



KABUSHIKI KAISHA BANDAI NAMCO
GAMES (ALSO TRADING AS NAMCO
BANDAI GAMES INC.),
Opposer,

-versus-

FRABELLE FISHING CORPORATION,
Respondent-Applicant.

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}
} IPC No. 14-2014-00398
} Opposition to:
} Appln Serial No. 4-2014-005410
} Date Filed: 05 May 2014
} TM: "FRABELLE FOODS
} PACMAN HOTDOGS"

NOTICE OF DECISION

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FRABELLE FISHING CORPORATION
Respondent-Applicant
1051 North Bay Boulevard
Navotas City 1485, Metro Manila

GREETINGS:

Please be informed that Decision No. 2015 - 161 dated August 04, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 04, 2015.

For the Director:


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

KABUSHIKI KAISHA BANDAI NAMCO
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} IPC NO. 14-2014-00398

} Opposition to:

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} Appln. Ser. No. 4-2014-005410

} Filing Date : 5 May 2014

} Trademark: FRABELLE FOODS

} PACMAN HOTDOGS

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DECISION

KABUSHIKI KAISHA BANDAI NAMCO GAMES (ALSO TRADING AS NAMCO BANDAI GAMES INC.), (“Opposer”)¹ filed an opposition to Trademark Application Serial No. 4-2014-005410. The application, filed by FRABELLE FISHING CORPORATION, (“Respondent-Applicant”)², covers the mark “FRABELLE FOODS PACMAN HOTDOGS”, for use on “Hotdogs and sausages, processed meat products” under Class 29 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:



“9. The mark being applied for by respondent-applicant is identical to opposer’s well-known trademark PAC-MAN, registered in the Philippines and in 40 countries, as to likely, when applied to or used in connection with the goods of the respondent-applicant, cause confusion, mistake and deception on the part of the purchasing public.



“10. The registration of the mark in the name of the respondent-applicant will violate Section 123.1, subparagraphs (d) and (f) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code), to wit:

Section 123. Registrability.-123.1. A mark cannot be registered if it:

(d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

(i) the same goods or services; or

¹ A corporation organized and existing under the laws of the Japan with address at 4-5-15, Higashi-Shinagawa, Shinagawa-Ku, Tokyo, Japan

² A domestic corporation with address at 1051 North Bay Boulevard Navotas City 1485

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.



- (ii) closely related goods or services; or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion;

xxx

(f) is identical with, or confusingly similar to, or constitutes a translation of, a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services, would indicate a connection between those goods and services, and the owner of the registered mark; Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

"11. The registration and use by respondent-applicant of the mark




will diminish the distinctiveness and dilute the goodwill of opposer's trademark PAC-MAN.



"12. The registration of the mark in the name of respondent-applicant is contrary to other provisions of the IP Code of the Philippines."

According to the Opposer:

"22. Opposer's PAC-MAN also known as  is an iconic mark that has been identified with NAMCO BANDAI GAMES INC. This is a mark that people from around the world have identified with the opposer. The mark is omnipresent in all corners of the globe. It is registered and used in practically the whole world. Both are 'well-known' marks as defined in both international conventions as well as in the IP Code of the Philippines.

"23. Bandai Namco Games is a wholly owned subsidiary of Bandai Namco Holdings (BNHD) and specializes in management and sales of video games and other related entertainment products, while its Bandai Namco Studios subsidiaries specialize in the development of these products. It is the core company of Bandai Namco Group's Content Strategic Business Unit (Content SBU). In addition to its core publisher operations in Japan, Bandai Namco Games publishes content worldwide through different entities.

"24. PAC-MAN is a worldwide well-known videogame created in 1979 by young designer Toru Iwatani of Nameo Ltd.

"25. On July 1980, video game machines for commercial use were sold in Japan. They were called PUCK MAN at the time.

"26. On October 31, 1980, it began sale of its video game machines in USA. The contents were the same as those of Japan but the denomination of the machines was changed to PAC-MAN. After that, the denomination PAC-MAN has been used globally. The aforesaid videogame machine was a big hit globally, particularly in Japan, USA and Europe and 293,822 machines were sold between 1981 and 1987 worldwide.

"27. On May 27, 1981, it started selling videogame cartridges for console game machines Atari 2600. 7,000,000 cartridges were sold PAC-MAN game began the biggest hit in the cartridges for Atari 2600.


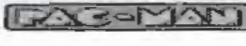
"28. In 1982, Opposer started its sale of videogame machines Ms. PAC-MAN, TV animation program PAC-MAN produced by Hanna Barbera Production was on ABC (the American Broadcasting Companies, Inc.) in USA and won 56% audience rating at its best. On the other hand, Buckner & Garcia sold phonograph records PAC-MAN Fever and achieved over a million sales in USA.

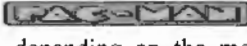
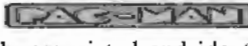
"29. In 2005, PAC-MAN game was published in The Guinness Book of Records as the most successful coin-operated game in the world.

"30. In 2010, PAC-MAN marked its 30th anniversary. From 2013, TV animation broadcasts were started and development worldwide was linked to the broadcasts, including sales of game software, arcade, game machines, network content, toys and licensed merchandise. Overseas bandai Namco Group is implementing initiatives on a Group Wide bases to further nurture PAC-MAN as a long-established IP. Up to now, development and sale of PAC-MAN series game software for many kind of game machines have been continued.

"31. The trademark PAC-MAN is also registered to opposer in various countries including Andora, Argentina, Australia, Austria, benelux, Canada, Chile, China, CTM, Denmark, Egypt, Finland, France, Ireland, Israel, Italy, japan, Korea, Macau, Malaysia, Mexico, New Zealand, Norway, Russia, Singapore, South Africa, Spain, Sweden, Switzerland, Taiwan, Thailand, Turkey, United Kingdom and United States of America.

"32. By virtue of opposer's prior trademark registrations for PAC-MAN in various jurisdictions, PAC-MAN has become distinctive of opposer's goods and business.

"33. The marks PAC-MAN and  owned by opposer are extensively used and publicized all over the world. Opposer actively and vigorously promotes and advertises its mark PAC-MAN and  through various media and venues worldwide.

"34. Opposer runs advertisements in major media markets in the world. In these advertisements, the marks PAC-MAN and  are prominently displayed or shown, either in print or video depending on the medium used. Such worldwide exposure has made PAC-MAN and  an easily-recognized mark and likewise, the mark is readily associated and identified with the opposer. xxx

"35. Opposer likewise maintains comprehensive website portals on the Internet where the online community in general can access details of its goods and services with just a mouse-click. The main portal is <http://www.bandainamcogames.com/home.html>.

"36. Opposer also promotes and advertises its mark through non-traditional forms of advertising. PAC-MAN games may be accessed and downloaded through IOS, Android and other mobile applications.

"37. Among various PAC-MAN products distributed by Opposer, PAC-MAN game application for iPhone and iPad is marketed most extensively around the world. The application may be downloaded through the following link: <https://itunes.apple.com/us/app/pac-man/id281656475?mt=8>. In addition, Opposer distributes the game application 155 countries and territories including the Philippines.

"38. Moreover, PAC-MAN is also part of the collection of the Smithsonian Institute in Washington, D.C. and New York's Museum of Modern Art. The brand PAC-Man also has the highest brand awareness among the American consumers.xxx"

To support its opposition, the Opposer submitted as evidence the following:

1. copy of Cert. of Reg. No. 4-2010-001580 for the mark "PAC-MAN";
2. copy of Cert. of Re. No. 4-2010-001581 for the mark "PAC-MANIA";
3. CD-ROM containing worldwide registrations of the mark "PAC-MAN";
4. copy of Guinness Book of Records Certificate showing "PAC-MAN" as the most successful coin-operated game in the world;
5. CD-ROM containing advertisements and promotional paraphernalia of Namco Bandai Games, Inc.;
6. copy of print-outs of the website <http://www.bandainamcogames.com/home.html>-outs
7. print-outs of website pages of Namco Bandai Games Inc;
8. List of applications and revenue generated for downloading the application PAC-MAN;
9. copy of decision in the opposition case in Korea Intellectual Property Office;
10. copy of Annual Report for 2014;
11. notarized and legalized affidavit of Satoshi Oshita, dated 22 Oct. 2014; and
12. notarized and legalized affidavit of Satoshi Oshita, dated 22 Oct. 2014.⁴

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 21 November 2014. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark FRABELLE FOODS PACMAN HOTDOGS?

Records show that at the time Respondent-Applicant filed its trademark application, the Opposer already has existing registrations for the marks PAC-MAN and PAC-MANIA under Cert. of Reg. No. 4-2010-001580 and Cert. of Reg. No. 4-2010-001581, both issued on 5 August 2010. The goods covered by the Opposer's trademark registrations are goods under Class 09, namely: "*entertainment software, computer game programs, downloadable pictures, motion pictures, movies and music, electronic publications, additional data for computer games (downloadable) and class 41, namely: "providing information about video games, computer games, amusement machines, amusement center or amusement parks through telecommunication or computer networks, providing video games, computer games, sound or images, or movies through telecommunication or computer networks."*

⁴ Exhibits "A" to "L" with submarkings

The mark applied for registration by the Respondent-Applicant contains the word PACMAN. PACMAN is a registered trademark owned by the Opposer. While this Bureau noticed that the goods indicated in the Respondent-Applicant's trademark application are not similar or closely related to those covered by the Opposer's trademark registrations, Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), states:

Section 123. Registrability.-123.1. A mark cannot be registered if it:

- (d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
 - (i) the same goods or services; or
 - (ii) closely related goods or services; or
 - (iii) **if it nearly resembles such a mark as to be likely to deceive or cause confusion;** (*Underscoring supplied*)

Thus, the proscription against trademark registration applies even when the goods and/or services covered are not similar or closely related, if the resemblance between the marks involved is "*likely to deceive or cause confusion*".

In this regard, "PACMAN" is an invented word and hence, is a fanciful trademark and therefore highly distinctive. As pointed out by the Opposer in its Verified Notice of Opposition:

"24. PAC-MAN is a worldwide well-known videogame created in 1979 by young designer Toru Iwatani of Nameo Ltd.

"25. On July 1980, video game machines for commercial use were sold in Japan. They were called PUCK MAN at the time.

"26. On October 31, 1980, it began sale of its video game machines in USA. The contents were the same as those of Japan but the denomination of the machines was changed to PAC-MAN. After that, the denomination PAC-MAN has been used globally. The aforesaid videogame machine was a big hit globally, particularly in Japan, USA and Europe and 293,822 machines were sold between 1981 and 1987 worldwide.

"27. On May 27, 1981, it started selling videogame cartridges for console game machines Atari 2600. 7,000,000 cartridges were sold PAC-MAN game began the biggest hit in the cartridges for Atari 2600.

"28. In 1982, Opposer started its sale of videogame machines Ms. PAC-MAN, TV animation program PAC-MAN produced by Hanna Barbera Production was on ABC (the American Broadcasting Companies, Inc.) in USA and won 56% audience rating at its best. On the other hand, Buckner & Garcia sold phonograph records PAC-MAN Fever and achieved over a million sales in USA."

The Opposer advertised the mark PAC-MAN⁵ in various media and has received an award from the Guinness World Records⁶ as the most successful coin operated game in history. A print-out of its internet advertising⁷ is depicted below:



Succinctly, if the Respondent-Applicant use the unique and famous mark of the Opposer in its products, it is likely that the consumers will have the impression that these goods originate from a single source or origin, albeit used on goods/products of a different class. In fact, the Respondent-Applicant did not only appropriate the word PACMAN, it even presented the word in font style that mimics the manner in which the Opposer's mark and videogame PACMAN is presented in advertising. This would have the likely effect on consumers believing that there is a connection between the parties, such as in licensing agreement, when in fact there is none. As held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁸

Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁹

⁵ Exhibit "E" to "G"

⁶ Exhibit "D"

⁷ Exhibit "F"


⁸ *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁹ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-005410 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 04 August 2015.



Atty. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs