

MANG INASAL PHILIPPINES, INC.,
Opposer,

-versus-

GOLD MEDAL FOOD MANUFACTURING CO.,
Respondent- Applicant.

X-----X

IPC No. 14-2011-00407
Opposition to:
Application No. 4-2011-000382
Date Filed: 12 January 2011
Trademark: **"Ma'am inasal ang
ulam crackers label"**

NOTICE OF DECISION

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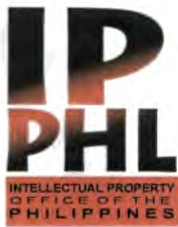
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GREETINGS:

Please be informed that Decision No. 2016 - 379 dated October 13, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 13, 2016.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



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- versus -

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ulam crackers label**"
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DECISION

MANG INASAL PHILIPPINES, INC. ("Opposer"),¹ filed a verified opposition to Trademark Application Serial No. 4-2011-000382. The application, filed by GOLD MEDAL MANUFACTURING CORP. ("Respondent-Applicant"),² covers the mark "Ma'am inasal ang ulam crackers label" for use on "*chicken flavored crackers*" under class 30 of the International Classification of Goods³

The Opposer alleges, among others, the following:

"3. The registration of the mark MA'AM INASAL is contrary to the provisions of Sections 123.1 (d), (e) and (f) of Republic Act No. 8293, as amended.

"4. The Opposer is the successor-in-interest to Mr. Edgar J. Sia II over the mark Mang INASAL Home of Real Pinoy Style Barbeque & Device -and is the current owner thereof. This mark is registered with the Philippine Intellectual Property Office ('IPO') in class 43 for restaurant services.

"5. As a registered owner of the above trademark, Opposer enjoys the exclusive right to prevent all third parties not having its consent from using in the course of trade identical or similar signs for goods which are identical or similar to those in respect of which its trademarks are registered, where such use would result in a likelihood of confusion.

"6. Respondent-Applicant's mark MA'AM INASAL is confusingly similar to the Opposer's registered mark MANG INASAL."

The Opposer's evidence consists of the following:

1. Original notarized Affidavit of Atty. Gonzalo D.V. Go III;
2. Copy of the Deed of Assignment from Edgar J. Sia II to INJAP INVESTMENTS, INC.;

¹ A company organized under the laws of the Philippines with principal address at Delgado street corner Fuentes Street, Iloilo City, Philippines.

² With address at 491 Gen. Capinpin Street, Manggahan, Pasig City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

3. Copy of the Deed of Assignment from INJAP INVESTMENTS, INC.;
4. Screen shots of the company website;
5. Representative samples of promotional materials and advertisement for the mark MANG INASAL;
6. Table showing details of the Opposer's trademark registration and/or applications for the mark MANG INASAL worldwide
7. Original printout of Philippine Trademark Registration No. 4-2006-009050 for Mang INASAL Home of Real Pinoy Style Barbeque & Device;
8. Copy of the request for recordal assignment of Mang INASAL Home of Real Pinoy Style Barbeque & Device;
9. Photograph of Respondent-Applicant's product in actual commerce;
10. Food container using Opposer's mark;
11. Sample photographs of MANG INASAL restaurant/branches;
12. Original notarized Certificate executed by William Tan Untiong; and,
13. Original notarized Secretary's Certificate executed by William Tan Untiong.

On 18 June 2012, Respondent-Applicant filed its Answer containing among others the following affirmative and/or special defenses:

"6. Respondent's Application SN 4-2011-006782 is not proscribed by Section 123.1(d) of the IP Code.

"7. Respondent's 'Ma'am inasal and ulam crackers label' mark is neither identical nor confusingly similar to Opposer's 'Mang INASAL Home of Real Pinoy Style Barbeques & Device'.
x x x

7.1 A side-by-side comparison of the reproduction of the parties' contending marks will show the visual, as well as the aural differences between them negating any likelihood of confusion.

7.2 As shown above, only the word 'INASAL' is common and/or found in the parties' contending marks. Even then, the marks of presentation in the parties' contending marks is distinctly different.

7.3 In both the parties' contending marks, the word 'INASAL' is disclaimed. x x x

7.4 The colors used and the overall commercial impression of the parties' contending marks are so different, so much so that the issue of confusion and/or deception simply does not exist.

7.5 The goods of the parties are neither identical nor closely related. While Opposer's mark is registered for 'restaurant' falling under Class 43, Respondent's label mark is being applied for registration for use on 'chicken flavored crackers' falling under Class 30."

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

1. Copy of Application SN 4-2011-000382 for Ma'am inasal ang ulam crackers label for class 30;
2. Copy of the Registrability Report with mailing date of 28 March 2011;
3. Copy of Respondent's Response dated 08 April 2011;
4. Copy of the Notice of Allowance with mailing date of 22 July 2011;
5. Print-out of Respondent's mark Ma'am inasal ang ulam crackers label;

6. Copy of the Assignment of Application SN 4-2011-000382 executed 15 May 2012 in favor of Gold Medal Food Manufacturing Corp.;
7. Actual Ma'am inasal ang ulam crackers label of Respondent-Applicant;
8. Printout of Opposer's Registration No. 4-2006-009050; and,
9. Duly notarized Affidavit of Rodolfo L. See.

Thereafter, the Preliminary Conference was conducted and terminated on 04 February 2013. Upon the filing of the Opposer and Respondent-Applicant's position papers, this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark **Ma'am inasal and ulam crackers label**?

Records reveal that at the time Respondent-Applicant filed an application for registration of the subject mark, the Opposer has a valid and existing registration of its mark "MANG INASAL HOME OF REAL PINOY STYLE BARBEQUE AND DEVICE", "MANG INASAL" and "MANG INASAL LOGO AND DEVICE (BLACK & WHITE) issued under Certificate of Registration Nos. 4-2006-009050, 4-2011-006655 and 4-2012-004769⁴, respectively.

Now, to determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the competing marks are shown below for comparison:



Opposer's Trademark



Respondent-Applicant's Trademark

When one looks at the Opposer's marks, what is impressed in the eyes and mind is the word "inasal". It is the integral component of the Opposer's "MANG INASAL" marks because it is conveyed in bold letters and positioned at the center. Upon scrutiny of Respondent-Applicant's mark, the same conclusion may be derived there from. Be that as it may, the similarity is insufficient to reach a conclusion that there may exist a confusion, much more deception. The only similarity between the two competing marks is the appropriation of the word "inasal", which describes a manner of cooking meat and therefore, descriptive. Other than this, the two competing marks are uniquely presented.

In **Societe des Produits Nestle vs. Court of Appeals**⁵, the Supreme Court explained:

⁴ IPOPhil Trademark Database, available at <http://www.wipo.int/branddb/ph/en/>.

⁵ G.R. No. 112012, 04 April 2001.

"Generic terms are those which constitute 'the common descriptive name of an article or substance,' or comprise the 'genus of which the particular product is a species' or are 'commonly used as the name or description of a kind of goods,' or 'imply reference to every member of a genus and the exclusion of individuating characters,' or 'refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product,' and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it 'forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is,' or 'if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods,' or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination". (Emphasis supplied.)

The so-called descriptive terms, which may be used to describe the product adequately, cannot be monopolized by a single user and are available to all. It is only natural that the trade will prefer those marks which bear some reference to the article itself.⁶ Precisely for this reason, Opposer was constrained to disclaim the word "inasal" in its Certificate of Registration. This word cannot be subject of exclusive use in view of its descriptive property. In fact, the Trademark Registry of the Intellectual Property Office Philippines (IPOPIL), the contents of which this Bureau can take cognizance of via judicial notice, would disclose that there are other entities aside from Opposer and Respondent-Applicant that utilizes the word "inasal" as part of their marks presented in similar font and color.

Moreover, the confusion or mistake, much more deception, is unlikely in this instance as bolstered by the fact that the goods covered by Opposer's trademark registration are different from that of the Respondent-Applicant's. Opposer's goods and/services are particular for that which are offered in their fastfood and restaurant chains. On the other hand, Respondent-Applicant's goods consists of snacks or crackers that are available in ordinary stores. They do not flow in the same channels of trade as to result to any confusion. A consumer could easily discern that there is no connection between the snacks or crackers offered by Respondent-Applicant and the meals offered by the Opposer in its restaurants.

Corollarily, the enunciation of the Supreme Court in the case of **Mighty Corporation vs. E. & J. Gallo Winery**⁷ aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. he is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

Finally, 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 into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are

⁶ Ong Ai Gui vs. Director of Philippine Patent Office, G.R. No. L-6235, 28 March 1955.

⁷ G.R. No. 154342, 14 July 2004.

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.⁸ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-000382, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. **13 OCT 2016**



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

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.