

GLOBAL QUEST VENTURES INC.,
Opposer,

-versus-

RACKEY CRYSTAL CORPORATION,
Respondent-Applicant.

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IPC No. 14-2014-00060
Opposition to:

Appln. Serial No. 4-2012-013561
Date Filed: 07 November 2012

**TM: MASTER GULAMAN
& DEVICE**

NOTICE OF DECISION

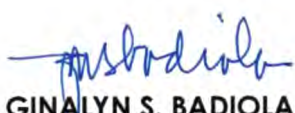
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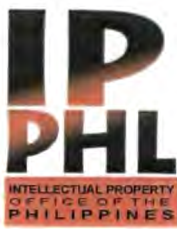
HECHANOVA BUGAY VILCHEZ & ANDAYA-RACADIO
Counsel for Respondent- Applicant
G/F Salustiana T. Dy Tower,
104 Paseo de Roxas, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 305 dated 14 September, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 14 September 2016.


Atty. GINALYN S. BADIOLA
Adjudication Officer
Bureau of Legal Affairs



GLOBAL QUEST VENTURES, INC.,
Opposer,

- versus -

RACKEY CRYSTAL TOP CORPORATION,
Respondent-Applicant.
X----- X

IPC No. 14-2014-00060
Opposition to:

Appln. No. 4-2012-013561
Date Filed: 07 November 2012
Trademark: **"Master Gulaman"
& Device**

Decision No. 2015 - 305

DECISION

GLOBAL QUEST VENTURES, INC. ("Opposer"),¹ filed an opposition to Trademark Application Serial No. 4-2012-013561. The application, filed by RACKEY CRYSTAL TOP CORPORATION ("Respondent-Applicant"),² covers the mark "Master Gulaman" & Device for use on goods under class³ 29 namely: *jelly powder*.

The Opposer alleges that it is engaged in the manufacture and sale of jelly powder mix bearing the name MR. GULAMAN and its logo design. The MR. GULAMAN name and logo are printed on the box and sachets of its products which have become well known in the market and are closely associated with Opposer. Its brand 'MR. GULAMAN' is derived from the vernacular term for jelly, which is 'gulaman.' It is prefixed by 'MR.' to underscore expertise and notoriety with respect to jellies. In its labels, the term MR. GULAMAN is preceded by the coined adjectives MEGALICIOUS which is derived from the slang superlative 'mega' and the adjective 'delicious' to describe the product's taste.

In 1996, Mr. Luis C. Chan, Opposer's VP for Marketing, conceptualized the label design MR. GULAMAN jelly powder mix products with the assistance of Edmond del Rosario of Solvic Industrial Corporation to come up with the final drawing. Opposer then asked Atty. Benjamin Irao, Jr. to deposit the design's copyright with the National Library which was issued a Copyright Certificate for the MR. GULAMAN label design in the name of Atty. Irao who later transferred the ownership of the copyrighted work to the Opposer through a Deed of Assignment. On 13 December 2006, Opposer improved the logo by adding 5 color backgrounds - orange, yellow, red, green and white which then, was deposited with the National Library the copyrights for MEGALICIOUS MR. GULAMAN.

The Opposer enumerated the following grounds for opposition: (1) Respondent-Applicant or its predecessors and agents have used Opposer's mark without its knowledge and consent to its extreme damage and prejudice; and, (2) Respondent-applicant or its predecessors and agents have been using Opposer's mark and have fraudulently applied for registration of its forms, in composite or in parts, arrogating its ownership unto itself identical marks to that of Opposer's, containing the terms 'MR.

¹ A corporation organized under the laws of the Republic of the Philippines, with principal place of business at 1841 P. Hidalgo Lim St. Malate, Manila.

² With registered address at Unit B No. 1191 Kabatuhan Street, Mapulang Lupa, Valenzuela City, Metro Manila.

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.

GULAMAN,' MEGALICIOUS.' 'MRS. GULAMAN,' and the subject of this opposition, 'MASTER GULAMAN'; and, (3) Respondent-Applicant's MASTER GULAMAN is confusingly similar with Opposer's MR. GULAMAN & DESIGN in spelling and pronunciation. Respondent-Applicant used the word 'MASTER' in its mark. It merely spelled out the contraction of the title 'MR.' and replaced 'I' in Mister with an 'A'. It also feature prominently a baker's hat. Thus, both visually and aurally, 'Master Gulaman' was designed to deceive or confuse the buying public.

The Opposer's evidence consists of the following:

1. Articles of Incorporation of Global Quest Ventures, Inc.;
2. Certificate of Copyright Registration and Deposit issued to Atty. Benjamin Irao Jr.;
3. Deed of Assignment executed by Atty. Irao;
4. Certificates of Copyright Registration and Deposit issued to Global Quest Ventures, Inc.;
5. Affidavit of Mr. Luis Chan;
6. Affidavit of Atty. Irao, Jr.;
7. Certification from Solvic Industrial Corporation of Opposer's doing business since November 1997 and printing labels with the mark 'MR. GULAMAN MEGALICIOUS
8. Sales Invoice of Opposer's sales prior to the application for registration of Respondent-Applicant; and,
9. Affidavit of Atty. Irao.

On 17 June 2014, Respondent-Applicant filed its Answer alleging among others that 'Master Gulaman' & device is not confusingly similar to 'Megalicious Mr. Gulaman' and logo design. A cursory glance of the two marks show that they are very distinct from and not confusingly similar with each other. In the mark 'Megalicious Mr. Gulaman' and device, the dominant feature is the device consisting of a chef presenting a plateful of red jelly, while in the mark 'Master Gulaman' the dominant feature is the word 'Master' written in specialized font. When spoken, the mark 'Megalicious Mr. Gulaman' is clearly different from 'Master Gulaman'.

Respondent-Applicant further contended that it is the prior user and owner of the mark 'Mr. Gulaman (Stylized)' for goods under Class 29 (jelly powder), covered by Certificate of Registration No. 4-2005-004181 and 'Megalicious Mr. Gulaman Jelly Powder Mix & Device' subject of TM Application No. 4-2006-004181 and TM Application No. 4-2006-002157. It was pointed further that the only issue before this Honorable Bureau, and the only issue cognizable by it, is whether or not the marks 'Megalicious Mr. Gulaman' and device and 'Master Gulaman' and device subject of the present opposition case are confusingly similar. The issue of ownership of the mark '(Megalicious) Mr. Gulaman' and device has already been passed upon by the IPO in two previous inter-partes cases, which are now pending appeal with the Court of Appeals. In fact, IPC Case No. 14-2006-00121, one of the cases pending in the Court of Appeals, was decided solely on the evidence of the Opposer, after the Answer was not duly admitted.

By way of its Special and Affirmative Allegations, Respondent-Applicant alleged among others that the copies of the sales invoices attached to the instant Verified Opposition are mere photocopies and not originals. The authenticity and validity of said invoices, which on its face were clearly tampered, are questioned by Respondent in IPC Case No. 14-2006-00121 as to the production of the original documents and the tampering of said invoices. Further,

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

1. Special Power of Attorney;
2. Secretary's Certificate;



3. Details of Trademark Registration No. 4-2005-004181 for "Mr. Gulaman (Stylized)"; and Trademark Application No. 4-2006-002157 for "Megalicious Mr. Gulaman Jelly Powder Mix & Device";
4. Details of Trademark Registration Nos. 4-2004-011095 for Master Chef; 4-1986-41285 for Mr. Chef; and, 4-2006-13429 for Mister Chef's;
5. Details of Trademark Registration Nos. 4-2009-008615 for Master Burger; and, 2011-012073 for Mr. Burger;
6. Copy of the Petition for Cancellation of Trademark Registration No. 4-2005-004181;
7. Sample of Opposer's packaging;
8. Product packaging by Bendum Trading since 2004;
9. Opposer's letter to the Director General of the IPO dated 20 February 2006;
10. Certificate of Copyright Registration for the work MR. GULAMAN (w/Logo Design);
11. Deed of Assignment executed by Mr. Irao;
12. Answer dated 27 June 2007; and,
13. Certification from the Notarial Section, Office of the Clerk of Court;

Thereafter, the Opposer and the Respondent-Applicant filed its position papers on 22 September 2014 and 18 September 2014, respectively. Hence, this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark **MASTER GULAMAN & DEVICE**?

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

The competing marks are reproduced below for comparison:



Opposer's Trademark



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

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).

Just

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.⁵ 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 Opposer's mark contain the word marks MEGALICIOUS and MR. GULAMAN, illustrated in distinct display of colors, with a device of a chef in toque, which is half drawn and showing only the top portion of the chef's toque below the head/face figure of a man, holding a white plate of red jelly or gulaman. On the other hand, Respondent-Applicant's mark contain the word marks MASTER and GULAMAN with no claim of color/s and consisting of a device of a cloud-like representation which appears as a chef's toque. Comparing the visual representation of both marks, they appear distinct to each other and has relatively independent creative concepts. The fonts adopted by both marks are unique and exceptional to the contending marks. The word mark GULAMAN, a vernacular term or Tagalog translation of "jelly", being a generic name for the goods it seek to identify, is not registrable or cannot be subject of appropriation.⁶ In addition, the word marks "MR." and "Master" have different meanings and pronunciation. Thus, the total presentation of the contending products bearing their respective marks⁷ demonstrates diverse individualities and creates divergent impression to the public, unlikely to cause confusion, mistake or deception to the ordinary purchasers.

In this regard, the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, consist of registered trademarks which illustrates word marks that contain "MR.", "Mister", and "Master" with the combination of the same word covering the same classification of goods but under different registered owners, such as: "**MASTER CHEF**" (Reg. No. 4-2004-0111095 under Joseph O. Yao); "**MR. CHEF**" (Reg. No. 4-1986-41285 under Haaree Foods, Inc.); *and*, "**Mister Chef's**" (Reg. No. 4-2006-13429 under Noel N. Barraquio)⁸; "**MASTER BURGER**" (Reg. No. 4-2009-008615 under Unified Sango Asiafoods Corporation); and "**Mr. Burger!**" (Reg. No. 2011-012073 under Quantum Global Food Concepts, Inc.)⁹; "**Master PizzaMan**" (Reg. No. 4-2009-004141 under Raymundo A. Almoneda); and "**Mr. Pizza**" (Reg. No. 2004-004529 under Joel F. Romana)¹⁰ These marks cover the same classification 30 of goods.

Hence, to sustain this opposition solely on the ground that the competing marks both contain the word "**GULAMAN**" would have the unintended effect of giving the Opposer exclusive use of the same, despite the difference or unrelated character of the over-all appearance of the marks.

The contention of the Opposer that this Bureau has rendered a decision in its favor for the marks "MEGALICIOUS MR. GULAMAN & DEVICE"¹¹ and "MR. GULAMAN AND DEVICE"¹² to bar the application for registration of Sharmaine Medina¹³, finds no merit in this instant case. While the

⁵ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

⁶ Sec. 123.1 (h), IP Code.

⁷ Exhibits "14, "15" and "16" of Respondent-Applicant.

⁸ Exhibits "3", "3-a" and "3-b" of Opposer; IPOPHL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/>

⁹ Exhibits "4" and "4-a" of Opposer; IPOPHL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/>

¹⁰ Exhibits "5" and "5-a" of Opposer; ; IPOPHL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/>

¹¹ Verified Opposition p. 5.

¹² Verified Opposition p. 6.

¹³ Answer p. 16.

mentioned cases involve the same parties, the cause of action or the trademarks opposed are different. Moreover, there is no final order or judgment on the merits. Thus, the said decisions bear insufficient precedential value.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-013561 is hereby **DISMISSED**. 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, 14 SEP 2016



Atty. GINALYN S. BADIOLA
Adjudication Officer, Bureau of Legal Affairs