

**IDEAL MACARONI & SPAGHETTI
FACTORY INC.,**
Opposer,

-versus-

TERESITA T. NOLASCO,
Respondent- Applicant.

x-----x

} **IPC No. 14-2014-00113**
}
} Opposition to:
} Appln. No. 4-2013-006969
} Date Filed: 17 June 2013
} **TM: "SUNSHINE"**
}
}
}

NOTICE OF DECISION

SAPALO VELEZ BUNDANG & BULILAN
Counsel for the Opposer
11th Floor, Security Bank Centre
6776 Ayala Avenue, Makati City

WENDAM AND WENDAM LAW OFFICES
Counsel for Respondent- Applicant
14 Baguio Road, Philam Homes
Quezon City

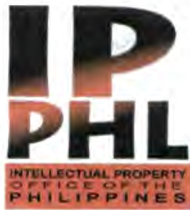
GREETINGS:

Please be informed that Decision No. 2016 - 265 dated July 28, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 28, 2016.

For the Director:

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



**IDEAL MACARONI & SPAGHETTI
FACTORY INC.,**
Opposer,

- versus -

TERESITA T. NOLASCO,
Respondent-Applicant.

X ----- X

IPC No. 14-2014-00113

Opposition to:

Appln. No.: 4-2013-006969

Date Issued: 17 June 2013

Trademark: "SUNSHINE"

Decision No. 2016 - 265

DECISION

IDEAL MACARONI & SPAGHETTI FACTORY INC. (Opposer)¹ filed a Verified Notice of Opposition to Trademark Application Serial No. 14-2013-006969. The application, filed by TERESITA T. NOLASCO (Respondent-Applicant)² covers the mark "SUNSHINE" for use on "*sauces and spices, condiments, pepper, soysauce, catsup, tomato sauce, spaghetti sauce, salt, vinegar, mixes for marinating sauce*" under class 30 of the International Classification of Goods and Services.³

The Opposer alleges the following grounds for opposition:

"1. The Opposer is the first to adopt, use, apply for and register the "SUNSHINE" trademark (in the Philippines for goods under class 30)]]. Therefore, it enjoys under Section 147 of Republic Act (R.A.) No. 8293 the right to exclude others from registering or using identical or confusingly similar mark such as Respondent-Applicant's 'SUNSHINE' mark.

"2. The Opposer's 'SUNSHINE' trademarks is well-known in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being trademarks expressly and directly referring to and owned by the Opposer.

"3. There is a likelihood of confusion between Opposer's 'SUNSHINE' trademarks and Respondent-Applicant's 'SUNSHINE' mark because the latter's mark is identical in sound, spelling and appearance to the former's 'SUNSHINE' trademarks as to likely cause confusion, mistake and deception to the public.

"4. Respondent-Applicant, by adopting the 'SUNSHINE' mark for its goods, is likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection, or association with the Opposer, or as to origin, sponsorship, supervision, authorization or approval of its products by the Opposer, for which it is liable for false designation of origin, false description or representation under Section 169 of R.A. No. 8293."

¹ A corporation existing under the laws of the Philippines with address at 33 Luna 2nd Street, San Agustin, Malabon City 1470, Metro Manila.

² With address at Gov. Pascual Street, Malabon, Metro Manila.

³ The Nice Classification of goods and services is for registering trademark 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.

Among the arguments to support these grounds are as follows:

"2.1 Since their first use, the Opposer's 'SUNSHINE' trademarks have been used, promoted and advertised for a considerable duration of time and all over wide geographical areas in the Philippines. Opposer has invested tremendous amounts of resources in the promotion of the 'SUNSHINE' and 'PREMIUM SUNSHINE SAGO & DEVICE' trademarks. x x x

"2.3 'SUNSHINE' trademarks enjoy a high degree of reputation as the identifier of the Opposer and its products. Through the years, 'SUNSHINE' products continuously earn and reap its distinction in the industry. Opposer's 'SUNSHINE' products have been identified and gained a reputation as products of high-quality, hence, from a considerable number of stores where they were first sold, Opposer's products bearing 'SUNSHINE' trademark are now available and patronized in almost all parts of the country.

x x x

"4.2 The use by Respondent-Applicant of the 'SUNSHINE' mark for its products, specifically in her 'spaghetti sauce' will definitely mislead the public into believing that its products originate from, or are licensed or sponsored by Opposer or the Respondent-Applicant is associated with or an affiliate of the Opposer.

"4.3 The flagrant and veritable imitation of herein Opposer's 'SUNSHINE' trademark is likely to cause confusion, mistake and deception to the public as to the source and origin of Respondent-Applicant's products.

"4.4 It is the resultant goodwill and popularity of Opposer's 'SUNSHINE' and 'PREMIUM SUNSHINE & SAGO DEVICE' trademarks that Respondent-Applicant wishes to exploit and capitalize. Accordingly, the use and approval for registration of Respondent-Applicant's 'SUNSHINE' trademarks are protected by law. Such will most assuredly cause the dilution and loss of distinctiveness of Opposer's 'SUNSHINE' trademarks as well as cause irreparable damage and injury to Opposer."

Opposer's evidence consists of the following:

1. Judicial affidavit of Dory Paredes, Sales Admin. Manager of IMSF;
2. Certified true copies of certificates of registration for SUNSHINE and PREMIUM SUNSHINE SAGO & DEVICE;
3. Sample products as evidence of prior use;
4. Proof of advertisements of products carrying the SUNSHINE trademarks;
5. Billings from radio stations and TV commercials;
6. Photographs of stores where their products carrying the SUNSHINE trademark are sold; and,
7. Annual Sales Report for the years 2011 to 2013 and sample duplicate invoices.⁴

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 22 September 2014. Respondent-Applicant however, did not file an answer. Thus, in Order 2015-230, Respondent-Applicant was declared in default and the case deemed submitted for decision.

Should Respondent-Applicant be allowed to register the trademark "SUNSHINE"?

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

⁴ Exhibits "A" to "J" including sub-markings.

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.⁵

Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines provides:

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; (emphasis supplied)

Records show that at the time Respondent-Applicant filed its trademark application on 17 June 2013, the Opposer already has an existing trademark for the mark “SUNSHINE” under Certificate of Registration No. 4-2010-005622 issued on 17 February 2011. The registration covers “pasta” under class 30. This Bureau notes that the Opposer’s goods are closely-related to “tomato sauce, spaghetti sauce” under class 30 which are among the goods included in Respondent-Applicant’s trademark application. The Opposer also owns the trademark “PREMIUM SUNSHINE SAGO & DEVICE” under Certificate of Registration No. 4-2003-011572 issued on 13 May 2006.

But do the competing marks, as shown below, resemble each other such that confusion or deception is likely to occur?



Opposer's Trademarks

Respondent-Applicant's Trademark

The marks show that while the Respondent-Applicant’s mark consists of plain lettering or font letter design, it is consistent with the dominant feature of Opposer’s marks bearing the word “SUNSHINE.

⁵ 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).

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.⁶ Colourable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colourable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark with that of the other mark or trade name in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.⁷

Also, considering the similarity or relatedness of goods carried by the contending marks, the consumers will have the impression that these products originate from a single source or origin or they are associated with one another. The likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:⁸

Callman[n] 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, defendants goods are then bought as the plaintiffs, and the poorer quality of the former reflects adversely on the plaintiffs reputation. The other is the confusion of business: Here though the goods of the parties are different, the defendants 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist.⁹ (emphasis and underscoring supplied)

Finally, this Bureau conforms to the pronouncements of the Supreme Court that protection of trademarks are not only limited to the particular goods in their registration but also extend to related goods and "market areas that are the normal [potential] expansion of (his) business."¹⁰ Through substantial evidence, the Opposer has established that it has exerted a considerable amount of skill and resources to build its goodwill and that they have continuously used the trademark "SUNSHINE" in commerce to market their pasta products. It is reasonable to expect that "spaghetti sauce or tomato sauce" are among the products that can be expected to be within the normal potential expansion of their business.

WHEREFORE, premises considered, the instant petition for opposition is hereby **GRANTED**. Let the filewrapper of Trademark Application No. 4-2013-006969 be returned together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 28 JUL 2016


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

⁶ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 200, 356 SCRA 207, 217.

⁷ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.

⁸ Id.

⁹ Societe des Produits Nestle, S.A. vs. Martin Dy, Jr., G.R. No. 172276, August 8, 2010 citing Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft, G.R. No. L-19906, April 30 1969.

¹⁰ Id., And see: McDonalds Corporation v. L.C. Big Mak Burger, Inc., G.R. No. 143993, August 18, 2004.