

NUTRI-ASIA INC.,
Opposer,

-versus-

FRESH FRUIT INGREDIENTS, INC.,
Respondent-Applicant.

X-----X

} **IPC No. 14-2011-00491**
} Opposition to:
} Appln. Serial No.4-2009-010832
} Date filed: 22 October 2009
} **TM: "FIESTA BRANDS AND**
} **DEVICE (BLACK AND WHITE)"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 268 dated November 10, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 10, 2015.

For the Director:


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

NUTRI-ASIA, INC.,
Opposer,

- versus -

FRESH FRUIT INGREDIENTS, INC.,
Respondent-Applicant.
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IPC No. 14-2011-00491
Opposition to:

Appln. Serial No. 4-2009-010832
Date filed: 22 October 2009
Trademark: "FIESTA BRANDS AND
DEVICE (BLACK AND WHITE)"

Decision No. 2015 - 268

DECISION

NUTRI-ASIA, INC. ("Opposer"),¹ filed a verified opposition to Trademark Application Serial No. 4-2009-010832. The application, filed by FRESH FRUIT INGREDIENTS, INC., ("Respondent-Applicant")², covers the mark "FIESTA BRANDS AND DEVICE (BLACK AND WHITE)" for use on goods under the following classes³: **29** namely, *desiccated coconut, coconut milk powder, coconut cream, coconut milk*; **30** namely, *preparations made from cereals, bread, biscuits, cakes pastry and confectionery, sauces*; and, **32** namely, *coconut water natural plus variants*.

The Opposer alleges the following grounds for opposition:

"I. When opposer NUTRI-ASIA merged with SAFI, it acquired the latter's rights as owner, by prior registration of the trademark 'UFC LOGO & Golden Fiesta' and 'UFC HAPI FIESTA', the dominant feature of which is 'FIESTA'. Respondent-Applicant's mark infringes on NUTRI-ASIA's (SAFI's) registered marks.

"II. The registration of Respondent-Applicant's 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' trademark will cause confusion among the relevant consuming public and will hamper the normal expansion of NUTRI-ASIA's business.

"III. The registration of Respondent-Applicant's 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' trademark will cause damage to goodwill built by SAFI upon its trademarks, which goodwill was assumed by NUTRI-ASIA under its Articles of Merger with SAFI."

The Opposer's evidence consists of the following:

1. Articles of Merger;
2. Amended Articles of Incorporation of NUTRI-ASIA;
3. Amended Articles of Incorporation of SAFI;
4. Pertinent pages of the Judicial Affidavit of Ms. Cristy Magno;
5. Photographs;

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 1052 EDSA, Magallanes Village, Makati City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

6. Print-outs of the print advertisements;
7. Compact Disk;
8. Affidavit of Atty. Lalaine Gonzalez-Camina;
9. Certificate of Registration No. 4-2007-008197;
10. Trademark Application No. D002008043453 for UFC Golden Fiesta with the Trade Mark Office of the Republic of Indonesia;
11. Trademark Application No. 8024794 for UFC Golden Fiesta with the Intellectual Property Register of Malaysia;
12. Certificate of Registration No. 4-2009-000504;
13. Trademark Application No. D002008043452 for UFC HAPi FIESTA with the Trade Mark Office of the Republic of Indonesia; and,
14. Trademark Application No. 8024795 for UFC HAPi FIESTA with the Intellectual Property Registrar of Malaysia.

On 17 May 2005, Respondent-Applicant filed its Verified Answer containing among others the following Special and Affirmative Defenses:

"Respondent-Applicant's mark will not infringe on Opposer's registered mark on the basis of the allegation that Opposer is the owner, by prior registration, of the trademark 'UFC LOGO & GOLDEN FIESTA' and 'UFC HAPi FIESTA'.

"9. The mark 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' is a mark being used by Respondent-Applicant since July 1991.

"10. On 24 September 1992, the 'FIESTA' mark was applied for registration by Mr. Paul Rene Z. Tayag for Fiesta Brands, Inc. (an affiliate of Fresh Fruit Ingredients, Inc., herein Respondent-Applicant), bearing Application Nos. 4-1992-082682 and 4-1992-082683.

"11. The mark, however, was re-filed for registration last 22 October 2009 under the name of Respondent-Applicant, as its publication was denied on 18 August 2004 due to an administrative lapse (i.e. failure to file the requisite Declaration of Actual Use).

"12. Thus, Opposer's insinuation that Respondent-Applicant's 'later' application for its 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' mark will give the latter the opportunity to ride on the invaluable goodwill that inheres in the trademarks the former has acquired is unfounded. The truth is that the mark has been used in Respondent-Applicant's business operations since the establishment of Fiesta Brands, Inc.

"13. In contrast to Opposer's continuous and uninterrupted use of its 'UFC LOGO & GOLDEN FIESTA' mark for over ten years, 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' has in fact been used by Respondent-Applicant as a brand name and as a trade name (Fiesta Brands, Inc.) since 1991. Therefore, despite Opposer's 'prior registration', it cannot be gainsaid that Respondent-Applicant has existing prior rights on the basis of the use of its 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' mark as a brand name and as a trade name.

x x x

"Respondent-Applicant's 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' mark is not confusingly similar to Opposer's 'UFC LOGO & GOLDEN FIESTA' and 'UFC HAPi FIESTA'.

Further, the registration of Respondent-Applicant's 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' mark will not cause damage to the goodwill built by Opposer upon its trademarks.

"19. Opposer maintains that 'FIESTA', the dominant feature of Respondent-applicant's 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' mark, is identical to the dominant features of its 'UFC LOGO & GOLDEN FIESTA' and 'UFC HAPi FIESTA' trademarks, and as such, the registration of the 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' mark is proscribed under Section 123.1 (d) of the Intellectual Property Code (IP Code).

"20. Respondent-applicant contends, however, that Opposer cannot simply conclude that through the application of the Dominancy Test, Respondent-Applicant's mark is, or will be, confusingly similar to those of Opposer's.

x x x

"21. The distinction between the subject mark, 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' and the marks 'UFC LOGO & GOLDEN FIESTA' and 'UFC HAPi FIESTA' is apparent upon the application of the Holistic Test, as enunciated by the Supreme Court in the case of Mead Johnson & Co. vs. N.V.J. Van Dorf Ltd., and reiterated in the case of American Cyanamid Company v. Director of Patents, x x x.

"22. A comparison of the cited marks shows readily that registration of the 'FIESTA BRANDS AND DEVICE (BLACK AND WHITE)' mark would not likely cause confusion, since they are essentially different as to the components of the marks, as well as the general depiction/representation of the marks themselves."

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

1. Secretary's Certificate;
2. Affidavit of Mr. Henry Raperoga;
3. Amended Article of Incorporation of Fresh Fruit Ingredients, Inc.;
4. General Information Sheet for the year 2011 of Fresh Fruit Ingredients, Inc.;
5. Sales Invoices of Fresh Fruit Ingredients, Inc.; and,
6. Notice of Issuance for FIESTA BRANDS AND DEVICE (BLACK AND WHITE) from the Bureau of Trademarks.

Thereafter, the preliminary conference was conducted and terminated on 03 December 2012. The parties filed their respective position papers.⁴ Hence, this decision.

Should the Respondent-Applicant be allowed to register the trademark FIESTA BRANDS AND DEVICE (BLACK AND WHITE)?

As culled from the records and evidence, the Opposer has valid and existing Registration No. 4-2007-008197 for its mark "UFC LOGO & GOLDEN FIESTA" dated 09 June 2008;⁵ and, Registration No. 4-2009-000504 for its mark "UFC HAPi FIESTA" dated 16 July 2009.⁶ It has also foreign applications of its mark in Malaysia and Indonesia.⁷ On the other hand, Respondent-Applicant filed its

⁴ Opposer filed position paper on 14 December 2012; Respondent-Applicant filed position paper on 20 December 2012.

⁵ Exhibit "I" of Opposer.

⁶ Exhibit "L" of Opposer.

⁷ Exhibits "J", "K", "M" and "N" of Opposer.

application for the mark "FIESTA BRANDS AND DEVICE (BLACK AND WHITE) on 22 October 2009.

But are the competing marks, as shown below, confusingly similar?



Opposer's Trademarks



Respondent-Applicant's Trademark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁸ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The eyes can easily see that the marks are different. The similarity between the marks manifests only in the word mark FIESTA. Such resemblance, however, is not sufficient to conclude that confusion is likely to occur.

The word "FIESTA" is a common word usually used in relation to food. The word is widely used as a trademark or part thereof. In fact, the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, shows registered marks that consist alone of the word "FIESTA"

⁸ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

for goods covering the same or related class, such as: **FIESTA** (Reg. No. 1217538 dated 05 February 2015 for classes 9, 34); **FIESTA** (Reg. No. 500102 dated 22 September 2013 for class 29); **FIESTA** (Reg. No. 5416 dated 18 September 2013 for class 29); **FIESTA** (Reg. No. 5417 dated 03 April 2013 for class 29); **FIESTA** (Reg. No. 10831 dated 08 March 2012 for classes 29, 30, 32); **FIESTA** (Reg. No. 7728 dated 31 October 2005 for class 29); and, **FIESTA** (Reg. No. 86551 dated 23 July 2001 for class 29).⁹ Other registered marks that contain the word "FIESTA" as an element or component and used also on goods under classes 29, 30 and 32 includes "FIESTA GUCAMON", "FIESTA MIXX", "ROYAL FIESTA", "FIESTA VILLAGE", "HAPPY FIESTA", "FIESTA PLATTERS", and "FIESTA FOOD". These marks are owned by entities other than the Opposer. The Respondent-Applicant also has existing registration for the mark **FIESTA TROPICALE** (Reg. Nos. 8234 dated 14 July 2011; and, 32341 dated 05 November 2007 both covering classes 29, 30 and 32)¹⁰. This only shows that the word "FIESTA" as a mark is not anymore distinctive as far as goods under classes 29, 30 and 32 are concerned.

The Opposer's marks include the words GOLDEN and HAPI in distinctive font, more noticeably accompanied by the housemark UFC which is enclosed by a figure which is stylized depiction of a cooking pot with the cover on top of the letters "UFC" and the base of the pot under the letters "UFC".¹¹ On the other hand, the Respondent-Applicant's mark consists of a stylized representation of the word FIESTA in a font design obviously diverse from that of the Opposer's. The device of two flags diagonally positioned with shadows below the word FIESTA, and enclosed in a square and the word BRANDS positioned directly below the two flags representation, and the whole components framed in a rectangle,¹² make Respondent-Applicant's mark distinct in its appearance and individuality.

Moreover, confusion or mistake, much less deception, is unlikely in this instance because the goods or service covered by Opposer's trademark registration are different from that of the Respondent-Applicant's. The Opposer's marks cover cooking oil; while the Respondent-Applicant's mark covers dessicated coconut, coconut milk powder, coconut cream, coconut milk; preparations made from cereals, bread, biscuits, cakes pastry and confectionery, sauces; and, coconut water natural plus variants. A consumer could easily discern that there is no connection between the two marks because of the mentioned stark differences of the marks and goods it cover.

Corollarily, the enunciation of the Supreme Court in the case of Mighty Corporation vs. E. & J. Gallo Winery¹³ aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. he is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

⁹ IPOPHEL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/> (last access 09 November 2015).

¹⁰ Id.

¹¹ Exhibits "I" and "L" of Opposer.

¹² Filewrapper records.

¹³ G.R. No. 154342, 14 July 2004.

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. 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.¹⁴ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-010832 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 November 2015.


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

¹⁴ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.