

SHINE TV LIMITED,
Opposer,

-versus-

IPC No. 14-2013-00433

Opposition to:

Appln. Serial No. 4-2013-004727

Date Filed: 27 February 2013

MARK'S CATERING & FOOD SERVICES CORP.,
Respondent-Applicant.

TM:



X-----X

NOTICE OF DECISION

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MARK'S CATERING & FOOD SERVICES CORP.

Respondent- Applicant
#15 Saint Catherine Street,
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GREETINGS:

Please be informed that Decision No. 2017 - 231 dated 19 June 2017 (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, 20 June 2017.

MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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MARK'S CATERING & FOOD
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DECISION NO. 2017 - 231

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DECISION

SHINE TV LIMITED (Opposer)¹ filed an Opposition to Trademark Application No. 42013004727. The trademark application filed by MARK'S CATERING & FOOD SERVICES CORP. (Respondent-Applicant)², covers the mark (m), for use on "*services for providing food and drink*" covered under Class 43 of the International Classification of Goods.³

The Opposer's pertinent averments in the Opposition are quoted as follows:

2. The opposer is the first user and rightful owner of the MASTERCHEF trademark and the MASTERCHEF LOGO (hereafter "M LOGO" to differentiate it from the M trademark of Respondent-Applicant)

3. The Philippines and the United Kingdom, where the Opposer is incorporated, are parties-signatories to the Paris Convention for the Protection of Industrial Property ("Paris Convention"), the Agreement on Trade-Related Aspects of Intellectual Property Rights of the World Trade Organization ("WTO"), and are members of the WTO and the World Intellectual Property Organization, which were all intended, among others, for the protection of industrial property.

¹ A corporation organized under the laws of United Kingdom with principal business address at Primrose Studios, 109 Regent's Park Road, United Kingdom NW1 8UR

² A corporation with address at _____

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.

4. The Opposer brings the present action pursuant to Section 2, Article II of the Philippine Constitution, which provides that the Philippines adopts, among others, the generally accepted principles of international law as part of the law of the land and adheres to the policy of peace, equality, justice, freedom, cooperation and unity with all nations. Furthermore, Sections 3 and 160 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), grant a right in favor of the Opposer to seek redress before this Honorable Office insofar as it states that:

Sec. 3. International Conventions and Reciprocity. - Any person who is a national or who is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law, shall be entitled to benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by this act.

... ..
Section 160. Right of Foreign Corporation to Sue in Trademark or Service Mark Enforcement Action. Any foreign national or juridical person who meets the requirements of Section 3 of this Act and does not engage in business in the Philippines may bring a civil or administrative action hereunder for opposition, cancellation, infringement, unfair competition, or false designation of origin and false description, whether or not it is licensed to do business in the Philippines under existing laws.

5. The foregoing has been confirmed by the Supreme Court in the case of *La Chemise Lacoste vs. Fernandez*.

6. The registration of the M trademark is contrary to the provisions of Section 123.1 (d) of the IP Code which prohibits the registration of a mark that:

- "(d) Is **identical with a** registered mark belonging to a different proprietor or **a mark with on 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

9.1. The dominant effect - in fact the only element - in the Opposer's mark is the small letter "m" the end of which connects to a swirl device that encircles the letter. The Respondent-Applicant's M trademark exactly copies the concept, if not appearance, of the M LOGO. It also utilizes a small letter "m" within a swirl device, albeit, with slight modifications i.e. the small letter "m" is connected in reverse when compared to the M LOGO and it employs a single swirl as opposed to the double swirl of the M LOGO.

9.2. Despite the slight modifications, the M trademark still appears almost identical to the M LOGO. Such similarity, likeness and resemblance causes confusion. It is settled jurisprudence that identity or similarity in the dominant features of two (2) competing marks will cause mistake or confusion in the minds of the relevant sector of the purchasing public.

9.3. The likelihood of confusion or mistake is further enhanced since the services for which the Respondent-Applicant's M trademark is applied for registration, *i.e.*, *services for providing food and drink* in Class 43, is closely related to and belong within the zone of natural expansion of the goods and services covered by the Opposer's earlier registration for the M LOGO. The M LOGO is primarily being used in connection with a "competitive cooking reality show for amateur and home chefs". The M trademark, on the other hand, is to be used for catering services. Both of these serve similar concepts and purposes, have the same characteristics and may be found in the same channels of business and trade.

10. Indeed, it is surprising to note that notwithstanding a boundless choice of words, phrases, symbols and designs available to the Respondent-Applicant, it is adopted a mark that is practical identical to the Opposer's earlier M LOGO for use on closely related goods and services. In the absence of a plausible explanation from the Respondent-Applicant as to how this happened, it can be reasonably concluded that the Respondent-Applicant was aware of the existence, use, and registration of the Opposer's M LOGO

11. We can likewise reasonably assume that Respondent-Applicant was aware of the world famous and internationally well known cooking reality show television series, *MasterChef*. *MasterChef* uses the M LOGO prominently and is a globally aired television program in at least 200 different territories. With local editions of the popular cooking show in more than 35 countries, including the Philippines.

12. The Opposer's rights over the M LOGO extends not only to the goods and services stated in the certificate but also to those related thereto, including goods and services within the normal scope of business expansion. The fact that Opposer uses its M LOGO in connection with a cooking show and Respondent-Applicant's M trademark application covers "services of food and drink" undoubtedly infringes on Opposer's trademark rights and Respondent-Applicant's application should be rejected. Please note that Opposer's M LOGO is also used for food-related consumer products, exhibitions and live experiences (like pop-up restaurants, cooking demonstrations and themed occasions) which is very similar, if not identical, to the services covered by the opposed application. People seeing the M trademark will be deceived into believing that Respondent-Applicant is related to or somehow sponsored by Opposer and its television program.

13. The unauthorized copying of the Opposer's trademark leads to no other conclusion than that the Respondent-Applicant's act of adopting similar trademark was not only deliberate, but also made in bad faith to take advantage of the goodwill attached to Opposer's M LOGO

14. Even if we were to say, for the sake of argument, that Respondent-Applicant had a reason to use the letter "M" since its name starts with this letter, it still does not explain how Respondent-Applicant ended up with a design that is practically identical to Opposer's M LOGO.

15. In view of the foregoing, the registration of the almost identical mark M trademark of the Respondent-Applicant may not be allowed since the same is contrary to section 123.1 (d) of the IP Code.

x x x

18. The Opposer also has continuously and extensively promoted its products and services bearing the M LOGO worldwide. Since the first launch of the *MasterChef* series and using the M LOGO, the show has gained significant worldwide exposure in various media, including television commercials, advertisements, internationally well-known print publications, the internet, and other promotional events, including cooking, food and beverage related activities.

19. Through long, continuous and extensive use, promotion and advertising of the M LOGO, the same has become so popular throughout the Philippines and around the world such that a mere mention of or a look at the mark would immediately cause the purchasing public to associate the same with the Opposer, its business and its cooking reality show program. Thus, the Respondent-Applicant's use of the confusingly similar M trademark would cause purchasers to believe that its catering services are produced by, originate from, or are under the sponsorship of the Opposer.

21. If allowed to proceed to registration, the consequent use of the M trademark by the Respondent-Applicant will amount to unfair competition against the Opposer's internationally well known M LOGO, which has attained valuable goodwill and reputation through years of extensive and exclusive use worldwide.

22. At the very least, the use by the Respondent-Applicant of the M trademark in relation to catering services, which is similar to and closely related to the cooking reality show series of the Opposer, will take unfair advantage of. Dilute the goodwill and diminish the distinctive character or reputation of the M LOGO, and will clearly result in irreparable damage to the business and reputation of the Opposer.

23. The Opposer has no control over the Respondent-Applicant's business. Consequently, the Opposer has no control over the quality of the Respondent-Applicant's catering services and distributed under the M trademark. Thus, potential damage to the reputation of the Opposer will likely be caused as a result of this inability to control the quality of the goods offered to the public by the Respondent-Applicant.

24. Furthermore, considering the substantial investment incurred by the Opposer in promoting its cooking reality show series that uses the M LOGO in the Philippines and around the world, it is clear that the Respondent-Applicant's conduct in securing the registration of a mark almost identical to the M LOGO and in exploiting the same is aimed towards unduly enriching itself at the expense of the Opposer.

25. The foregoing discussion indubitably shows that the Respondent-Applicant has no right whatsoever to register the almost identical M trademark in its name for being violative of the Opposer's vested right to the earlier registered M LOGO. The opposed trademark application should therefore be denied registration in accordance with the provisions of the IP Code, as well as the Paris Convention to which the Philippines is contractually and legally bound.

x x x

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

Exhibit "A" – Authenticated Verified Notice of Opposition;

Exhibit "B" – Authenticated Special Power of Attorney;

Exhibit "C" – Authenticated Affidavit of Mr. Bryce Coughlin;

Exhibit "C-1" – Summary report of Status of Trademark Applications and Registrations;

Exhibit "C-2" – Copies of the Trademark Registrations of Master Chef Trademark in different countries;

Exhibit "C-3" – Tables on statistics on popularity/audience share of the Master Chef series;

Exhibit "C-4" – Copies of websites showing Master Chef's episodes in various countries and websites selling Master Chef products;

Exhibit "C-5" – Copies of the Master Chef advertising materials; and

Exhibit "C-6" – Copies of Master Chef's product catalog;

This Bureau issued a Notice to Answer on 16 January 2014 and served a copy to the Respondent-Applicant on 23 January 2014. However, the Respondent-Applicant did not file an Answer. In view thereof, an Order dated 26 August 2014 was issued declaring the Respondent-Applicant in default. Consequently, this case was submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant should be allowed to register the trademark



This Opposition is anchored on Section 123.1, par (d), of the Intellectual Property Code of the Philippines (IP Code) which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

The contending marks are depicted below for examination and comparison:



Respondent – Applicant’s Mark



Opposer’s Mark

Both parties use a small letter “m” connected to a swirl device encircling the said letter. While the directions of the swirl devices that encircle the letter m in the competing trademarks are at the opposite directions, the concept is the same, which the resulting difference is not substantial and at best negligible.

Also, this Bureau finds that, the goods covered by the two competing marks are closely related goods. The Respondent-Applicant’s mark is being applied for use on “*services for food and drinks*” which are closely related and can be associated to the goods of the Opposer, which is used for *entertainment and cooking show*. Thus, it is very probable that consumers would think that both goods and services are all came from one source or that they are related.

Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trademark or trade name is likely to lead to a confusion of a source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field.⁴

Succinctly, the Supreme Court has consistently stressed that a trademark is a distinctive mark of authenticity through which the merchandise of a particular producer or manufacturer may be distinguished from that of others, and its sole function is to designate distinctively the origin of the products to which it is attached.⁵ More importantly, the protection of trademarks as intellectual property is intended not only to preserve the goodwill and reputation

⁴ Dermaline, Inc. vs. Myra Pharmaceuticals, Inc., G.R. No. 190065, 16 August 2010; McDonalds Corporation v. L. C. Big Mak Burger, Inc., G.R. No. 143993, 18 August 2004

⁵ Arce Sons and Co. vs. Selecta Biscuit et. al., G.R. L-14761, 28 January 1961 citing Reynolds & Reynolds Co. vs. Nordic, et al., 114F 2d, 278

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of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.⁶

A perusal of the records in the instant case shows that the Opposer already had a prior trademark application when the Respondent – Applicant filed its application for a confusingly similar trademark. Thus, under Section 123.1 of the IP Code, the registration of the Respondent-Applicant's trademark cannot be allowed.

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 42013004727 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42013004727 be returned together with a copy of this DECISION to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 19 JUN 2017


Atty. **Leonardo Oliver Limbo**
Adjudication Officer
Bureau of Legal Affairs

⁶ *McDonald's Corporation v. MacJoy Fastfood Corporation* 215 SCRA 316, 320 (1992);
and *Chuanchow Soy & Canning Co. v. Dir. of Patents and Villapania*, 108 Phil. 833, 836 (1960).