

**KRAFTS FOOD GLOBAL BRANDS, LLC.,**  
Opposer,

**-versus-**

**HUAN SIEK T. SY,**  
Respondent- Applicant.

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**IPC No. 14-2010-00006**  
Opposition to:  
Appln. Serial No. 4-2007-009027  
Date Filed: 21 August 2007  
**TM: "PEANUT CHEF  
CARTOON CHARACTER"**

**NOTICE OF DECISION**

**ORTEGA, DEL CASTILLO, BACORRO  
ODULIO, CALMA & CARBONELL**  
Counsel for the Opposer  
5<sup>th</sup> & 6<sup>th</sup> Floors, ALPAP I Bldg.  
140 L.P. Leviste Street  
Salcedo Village, Makati City

**BENZON NEGRE UNTALAN  
Intellectual Property Attorneys**  
Counsel for Respondent-Applicant  
2<sup>nd</sup> Floor, SEDCCO Bldg.  
Rada cor. Legazpi Streets  
Salcedo Village, Makati City

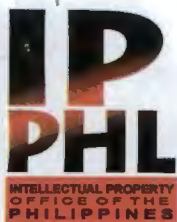
**GREETINGS:**

Please be informed that Decision No. 2016 - 487 dated December 23, 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, December 23, 2016.

**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs



**KRAFTS FOOD GLOBAL BRANDS, LLC.**  
Opposer,

-versus-

**HUAN SIEK T. SY,**  
Respondent-Applicant.

} **IPC NO. 14-2010-000006**  
} Opposition to:  
} Appln. Ser. No. 4-2007-009027  
} Date Filed: 21 August 2007  
} Trademark : **PEANUT CHEF**  
} **CARTOON CHARACTER**  
}

X-----x } Decision No. 2016 - **487**

**DECISION**

**KRAFTS FOOD GLOBAL BRANDS, LLC**, (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2007-009027. The application, filed by **HUAN SIEK T. SY** (Respondent-Applicant)<sup>2</sup>, covers the mark **PEANUT CHEF CARTOON CHARACTER**, for use on “peanut, coated peanut, fried peanut, crackernuts, corn, cornik, cornchips, chichacorn, fishcrackers, butong pakwan, greenpeas, squash seeds, pasas, biscuit, chocolate, wafer stick, milk powder, noodles, cookies, cheezecurl, corncurls, polovoron, and other related goods” under Class 30 of the International Classification of Goods<sup>3</sup>.

The Opposer relies on the following facts and grounds in support of its Opposition:

“1. Opposer is the owner of the marks Mr. Peanut and the Representation of Mr. Peanut, which have been registered by Opposer in the Philippines prior to the filing of respondent-applicant’s trademark application for the identical or confusingly similar mark Peanut Chef Cartoon Character on 21 August 2007.

“1.1. In the Philippines, an application for the registration of Opposer’s mark representation of Mr. Peanut was filed on 24 August 1998. Opposer’s mark was thereafter registered on 04 November 2002 for ‘*tortilla chips and corn chips*’ in class 29 and ‘*pretzels, cheese flavored corn snacks*’ in class 30 under Philippine Trademark Registration No. 4-1998-006371.

“1.2. Another trademark application for the Representation of Mr. Peanut was filed on 17 September 2001 and registered on 18 September 2006 for ‘*processed nuts and seeds, snack mix consisting primarily of processed fruits, processed nuts and/or raisins, and cheese and crackers combinations*’ in class

<sup>1</sup> A limited liability company organized and existing under the laws of the State of Delaware, United States of America with address at Three Lakes Drive, Northfield, Illinois 60093, U.S.A.

<sup>2</sup> Filipino with address at 209 Laureano Avendano St. Brgy. Sto. Cristo, Pulilan, Bulacan

<sup>3</sup> 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.

29, and *'snack items, baked or fried, of a cheese, cereal or vegetable nature, sugared nuts, glazed nuts, candied nuts, and chocolate-covered nuts'* in class 30 under Philippine Trademark Registration No. 4-2001-006970.

"1.3. Opposer is also the owner of the word mark MR. PEANUT, which was registered for goods in class 30 under Philippine Trademark Registration No. 031652 issued on 16 March 1983 and renewed on 16 March 2003 for *'snack foods containing cheese'*.

"1.4. The word mark MR. PEANUT was further registered under Philippine Trademark Registration No. 012429 issued on 04 August 1996 and renewed on 04 August 2006 for *'prepared nuts, namely salted nuts, sugared nuts, glazed nuts, and candy coated nuts'*.

"1.5. Such prior registration for the trademarks representation of Mr. Peanut and Mr. Peanut for goods in classes 29 and 30 prevents the registrations of an identical or confusingly similar mark such as respondent-applicant's Peanut Chef Cartoon Character used also for the same or related goods in class 30, namely: *'peanut, coated peanut, fried peanut, crackernuts, corn, cornik, cornchips, chicharon, fishcrackers, butong pakwan, greenpeas, squashseeds, pasas, biscuit, chocolate, wafer stick, milk powder, noodles, cookies, cheezecurl, corncurls, polvoron and other related goods'*.

"1.6. The confusing similarity of respondent-applicant's Peanut Chef Cartoon Character to Opposer's mark representation of Mr. Peanut becomes obvious especially when the two marks are juxtaposed.

"1.6.1. As can be gleaned from the illustrations above, the confusing similarities of respondent-applicant's later-filed Peanut Chef Cartoon Character to the earlier filed and registered representation of Mr. Peanut of the Opposer are as follows:

- Both marks feature similarly-sized and similarly-shaped humanized peanuts.
- Both characters wear tall hats.
- The characters bear similar facial features, and are both smiling.
- Both characters are holding a long thin black object.
- Both characters have thin black arms and legs.
- Both characters are wearing white gloves.
- Both peanut bodies have the same number and appearance of black groove marks on the same area of their lower right side.
- Both characters are wearing white socks and black shoes.

"1.6.2. The identity or confusing similarity of the Respondent-Applicant's Peanut Chef Cartoon Character to Opposer's representation of Mr. Peanut becomes even more obvious when the marks as used are examined. Photographic reproductions of the marks as used are juxtaposed below.

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"1.6.3. In addition to the similarities of respondent-applicant's Peanut Chef Character to Opposer's representation of Mr.



Peanut as outlined in the previous paragraph, the marks as they are used commercially, are extremely confusingly similar in that both characters' bodies are yellow in color, and are even of the same shade of yellow.

1.7. From the foregoing, it is apparent that the registration of an identical or confusingly similar trademark Peanut Chef Cartoon Character also for the same goods under class 30 will be a breach of the clear provision of Section 123.1 (d) of the Intellectual Property Code, which specifically provides:

Sec. 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;

"2. Moreover, Opposer's representation of Mr. Peanut is an internationally well-known mark entitled to protection.

"2.1 In 1986, a young and ambitious nineteen-year-old Italian immigrant named Amadeo Obici began selling roasted peanuts in Wilkes-Barre, Pennsylvania. In 1906, Obici and his business partner and fellow Italian immigrant, Mario Peruzzi, founded the Planters Nut & Chocolate Company ('Planters').

"2.2 Planters was a pioneer not only in its business strategy of selling brand-name whole, salted peanuts on a large scale. It also introduced, among other things, innovative vacuum-sealed eight-ounce cans of 'Cocktail Peanuts'. It also introduced a moderate-size packaging that kept the product fresh almost indefinitely.

"2.3 Planters has also created and used some of the most powerful advertising campaigns or slogans ever conceived.

"2.3.1. In 1916, Planters' golden advertising egg, the representation of Mr. Peanut ('Mr. Peanut') was born. Mr. Peanut, one of the world's most familiar commercial symbols, was created in 1916 when Planters offered a prize for the best sketch suitable for adoption as a trademark. The winning drawing turned out to be a humanized peanut with a top hat, a cane and a monocle.

"2.3.2. Mr. Peanut was first used in Planters advertising material in 1918 in a full-page advertisement in The Saturday Evening Post. Planters peanuts were the first salted peanut ever to be advertised.

"2.3.3. In 1923, Planters introduced "The Nickel Lunch" campaign, which introduced to the public that peanuts are a nourishing food and not just a snack.

"2.3.4. In 1937 to 1938, the first Mr. Peanut billboard appeared in Times Square in New York City.

“2.3.5. During the Second World War, from 1939 to 1945, Mr. Peanut was used to promote war saving stamps.

“2.3.6. After the war, in the 1950’s the first television commercials featuring Mr. Peanut were aired.

“2.3.7. From 1961 to 1965, Mr. Peanut was a star attraction at the New York World’s Fair.

“2.3.8. By 1978, Mr. Peanut and Planters had become so famous that the Peanut Pals Organization, a non-profit group dedicated to Mr. Peanut and Planters memorabilia, was founded.

“2.3.9. In 1991, in celebration of his 75<sup>th</sup> birthday, Mr. Peanut paid a visit to Capitol Hill. Some of his well-wishers included United States Senators Jim Exon, Sam Nunn and John Warner.

“2.3.10. Mr. Peanut also appeared in the 1997 Macy’s Thanksgiving Day Parade in New York City.

“2.3.11. In 1999, Mr. Peanut earned the title *Official NASCAR Snack Nut*.

“2.3.12. Planters and Mr. Peanut have even been directly referred to in the 2001 Tom Hanks movie *The Terminal*.

“2.3.13. Mr. Peanut has become so famous that in 2004, he earned a spot on Madison Avenue’s Advertising Walk of Fame.

“2.4. The representation of Mr. Peanut has been used and advertised internationally on Planters products and in various Planters advertisements for more than ninety (90) years now.

“2.4.1. Planters products bearing the representation of Mr. Peanut have been available worldwide since 1916.

“2.4.2. In the Philippines, Planters products bearing the marks Mr. Peanut and the representation of Mr. Peanut have been distributed and sold since 1948.

“2.4.3. The representation of Mr. Peanut is also extensively promoted and advertised for the various Planters products (such as Planters Dry Roasted Peanuts, Planters Roasted Almonds, Planters Honey Roasted Peanuts, Planters Cocktail Peanuts, and Planters Peanut Oil at the Planters website, <http://www.planter.com>).

“2.5. Planters products are sold and promoted extensively in the Philippines and in other countries, namely, the United States of America, Algeria, Argentina, Aruba, Australia, the Bahamas, Bahrain, Bangladesh, Barbados, Belize, Benelux, Bermuda, Bolivia, Brazil, Brunei Darussalam, Bulgaria, Burundi, Chile, China, Colombia, the Democratic Republic of Congo, Costa Rica, Croatia, Cuba, Cyprus, the Dominican Republic, Ecuador, Egypt, El Salvador, Fiji, Guatemala, Guinea, Guyana, Haiti, Honduras, Hong Kong,

Hungary, Iceland, India, Indonesia, Iran, Israel, Jamaica, Japan, Jordan, Kenya, South Korea, Kuwait, Latvia, Lebanon, Liberia, Lithuania, Macau, Madagascar, Malawi, Malaysia, the Maldives, Mauritius, Mexico, Montenegro, Morocco, Mozambique, Myanmar, Namibia, the Netherlands, New Zealand, Nicaragua, Nigeria, Norway, Oman, Pakistan, Panama, Paraguay, Poland, Qatar, Romania, Russia, Rwanda, Sao Tome & Principe Serbia, Sierra Leone, Singapore, Slovakia, Slovenia, South Africa, Sri Lanka, Sudan, Suriname, Sweden, Taiwan, Thailand, Trinidad & Tobago, Tunisia, Turkey, Uganda, United Arab Emirates, the United Kingdom, Uruguay, Venezuela, Vietnam, Yemen, and Zimbabwe.

“2.6. Planters products including those bearing the representation of Mr. Peanut rake in more than One Billion US Dollars (\$1,000,000,000.00) in annual revenue from global sales.

“2.6.1. In 2008, sales in the Philippines of Planters products including those bearing the Representation of Mr. Peanut amounted to more than One Million US Dollars (\$1,000,000.00).

“2.7. There are also at least two hundred seventeen (217) trademark registrations for the Mr. Peanut and Device or the Representation of Mr. Peanut in more than one hundred (100) countries worldwide.

“2.8. Clearly, when respondent-applicant applied for registration of its Peanut Chef Cartoon Character, Opposer had already been using and advertising the Representation of Mr. Peanut in the Philippines and internationally, and the same had already been registered in countries worldwide. It is undeniable that since its inception in 1916, Opposer’s mark has already attained the status of a well-known mark internationally and in the Philippines.

“2.9. Respondent-Applicant’s trademark application for the Peanut Chef Cartoon Character creates an identical overall impression as the Opposer’s Representation of Mr. Peanut, which clearly diminishes and dilutes the distinctiveness of Opposer’s well-known mark.

“2.10. Thus, the registration of an identical or confusingly similar trademark Peanut Chef Cartoon Character for the same goods, such as nuts and other snack food products under class 30, will be a breach of the clear provision of Section 123.1(e) of the Intellectual Property Code, which provides:

Sec. 123.1. A mark cannot be registered if it:

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

“3. Lastly, respondent-applicant’s application for the registration of the identical or confusingly similar Peanut Chef Cartoon Character device is tainted with bad faith.

“3.1. Given that Respondent-Applicant and Opposer are in the same industry, and that fact that Planters products have been sold in the Philippines

since 1948, it is highly impossible that respondent-applicant is not aware of the existence of the Opposer's mark Representation of Mr. Peanut.

"3.2. Further, respondent-applicant seeks to register the identical or confusingly similar mark Peanut Chef Cartoon Character for the same class of products in class 30 such as nuts and snack food for which Opposer uses its mark, the Representation of Mr. Peanut.

"3.3. Respondent-Applicant's Peanut Chef Cartoon Character resembles Opposer's Representation of Mr. Peanut in numerous particulars, including size and form, and presents an identical overall impression closely resembling Opposer's mark.

"3.4. Respondent-Applicant's actual commercial use of its Peanut Chef Cartoon Character in the same class 30 for which the Representation of Mr. Peanut is registered and used by Opposer, is such that it is likely to deceive or cause confusion to the public that respondent-applicant's products are related to or sponsored by the Opposer.

"3.5. These badges of bad faith indicate that respondent-applicant was aware of the use of the Representation of Mr. Peanut in the market, and despite such knowledge, applied for the registration of the identical or confusingly similar mark Peanut Chef Cartoon Character."

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

1. Copy of 2008 Kraft Sheet;
2. Print-out of <http://www.kraftfoodscompany.com/About/hsitory/index.aspx>
3. Copy of "The Story of Planters Nuts, an issuance of the Planters Public Relations Department;
4. Print-out of <http://www.planters.com/hsitory.aspx>;
5. Print-out of <http://www.peanutpals.org>;
6. Print-out of <http://www.macys.com/campaign/parade/parade/jsp>;
7. List of worldwide trademark registrations of Mr. Peanut and Device;
8. Certified true copy of trademark registrations in the following countries: United States of America, United Kingdom, Australia, Singapore, China, Egypt, Hong Kong, Korea, Russian Federation, South Africa and Kenya for the mark "MR. PEANUT & REP. OF MR. PEANUT";
9. Certified true copy of Trademark Registration No. 4-1998-06371 for the mark "MR. PEANUT & REP. OF MR. PEANUT" dated 4 November 2002; g4
10. Certified true copy of Trademark Registration No. 4-2001-006970 for the mark "REP. OF MR. PEANUT" dated 18 September 2006; g5
11. Certified true copy of Trademark Registration No. 31652 dated 16 March 1983;
12. Certified true copy of Trademark Renewal Registration No. 12429 dated 4 August 1966;

13. Photos of Planters products bearing the marks “MR. PEANUT & REPRESENTATION OF MR. PEANUT”;
14. Sample labels of Sugo Greaseless Peanuts
15. Print-out of <http://www.jockersfoods.com>; and
16. Affidavit of Susan H. Frohling dated 14 December 2009.<sup>4</sup>

The Respondent-Applicant filed his Answer on 31 August 2010, alleging among other things, the following:

“25. On 15 August 1989, Salome T. Alvite applied for the registration of the ‘SUGO’ Mark in the principal Register of the Bureau of Patents, Trademarks and Technology Transfer. ‘SUGO’ is a trademark that she has been using on peanut products since 12 October 1988 (date of first use in the Philippines). On 8 August 1991, the ‘SUGO’ Trademark was registered.

“26. On 18 November 1991, Salome Alvite likewise filed an application for the registration of the ‘SUGO’ Label Mark in the Supplemental Register of the Bureau of Patents, Trademarks and Technology Transfer. Registration. Registration was granted on 19 August 1992.

“27. On 2 May 2001, Salome Alvite and Respondent-Applicant entered into a Deed of Transfer. Salome Alvite who has been selling ‘SUGO’ Peanut Products through her sole proprietorship, Jocker’s –had transferred all her rights and participation in the business to Respondent-Applicant through the Deed. By virtue of the Deed of Transfer, Respondent-Applicant acquired all of Salome Alvite’s assets in relation to Jocker’s, which included the trademark registration for ‘SUGO’. As a result, the 8 August 1991 Registration for the ‘SUGO’ Mark was assigned to Respondent-Applicant.

“28. Subsequently, Respondent-Applicant obtained trademark registrations for other ‘SUGO’ Marks that have been used in the trade of ‘SUGO’ Peanut Products. The registered ‘SUGO’ Marks include ‘SUGO’ Labels, which incorporate the ‘PEANUT CHEF CARTOON CHARACTER.’ Respondent-Applicant owns trademark registrations for the following: xxx SUGO, SUGO SALTED PEANUTS LABEL, SUGO GREASELESS HOT & SPICY PEANUT LABEL MARKS xxx

“29. Respondent-Applicant also has a pending trademark application for the mark ‘SUGO GARLIC ADOBO PEANUTS LABEL’.

“30. The registered ‘SUGO’ Labels, as well as the ‘SUGO’ Label with pending application, have been used by the Respondent-Applicant in packaging its ‘SUGO’ Peanut Products. xxx Purchaser’s have come to know ‘SUGO’ written in block letters on the very top of the label; a white oval in the middle of the label, containing the name of the product variant; a photograph of peanuts in the background; and the ‘PEANUT CHEF CARTOON CHARACTER’ on the left side of the oval.

“31. From 21 October 2000 at the latest, the ‘PEANUT CHEF CARTOON CHARACTER’ has been used on the packaging of ‘SUGO’ Peanut Products. This has been attested to by Ms. Maria Thelma Ang Go, a purchasing manager who has been continuously transacting with Jocker’s. xxx

“32. The popularity of ‘SUGO’ Peanut Products in the Philippines is brought about by the massive demand for these products According to the Affidavit of Ms. Caroline S. Sy, the Finance Officer of Jocker’s, the revenues of ‘SUGO’ Peanut Products from the year 2005 up to June 2010 total to more or less 140 million.

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<sup>4</sup> Exhibits “A” to “K”, inclusive of submarkings





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“34. In paragraph 1.6.2. of the Opposition, Opposer presented an image of the ‘REPRESENTATION OF MR. PEANUT’, as it is allegedly used in the market. The image is identical to the allegedly registered ‘REPRESENTATION OF MR. PEANUT’.

“35. Opposer is guilty of misrepresentation for alleging that the first image is how the ‘REPRESENTATION OF MR. PEANUT’ is actually used in commerce. Opposer has not shown proof that the ‘PLANTERS’ Corn Chips product, from which the first image was derived, is available in commerce in the Philippines. Absent such proof, there is absolutely no basis for Opposer’s claim that the first image is how the ‘REPRESENTATION OF MR. PEANUT’ is actually used in the market.

“36. However, Respondent-Applicant affirms that the photographs in the last page of Opposer’s Exhibit ‘H’ accurately present how the ‘REPRESENTATION OF MR. PEANUT’ is actually used in the market. The last page of Opposer’s Exhibit ‘H’ shows photographs of various ‘MR. PEANUT’ Products, some of which are actually sold in the Philippine market. The photographs belie Opposer’s own allegation as to the actual usage of the ‘REPRESENTATION OF MR. PEANUT’ Mark, and it reveals Opposer’s inconsistent use of the Mark. The ‘MR. PEANUT’ Character that Opposer actually uses on its products looks different from the allegedly registered ‘REPRESENTATION OF MR. PEANUT’.

“37. To further demonstrate this point, Respondent-Applicant purchased various ‘MR. PEANUT’ Products from local supermarkets last June 2010. The purchase is evidenced by receipts attached to the Affidavit of Mr. Kissinger S. Sy. Some, but not all, of the ‘MR. PEANUT’ Products that were purchased are identical to those featured in the last page of Opposer’s Exhibit ‘H’. xxx

“38. There are three (3) ways by which Opposer uses the ‘MR. PEANUT’ Character, as exhibited in ‘SET 1,’ ‘SET 2,’ and ‘SET 3’ above. The following are comparative tables that describe how the ‘MR. PEANUT’ Character appears in each set vis-à-vis how it appears in the registered ‘REPRESENTATION OF MR. PEANUT’:

The ‘MR. PEANUT’ Character SET 1	The Registered ‘REPRESENTATION OF MR. PEANUT’
<ul style="list-style-type: none"><li>• The ‘MR. PEANUT’ Character is leaning to the left.</li></ul>	<ul style="list-style-type: none"><li>• The ‘MR. PEANUT’ Character is slightly leaning to the right.</li></ul>
<ul style="list-style-type: none"><li>• The markings (or ‘black groove marks’) in the character’s body are seen on the left side</li></ul>	<ul style="list-style-type: none"><li>• The black groove marks are on the right side.</li></ul>
<ul style="list-style-type: none"><li>• There is no definite number of black groove marks. In some labels, there are three (3), while others contain five (5).</li></ul>	<ul style="list-style-type: none"><li>• There are exactly six (6) black groove marks.</li></ul>
<ul style="list-style-type: none"><li>• The right hand of the ‘MR. PEANUT’ Character is pinching the rim of the top hat. The left hand is holding the cane to the Character’s chest.</li></ul>	<ul style="list-style-type: none"><li>• The right hand is placed at the Character’s waist, while the left hand is holding a cane to the ground.</li></ul>

<ul style="list-style-type: none"> <li>• Only the upper body of the Character is shown.</li> </ul>	<ul style="list-style-type: none"> <li>• The whole body of the Character is shown.</li> </ul>
The 'MR. PEANUT CHARACTER in Set 2	The Registered 'REPRESENTATION OF MR. PEANUT'
<ul style="list-style-type: none"> <li>• The 'MR. PEANUT' Character is slightly leaning to the left.</li> </ul>	<ul style="list-style-type: none"> <li>• The 'MR. PEANUT' Character is slightly leaning to the right.</li> </ul>
<ul style="list-style-type: none"> <li>• There is no definite number of black groove marks. In some labels, there are three (3), while others contain six (6).</li> </ul>	<ul style="list-style-type: none"> <li>• There are exactly six (6) black groove marks.</li> </ul>
<ul style="list-style-type: none"> <li>• The right hand of the 'MR. PEANUT' Character is pinching the rim of the top hat. The left hand is holding the cane to the Character's chest. Unlike in Set 1, the Character's left hand in Set 2 are showing two (2) fingers.</li> </ul>	<ul style="list-style-type: none"> <li>• The right hand is placed at the Character's waist, while the left hand is holding a cane to the ground.</li> </ul>
<ul style="list-style-type: none"> <li>• Only the upper body of the Character is shown.</li> </ul>	<ul style="list-style-type: none"> <li>• The whole body of the Character is shown.</li> </ul>
The 'MR. PEANUT/ Character in Set 3	The Registered 'REPRESENTATION OF MR. PEANUT'
<ul style="list-style-type: none"> <li>• The 'MR. PEANUT' Character is slightly leaning to the left.</li> </ul>	<ul style="list-style-type: none"> <li>• The 'MR. PEANUT' Character is slightly leaning to the right.</li> </ul>
<ul style="list-style-type: none"> <li>• The black groove marks in the Character's body are seen on the left side.</li> </ul>	<ul style="list-style-type: none"> <li>• The black groove marks are on the right side.</li> </ul>
<ul style="list-style-type: none"> <li>• There is no definite number of black groove marks. In some labels, there are three (3), while others contain four (4).</li> </ul>	<ul style="list-style-type: none"> <li>• There are exactly six (6) black groove marks.</li> </ul>
<ul style="list-style-type: none"> <li>• The right hand of the 'MR. PEANUT' Character is pinching the rim of the top hat. The left hand is holding the cane to the Character's chest.</li> </ul>	<ul style="list-style-type: none"> <li>• The right hand is placed at the Character's waist, while the left hand is holding a cane to the ground.</li> </ul>
<ul style="list-style-type: none"> <li>• Only the upper body of the Character is shown.</li> </ul>	<ul style="list-style-type: none"> <li>• The whole body of the Character is shown.</li> </ul>

"39. Opposer's juxtaposition of the 'REPRESENTATION OF MR. PEANUT' and the 'PEANUT CHEF CARTOON CHARACTER' has no value, for the reason that the 'REPRESENTATION OF MR. PEANUT', as registered, is not faithfully used on the market. The similar features, pointed out by the Opposer, between the two (2) marks are absent in actual usage: (1) the thin black legs, white socks and black shoes (the 'REPRESENTATION OF MR. PEANUT,' as actually used, only consists of the upper body of the 'MR. PEANUT' Character); and (2) the number and appearance of black

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groove marks (the 'REPRESENTATION OF MR. PEANUT', as actually used, does not have a standard number and positioning of groove marks). Opposer uses these non-existent similarities between the 'REPRESENTATION OF MR. PEANUT' and the 'PEANUT CHEF CARTOON CHARACTER' as bases for saying that there is confusing similarity between the two (2) Marks, as they are used in the market. Having rebutted the existence of these alleged similarities, it is evident that Opposer's allegations of confusing similarity holds no water.

"40. A truthful juxtaposition of the 'REPRESENTATION OF MR. PEANUT' and 'PEANUT CHEF CARTOON CHARACTER' as they are actually used, reveals more differences than similarities between the two Marks: xxx

"41. At this point, the only similarity left between the 'REPRESENTATION OF MR. PEANUT' and the 'PEANUT CHEF CARTOON CHARACTER' is the use of an image of a peanut. Respondent-Applicant submits that Opposer has no exclusive right to use an image of a peanut in its trademark. The image of a peanut is a generic device or symbol, which is available to all peanut manufacturers in designating their goods. In fact, the trademark registration of the 'REPRESENTATION OF MR. PEANUT', with registration no. 41998006371, contains a disclaimer of 'PEANUT' [see Exhibit 'G-4', Opposition], which means that the exclusive right to use the image of a peanut is being disclaimed. Hence, Opposer cannot preclude Respondent-Applicant from using an image of a peanut in the 'PEANUT CHEF CARTOON CHARACTER' mark."

The Respondent-Applicant submitted as evidence, the following:

1. Copy of trademark application form for the mark SUGO PEANUT CHEF CARTOON CHARACTER;
2. Certified true copy of Certificate of Registration No. 51132 for the mark SUGO covering the goods under class 30, peanuts;
3. Certified true copy of Certificate of Registration No. 8695 for the mark SUGO (LABEL MARK) covering goods under class 29, peanuts;
4. Deed of Transfer between Salome T Alvite and Sy Huan Siek dated 2 may 2001;
5. Certified true copy of Certificate of Registration No. 4-2006-000638 for the mark SUGO dated 15 September 2008 covering goods under class 29 and 30;
6. Certified true copy of Certificate of Registration No. 4-2006-003481 for the mark SUGO SALTED PEANUT LABEL MARK dated 21 May 2007 covering goods under class 30;
7. Certified true copy of Certificate of Registration No. 4-2006-003480 for the mark SUGO GREASELESS HOT & SPICY PEANUTS LABEL MARK dated 2 October 2009 covering goods under class 29;
8. Certified true copy of Application No. 4-2009-010613 for the mark SUGO GARLIC ADOBO PEANUTS LABEL;
9. Certified copy of Declaration of Actual Use for the SUGO SALTED PEANUT LABEL MARK dated 13 February 2009;
10. Certified copy of Declaration of Actual Use for the SUGO GREASELESS HOT & SPICY PEANUTS LABEL MARK dated 13 February 2009;
11. Affidavit of Maria Thelma Ang Go dated 27 August 2010;
12. Affidavit of Caroline S. Sy dated 16 August 2010;
13. Random samples of invoices/delivery receipts for SUGO products;
14. Affidavit of Kissinger S. Sy dated 27 August 2010; and

15. Affidavit of Simplicio Escudero dated 20 July 2010.<sup>5</sup>

The Hearing Officer issued on 14 October 2010 a notice setting the Preliminary Conference on 18 October 2010. On 17 March 2011, the Preliminary Conference was terminated, thereafter, the Hearing Officer issued on 17 May 2011 Order No. 2011-577 directing both parties to file their respective position papers. The Opposer and the Respondent-Applicant filed their position papers on 2 June 2011 and 6 June 2011 respectively.

Should the Respondent-Applicant be allowed to register the trademark PEANUT CHEF CARTOON CHARACTER?

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 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>6</sup>

Records show that at the time the Respondent-Applicant applied for registration of the mark "PEANUT CHEF CARTOON CHARACTER", the Opposer had already registered the mark MR. PEANUT & REPRESENTATION OF MR. PEANUT (Certificate of Registration No. 4-199806371)<sup>7</sup> dated 4 November 2002 and "REP. OF MR. PEANUT" (Certificate of Registration No. 4-2001-006970) dated 18 September 2006. The goods covered by the Opposer's trademark registration are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application.

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

Opposer's mark



Respondent-Applicant's mark



<sup>5</sup> Annexes "A" to "N" inclusive of submarkings

<sup>6</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

<sup>7</sup> Exhibit "G-4"

A handwritten signature or set of initials in blue ink, located in the bottom right corner of the page. The signature appears to be stylized and possibly reads "A.M." or similar.



The marks are similar in the sense that they are both humanized peanuts. According to the Opposer, both marks are similarly shaped humanized peanuts, wearing tall hats, similar smiling facial features, holding thin black objects, with thin black arms and legs, with white gloves, white socks and black shoes and groove marks on the same location of the body. The Opposer juxtaposed reproductions of the mark highlighting their characteristic yellow bodies<sup>8</sup>, as seen below:



REPRESENTATION OF MR. PEANUT



PEANUT CHEF CARTOON CHARACTER

Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. The consumers can easily see the differences between the two marks. The top hats are different with one bearing the name "MR PEANUT". One is wearing glasses while the other is not. One is holding a cane while the other is raising a kitchen utensil. The body position and angle are different. More importantly, the Respondent-Applicant has pointed out that the Opposer's REPRESENTATION OF MR. PEANUT mark is not faithfully used in the market. This Bureau finds merit in the Respondent-Applicant's observation:

"36. However, Respondent-Applicant affirms that the photographs in the last page of Opposer's Exhibit 'H' accurately present how the 'REPRESENTATION OF MR. PEANUT' is actually used in the market. The last page of Opposer's Exhibit 'H' shows photographs of various 'MR. PEANUT' Products, some of which are actually sold in the Philippine market. The photographs belie Opposer's own allegation as to the actual usage of the 'REPRESENTATION OF MR. PEANUT' Mark, and it reveals Opposer's inconsistent use of the Mark. The 'MR. PEANUT' Character that Opposer actually uses on its products looks different from the allegedly registered 'REPRESENTATION OF MR. PEANUT'.

"37. To further demonstrate this point, Respondent-Applicant purchased various 'MR. PEANUT' Products from local supermarkets last June 2010. The purchase is evidenced by receipts attached to the Affidavit of Mr. Kissinger S. Sy. Some, but not all, of the 'MR. PEANUT' Products that were purchased are identical to those featured in the last page of Opposer's Exhibit 'H'. xxx"

The Opposer's evidence which include pictures<sup>9</sup> of PLANTERS products and advertisements worldwide and in the Philippines, with the REPRESENTATION OF MR. PEANUT mark is reproduced below:



The Respondent-Applicant admits that some of the products in Exhibit "H" are present in local stores. The Respondent-Applicant was able to purchase samples of the Opposer's products<sup>10</sup> in local supermarkets bearing the REPRESENTATION OF MR. PEANUT mark as seen below:

<sup>9</sup> Exhibit "H"  
<sup>10</sup> Annex "N-4"



PLANTERS Sesame Nut Mix with Peanut & Cashews  
241 grams

A side by side comparison of the product of the Opposer bearing the REPRESENTATION OF MR. PEANUT mark, as it is depicted in the market place, with that of Respondent-Applicant's show that the contending marks are not confusingly similar. The REPRESENTATION OF MR. PEANUT mark in the actual food products are not the exact or accurate representation of the picture appearing in the Opposer's registration. The MR. PEANUT is shown in half body but still with its distinct black top hat, eyeglass, and its hand touching the rim of the black hat. On the other hand, the PEANUT CHEF CARTOON CHARACTER mark is different and depicted in an original way. When placed against the backdrop of the SUGO SALTED PEANUT LABEL MARK or SUGO GREASELESS HOT & SPICY PEANUTS LABEL MARK, the PEANUT CHEF CARTOON CHARACTER, would not result to a likelihood of confusion among the buying public because the Respondent-Applicant's mark creates a different conceptual commercial impression, as seen below:

"Exhibit N-5"



The records also show that the Respondent-Applicant has been using its mark on its "SUGO" peanut products in the Philippines since 2000 and the revenues earned proves the market demand for the "SUGO" peanut products, which label contains the PEANUT CHEF CARTOON CHARACTER mark. He has created his own niche in the

market and goodwill through the continued use of his own unique and distinct mark. Besides, "PEANUT" is disclaimed in Opposer's registrations. Thus, Opposer may not have a monopoly on the depiction of a humanized peanut, specially so that the goods being described are particularly peanuts. Clearly, based on appearance, the marks are distinguishable from each other. Finally, the evidence show that the words "PLANTERS" and "SUGO", usually accompany the "MR. PEANUT" and "PEANUT CHEF CARTOON CHARACTER" in their respective goods, which further distinguishes one product from the other, thus confusion is unlikely.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2007-009027 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, 23 DEC 2016



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