

SHINE TV LIMITED,
Opposer,

-versus-

RAINTREE TRI-MEDIA CORPORATION,
Respondent- Applicant.

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}
} **IPC No. 14-2011-00304**
} Opposition to:
} Appln. Serial No. 4-2011-000157
} Date Filed: 05 January 2011
} **TM: "MASTER CHEF"**

NOTICE OF DECISION

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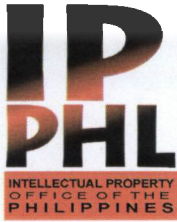
GREETINGS:

Please be informed that Decision No. 2016 - 42 dated February 09, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 09, 2016.

For the Director:

Edwin A. Dating
Atty. EDWIN DANILLO A. DATING
Director III
Bureau of Legal Affairs



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- versus -

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IPC No. 14-2011-00304
Opposition to:

Appln. No. 4-2011-000157
Date Filed: 05 January 2011
Trademark : "MASTER CHEF"

Decision No. 2016 - 42

DECISION

SHINE TV LIMITED ("Opposer"),¹ filed a verified opposition to Trademark Application Serial No. 4-2011-000157. The application, filed by RAIN TREE TRI-MEDIA CORPORATION ("Respondent-Applicant")², covers the mark "MASTER CHEF" for use on goods under classes³ **29**: *frozen prepared or packed meals consisting primarily of meat, fish poultry or vegetables; prepared food kits composed of meat, poultry fish, seafood, and/or vegetables and also including sauces or seasonings, ready for cooking and assembly as a meal; and, 43: restaurant/fast food restaurant.*

The Opposer alleges the following grounds for this instant opposition:

- "A. Opposer is the prior adopter, user and true owner of the MASTERCHEF trademarks.
- "B. Opposer's MASTERCHEF trademarks are internationally well-known.
- "C. Respondent-Applicant's MASTERCHEF mark is identical to Opposer's internationally well-known MASTERCHEF trademarks.
- "D. Since Opposer's MASTERCHEF trademarks are internationally well-known, they are entitled to protection against confusingly similar marks covering similar or related goods."

The Opposer's evidence consists of the following:

1. Duly authenticated and notarized Special Power of Attorney;
2. Affidavit Direct-Testimony of Atty. Chrissie Ann L. Barredo providing for original printout of Opposer's official website, information on Opposer's program including MasterChef, The Biggest Loser, Merlin;
3. Original printouts from the aforementioned sites;
4. Original printouts from official websites of various MASTERCHEF programs and adaptations in USA, UK, Australia and Philippines;
5. Original printout from ABS-CBN website of Junior MasterChef Pinoy Edition;

¹ A corporation organized and existing under the laws of England, with principal office at Primrose Studios, 109 Regents Park Road, London NW1 8 UR.

² With address at Penthouse Solar Century Tower No. 100 Tordesillas Cor. HV Dela Costa Streets, Salcedo 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. Original printouts containing the application and/or registration details of Opposer's MASTERCHEF trademarks;
7. MASTERCHEF Wikipedia entries;
8. Original printouts for worldwide customers' view and online purchase of MASTERCHEF merchandise and registration for cooking or baking classes showing MASTERCHEF trademarks in aprons, chef coats, cookbooks, knife sets, cake/cookie/muffin/pancake kits, t-shirts, baking and cooking classes;
9. Advertisement in The Philippine Star on 20 August 2011 of Junior MasterChef Pinoy Edition;
10. Original printouts from the official Facebook page of the aforementioned shows including online article;
11. Original printouts of the official Facebook page of upcoming show; and,
12. Online article published on Oks! News Philippines on Junior MasterChef Pinoy Edition;

On 12 January 2012, Respondent-Registrant filed its Answer containing the following special and affirmative defenses:

"I. MASTER CHEF is the shortened name of Master Chef Food Commissary Corporation which authorized Respondent-Applicant to file and prosecute the application for registration of the mark 'MASTER CHEF'.

"II. Opposer has utterly failed to adduce evidence that will support its claim of ownership over the mark 'MASTER CHEF'.

A. Opposer has not presented evidence that it is the true owner of the mark 'MASTER CHEF'.

B. Opposer has not presented evidence that its alleged 'Masterchef' trademarks are well-known internationally or in Philippines.

"III. Master Chef Commissary has vested rights in its trade name and such rights have been transferred to Respondent-Applicant.

"IV. Opposer has no cause of action since it has not shown that it is the real party in interest in the instant case.

"V. Even assuming that Opposer's 'MasterChef' trademarks are well-known, Respondent-Applicant's mark 'MASTER CHEF' is not confusingly similar or identical thereto.

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

1. Certified true copies of the Articles of Incorporation and By-Laws of the Respondent-Applicant;
2. Certified true copies of the Articles of Incorporation and By-Laws of Master Chef Commissary;
3. Annual Income Tax Return for the fiscal year ending December 2010 and the Statement of Income and Retained Earning of Master Chef Commissary as of 31 December 2010;
4. List of products sold by Master Chef Commissary;
5. Photographs of food products manufactured by Master Chef Commissary;
6. Certified true copy of Permit to Operate of Master Chef Commissary;
7. Photographs of machinery housed in the production plant of Master Chef Commissary;

8. List of some clients of Master Chef Commissary;
9. Copies of purchase orders, invoices and receipts;
10. Original, notarized Certification by Willy Tieng in relation to the mark Master Chef; and,
11. Printout of the screen for a trademark search in the name of Shine Limited conducted in the IPO website.

Should the Respondent-Applicant be allowed to register the trademark MASTER CHEF?

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 out into the market a superior 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.⁴

Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code ("IP Code") provides:

A mark cannot be registered if it:

x x x

(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;

Records show that the Respondent-Applicant has prior-dated trademark application for MASTER CHEF on 05 January 2011.⁵ The Opposer, on the other hand, filed its application for the registration of its trademark MASTERCHEF in the Philippines on 10 February 2012, and was issued registration on 25 October 2012 for classes 9 and 41.⁶ It also has pending application for classes 35 and 43 dated 25 June 2015.⁷ Opposer has likewise shown various foreign registrations of its mentioned trademark for all the mentioned classes.⁸

The competing marks are hereby reproduced below for comparison:



Opposer's Trademarks

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

⁵ Filewrapper Records.

⁶ Philippine Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/> (Last accessed 09 February 2016).

⁷ Id.

⁸ Exhibits "G" to "G-6", "H" to "H-5", "I" to "I-4", "K" to "K-6", "L" to "L-10", "P-9" to "P-28" of Opposer.

MASTER CHEF

Respondent-Applicant's Trademark

The competing marks are identical in all aspects. The difference in the font or letter design is not sufficient to distinguish the two marks.

Thus, the competing marks being used on goods that are similar or closely related to each other, and which cater to same cluster of purchasers and flow on the same channels of trade, particularly that falling under Classes 29 and 43.⁹ Thus, it is likely that the consumers will have the impression that these goods or products originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:¹⁰

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily 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. Hence, 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 which, in fact does not exist.

The public interest, therefore, requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that the function of 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.¹¹

It is stressed that the Philippines implemented the TRIPS Agreement when the IP Code took into force and effect on 01 January 1998. Art. 15 of the TRIPS Agreement reads:

Section 2: Trademarks
Article 15
Protectable Subject Matter

1. Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words, including personal names, letters, numerals, figurative

⁹ Opposer's class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; and class 43: restaurant, cafes; snack bars; provision of food and drink; provision of temporary accommodation.

Respondent-Applicant's class 29: Frozen prepared or packed meals consisting primarily of meat, fish, poultry or vegetables; prepared food kits composed of meat, poultry fish, seafood, and/or vegetables and also including sauces or seasonings, ready for cooking and assembly as a meal; and, class 43: restaurant/fast food restaurant.

¹⁰ Converse Rubber Corporation v. Universal Rubber Products Inc., et al., G.R. No. L-27906, 08 Jan. 1987.

¹¹ Pribhdas J.Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

elements and combinations of colours as well as any combination of such signs, shall be eligible for registration of trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, members may make registrability depend on distinctiveness acquired through use. Member may require, as a condition of registration, that signs be visually perceptible.

2. Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provision of the Paris Convention (1967).
3. Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.
4. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.
5. Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.

Article 16 (1) of the TRIPS Agreement states:

1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights prescribed above shall not prejudice any existing prior rights, not shall they affect the possibility of Members making rights available on the basis of use.

Significantly, Sec. 121.1 of the IP Code adopted the definition of the mark under the old Law on Trademark (Rep. Act No. 166), to wit:

121.1. "Mark" means any visible sign capable of distinguish the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods; (Sec. 38, R.A. No. 166a)

Sec. 122 of the IP Code states:

Sec. 122. How Marks are Acquired. - The rights in a mark shall be acquired through registration made validly in accordance with the provision of this law. (Sec. 2-A, R.A. No. 166a)

There is nothing in Sec. 122 which says that registration confers ownership of the mark. What the provision speaks of is that the rights in a mark shall be acquired through registration, which must be validly in accordance with the provision of the law.

Corollarily, Sec. 138 of the IP Code provides:

Sec. 138. Certificates of Registration. - A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and the

registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate. (Emphasis Supplied)

Clearly, it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right to registration. While the country's legal regime on trademarks shifted to a registration system, it is not the intention of the legislators not to recognize the preservation of existing rights of trademark owners at the time the IP Code took into effect.¹² The registration system is not to be used in committing or perpetrating an unjust and unfair claim. A trademark is an industrial property and the owner thereof has property right over it. The privilege of being issued a registration for its exclusive use, therefore, should be based on the concept of ownership. The IP Code implements the TRIPS Agreement and therefore, the idea of "registered owner" does not mean that ownership is established by mere registration but that registration establishes merely a presumptive right of ownership. That presumption of ownership yields to superior evidence of actual and real ownership of the trademark and to the TRIPS Agreement requirement that no existing prior rights shall be prejudiced. In *E.Y. Industrial Sales, Inc. and Engracio Yap v. Shen Dar Electricity Machinery Co. Ltd.*¹³, the Supreme Court held:

RA 8293 espouses the "first-to-file" rule as stated under Sec. 123.1(d) which states:

x x x

Under this provision, the registration of a mark is prevented with the filing of an earlier application for registration. This must not, however, be interpreted to mean that ownership should be based upon an earlier filing date. While RA 8293 removed the previous requirement of proof of actual use prior to the filing of an application for registration of a mark, proof of prior and continuous use is necessary to establish ownership of a mark. Such ownership constitutes sufficient evidence to oppose the registration of a mark.

Sec. 134 of the IP Code provides that "any person who believes that he would be damaged by the registration of a mark x x x" may file an opposition to the application. The term "any person" encompasses the true owner of the mark, the prior and continuous user.

Notably, the Court has ruled that the prior and continuous use of a mark may even overcome the presumptive ownership of the registrant and be held as the owner of the mark. As aptly stated by the Court in *Shangri-la International Hotel Management, Ltd. v. Developers Group of Companies, Inc.*

Registration, without more, does not confer upon the registrant an absolute right to the registered mark. The certificate of registration is merely a prima facie proof that the registrant is the owner of the registered mark or trade name. Evidence of prior and continuous use of the mark or trade name by another can overcome the presumptive ownership of the registrant and may very well entitle the former to be declared owner in an appropriate case.

In this instance, the Opposer proved that it is the owner of the contested mark. It has submitted evidence relating to its ownership, company growth and programs.¹⁴ It has shown evidence of actual use and adoption of its mark both locally and abroad¹⁵. Moreover, the Opposer has recounted its continuous operation through various television shows carrying the mark MasterChef¹⁶.

¹² See Sec. 236, IP Code.

¹³ G.R. No. 184850, 20 October 2010.

¹⁴ Exhibits "M" to "M-4" of Opposer.

¹⁵ Exhibits "E-7" and "P-30" of Opposer.

¹⁶ Exhibits "J" and "P" and sub-markings of Opposer.

Thus, to allow the application for registration of Respondent-Applicant is to cause confusion to the public of the presence of identical marks on goods that are covered by Opposer's mark or goods closely related thereto, it will also deprive the true and actual owner of the mark.


Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why, of the million of terms and combination of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.¹⁷

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-000157 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 February 2016.



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

¹⁷ American Wire & Cable Company v. Director of Patents, G.R. No. L-26557, 18 February 1970.