

SAN MIGUEL PURE FOODS COMPANY, INC.,
Opposer,

-versus-

STEVE UY,
Respondent-Applicant.

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IPC No. 14-2014-00073
Opposition to:
Appln. Ser. No. 4-2013-008897
Date Filed: 26 July 2013

TM: MAMANG SORBETERO

NOTICE OF DECISION

ANGARA ABELLO CONCEPCION REGALA & CRUZ

Counsel for Opposer
22nd Floor, ACCRALAW Tower
2nd Avenue corner 30th Street,
Crescent Park West, Bonifacio Global City
Taguig City

ATTY. MONTINI FELICILDA/Cilda Law


Counsel for Respondent-Applicant
Unit 1902-A Philippine Stock Exchange (PSE)
East Tower, Exchange Road, Ortigas Center
Pasig City

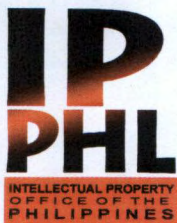
GREETINGS:

Please be informed that Decision No. 2017 - 991 dated 06 September 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, 07 September 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



**SAN MIGUEL PURE FOODS
COMPANY, INC.,**

IPC NO. 14 – 2014-00073

Opposer,

Opposition to:

- versus -

Appln Serial No. 42013008897

**TM: “MAMANG
SORBETERO”**

STEVE UY,

Respondent-Applicant.

x-----x

DECISION NO. 2017 - 331

D E C I S I O N

SAN MIGUEL PURE FOODS COMPANY INC (Opposer),¹ filed a Verified Notice of Opposition to Trademark Application No. 4-2013-008897 on 14 April 2014. The subject Trademark Application filed by STEVE UY, (Respondent-Applicant)² covers the mark “MAMANG SORBETERO” for “services for providing food and drinks” under Class 43 of the International Classification of Goods.³

The pertinent allegations in the Verified Notice of Opposition are quoted as follows:

- 4.1. Opposer is the true, lawful owner of the Sorbetero Marks.
- 4.2. Since Respondent-Applicant’s “MAMANG SORBETERO” mark is confusingly similar with Opposer’s Sorbetero Marks, the registration of Respondent’ Applicant’s mark violates Section 123.1 (d) of the IP Code and international treaties.
- 4.3. The registration, use and appropriation of Respondent-Applicant’s “MAMANG SORBETERO” mark falsely suggest a connection between it and Opposer, thereby causing damage to Opposer and the public.

¹ Assignee of SALUDO ICE PLANT & COLD STORAGE CORPORATION with business address at Magsaysay, Ichon, Macrohon, Sothern Leyte.

² A corporation with business address at 822 Elcano Street, Binondo, 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 International Classification of Goods and Services for Registration of Marks concluded in 1957.

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph

5.1. The "Magnolia SORBETERO" mark was taken from the "SORBETERO" and the "SORBETERO ICE SARAP AND DEVICE" marks, which were used on ice cream products by Seamark Enterprises, a Philippine company established in the mid-1970's. More than thirty years ago, Seamark Enterprises was the second largest ice cream company in the Philippines, producing two successful ice cream brands, Coney Island and Sorbetero Ice Cream. The Sorbetero Ice Cream was positioned as the All-Filipino ice cream with a distinct Filipino taste while its Coney Island Ice Cream was marketed as "The All-American Ice Cream," which offered popular American flavors.

5.2. Seamark Enterprises was also a pioneer in the local Quick Service Restauranting industry. At one point, the company operated 33 Coney Island Scooping Stations throughout the Philippines, 17 of which were franchised outlets.

5.3. Seamark Enterprises also launched the Coney Island Scoops and Steaks Chain. These stores combined soda fountain treats with sandwiches, fries and other snack items. In 1984, the group established Seamark Creamery of California and pioneered in the premium tropical flavor ice cream segment in the U.S. West Coast. Seamark Enterprises was acquired in 1991 by Ayala's Pure Foods Corporation (one of the largest Philippine conglomerates) and Seamark Creamery of California was sold in 1993.

5.4. From 1992 to 1996, Pure Foods Corporation re-launched the Sorbetero and Coney Island Ice Cream brands nationally, with various improved flavors, unique rectangular containers, and reduced prices, intended to be at par with the competition. The Annual Reports of Pure Foods Corporation for the years 1991 to 1997 featured the company's various products, including the Sorbetero Ice Cream product

5.5. In May 2001, San Miguel Corporation acquired Pure Foods Corporation and merged it with another food industry leader, San Miguel Food Group, to form the Opposer, ushering in a new era of growth and market leadership of the integrated food businesses. The acquisition included key brands and products of the Pure Foods Corporation, including the Sorbetero Ice Cream brand, which has become an ingrained part of the Filipino food scene. In 2004, San Miguel Food Group re-opened its ice cream business through its subsidiary Magnolia, Inc.

5.6. As early as 1984, Opposer's predecessor-in-interest, Seamark Enterprises, already sought protection for its "SORBETERO ICE SARAP AND DEVICE" mark by filing an application for its registration with this Honorable Office on 24 April 1984.

5.7. In the United States of America, Opposer's predecessor Seamark Enterprises likewise obtained a registration for its "SORBETERO" mark on 08 April 1986, covering ice cream goods.

5.8. To further protect the "SORBETERO" mark, Opposer filed on 28 June 2013, applications for registration of its "MAGNOLIA

2013

SORBETERO" and "MAGNOLIA SORBETERO ICE SARAP" marks (the "Sorbetero Marks") covering ice cream in Class 30.

5.9. It bears noting that the Philippines adopted the first-to-file system with the enactment of the Intellectual Property Code in January 1998. This means that a mark may not be registered if it is identical with a registered mark belonging to a different proprietor of 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. Opposer filed its application for the Sorbetero Marks on 28 June 2013 while Respondent-Applicant filed its application for the confusingly similar "MAMANG SORBETERO" mark almost a month later on 26 July 2013. Thus, following the Intellectual Property Code, Opposer's prior applications for the Sorbetero Marks should prevent Respondent-Applicant's confusingly similar mark from being registered.

5.10. Opposer has continuously and extensively used the Sorbetero Marks since 1970 when the Sorbetero Ice Cream products were first produced and commercially sold in the Philippines, The Opposer not only owns the Sorbetero Marks, but also the goodwill over these marks. Opposer and its predecessors, Seamark Enterprises and Pure Foods Corporation, have exerted significant efforts in widely promoting, advertising, marketing, and distributing the ice cream products bearing the Sorbetero Marks through the years. This, coupled with its prior application for the Sorbetero Marks, Opposer has undoubtedly acquired substantial goodwill and reputation over the Sorbetero Marks

5.11. It is clear from the foregoing that Opposer is the true and legitimate owner of the Sorbetero Marks. Consequently, Respondent-Applicant's application for the registration of the confusingly similar mark, "MAMANG SORBETERO", should be refused.

5.12. Section 123.1 (d) of the IP Code prohibits the registration of a mark that is identical with, or nearly resembles, a registered mark belonging to another, with an earlier filing or priority date.

5.13. Respondent-Applicant's application for the registration of its "MAMANG SORBETERO" mark squarely falls within the proscription under Sec. 123 (d) of the IP Code. First, Opposer's applications for the Sorbetero Marks have an earlier filing date. Second, the resemblance of Respondent-Applicant's "MAMANG SORBETERO" mark to Opposer's Sorbetero Marks will likely deceive or cause confusion among the consuming public.

5.14. The Supreme Court has consistently used the Dominancy Test in determining whether two marks are confusingly similar with each other. As its name suggests, the Dominancy Test focuses on the similarity of the prevalent, essential, or dominant features of competing marks that might cause confusion or deception. Under the Dominancy Test, not every word in a trademark must be copied. As long as sufficient elements or components of a mark are taken so as to deceive the consuming public into purchasing the goods, confusing similarity between the competing marks exists.

5.15. As clearly shown in the comparative table, Respondent-Applicant's "MAMANG SORBETERO" mark appropriated the dominant element of, and so resembles, Opposer's Sorbetero Marks as to likely cause confusion, mistake and deception on the part of the purchasing public by misleading them into purchasing Respondent-Applicant's goods thinking these to be coming from the Opposer.

5.16. In the present case, the use of the identical word "SORBETERO" in both marks is more than sufficient to render Respondent-Applicant's mark confusingly similar to Opposer's registered trademarks. Notwithstanding the stylized form of Respondent-Applicant's mark, the word "SORBETERO" is clearly the most dominant element in its "MAMANG SORBETERO" mark. Thus, Respondent-Applicant's use of the dominant word "SORBETERO" is enough to constitute infringement.

5.17. Even when viewed in their entirety, the competing marks project the same overall commercial impression. It cannot be denied that since the Opposer's Sorbetero Marks and Respondent-Applicant's "MAMANG SORBETERO" mark all utilize the dominant word "SORBETERO", all these marks are visually, phonetically, and aurally similar. It is settled that confusing similarity is to be determined on the basis of visual, aural, and connotative comparisons and overall impressions engendered by the marks in controversy as they are encountered in the realities of the marketplace.

5.22. Consequently, the close resemblance between Respondent-Applicant's "MAMANG SORBETERO" mark and Opposer's Sorbetero Marks renders the former unregistrable as expressly provided in Section 123.1 (d) of the IP Code

5.24. In the present case, Respondent-Applicant's unauthorized use and application for the registration of the "MAMANG SORBETERO" mark, which is confusingly similar to Opposer's Sorbetero Marks, falsely represent the true ownership of Respondent-Applicant's mark and suggest a fictitious connection between it and Opposer, thereby deceiving the consuming public as to the affiliation, connection, or association of either or both parties, or as to the origin, sponsorship, or approval of the goods bearing the "MAMANG SORBETERO" mark of Respondent-Applicant

5.25. Based on official records, Opposer's Sorbetero Marks have an earlier filing date than the filing of the Respondent-Applicant's Mark. It was only on 26 July 2013, or one (1) month after Opposer filed its application for the registration of the Sorbetero Marks that Respondent-Applicant filed its trademark application for the "MAMANG SORBETERO" mark. Respondent-Applicant, by appropriating the words "MAMANG SORBETERO", and by applying for the registration thereof, clearly has the sole intention of riding on, and taking advantage of, the popularity and goodwill already generated by, and associated with, Opposer's Sorbetero Marks and products.

5.26. The unauthorized use by the Respondent-Applicant of the word "MAMANG SORBETERO" as its own mark will inevitably result in

confusion among the relevant sector of the public. The registration and use of the trademark "MAMANG SORBETERO" by Respondent-Applicant will also diminish the distinctiveness and dilute the goodwill associated with Opposer's Sorbetero Marks, which has become distinctive of the ice cream products manufactured and sold by the Opposer.

5.27. The real danger in allowing the registration of the Respondent-Applicant's mark is that the public may be mistaken that one's product is just a variation of the other's product and that both came from the same manufacturer, thereby deceiving the consuming public as to the affiliation, connection or association of either or both parties, or as to the origin, sponsorship or approval of the goods bearing the Respondent-Applicant's "MAMANG SORBETERO" mark. The resulting damage to the Opposer is not limited to a possible confusion of goods but also included confusion in reputation if the public could perceptibly assume that the goods of the parties originated from the same source.

In support of its Opposition, the Opposer submitted the following:

1. Exhibit "A" – Affidavit of Atty. David R. Hilario;
2. Exhibit "B" – Affidavit of Mr. Raul B. Nazareno including Annexes "A" to Annex "H";
3. Exhibit "C" – Print out from IPO online trademark database of the "SORBETERO ICE SARAP AND DEVICE";
4. Exhibit "D" – Print out from USPTO online trademark database "SORBETERO" mark; and
5. Exhibit "E" – Print out from IPO online trademark database "MAGNOLIA SORBETERO" and "MAGNOLIA SORBETERO ICE SARAP" marks;

This Bureau issued a Notice to Answer on 21 April 2014 and received by Respondent-Applicant on 24 April 2014. However, the Respondent-Applicant did not file an Answer to the Opposition. This Office issued an Order dated 9 September 2015, declaring the Respondent-Applicant in default. Consequently, this case was submitted for Decision.

The issue to resolve in the present case is whether the Respondent-Applicant should be allowed to register the trademark "MAMANG SORBETERO."

Opposer argued that: Opposer is the true, lawful owner of the Sorbetero Marks; Since Respondent-Applicant's "Mamang Sorbetero" mark is confusingly similar with Opposer's Sorbetero Marks, the registration of Respondent-Applicant's mark violates Section 123.1 (d) of

the IP Code and international treaties; and the registration, use and appropriation of Respondent-Applicant's "MAMANG SORBETERO" mark falsely suggest a connection between it and Opposer, thereby causing damage to Opposer and the public.

The competing marks are reproduced below for comparison:



Opposer Trademarks



Respondent-Applicant
Trademark

Evidently from the above, the contending trademarks are different from each other both visually and aurally. The first cited mark of the opposer is a wordmark of "MAGNOLIA SORBETERO" which is easily identifiable from the word mark of the Respondent-Applicant's "MAMANG SORBETERO." The first word "Magnolia" in the Opposer's mark can easily be distinguish from the first word "Mamang" in the Respondent-Applicant's mark. Although the contending marks of the parties have a similar second word "SORBETERO," the Opposer could not claim exclusive ownership of the said word, since as correctly stated by the Opposer, it is the Filipino word for a person selling ice cream.⁴ Thus, the "SORBETERO" is considered as generic term for such services.

The second cited mark of the Opposer, which is composed of a cartoon-like illustration of an ice popsicle with the words "ICE SARAP" design above and the word "SORBETERO" in an ice cream cart design. This cited mark is very distinct and could not also be confused with Respondent-Applicant's applied trademark.

Even with the above findings of non-confusing similarity between the contending trademarks, this Bureau still holds that the Respondent-Applicant could not be allowed to register the mark "Mamang Sorbetero."

At this juncture, this Bureau takes judicial notice of the fact that the whole phrase "Mamang Sorbetero" is a common Filipino term being used by the public to refer to the vendor of ice cream and therefore, is also considered generic relative to anyone serving ice cream products. In fact, the said term was used as the title in a popular 1970s local song, which pay homage to the local ice cream vendors. Records from the Bureau of

⁴ Paragraph 5.19 of the Verified Opposition

Trademarks also show that the original trademark applied by the Respondent-Applicant before it was amended include the term "PINOY ICE CREAM."

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.⁵ Verily, under Section 123.1 (h) of the IP Code, a mark cannot be registered if it consists exclusively of signs that are generic for the goods or services that they seek to identify.

The Respondent-Applicant cannot circumvent the above prohibition by using a general description "services for providing food and drinks" on the trademark use in its trademark application. The records from the filewrapper from the Bureau of Trademark belie this, as it shows that the original trademark design before the Respondent filed an amendment include the words, "Pinoy Ice Cream." Thus, in the absence of proof that the Respondent-Applicant intend to use the applied mark for goods or services which is not connected to ice cream or related products, the subject trademark of Respondent-Applicant cannot be allowed to be registered.

The Supreme Court in the case of *The East Pacific Merchandising Corporation vs. The Director of Patent et. al*⁶ had the occasion to explain while citing a United States case, to wit:

There is no principle more firmly settled in the law of trademark, than that words or phrases which have in common use and which indicate the character, kind, quality and composition of the thing [or service], may not be appropriated by anyone to his exclusive use. In the exclusive use of them the law will not protect x x x

Thus, allowing the Respondent-Applicant to register the generic mark "Mamang Sorbetero" is tantamount to giving the Respondent-Applicant the monopoly and exclusive use of the said term at the expense of the public.

WHEREFORE, premises considered, the Opposition to the registration of Trademark Application Serial No. 42013008897 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No.


⁵ *Societe Des Produits Nestle, S.A. et. al. vs CA, G.R. No. 112012, 4 April 2001*

⁶ *G.R. No. L-14377, 29 December 1960*

42013008897 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 06 SEP 2017


Atty. Leonardo Oliver Limbo
Adjudication Officer
Bureau of Legal Affairs