

SAN MIGUEL PURE FOODS COMPANY, INC., }
Opposer, }
 -versus- }
KING SUE HAM & SAUSAGES CO., INC., }
Respondent-Applicant. }

X-----X

IPC No. 14-2012-00564
 Opposition to:
 Appln. Serial No. 4-2012-008309
 Date Filed: 10 July 2012

TM: MALINAMHAM

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 524 dated 23 December 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, 06 January 2017.


MARILYN F. RETUAL
 IPRS IV
 Bureau of Legal Affairs

SAN MIGUEL PURE FOODS COMPANY, INC.,	} IPC NO. 14-2012-00564
Opposer,	} Opposition to:
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-versus-	} Appln. Ser. No. 4-2012-008309
	} Date Filed: 10 July 2012
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KING SUE HAM & SAUSAGE CO., INC.,	} Trademark: MALINAMHAM
Respondent-Applicant.	}
x-----x	} Decision No. 2016- 524

DECISION

SAN MIGUEL PURE FOODS COMPANY, INC. (Opposer),¹ filed an opposition to Trademark Application Serial No. 4-2012-008309. The application, filed by KING SUE HAM & SAUSAGE CO., INC. (Respondent-Applicant)², covers the mark "MALINAMHAM", for use on "frozen, refrigerated, preserved, canned, cooked, or pre-cooked processed meat falling under Class 29 only: ham, sausages, salami, pepperoni, bacon and meat loaf" under Class 29 of the International Classification of Goods³.

The Opposer based its opposition on Section 134 of Republic Act 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code") in relation to Section 123.1 par. (d) and (j) because it believes that it will be damaged by the registration of the Respondent-Applicant's mark. Section 123.1 (d) and (j) provides:

Sec. 123.1. Registrability. A 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.

x x x

- (j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended

¹ A domestic corporation with address at JMT Corporate Condominium, ADB Avenue, Ortigas Center, Pasig City

² A domestic corporation with address at 402 Tandang Sora St., 1st Ave., Grace Park, Caloocan City, 1400 Metro Manila

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.

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purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services

The Opposer alleges, among other things, the following:

“21. The mark 'Malinamham' nearly resembles 'Linam-ham', because they have the same aural/phonetic and visual similarities, as well as commercial impressions. The phonetic similarity of the marks may become the basis of finding of confusing similarity. Marks may sound the same to the ear, even though they may be readily distinguishable to the eye. xxx

“22. Although the trademark has other features, the dominant portion thereof is the term 'Linam-ham,' which in fact serves as the brand name of its products. Under the Dominancy Test, which focuses on the similarity of the main, prevalent or essential features of the competing trademarks that might cause confusion arising from the adoption of the dominant features of the registered mark, there is no doubt that the use and registration of 'Malinamham' will cause confusion because it is similar to the dominant portion of Opposer's trademark in terms of its aural, visual and commercial impressions. xxx

“34. 'Malinamham' is a phonetic equivalent of 'malinamnam,' which translates to 'delicious'. As such, 'Malinamham' should not be registered because it merely expresses a desirable quality or a characteristic of food products. Pertinently, Respondent-Applicant's application for registration refers to goods under Class 29 which consist of food items. The use of the word 'Malinamham' describes the quality of the goods and in no way distinguishes it from other goods belonging to the same class. xxx”

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

1. Verification and Certification signed by Mr. Jose Gabriel S. Cruz;
2. Special Power of Attorney signed by Atty. Alexandra B. Trillana;
3. Special Power of Attorney Mr. Jose Gabriel S. Cruz;
4. Certified copy of Certificate of Registration No. 4-2011-501274 for the mark “PUREFOODS STAR LINAM-HAM LABEL DESIGN” for “ham” under Class 29;
5. Certified true copy of Trademark Application No. 4-2012-008309;
6. Affidavit of Mr. Jose Gabriel S. Cruz;
7. Copy of Articles of Incorporation of Purefoods-Hormel Company; and
8. Sample packaging of Linam-ham⁴

⁴ Exhibits "A" to "J" inclusive of submarkings

The Respondent-Applicant filed its Answer on 21 May 2013, alleging among other things, the following affirmative defenses:

“SENIOR REGISTRANT VS. SENIOR USER

“2. Undeniably, Opposer is the senior registrant for having obtained trademark registration for its label design comprising of the words ‘Purefoods’ and ‘STAR’ in addition to ‘Linam-HAM’. But Opposer failed to establish that it is a senior user in respect of the mark MALINAMHAM, which was used in commerce by the applicant in 2009.

“3. In the Affidavit of Mr. Jose Gabriel S. Cruz, the marketing manager who managed the promotion of Purefoods Hormel products, he proffered that the nationwide sales of Purefoods Star Linam-hams amounted to Php 22,150, 176 in 2012. As no other date earlier than 2012 was alleged and claimed by the Opposer, it is a plausible presumption that the composite mark was actually used for the first time in 2012.

“4. Respondent-Applicant actually sold its MALINAMHAM hams in 2009. As proof of use, copies of sales invoices and official receipts are attached and marked xxx”

“NO LIKELIHOOD OF CONFUSION OR DECEPTION x x x

“13. At a glance, the subject mark and the Opposer’s mark are not identical nor confusingly similar, whether viewed using the holistic test or the dominancy test.

“14. In view of the aural and visual impressions conveyed by the features of the competing marks, an ordinary intelligent purchaser will not be likely deceived that MALINAMHAM resembles Opposer’s registered mark.

As per the Competing marks Actual Use in Commerce x x x

“16. At a glance, the two marks above will immediately convey to the ordinary purchaser that the marks are not the same or confusingly similar.
xxx

“NO LIKELIHOOD OF CONFUSION AS TO SOURCE OR AFFILIATION OF GOODS x x x

“21. Although there is identity in goods in respect of the goods ‘ham’ it is worthy to note that there is no identity and/or confusingly similarity between the two marks. When there are differences in their respective labels in relation to the good to which they are attached, an intelligent purchaser will not be likely led to buy Respondent-Applicant’s ham product believing that it is the Opposer’s ham product.

“22. Looking back at table 2, there is not a single word in Opposer’s composite label mark which matches Respondent-Applicant’s word mark. Needless to say, MALINAMHAM is not the same as PUREFOODS STAR LINAM-HAM’, compared one at a time as a whole.

“23. Contrary to Opposer’s imagined ‘confusion of goods’, an ordinary prudent purchaser will be able to distinguish the source and affiliation of the ham he/she is purchasing because the affiliation of the goods is already suggested/indicated in their actual labels, that is, ‘KING SUE’ for Respondent-Applicant and PUREFOODS for Opposer.

“24. As the one-word mark MALINAMHAM is clearly far different from the composite mark PUREFOODS STAR LINAMHAM Label Design, it is improper to raise confusion of goods as a valid ground to preclude the registration of the subject mark. xxx

“RESPONDENT-APPLICANT’S USE AND APPLICATION FOR REGISTRATION FOR THE MARK MALINAMHAM WAS DONE IN GOOD FAITH

“27. Opposer asserts that it has developed goodwill and good business reputation in the Philippines for over half a century (50 years). Respondent-Applicant asserts that it has also painstakingly built its goodwill and business reputation over 80 years, hence, it does not need to ride on the name of or be falsely associated with the business of Opposer. xxx

“MALINAMHAM IS NON-DESCRIPTIVE

“32. Malinamham is a coined mark consisting of the Tagalog word for delicious, which is ‘malinamham’ and the flagship product of Respondent-Applicant, which is ‘ham’. It is a unique, fanciful oneword mark which is not found in English or Tagalog dictionaries.

“33. Respondent-Applicant believes that it is entitled to obtain protection for the mark only because it is fanciful but because it was already used in commerce before Opposer obtained registration for its mark. xxx

“ESTOPPEL

“35. Opposer claims that the dominant portion of its composite mark is ‘Linam-ham’.

36. However, in Opposer’s description of the mark contained in the Certification of Registration, it was declared that the word STAR is the dominant term. The Description of the Mark is quoted below:

'A STYLIZED WORD 'STAR DOMINANTLY WRITTEN ABOVE THE TERM 'LINAMHAM WITH A FANCIFUL REPRESENTATION OF A SLICED HAM AND A SANDWICH xxx'

"37. Based from the Description, it is clear that Opposer has already declared that the dominant portion of its composite mark is 'STAR' and not 'Linam-Ham' as later alleged by the Opposer. Opposer is therefore stopped to declare otherwise. xxx"

The Respondent-Applicant submitted as evidence, the following:

1. Sample sales invoices, official receipts issued by Respondent-Applicant;
2. Sample official receipts issued by Supplier; and
3. Sample product labels/packaging of "MALINAMHAM"⁵

The Preliminary Conference was terminated on 12 September 2013 were the parties were directed to submit their position papers.

Should the Respondent-Applicant be allowed to register the trademark MALINAMHAM?

Sec. 123.1. Registrability. 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.

Records show that at the time Respondent-Applicant applied for registration of the mark "MALINAMHAM" the Opposer already registered the mark "PUREFOODS STAR LINAM-HAM LABEL DESIGN" under Certificate of Registration No. 4-2011-501274 for the goods, "ham".⁶ The goods covered by the Opposer's trademark registration are also under Class 29, same as indicated in the Respondent-Applicant's trademark application⁷.

But are the competing marks, depicted below closely resembling each other such that confusion, even deception, is likely to occur?

⁵ Exhibits "1"- "3" inclusive of submarkings

⁶ Exhibit "D"

⁷ Exhibit "E"



MALINAMHAM

Opposer's mark

Respondent-Applicant's mark

Scrutinizing the trademarks involved in this case, it is observed that both marks, are similar with respect to the eight (8) letters ("LINAMHAM"), differing only in that Respondent's mark added the prefix MA. The addition of the prefix "MA" to the Respondent-Applicant's "LINAMHAM" is negligible because when pronounced, the words LINAM-HAM and MALINAMHAM sound the same. The resultant marks when spoken are *idem sonans* or phonetically similar. The Supreme Court in the case of *Marvex Commercial Co., Inv. V. Petra Hawpia & Co. and the Director of Patents*⁸ is instructive on the matter, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS"; the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (*Co Tiong Sa vs. Director of Patents*, 95 Phil. 1 citing *Nims, The Law of Unfair Competition and Trademarks*, 4th ed., vol. 2, pp. 678-679). xxx

The following random list of confusingly similar sounds in the matter of trademarks, culled from *Nims, Unfair Competition and Trade Marks*, 1947, vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "Gold Drop"; "Jantzen" and "Jazz-Sea"; "Silver Flash" and "Supper-Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo". Leon Amdur, in his book "TradeMark Law and Practice", pp. 419-421, cites, as coming within the purview of the *idem sonans* rule, "Yusea" and "U-C-A", "Steinway Pianos" and "Steinberg Pianos", and "Seven-Up" and "Lemon-Up". In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Cordura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin", as the sound of the two names is almost the same.

In the case at bar, "SALONPAS" and "LIONPAS", when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see *Celanese Corporation of America vs. E. I. Du Pont*, 154 F. 2d. 146, 148).

Moreover, the confusing similarity is compounded by the fact that the marks are used on the same time of products under Class 29. "In fact, even their similarity in sound is taken into consideration, where the marks refer to merchandise of the same descriptive properties, for the reason that trade *idem sonans* constitutes a violation of trade mark patents." (*Sapolin Co., Inc. v. Balmaceda*, 67 Phil 705)

⁸ G.R. No. L-19297, 22 December 1966

Visually, the contending marks are similar. The Opposer's mark, LINAM-HAM is a fanciful and coined word, which is apparently a play of the *tagalog* or Pilipino word "Malinamnam" or "Linamnam", which means "palatable, delicious, savory".⁹ The syllable/word, "HAM", Opposer's goods, was appended to "LINAM". The combination is a fanciful mark conveying a flavorful ham. The Respondent-Applicant appropriated, the dominant portion of Opposer's mark, and modified it by adding the prefix, "MA", forming MALINAMHAM. One is the colorable imitation of the other. The Supreme Court in *Etepha A.G v. Director of Patents*¹⁰ held:

The phrase "colorable imitation" denotes such a "close or ingenious imitation as to be calculated to deceive ordinary persons, or such a resemblance to the original as to deceive an ordinary purchaser, giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other.


It is of no moment that other elements are contained in the Opposer's label, such as "PUREFOODS" or "STAR". Similarly, the actual label¹¹ of Respondent-Applicant indicates "KING SUE". These words are brand names that appear in the labels, yet, clearly, the Respondent-Applicant's mark, is confusingly similar to the dominant element of Opposer's mark. The Supreme Court in *American Wire & Cable Company v. Director of Patents*¹² held:

In short, to constitute an infringement of an existing trademark patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-008309 is hereby **SUSTAINED**. Let the filer wrapper 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

⁹ <https://filipinodict.com/en/tl/en/malinamnam>

¹⁰ G.R. No. L-20635, March 31, 1996

¹¹ Exhibit "3"

¹² G. R. No. L-26557, 18 February 1970