

OII HONGKONG STYLE NOODLES CORP.,  
 and MARY JOY W. EMPEDRAD,  
 Petitioners,  
 -versus-  
 PRUDENT OUTSOURCING BUSINESS  
 DEVELOPMENT CORP.,  
 Respondent- Registrant.

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IPC No. 14-2012-00336  
 Cancellation of:  
 Reg. No. 4-2010-009349  
 Date Issued: 02 June 2011  
 TM: "OI AND DEVICE"

**NOTICE OF DECISION**

**MR. ALEX EMPEDRAD**  
 President  
 OI HONGKONG STYLE NOODLES CORPORATION  
 31 Don Asterio St., Don Enrique Heights  
 Quezon City

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 Counsel for the Respondent- Registrant  
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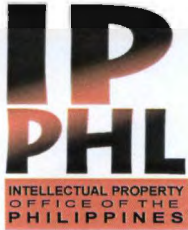
**GREETINGS:**

Please be informed that Decision No. 2016 - 107 dated April 05, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 05, 2016.

For the Director:

*Edwin O. Dating*  
**Atty. EDWIN DANILO A. DATING**  
 Director III  
 Bureau of Legal Affairs



**OI! HONGKONG STYLE NOODLES CORP.**  
**and MARY JOY W. EMPEDRAD,**  
*Petitioners,*

**IPC No. 14-2012-00336**  
Cancellation of:

- versus -

Reg. No.: 4-2010-009349  
Date Issued: 02 June 2011  
Trademark: "OI AND DEVICE"

**PRUDENT OUTSOURCING BUSINESS  
DEVELOPEMENT CORP.,**  
*Respondent-Registrant.*

Decision No. 2016 - 107

X----- X

## DECISION

OI! HONGKONG SYLE NOODLES CORP.<sup>1</sup> and MARY JOY W. EMPEDRAD<sup>2</sup> ("Petitioners"), filed a petition for cancellation of Trademark Registration No. 4-2010-009349. The registration, issued to PRUDENT OUTSOURCING BUSINESS DEVELOPMENT CORP. (Respondent-Registrant)<sup>3</sup>, covers the mark "OI AND DEVICE" for use on goods under classes<sup>4</sup> **38** namely: *advertising business*; and **16** namely: *(business) services for providing food and drinks; temporary accommodation*.

The Petitioner alleges, among others, the following:

"4. Petitioner is the registered owner of the mark 'OI! HONGKONG STYLE NOODLE' for Class 30, having a filing date of November 25, 2007, for which IPO Certificate of Registration No. 4-2007-10678 with date of registration on May 5, 2008 was issued in her name.

"5. Respondent-Registrant is a registered owner of the mark 'OI AND DEVICE' for class 35 (advertising) and class 43 (services for providing food and drink), having a filing date of August 26, 2010, for which IPO Certificate of Registration No. 4-2010-009349 with date of registration on June 2, 2011, was issued in its name.

"6. The registration of the mark 'OI AND DEVICE' in the name of the Respondent-Registrant contravenes and violates Section 123.1 (d) of the IP Code, as amended, because the said Respondent-Registrant uses the dominant 'OI!' mark that is identical with a registered mark

<sup>1</sup> A domestic corporation duly organized and existing under and by virtue of Philippine laws with place of business at No. 2 Diamond St. Southville Subd., Brgy. Holy Spirit, Quezon City.

<sup>2</sup> Of legal age, Filipino, married and with place of business at No. 2 Diamond St., Southville Subd., Brgy. Holy Spirit, Quezon City.

<sup>3</sup> A domestic corporation duly organized and existing under Philippine laws with address at Unit 511 & 611 CSR Tower, Pres. Quirino Ave., Paco, Manila.

<sup>4</sup> 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.

belonging to the Petitioner, which mark is used and not abandoned by Petitioner, in respect of the same goods or services, or closely-related goods or services, or nearly resembles Petitioner's mark as to be likely to deceive or cause confusion or mistake, as in fact, it has actually deceived and caused confusion to third persons and the public as to the origins of the goods and services.

"7. Furthermore, the registration of the mark 'OI AND DEVICE' in the name of the Respondent-Registrant contravenes and violates Section 165.2 of the IP Code, as amended, which provides for the protection of trade names, in view of the issuance of Securities and Exchange Commission Company Registration No. CS 00805515 for 'OI! HONGKONG STYLE NOODLE CORP.' on April 14, 2008 in favor of Petitioner Corporation and its incorporators.

"8. The continued registration of the mark 'OI AND DEVICE' for services under classes 35 and 43 in the name of the Respondent-Registrant will cause, as it has caused, grave and irreparable injury and damage to the Petitioner for which reason they seek the cancellation of said registration."

The Petitioner's evidence consists of the following:

1. IPO Certificate of Registration No. 4-2007-10678 for Petitioner's OI! HONGKONG STYLE NOODLE;
2. IPO Certificate of Registration No. 4-2010-009349 for Respondent-Registrant's OI AND DEVICE;
3. SEC Company Registration No. CS00805515 for OI! HONGKONG STYLE NOODLE;
4. Amended Certificate of Incorporation and SEC Official Receipt No. 0708819;
5. DTI Certificate of Registration No. 204816 for AJ SISTERS FOOD HOUSE;
6. Award Notice of SM Prime Holdings, Inc. (A.N. No. 652) issued in favor of OI! HONGKONG STYLE NOODLE CORP.;
7. List of Petitioner's owned and operated kiosks and various franchisees;
8. Demand letter and follow-up letter for Respondent-Registrant;
9. Joint Affidavit of spouses Alex Empederad and Mary Joy Empederad;
10. Joint Affidavit of spouses Primitivo Tabunot Jr. and Pamela Tabunot, including Memorandum of Agreement with Respondent-Registrant;
11. Affidavit of Patrick K. Corcuera.

On 04 December 2012, Respondent-Registrant filed its Answer containing among others the following Special and Affirmative Defenses:

"Respondent-Registrant's OI AND DESIGN MRK is not confusingly similar enough to Petitioner's OI! HONGKONG STYLE NOODLE MARK to warrant the cancellation of the registration of Respondent-Registrant.

"The use of the subject marks is not likely to cause confusion or mistake in the mind of the public as they belong to different classes.

"Petitioner's use of its registered maker is for a purpose different from the class for which they registered the same."

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

1. Secretary's Certificate;
2. Trademark Registration No. 4-2010-009349 for Respondent-Registrant's OI AND DEVICE;
3. Photos of the overall appearance of Respondent-Registrant's OI AND DEVICE;
4. Affidavit of Jessie A. Cutillas;

5. Pictures of Sari-Sari store located at Macabebe, Pampanga owned by one of the Board of Directors since the year 2000; and,
6. Barangay Certificate dated 18th of January 2000.

The Preliminary Conference was held and terminated on 01 April 2013. Thereafter, this case is submitted for decision.

Should Respondent-Registrant's trademark OI AND DEVICE be cancelled?

Section 151.1 of the IP Code<sup>5</sup> provides:

x x x A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

x x x

(b) At any time, if the registered mark becomes generic name for three goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of this Act, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. x x x

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.<sup>6</sup>

Sec. 123.1 (d) of the IP Code provides:

Sec. 123. Registrability. - 123.1. 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;**  
(Emphasis Supplied)

Records show that at the time the Respondent-Registrant was issued registration for its trademark OI AND DEVICE on 02 June 2011<sup>7</sup>, herein Petitioner has already an existing registration for its trademark OI! HONGKONG STYLE NOODLE on 05 May 2008<sup>8</sup>.

<sup>5</sup> The Intellectual Property Code of the Philippines, R.A. No. 8293.

<sup>6</sup> 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).

<sup>7</sup> File wrapper records; Exhibit "B" of Opposer.

<sup>8</sup> Exhibit "A" of Petitioner.

The following marks are hereby reproduced for comparison:



Petitioner's Trademark



Respondent-Registrant's Trademark

The contending marks contain the identical word mark "OI". Significantly, the font used in the word mark "OI" is identical. While there are differences in the totality of the marks' appearance, it appears that the junior trademark or Respondent-Registrant's mark, stemmed from that of Opposer's. With respect to the goods covered, the aforementioned marks are used on goods that are related to each other, particularly class 30 of Opposer consisting of fried noodles, siomai and other dimsum products namely siopao, sharksfin/beef/nori/pearl, siomai, chicken feet and squid/chicken/crab/fish balls; as against class 43 of Respondent-Registrant consisting of services for providing food and drinks. The fact that they are both related to food business, it is likely that the goods are catered to the same class of purchasers and to the same channels of trade. This is shown in the photographs submitted by Respondent-Registrant showing a food cart/kiosk/restaurant showing various foods for sale.<sup>9</sup>

Therefore, there is the likelihood 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:<sup>10</sup>

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.<sup>11</sup>

<sup>9</sup> Exhibits "3", "3-1" and "3-2" of Respondent-Registrant.

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

<sup>11</sup> *Pribhdas J.Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.



Finally, the contention of the Respondent-Registrant that it has first used in the Philippines way back 2000 was not substantiated by any documentary proof. There was no evidence of actual and continuous operation of its business using the mark OI AND DEVICE. The photographs of a store bearing the signage "OI SARI-SARI STORE" and the Barangay Certification are not sufficient evidence of priority in use because they are not verified, authenticated and bears no assurance of legal credibility.

**WHEREFORE**, premises considered, the instant Petition for the Cancellation of Trademark Registration No. 4-2010-009349 is hereby GRANTED. 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, 05 April 2016.

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