

ANNIKA SHERRY L. YAO & JOSEPH O. YAO, }
Opposers, }

-versus- }

TRANS-MILLENIUUM MERCANTILE CORPORATION, }
Respondent-Applicant. }

X-----X

IPC No. 14-2015-00042
Opposition to:
Appl. Serial No. 4-2012-011582
Date Filed: 20 September 2012

TM: MASTER CHEF

NOTICE OF DECISION

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GREETINGS:

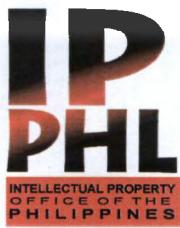
Please be informed that Decision No. 2017 - 277 dated 29 June 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL 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, 03 July 2017.


MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs



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& JOSEPH O. YAO,**
Opposers,

- versus -

**TRANS-MILLENIU
MERCANTILE CORPORATION,**
Respondent-Applicant.

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IPC No. 14-2015-00042
Opposition to:

Appln. No. 4-2012-011582
Date Filed: 20 September 2012
Trademark: "MASTER CHEF"

Decision No. 2017 - 277

DECISION

ANNIKA SHERRY L. YAO & JOSEPH O. YAO ("Opposers")¹, filed a verified opposition to Trademark Application Serial No. 4-2012-011582. The application, filed by TRANS-MILLENIU MERCANTILE CORPORATION ("Respondent-Applicant")², covers the mark "MASTER CHEF" for use on goods under class³ 29 namely: *skim milk powder, full cream milk powder, anhydrous milkfat, whey protein concentrate, non-hygroscopic/demineralized whey powder, buttermilk powder.*

The Opposers allege that they are the owners of the distinctive mark MASTER CHEF by prior actual use in commerce since the late 1990s; and prior registration in the Philippines. Mr. Yao first registered his MASTER CHEF trademark in 1995. Ms. Yao applied for a registration of her MASTER CHEF mark in 2013.

The Opposers have also extensively promoted their products bearing their MASTER CHEF trademark prior to Respondent-Applicant's filing of its trademark application for the subject mark MASTER CHEF. In fact, as a result of its promotion and sales, the Opposers have built and enjoy valuable goodwill in their MASTER CHEF mark.

According to the Opposers, the Respondent-Applicant's application for the registration of the mark MASTER CHEF is contrary to Section 123.1 (d) and (f) of the Intellectual Property Code. In fact, the act of the Respondent-Applicant in adopting the mark MASTER CHEF for its skimmed milk products in International Class 29 is clearly an attempt to trade unfairly on the goodwill, reputation and consumer awareness of the Opposers' well known registered trademark MASTER CHEF. The Opposers' MASTER CHEF is a registered trademark in International Classes 1, 29, and 30 for oxalic acid, milk products, salt, cornstarch, and a variety of other

¹ With business address at the 15th Floor, Unit B A Place Building, Coral Way Street, Macapagal Avenue, Pasay City, Philippines.
² With address at 4/F Narra Building, 2276 Pasong Tamo Extension, Makati City, Metro Manila, Philippines.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

baking products. Thus, the same is likely to be associated with the Respondent-Applicant's MASTER CHEF mark leading to consumer confusion.

Finally, the Opposers stated that they did not give consent to Respondent-Applicant's use and registration of the mark MASTER CHEF, or any other mark identical or similar to its well-known MASTER CHEF mark, who was their former customer in the late 1990s.

The Opposers' evidence consists of the following:

1. Legalized and authenticated Special Power of Attorney;
2. Affidavits of Joseph Yao and Annika Sherryn Yao;
3. Certificate of Registration No. 4-2004-011095 for the trademark MASTER CHEF AND DESIGN;
4. Sales Invoice showing Respondent-Applicant as their customer;
5. Trademark Application No. 04-2013-013658 for the trademark MASTER CHEF AND DEVICE;
6. Website of product sales of MASTER CHEF;
7. Affidavits of Rufo Taguiam and Mario C. Liu;
8. Affidavit of Service of April Joy Querubin;

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 10 April 2015. Respondent-Applicant however, did not file an answer within the period allowed by the rules. Thus, in Order No. 2015-1477 dated 09 October 2015, Respondent-Applicant is declared in default and this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark MASTER CHEF?

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 out into the market a superior 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.⁴

The instant case is anchored on the ground that the trademark application is contrary to the provision of Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code ("IP Code"):

A mark cannot be registered if it:

x x x

(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

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 20 September 2012, Opposer Mr. Yao already has an existing registration for the mark "MASTER CHEF AND DESIGN" under Registration Nos. 4-2004-011095 and 4-2013-003387 dated 18 September 2006 and 05 May 2016, respectively for classes 1, 29 and 30⁵. Also, Opposer Ms. Yao holds Registration No. 4-2013-013658 dated 26 May 2016 for the mark MASTER CHEF & DEVICE for class 30⁶. Under the law, a certificate of registration constitutes a prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.⁷

The contending marks are hereby reproduced as follows:



Opposers' Trademarks

Respondent-Applicant's Trademark

Obviously, Respondent-Applicant's trademark is identical and/or similar to Opposers' trademarks. In particular, Respondent-Applicant merely reproduced Opposer Mr. Yao's mark, consisting of the words "MASTER CHEF", with an oval background and a drawing representing a chef right beside the words. The font design of the word mark and the composite device of the marks are identical in almost every aspect.

As regards the goods covered by the marks, they are also similar and/or related principally, goods under class 29. They both cover food items or baking ingredients of various types which flow on the same channels of trade and available to the same class of purchasers. It is likely therefore, that the consumers will have the impression that these goods or products originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:⁸

⁵ Annex "A" of Opposers. IPPhI Trademark Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 28 June 2016).

⁶ Id.

⁷ Sec. 138, Intellectual Property Code (IP Code).

⁸ Converse Rubber Corporation v. Universal Rubber Products Inc., et al., G.R. No. L-27906, 08 Jan. 1987.

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiffs and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

The public interest, therefore, requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. Thus, Respondent-Applicant's mark should not be allowed registration because it resembles Opposers' marks as to be likely to deceive or cause confusion.⁹

In contrast, the Respondent-Applicant despite the opportunity given, failed to explain how it arrived at using the mark "MASTER CHEF" as it failed to file a Verified Answer. The Opposer's' marks are unique and highly distinctive with respect to the goods it is attached with. It is incredible for the Respondent-Applicant to have come up with the same mark practically for related goods by pure coincidence.

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-0011582 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 29 JUN 2017



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

⁹ Sec. 123.1 (d), IP Code.