

OFFICE OF THE DIRECTOR GENERAL

MANG INASAL PHILIPPINES INC.,
Appellant,

APPEAL NO. 14-2013-0052
IPC No. 14-2012-00369
Opposition to:

-versus-

IFP MANUFACTURING CORPORATION,
Appellee.

Application No. 4-2011-006098
Date Filed: 26 May 2011
Trademark: OK HOTDOG INASAL
CHEESE HOTDOG FLAVOR
LABEL MARK

x-----x

NOTICE

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Taguig City

NATHANIEL S. AREVALO
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Intellectual Property Office
Taguig City



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BY: [Signature]

GREETINGS:

Please be informed that on 15 December 2014, the Office of the Director General issued a Decision in this case (copy attached).

Taguig City, 15 December 2014.

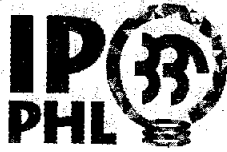
Very truly yours,

[Signature]

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OFFICE OF THE DIRECTOR GENERAL

MANG INASAL PHILIPPINES, INC.,
Opposer-Appellant,

Appeal No. 14-2013-0052

-versus-

IPC No. 14-2012-00369

Opposition to:

IFP MANUFACTURING
CORPORATION,

Application No. 4-2011-006098

Date Filed: 26 May 2011

Respondent-Appellee.

Trademark: OK HOTDOG INASAL
CHEESE HOTDOG FLAVOR
LABEL MARK

x-----x

DECISION

MANG INASAL PHILIPPINES, INC. ("Appellant") appeals the decision¹ of the Director of Bureau of Legal Affairs ("Director") dismissing the Appellant's opposition to the registration of the mark "OK HOTDOG INASAL CHEESE HOTDOG FLAVOR LABEL MARK" ("Hotdog Inasal Cheese Label Mark").

In its "APPEAL MEMORANDUM" filed on 25 October 2013, the Appellant cites the following:

GROUND S FOR THE APPEAL

I.

The BLA Director erred in ruling that Appellee's mark OK HOTDOG INASAL is not confusingly similar to Appellant's MANG INASAL marks.

II.

The BLA Director erred in ruling that confusion or mistake is unlikely since the goods covered by Appellant's registration are different from Appellee's goods, and flow through different channels of trade.

Records show that on 26 May 2011, IFP MANUFACTURING CORPORATION ("Appellee") filed Trademark Application No. 4-2011-006098 for Hotdog Inasal Cheese Label Mark for use on curls, corn, green peas, and biscuit. The trademark application was published in the Intellectual Property Office Electronics Gazette for Trademarks on 16 July 2012. Subsequently, the Appellant filed an opposition² alleging that it will be damaged by the registration of Hotdog Inasal Cheese Label Mark and that the registration of this mark is contrary to the provisions

¹ Decision No. 2013-182 dated 19 September 2013.

² NOTICE OF OPPOSITION filed on 15 October 2012.



inasalcheese

page 1

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of the Intellectual Property Code of the Philippines ("IP Code"). However, after the appropriate proceedings, the Director dismissed the Appellant's opposition. Hence, this appeal.

The Appellant argues that Hotdog Inasal Cheese Label Mark is confusingly similar to its registered "MANG INASAL" marks. The Appellant claims that the Appellee incorporates in Hotdog Inasal Cheese Label Mark the highly distinctive lettering style, color combination, and layout of the element "INASAL" present in its MANG INASAL marks and that the font design for "INASAL" in the Appellee's mark appears to be a literal copy of the design in the MANG INASAL marks. The Appellant asserts that the Appellee's adoption of an identical word and style demonstrates bad faith as it can be assumed that the Appellee is aware of the existence, use, and registration of MANG INASAL marks. According to the Appellant, given the substantial resemblance, if not identity, of the "INASAL" elements in their marks, one would inevitably be led to conclude that there is a studied attempt on the part of the Appellee to copy the Appellant's renowned MANG INASAL marks and ride on the goodwill that the Appellant has created through the years of continuous and exclusive use.

The Appellant maintains that while "INASAL" is arguably generic or descriptive in relation to barbecue products, it nevertheless has trademark rights over the particular stylized appearance of this word. The Appellant avers that while the goods covered by the Appellant's and Appellee's marks are different, they are nonetheless similar and related because both sets of goods pertain to food products and such food products contain chicken or "inasal" chicken-flavored ingredients. The Appellant states that under the doctrine of reasonable expansion of business, it should be free to use its MANG INASAL marks in goods which are within the normal potential expansion of its business. The Appellant contends that the Appellee's use of an identical "INASAL" mark will most likely mislead the purchasing public into believing that Appellee's goods are produced by, originate from or are under the sponsorship of the Appellant. The Appellant posits that the Appellee's use of Hotdog Inasal Cheese Label Mark in relation to goods which are similar and/or closely related to the Appellant's goods and services for which the MANG INASAL marks are used will take unfair advantage of, dilute the goodwill, and diminish the distinctive character or reputation of its marks.

On 18 December 2013, the Appellee filed its "COMMENT ON THE APPEAL MEMORANDUM OF OPPOSER/APPELLANT, MANG INASAL PHILIPPINES, INC." contending that its mark is not confusingly similar to the Appellant's MANG INASAL marks and that confusion or mistake is unlikely since the goods covered by the Appellant's registration are different from the Appellee's goods and flow through different channels of trade. The Appellee maintains that the only similarity of its mark with that of the Appellant's is the word "INASAL" which is descriptive and invalid as a trademark and which exclusive use was disclaimed by the Appellant in its registrations. The Appellee cites the findings of the Director that the contents of the Trademark Registry show that there are other entities that utilize "inasal" as part of their marks presented in similar font and color.



inasalcheese

page 2

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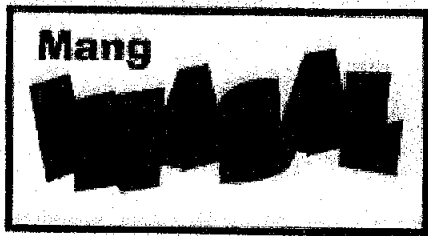
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On 06 January 2014, this case was referred to the IPOP HL Alternative Dispute Resolution (ADR) Services pursuant to Office Order No. 154, Series of 2010, Rules of Procedure for IPO Mediation Proceedings. Subsequently, on 27 January 2014, this Office received a copy of the "MEDIATOR'S REPORT" stating the termination of the mediation proceedings.

The main issue in this appeal is whether the Director was correct in dismissing the opposition to the registration of the mark Hotdog Inasal Cheese Label Mark. In this regard, the relevant question to answer is whether Hotdog Inasal Cheese Label Mark is confusingly similar to the MANG INASAL mark of the Appellant.

Below are the illustrations of the Appellant's and Appellee's marks:



Home of Real Pinoy Style Barbeque



Appellant's mark

Appellee's mark

A scrutiny of these marks shows that the word "INASAL" is their only similarity. Accordingly, the presence of this word in the Appellant's and Appellee's marks is not sufficient to conclude their confusing similarity. There are substantial differences in these marks that one will not be confused or be deceived that they are owned by the same person. There are words like "OK", "HOTDOG", and "CHEESE" and the figures of curls and cheese which are very noticeable in the Appellee's mark and which are not found in the Appellant's marks. Significantly, the Appellee's mark is a label mark which contains its name preventing any likelihood that the goods of the Appellee will be mistaken as coming from the Appellant. Hotdog Inasal Cheese Label Mark is a visible design capable of distinguishing the goods of the Appellee.

In addition, the Appellant cannot prevent the Appellee's use of "INASAL" which the Appellant itself disclaimed in its MANG INASAL marks. The Appellant's disclaimer on "INASAL" means that it is not seeking the right to exclude others from using this word. Moreover, "INASAL" being a descriptive word cannot be appropriated exclusively by the Appellant. As aptly discussed by the Director:

The so-called descriptive terms, which may be used to describe the product adequately, cannot be monopolized by a single user and are available to all. It is only natural that the trade will prefer those marks which bear some reference to the article



inasalcheese

page 3

DATE: 

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itself. Precisely for this reason, Opposer was constrained to disclaim the word "inasal" in its Certificate of Registration. This word cannot be subject of exclusive use in view of its descriptive property. In fact, the Trademark Registry of the Intellectual Property Office Philippines (IPOPIL), the contents of which this Bureau can take cognizance of via judicial notice, would disclose that there are other entities aside from Opposer and Respondent-Applicant that utilizes the word "inasal" as part of their marks presented in similar font and color.³

Regarding the Appellant's contention that its goods and services are similar and related to the Appellee's goods, this Office finds this argument untenable. The goods and services covered by the Appellant's and Appellee's marks are very different. As pointed out by the Appellee:

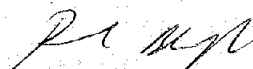
10.1. Respondent-Appellee's snacks or curls are different, non-related and non-competitive and are being sold in sari-sari stores, grocery stores, and other small distributor outlets whereas Opposer-Appellant's goods are found and particularly being offered and served in Opposer-Appellant's fastfood chains and restaurant, hence, their simultaneous existence cannot result into mistake, confusion or deception among purchasers or consumers as the 'purchaser' is not the completely unwary consumer but is the 'ordinarily intelligent buyer' considering the type of product involved and is accustomed to buy, and therefore, to some extent familiar with the goods in question.⁴

The mere fact that one person adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on unrelated articles of a different kind.⁵ In this instance, the very trademark which the Appellant is using to oppose the Appellee's trademark registration is not only used on different goods and services but has a word that itself is descriptive. Accordingly, under the circumstances of this case, the Appellee's use and registration of Hotdog Inasal Cheese Label Mark will not likely cause confusion or deception.

Wherefore, premises considered, the appeal is hereby dismissed. Let a copy of this Decision be furnished to the Director of Bureau of Legal Affairs and the Director of Bureau of Trademarks for their appropriate action and information. Further, let a copy of this Decision be furnished to the library of the Documentation, Information and Technology Transfer Bureau for records purposes.

SO ORDERED.

DEC 15 2014, Taguig City.


RICARDO R. BLANCAFLOR
Director General

³ Decision No. 2013-182 dated 19 September 2013, page 4.

⁴ COMMENT ON THE APPEAL MEMORANDUM OF OPPOSER/APPELLANT, MANG INASAL PHILIPPINES, INC. dated 18 December 2013, pages 11-12.

⁵ Esso Standard Eastern, Inc. v. Court of Appeals, G. R. No. L-29971, 31 August 1982.



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