

MARANAW HOTELS AND RESORT	}	Inter Partes Case No. 14-2007-00340
INC., owner and operator of	}	Case Filed : 23 November 2007
CENTURY PARK HOTEL,	}	Opposition to:
<i>Opposer,</i>	}	
	}	Appl'n. Serial No. : 4-2007-000130
	}	Date Filed : 04 January 2007
-versus-	}	Trademark : "TSUKIJI and
	}	Japanese Characters"
	}	
KAGA, INC.,	}	
<i>Respondent-Applicant.</i>	}	Decision No. 2009-126
x-----x		

## DECISION

This pertains to the opposition to the registration of the mark "TSUKIJI AND JAPANESE CHARACTERS" bearing application No. 4-2007-000130 filed on January 4, 2007 covering the products/services "*restaurant services*" falling under class 43 of the International Classification of goods or services which trademark application was published on July 27, 2007 in the Intellectual Property Philippines (IPP) electronic gazette (E-Gazette).

The Opposer in the instant case is "MARANAW HOTELS AND RESORT, INC." owner and operator of "CENTURY PARK HOTEL" a domestic corporation duly organized and existing under the laws of the Republic of the Philippines, with principal offices in Manila, Philippines. Opposer owns and manages the Century Park Hotel, an establishment located at 599 P. Ocampo Street, 1001 Malate, Manila. The Opposer is represented in this suit by its Executive Vice-President, Thian Koan Tan, and may be served legal processes through his counsel with office address at 4<sup>th</sup> Floor, S & L Building, Esteban corner Dela Rosa Streets, Legaspi Village, Makati City.

On the other hand, Respondent-Applicant is "KAGA, INC." a corporation duly organized and existing under Philippines laws, with address at A & G Building, Don Arnaiz Avenue, Makati City.

The grounds of the opposition are as follows:

- "I. TSUKIJI AND JAPANESE CHARACTER cannot be registered as a service mark under the Intellectual Property Code ("IPC") because:
  - A. It consists exclusively of signs or of indications that serves in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of ingredients used in Japanese Restaurant Services; and
  - B. It is likely to mislead the public, as to the nature, quality, characteristics or geographical origin of ingredients used in the Respondent-Applicant's Japanese Restaurant Services.
- "II. Respondent-Applicant, by failing to submit the English translation of Tsukiji and Japanese Characters, and by failing to disclose that the mark refers to places in Japan, and claiming instead that the same is a coined term, seeks to procure registration of the mark by means of fraudulent declaration."

The Opposer submitted the following as its exhibits:

Annex	Description
Annex "A"	Acknowledgment of the trademark application for the mark "TSUKIJI AND JAPANESE CHARACTERS" issued by the Intellectual Property Philippines (IPP).
Annex "B"	Amended articles of incorporation issued by the Securities and Exchange Commission (SEC) of Maranaw Hotels & Resorts Corporation
Annex "C"	Accreditation issued by the Department of Tourism for the Century Park Hotels as De Luxe Class Hotel.
Annex "D"	Secretary's Certificate
Annex "E"	SEC Registration No. 177734 issued by the SEC for the articles of incorporation and by laws of "KAGA, INC."
Annex "F"	General Information Sheet
Annex "G"	Copy of the hotel flyers promoting Century Tsukiji
Annex "H"	Copy of the official receipt issued by Respondent-Applicant
Annex "I"	Registrability report dated June 6, 2007
Annex "J"	Copy of the responsive action dated June 15, 2007
Annex "K"	Copy of Notice of Allowance
Annexes "L" to "N"	Copies of motions for extension
Annexes "O" to "Q"	Copies of the orders dated September 3 and 24, 2007
Annex "R"	Electronic print-outs of encyclopedia articles on Tsukiji administrative districts
Annex "S"	Electronic print-out of Tsukiji Honganji Temple homepage
Annexes "T-1" to "T-2"	Copy of English translation made by Hachi International Philippines as well as the latter's certificate of accreditation.
Annex "U"	Electronic print-out of the encyclopedia article on Tsukiji fish market
Annex "V"	Electronic print-out of the Tsukiji fish market homepage, the copyright of which belongs to the Tsukiji market association.

On March 3, 2008, Respondent-Applicant filed its Verified Answer denying all the material allegations of the opposition.

Respondent-Applicant submitted the following in support of its trademark application subject of the opposition proceedings:

Exhibit	Description
Exhibit "1"	Certificate of Registration of Business name "IZAKAYA-KAPPO-TSUKIJI RESTAURANT"
Exhibit "2"	Copy of Philippine Daily Inquirer dated September 9, 1997 issue
Exhibit "3"	Published article in 1997 namely a well-kept secret by Doreen Fernandez
Exhibit "4"	Eat Well by Chona Trinidad

Exhibit "5"	Japanese Food Three Floors Up (Food Guide)
Exhibit "6"	Philippine Inquirer Saturday Special (Two exceptional restaurants)
Exhibit "7"	Business World, Tradition of dinner-cooked meals continues at Tsukiji Annex
Exhibit "8"	Philippine Daily Inquirer – Authentic Japanese dishes concocted with love and passion
Exhibit "9"	Letter addressed to (Century Tsukiji Restaurant) from the law firm Zamora Poblador Vasquez & Bretaña
Exhibit "10"	Report Q191
Exhibit "11"	Certificate of Registration of Business Name "IZAKAYA-KAPPO-TSUKIJI RESTAURANT"
Exhibit "12"	Certificate of Registration of Business Name "IZAKAYA-KAPPO-TSUKIJI RESTAURANT"
Exhibit "13"	Certificate of Registration issued by ASEC. Ma. Theresa L. Pelayo bearing No. 00260735
Exhibit "14"	Picture of Japanese Cuisine & Yakiniku-Tsukiji
Exhibit "15"	Manila Bulletin, July 23, 1990 issue
Exhibits "16" to "16-A"	Official Receipt issued by Izakaya-Kappo-Tsukiji dated December 10, 2004
Exhibits "16-B" to "16-C"	Official Receipt issued on 2005
Exhibits "16-D" to "16-G"	Official Receipt issued on 2008
Exhibit "17"	Invoice No. 1218-A
Exhibit "18"	Affidavit of Jose S. Sandejas
Exhibit "19"	Affidavit of Katrina Araneta Hologores
Exhibit "20"	Affidavit of Luisita Cojuangco Bautista
Exhibit "21"	Affidavit of Romeo I. Chan
Exhibit "22"	Affidavit of Gabby T. Po
Exhibit "23"	Affidavit of Regina Gamboa Pimentel
Exhibit "24"	Business Name Search
Exhibit "25"	Sunday Inquirer Magazine
Exhibit "26"	Philippine Long Distance Telephone Company Directory
Exhibit "27"	Philippine Macintosh Users Group
Exhibit "28"	PinoyGolfer.com
Exhibit "29"	Interview by Aurora Diaz Wilson to Liza Araneta Marcos
Exhibit "30"	Triple Shobiz Treat – Zsa Says by Zsa Zsa Padilla
Exhibit "31"	BLOG-Wikipedia, the free encyclopedia
Exhibit "32"	War's on & Expat – What's on Dining
Exhibit "33"	Taste – Century Park Hotel open Tsukiji
Exhibit "34"	The Metro
Exhibit "35"	Affidavit of Regina Gamboa Pimentel

During the preliminary conference, the parties were given the opportunity to settle the case amicably, however, no agreement have been reached.

The issue to be resolved in this particular case is:

WHETHER OR NOT THE RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK "TSUKIJI AND JAPANESE CHARACTERS".

The applicable provision of law is Section 123 (G) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines which provides:

Section 123. *Registrability* – 123.1 A mark cannot be registered if it:

- |  |   |   |   |
|--|---|---|---|
|  | x | x | x |
|--|---|---|---|
- (g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

The mark involved in this particular case consists of the word "TSUKIJI" and Japanese Characters.

Records will show as contained in the recommendation for allowance duly signed by the Trademark Examiner and the Supervisor in-charge thereof, the translation of the Japanese character is "TSUKIJI". The word "*tsukiji*" is a coined word and has no English translation as claimed by the Respondent-Applicant in its response filed with the Bureau of Trademarks on June 15, 2007 denominated as Paper No. 3.

The response submitted by the Respondent-Applicant denominated as paper No. 3 is vital consideration that made the trademark examiner in concurrence with his supervisor, recommended the application for allowance for publication.

The objection of the trademark examiner was so clear. It was referring to the English translation of the Japanese characters appearing in the trademark sought to be registered which according to Respondent-Applicant, *has no English translation*.

However, the Opposer through Mr. Cesar T. Subido a translator accredited by the Japanese Embassy in the Philippines, certified that there are translations for the subject mark's dominant feature and accompanying characters that the mark "TSUKIJI and Japanese Characters" is Japanese, (Annexes "T-1" and "T-2") of the opposition. In short the Japanese characters refer to "TSUKIJI" such as "build" and the second is "earth", or "ground".

The act of the Respondent-Applicant by not giving the English translation of the Japanese characters as required by the trademark examiner is in violation of Rule 400 (j) of the rules and regulations on trademarks, service marks, trade names and marked or stamped containers.

Respondent-Applicant's refusal to recognize and comply with translation requirements exposes its intent to deceive this Honorable Office, fully knowing that a well-known term used to refer to prominent places and institution is not distinctive and would not be allowed registration. There was clearly bad faith, since it was precisely meant to conceal the fact that the mark "TSUKIJI and Japanese Characters" is neither distinctive nor an original term and thus cannot be appropriated by means of trademark registration.

The term "TSUKIJI" effectively and exclusively designates the geographical origin, quality or production of any product or service on which it is used as a mark. As a geographical name, Respondent-Applicant cannot exclusively appropriate the same. (Section 123 (j) of Republic Act No. 8293)

Considering that the word "Tsukiji" is a geographical indication which is in the sphere of the public domain is a common property and cannot be *appropriated by anyone*, the Opposer in

the instant case as deprived of the use of the mark under question which should be available for use by all the producers in that region if Respondent-Applicant's trademark application for the mark "TSUKIJI and Japanese Characters" be allowed and approved for registration.

In "Ang Si Heng vs. Wellington Department Store, Inc., G.R. No. L-4531, 92 Phil. 448, January 10, 1953" the Supreme Court stated:

It is likewise stated further, that "Tsukiji Fish Market" (Annex "4" of the Opposition and page 19 of the Verified Answer, paragraph 34). Respondent-Applicant stated that, the fact is that Respondent-Applicant has from the start of its restaurant operations, imported and continues to import fish, seafood and other ingredients from the "Tsukiji Fish Market" (Annex "T") the biggest wholesale fish and seafood market in the world and also one of the largest whole food markets of any kind. Tsukiji fish market is regulated by the Tokyo Central government, in cooperation with the Tsukiji Market Association. The market has become a popular tourist attraction and globally reputed to be the best place to source the freshest seafood ingredients needed in sushi and other Japanese delicacies.

As pointed out by the Opposer, "Tsukiji" is the name of at least three administrative districts in Japan, namely:

1. Tsukiji District, Chuo-ku, Tokyo City, Honshu Island Japan
2. Tsukiji District, Amagasaki City, Hyago Prefecture, Honshu Island Japan
3. Tsukiji District, Kobe City, Hyogo prefecture, Honshu Island Japan

It is also the name of the following well-known Japanese cultural institutions located in Chuo-ku, Tokyo, Japan.

1. Tokyo Metropolitan Central Wholesaler Market, popularly known as "Tsukiji Fish Market"
2. Tsukiji Hongan-ji Buddhist Temple

Based on the pleadings of the parties, it is observed that the term "tsukiji" is a name of a *place in Japan*.

Geographically descriptiveness are used in two situations which are fundamentally different from each other:

First, when the mark is the name of the place which is the origin of the goods or services.

Second, when the mark is the name of the place which is not the place from which the goods or services come.

When the mark is the name of the place which is not the place from which the goods or services come, the issue is WHETHER the mark when applied to the goods or services of the applicant is primarily geographically descriptive (TMEP Section 1210.01)

The word "Isabela" being the name of a geographically place of production or origin of tobacco, cannot be appropriated as a trademark for tobacco products and cannot be registered as such, any more than "Havana" or "Virginia" (Comprice General Tobacco vs. Alhambra Cigar & Cigarettes Co., 39 Phil. 485). But a geographical name not used in a geographical sense to denote place of origin, but used in arbitrary or fanciful way to indicate the origin or ownership regardless of location, may be sustained as a valid trademark (63 C.J.S. 53).

Basically, a geographical indication is a notice stating a given product originates in a given geographical area. The best known examples of geographical indications are those used for *wines* and *spirits*. For instance, the geographical indication champagne is used to indicate that a special kind of sparkling wine originates in *Champagne* region of France. In the same way, Cognac is used for brandy from the French region around the town of Cognac. However, geographical indications are also used for products other than wines and spirits. Such as tobacco from Cuba, or for cheeses such as Roquefort. They may also be used for industrial products, as Sheffield is for steel.

The use of geographical indications is an important method of indicating the origin of goods and services. One of the aims of their use is to promote commerce by informing the customer of the *origin* of the products. Often this may imply a certain *quality*, which the customer may be looking for.

Another important thing to be clarified is the distinction between a *geographical indication* and a *trademark*.

A trademark is a sign or symbol that an individual trader or company uses to distinguish its own goods or services from the goods or services of competitors. A *geographical indication* is used to show that certain products have a certain regional origin. A geographical indication must be available for *use by all the producers in that region*.

As previously stated, "Tsukiji" is a place in Japan, a fish market and the biggest wholesale fish and seafood market in the world and also one of the largest wholesale food markets of any kind. It is regulated by the Tokyo Central Government in cooperation with the "Tsukiji" Market Association. The market has become a popular tourist attraction and globally reputed to be the best place to source the freshest seafood ingredients needed in sushi and other Japanese delicacies. (Annexes "R", "U", "V" and "W" of the verified opposition)

Republic Act No. 8293, Section 123.1 (j) provides:

Section 123. *Registrability* – 123.1. A mark cannot be registered if it:

- |     |  |   |
|-----|--|---|
| x   | x  | x |
| (j) | Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services; |   |

The term "Tsukiji" being a name of a place in Japan, a fish market and the biggest wholesale fish and seafood market in the world being regulated by Tokyo Central Government in cooperation with the "Tsukiji" Market Association, and as such it is a sign or indication that any brand which include the same covering the goods/services particularly restaurant any ingredients may be served therein may be understood to mean that it came from "Tsukiji".

The term "TSUKIJI" is a district of Chuo-ku, Tokyo, Japan, the site of the "TSUKIJI FISH MARKET" and said to be one of the best sushi destination in the world and also the largest fish market in the world handling more than 2000 tons of 250 types of seafoods daily. Literally meaning "reclaimed land" it lies near the Sumida River on land reclaimed from Tokyo Bay in the 1700 during the Edo period (Annex "R"):

Tsukiji Fish Market is the biggest wholesale fish and seafood market in the world and also one of the largest wholesale food markets of any kind. It is located in Tsukiji in Central Tokyo (Annex "U").

The Tsukiji Market, Tokyo Metropolitan Central Wholesale Market Association, all rights reserved. (Annex "V")

Another vital point to be taken into consideration is the World Trade Organization (WTO) Trade Related Aspects in Intellectual Property Rights TRIPS Agreement of which the Philippine is a signatory.

Article 22 of the WTO TRIPS Agreement provides, inter alia, protection of geographical indications, states:

*Article 22*

*Protection of Geographical Indications*

“1. Geographical indications are, for the purposes of this Agreement, indications which identify goods as originating in the territory of a Member, or a region or locally in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.

In the case at bar, it cannot be denied that a cursory examination of the mark subject of the opposition, the word “TSUKIJI” being a name of a place in Japan and coupled with its Japanese Characters, automatically create the impression that the goods or service restaurant, a Japanese one, may be understood to mean that the ingredients particularly fresh fishes came from or originated from Tsukiji.

It is very difficult to understand why the Respondent-Applicant adopted the term “TSUKIJI” as its mark if not to mislead the public that its products originated from the same place which is popularly known for several types of seafood in Tokyo, Japan.

As to the claim of the Respondent-Applicant that it is the owner of the term “TSUKIJI” because it is using the said term as a mark since 1990, and as such it has become distinctive, such an event or circumstances does not change its nature and remain as a *geographical name*, hence, can never acquire secondarily meaning, and no length of use and no amount of advertising will make it to be distinctive.

Further, the term “TSUKIJI” being a district of Chuo-ku, Tokyo, Japan, the site of the “TSUKIJI Fish Market” a reclaimed land from Tokyo Bay in the 1700’s during the Edo period (Annex “R”) is a proof that Tsukiji has been existing long before the use of the Respondent-Applicant specially in 1990.

Considering therefore that the subject trademark “TSUKIJI and JAPANESE CHARACTERS” is a geographical indication, it must be available for use by all the producers in that region, hence, not subject to exclusive appropriation.

WHEREFORE, premises considered, the opposition is, as it is hereby SUSTAINED. Consequently, trademark application bearing No. 4-2007-000130 for the mark “TSUKIJI AND JAPANESE CHARACTERS” filed by KAGA, INC., on January 4, 2007 is, as it is hereby REJECTED.

Let the filewrapper of the trademark “TSUKIJI AND JAPANESE CHARACTERS” subject matter under consideration be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, 22 October 2009.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office