

NUTRI-ASIA, INC.,

Opposer,

-versus-

ZUFFA, LLC.,

Respondent-Applicant.

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IPC No. 14-2012-00074

Opposition to :

Appln. No. 4-2011-05719

Date Filed: 18 May 2011

TM : "UFC (Logo)"

NOTICE OF DECISION

POBLADOR BAUTISTA & REYES

Counsel for Opposer

5th Floor, SEDCCO I Building
120 Rada corner Legaspi Streets
Legaspi Village, Makati City

E.B. ASTUDILLO & ASSOCIATES

Counsel for Respondent-Applicant

10th Flr., Citibank Center
8741 Paseo de Roxas, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 346 dated October 06, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 06, 2016.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio, Taguig City
1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph

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}IPC NO. 14-2012-00074

}Opposition to:

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}Date Filed: 18 May 2011

}Trademark: UFC (Logo)

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x-----x}Decision No. 2016- 346

DECISION

NUTRI-ASIA, INC., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-05719. The application, filed by ZUFFA, LLC. (Respondent-Applicant)², covers the mark “UFC (Logo)”, for use on “Belts, bottoms, coats, dresses, gloves, jackets, lounge wear, scarves, sleepwear, socks, sweatbands, swimwear, tops, undergarments, warm up suits, footwear, namely athletic footwear, sports footwear, flip flop, sandals, sneakers, boots, headwear, namely: hats, caps, beanie hats” under Class 25 of the International Classification of Goods³.

The Opposer anchors its opposition on the following grounds:

“14. NUTRI-ASIA will be damaged by the registration of the trademark UFC (LOGO) and thus opposes the application on the following grounds:

- I. When Opposer NUTRI-ASIA merged with UFC Philippines, Inc. it acquired the latter’s rights as owner, by prior registration of the trade name ‘UFC Philippines’ and trademarks ‘UFC AND DEVICE’ and ‘UFC LABEL’. Respondent-Applicant’s mark infringes on NUTRI-ASIA’s trade name and registered marks.
- II. The registration of Respondent-Applicant’s ‘UFC (LOGO)’ 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 UFC (LOGO) trademark will cause damage to goodwill built by NUTRI-ASIA/UFC Philippines, Inc. upon its trade name and trademarks.
- IV. The registration of Respondent-Applicant’s UFC (LOGO) is unlawful under Section 165.2(b) of the IP Code and infringes upon Opposer’s business name, UFC Philippines.

¹ Philippine corporation with address at 12th Floor Centerpoint Condominium, Garnet Road corner Julia Vargas, Ortigas Center.

² A limited liability company organized and existing under the laws of the State of Nevada, USA with address at 2960 West Sahara Avenue, Las Vegas, Nevada 89102, U.S.A.

³ The Nice Classification of Goods and Services is for registering trademarks 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.

Opposer alleges, among other things, the following:

“9. In 2006, Heinz UFC Philippines, Inc. dropped ‘Heinz’ from its corporate name and became known as UFC Philippines, Inc. Again, the word ‘UFC’ was part of said corporation’s corporate and trade name apart from its holding rights to the trademark registrations for UFC AND DEVICE and UFC LABEL. Xxx

“11. The ‘UFC’ brand and trade name has achieved an iconic status in the Philippines. While it was originally used for, and was widely known as a brand for a host of products manufactured and distributed by NUTRI ASIA (doing business under the name and style of UFC Philippines) in the Philippines and abroad, the UFC brand is now used on catsup and several kinds of sauces (such as but not limited to, vinegar, soy sauce, tomato sauce and spaghetti sauce) powdered flavorings or cooking mixes, concentrated broth and seasoning, cooking oils, as well as various kinds of fruit and vegetable preserves. While NUTRI-ASIA has used ‘UFC’ brand only on food products, it has actively marketed the same using promotional items such as t-shirts and caps, among others which are goods on which Respondent -Applicant’s trademark is or will allegedly be used.

To support its opposition, the Opposer submitted as evidence the following:

1. Certificate of filing Amended Articles of Incorporation of NUTRI-ASIA, INC.,
2. Articles of Incorporation and Amended Articles of Incorporation;
3. Judicial Affidavit of Lalaine Gonzales-Camina dated 13 April 2012;
4. Assignment of Registered Trademark;
5. Copy of Certificate of Registration No. 4-1999-009590 dated 26 May 2006 for the mark “UFC AND DEVICE”;
6. Copy of Certificate of Registration No. 4-1999-009589 dated 26 May 2006 for the mark “UFC LABEL”;
7. Affidavit of Catherine Ramos dated 4 October 2012; and
8. Pictures of advertisements/promotional activities⁴

The Respondent-Applicant filed its Answer on 27 July 2012, alleging among other things, the following:

“22. Respondent-Applicant is the owner of and registrant of the marks UFC and UFC ULTIMATE FIGHTING CHAMPIONSHIP & Design in the Philippines, xxx

“23. Respondent-Applicant is also the owner of and/or registrant of and/or applicant in many trademark registrations and/or applications of the trademark UFC and other trademarks containing the UFC (‘UFC Marks’)

⁴ Exhibits “A” to “N” with submarkings

under different international classes in various countries around the world
xxx

“25. The trademark UFC was first used by Respondent’s predecessor in interest as early as 1993. Since then, the UFC marks have been largely used and have been successfully acquired distinctiveness worldwide. Around the world, various products bearing the UFC marks are known in approximately 430 million homes. UFC Sports events are seen on television in more than 130 countries, territories and jurisdictions including the Philippines. These events are aired in 19 different languages. Moreover, various products have been launched carrying the UFC brand and are now distributed worldwide by Respondent-Applicant’s licensee.

“26. Respondent-Applicant likewise maintains an official website on the internet, i.e. www.ufc.com which may be accessed by anyone with just a click of a mouse. Xxx

To support its Answer, the Respondent-Applicant submitted as evidence the following:

1. Copies of Certificates of Registration in classes 9, 28, 25, 41 of the “UFC Logo”;
2. List of a mark applications and registrations for the mark “UFC Logo”;
3. Print-out from the website of www.ufc.com;
4. Advertising expenses ledger of Respondent-Applicant;
5. Affidavit-testimony of Kirk D. Hendrick; and
6. Legalized executive vice president’s certificate.⁵

The Preliminary Conference was terminated on 14 August 2014 where both parties were directed to file their respective position papers. The Respondent-Applicant filed its position paper on 22 August 2014, followed by the Opposer's on 27 August 2014.

Should the Respondent-Applicant be allowed to register the trademark UFC (LOGO)?

Records show that at the time Respondent-Applicant applied for registration of the mark “UFC (LOGO)” the Opposer already has an existing registration for the mark UFC under Registration No. 4-1999-009590⁶ issued on 26 May 2006 for goods under class 30, namely : “Catsup, soy sauce, vinegar, fish sauce”. Respondent-Applicant’s trademark application meanwhile covers goods under class 25 specifically: “clothing and wearing apparel”.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

⁵ Exhibits “A” to “K”

⁶ Exhibit “H”

Opposer's mark

Respondent-Applicant's mark



Scrutinizing the marks, it is observed that both contain letters "U-F-C". The Opposer's mark however, depicts a representation of an earthen pot or "palayok" on top of a "potholder", with the mark UFC in the contour of a pot. On the other hand, Respondent-Applicant's mark is stylized and an acronym for "ULTIMATE FIGHTING CHAMPIONSHIP".

But even if the marks of the parties are identical, the kind, nature or type of goods upon which the marks are to be applied must be considered in determining the likelihood of confusion. The Opposer uses its mark on goods mainly under class 30, sauces, catsup etc., while the Respondent-Applicant uses its mark on clothing and wearing apparel. The channels of trade where the goods flow are worlds apart. The target market or consumers are also different, thus it is unlikely that on account of the identity of the marks UFC, the public would be vulnerable to confusion much less deception.

It is basic in trademark law that the same mark can be used on different types of goods. The Supreme Court in *Philippine Refining Co. Inc. v. Ng Sam*⁷ held:

A rudimentary precept in trademark protection is that "the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods." ¹ Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

The Supreme Court in *Canon Kabushiki Kaisha v. Court of Appeals*⁸ held:

xxx petroleum products on which the petitioner therein used the trademark ESSO, and the product of respondent, cigarettes are "so foreign to each other as to make it unlikely that purchasers would think that petitioner is the manufacturer of respondent's goods". Moreover, the fact that the goods involved therein flow through different channels of trade highlighted their dissimilarity xxx

⁷ .GR. No. L-26676 July 30, 1982

⁸ G R. 120900 July 20, 2000


Thus, the evident disparity of the products of the parties in the case at bar renders unfounded the apprehension of petitioner that confusion of business or origin might occur if private respondent is allowed to use the mark CANON."

While the Opposer argues that it also uses its UFC mark on clothing as part of its promotional and advertising activities, this Bureau believes that no damage will accrue to the Opposer. The Opposer's main business is in the food industry. Respondent-Applicant's UFC mark is indeed an acronym for "Ultimate Fighting Championship", a sporting event/entertainment event. In fact, Respondent-Applicant has also previously obtained registrations for its mark UFC LOGO for digital disks etc; and entertainment services and has advertised its events through various media. Because the marks are used on products of different nature, confusion and deception is unlikely. There is no likelihood of confusion of business. It is improbable for one who is buying or patronizing Opposer's food products to be reminded of the Respondent-Applicant's mark "UFC" which is applied on a clothing, reminiscent of its sporting events. "UFC" is not a word invented by the Opposer nor is it exclusively identified with the Opposer. The parties' respective businesses are so unrelated to even think that Opposer is producing such goods.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-005719 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 06 OCT 2016


Atty. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs