mark under Section 123.1 (j) of the IP Code.

WHEREFORE, premises considered, the instant petition is hereby **DISMISSED**. Let the filewrapper of Trademark Registration No. 4-2004-011237 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 05 November 2014.


Atty. **NATHANIEL S. AREVALO**
Director ~~IV~~, Bureau of Legal Affairs