



MAMA SITA'S HOLDING CO., INC.,
Opposer,

-versus-

INVICTUS FOOD PRODUCTS CORP.,
Respondent-Applicant.

X-----X

IPC No. 14-2014-00510

Opposition to:

Appln. Serial No. 4-2014-00008638

Date Filed: 10 July 2014

TM: LOLA PACITA

NOTICE OF DECISION

NORBERTO GONZALES

Counsel for Opposer

2302 Antel Global Corporate Center

Julia Vargas Ave., Ortigas Center, Pasig City

TRINIDAD NARAG & ASSOCIATES

Counsel for Respondent- Applicant

Unit 1536 City & Land Mega Plaza

ADB Ave., corner Garnet Road,

Ortigas Center, Pasig City

GREETINGS:

Please be informed that Decision No. 2016 - 311 dated 20 September 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 20 September 2016.

Atty. ADORACION U. ZARE

Adjudication Officer

Bureau of Legal Affairs

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

MAMA SITA'S HOLDING CO., INC.,

Opposer,

-versus-

INVICTUS FOOD PRODUCTS CORP.,

Respondent-Applicant.

x-----x

} **IPC NO. 14-2014-00510**

} Opposition to:

}

} Appln. Ser. No. 4-2014-008638

} Date Filed: 10 July 2014

}

} Trademark: **"LOLA PACITA"**

}

} *Decision No. 2016-311*

DECISION

MAMA SITA'S HOLDING CO., INC. , (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-008638. The application, filed by INVICTUS FOOD PRODUCTS CORP., (Respondent-Applicant)², covers the mark "LOLA PACITA", for use on "sauces & condiments" under Class 30 the International Classification of Goods³.

The Opposer relies on the following grounds, in support of the opposition:

"7. The 'LOLA PACITA' mark resembles the trademark 'MAMA SITA'S' owned by Opposer and duly registered with this Honorable Office prior to the Application of, and Publication for Opposition, of the 'LOLA PACITA' mark. Their resemblance is likely to deceive or cause confusion on the same goods or on closely related goods.

"8. The 'LOLA PACITA' mark shall likely cause confusion, mistake and deception on the part of the purchasing public, most especially considering that it is applied for under the same Class 30 of the International Classification of Goods, covering exactly the same goods consisting of 'Sauces and Condiments'.

"9. The registration of the 'LOLA PACITA' mark in the name of the Respondent-Applicant shall violate SEC. 123 OF THE IP CODE, which provides, in part, that a mark cannot be registered if it:

¹ A corporation duly organized and existing under Philippine laws with address at 131F. Manalo St., San Juan City

² A corporation duly organized and existing under Philippine laws with address at Purok 4, Brgy. Del Rosario, City of San Fernando, Pampanga

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.

(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.

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark with which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

(f) is identical with, or confusingly similar to, or constitutes a translation of, a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services, would indicate a connection between those goods and services, and the owner of the registered mark; *Provided further*, That the interests of the owner of the registered mark are likely to be damaged by such use;

"10. Under the above-cited provision, any mark, which is similar to a registered mark like the 'LOLA PACITA' mark, as in this instant case, shall be denied registration in respect of similar or related goods or if the mark applied for, like the subject mark, nearly resembles a registered mark that confusion or deception in the mind of the purchasers shall likely result."

The Opposer alleges that:

"11. Opposer has been engaged in the business of marketing and sale of a wide range of goods, covered under Class 30 of the International Classification of Goods under the Trademark 'MAMA SITA'S' since 1980. Its Trademark is well known all over the Philippines as a brand of sauces and condiments'. This is public knowledge.

It has invested and continues to invest, time, money to develop, maintain and promote the mark in the market and establish its good reputation and good will, covered by the same Class 30.

"12. Pursuant to its prior use, it registered the Trademark 'MAMA SITA'S' under Class 30 of the International Classification of Goods, for goods including sauces and condiments. xxx"

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

1. Print-out of IPO trademark database status of "LOLA PACITA " trademark application;
2. Copy of Certificate of Registration No. 4-2013-002500 for the mark "MAMA SITA'S SWEET CHILI SAUCE" issued on 25 July 2013 for goods under class 30;
3. Copy of Certificate of Registration No. 4-2013-001014 for the mark "MAMA SITA'S SARSA NG LECHON" issued on 25 July 2013 for goods under class 30;
4. Copy of Certificate of Registration No. 4-2011-007969 for the mark "MAMA SITA'S PANSIT BIHON LABEL" issued on 2 July 2012 for goods under class 30;
5. Copy of Certificate of Renewal of Registration No. 33612 for the mark "MAMA SITA'S" registered on 29 August 1984 for goods under class 30;
6. Affidavit of Dennis Yumul dated 24 April 2015; and
7. Affidavit of Renato Decena dated 22 April 2015.⁴

The Respondent-Applicant filed its Answer on 3 March 2015, alleging among other things, the following:

"16. Respondent is the manufacturer of food products starting with mayonnaise in 2007, then catsup in 2008, then sauces and condiments like soy sauce and vinegar in 2010, later to include oyster sauce, barbeque marinade and mixes.

"17. Respondent first used the mark LOLA PACITA on vinegar and soy sauce in 2010 and continuously up to the present. As a consequence of its long and exclusive and uninterrupted use of the mark LOLA PACITA on its products and the amount of money it has spent to promote and advertise the same and the volume of sales of its products bearing said mark, the mark LOLA PACITA has attained a high degree of fame and popularity, it has become a source identifier and has gained valuable goodwill.

"18. The present opposition to respondent's application for registration of the mark LOLA PACITA under Application Serial No. 4/2014/00008638 is without basis in fact and in law and should be denied by this Honorable Office because there is no violation of Sec. 123.1 (d) of the IP Code. Respondent's applied for mark LOLA PACITA is neither

⁴ Exhibits "A" to "D", inclusive of submarkings

identical to or confusingly similar with opposer's registered mark MAMA SITA'S, applying either or both the dominance or holistic test.

A. Respondent's mark is a distinctive mark consisting of the prefix 'LOLA' and the suffix 'PACITA', while the opposer's mark consist of the prefix 'MAMA' and the suffix 'SITA'S'.

B. The prefix of the words in both marks are substantially and markedly different. They completely and adequately distinguish one mark from the other. The distinction already appears in the first word, which by settled jurisprudence is that which is most pronounced and is that which is likely retained in the memory of the potential buyer. The word 'MAMA' in opposer's word combination mark, which is its dominant feature, was not copied by respondent. Thus, applying the Dominancy Test, there is no confusing similarity.

C. The prefix 'LOLA' in respondent's mark is sufficient warning to even the unwary customer that he is purchasing a product different from that of opposer's whose mark is prefixed by 'MAMA'. This renders remote the likelihood of the consumer's being deceived or confused. otherwise put, the use such distinguishing prefix indicates an honest intention on the part of respondent to abstain from associating its mark with that of opposer's.

D. There are five syllables in respondent's applied for mark there are only 4 syllables in opposer's mark.

E. In sum, there are differences between opposer's and respondent's mark which confer upon the latter a character that makes it distinguishable from opposer's mark as to composition, visual presentation and sound. By applying the trilogy test of sound, sight and meaning as applied in well-heeled trademark jurisprudence, the likelihood of confusion between the 2 marks is too remote.xxx"

The Respondent-Applicant submitted as evidence, the following:

1. Sworn Statement of Kevin B. Manaloto dated 27 February 2015;
2. Secretary's Certificate dated 20 February 2015;
3. Delivery Receipt Nos. 40064; 34575; 41245; 39161;
4. Certified copy of Securities and Exchange Commission Certificate of Incorporation dated 16 October 2006;
5. Certified copy of Securities and Exchange Commission Certificate of Filing of Amended Articles of Incorporation dated 6 October 2004; and
6. Certified true copy of death certificate of Pacita Manaloto⁵

⁵ Exhibits "1" to "6", inclusive of submarkings

The Hearing Officer issued on 29 September 2013 a notice setting the Preliminary Conference on 26 November 2015. On said date, the Preliminary Conference was terminated, thereafter, the Hearing Officer issued on 2 December 2015 Order No. 2015-1703 directing both parties to file their respective position papers. The Opposer and the Respondent-Applicant filed their position papers on 14 December 2015 and 22 December 2015, respectively.

Should the Respondent-Applicant be allowed to register the mark "LOLA PACITA"?

Records show that at the time Respondent-Applicant applied for registration of the mark "LOLA PACITA" for goods under class 30, the Opposer already registered the marks "MAMA SITA" under Registration No. 33612⁶ on 29 August 1984; "MAMA SITA'S PANSIT BIHON LABEL" under Registration No. 4-2011-007969⁷ on 2 July 2012; "MAMA SITA'S SARSA NG LECHON" under Registration No. 4-2013-001014⁸ on 25 July 2013; and "MAMA SITA'S SWEET CHILI SAUCE" Registration No. 4-2013-002500 on 25 July 2013, for identical goods under class 30.

But do the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

Opposer's marks



Respondent-Applicant's mark



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 into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and

⁶ Exhibit "B-3"

⁷ Exhibit "B-2"

⁸ Exhibit "B-1"

imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁹ Thus, Sec. 123.1 (d) of R. A. No. 8293, also known as The Intellectual Property Code of the Philippines ("IP Code") 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 a mark as to be likely to deceive or cause confusion.

In ascertaining whether any resemblance between the contending marks result to a likelihood of confusion, the over-all commercial impression is considered. The marks are similar with respect to their suffixes "CITA" and "SITA". The letters "C" and "S" when pronounced are aurally the same. The marks differ in other literal components, but both marks also use the vowel, "A", in their prefixes "LOLA PA-" and "MAMA". The resultant marks when pronounced 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 Patents¹⁰ 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).

Visually, the contending marks are similar. The mark of Respondent-Applicant is written in stylized letters set against a red oval shaped background with "red banner panel". Similarly, the Opposer's "MAMA SITA'S" in Reg. 4-2011-007969¹¹ and Reg. No. 4-2013-001014¹² is written in stylized lettering inside a rectangular box, which looks like the "red banner panel" of the Respondent-Applicant's mark. In these registrations,

⁹ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

¹⁰ G.R. No. L-19297, 22 December 1966

¹¹ Exhibit "B-2"

¹² Exhibit "B-1"

the Opposer claims the colors: Red, brown and green. Even if the Respondent-applicant claim the colors: Red, yellow, white and gold, its mark show that red is its predominant color. The size of the letters and style of writing look the same. The word MAMA is slanting upwards and placed on the left side, above the word SITA. Similarly, the word LOLA is slanting upwards, positioned on the top left portion of the word PACITA. Hence, it not unlikely that the purchasing public will mistake the goods as that of Opposer, when in fact, they are not. One is the colorable imitation of the other. The Supreme Court in Etepha A.G v. Director of Patents¹³ 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. etepha

In Del Monte Corporation v. Court of Appeals¹⁴, the High court, elaborates:

A confusing similarity will justify the intervention of equity. The judge must also be aware of the fact that usually a defendant in cases of infringement does not normally copy but makes only colorable changes. Well has it been said that the most successful form of copying is to employ enough points of similarity to confuse the public with enough points of difference to confuse the courts.

As explained further in the case of Chuanchow Soy & Canning Co. v. Director of Patents¹⁵, to wit:

When two competing labels are placed together for inspection and still they may confuse an ordinary person, specially cooks and maids, who as a rule are the one in charge of buying such household article as soy sauce, there would be more confusion and doubt when the two labels are not placed together for comparison and the prospective purchaser is guided only by his memory or recollection that the soy sauce he or she is planning to buy has as its label the drawing of a fish with letters and Chinese characters, written in a certain style of lettering and color. When, as in the present case, one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill.

Applying the dominancy test, the Respondent-Applicant's mark appropriates the prevalent, central feature of Opposer's MAMA SITA'S mark. "SITA'S" and "PACITA" are visually and aurally similar, as one can be thought of as a shortened version of the other. The etymology of the words LOLA and MAMA, similarly connote an older female kin, a mother and grandmother. Succinctly, because the Respondent-Applicant uses its mark on goods that are similar or closely related to the Opposer's it is likely that the

¹³ G.R. No. L-20635, March 31, 1996

¹⁴ G.R. No. L- 78325, 25 Jan 1990

¹⁵ G.R. L. No. 13947, June 30, 1960

consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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 plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, 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.¹⁶

Finally, the Opposer, through a Motion for Leave to Admit Supplemental Pleading, submitted the Affidavits of Dennis Yumul¹⁷ and Renato Decena¹⁸. The affiants, sales coordinators of the Opposer, testified that they received feedback from different customers/store owners. According to the customers/store owners, they were informed by agents of LOLA PACITA products that the owner of MAMA SITA'S and LOLA PACITA are the same, while some were informed that MAMA SITA'S products no longer exist and the name was changed to LOLA PACITA. Some store owners/customers were told that MAMA SITA'S and LOLA PACITA are produced by the same manufacturer. These events which occurred after the filing of the instant opposition is testament to actual confusion and deception among the buying public, given that the Opposer's mark MAMA SITA'S has been in existence since 29 August 1984 and Respondent-Applicant's mark is a colorable imitation of the Opposer's mark.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-008638 is hereby **SUSTAINED**. Let the filewrapper 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, 20 SEP 2016


ADORACION U. ZARE
Adjudication Officer

¹⁶ *Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

¹⁷ Exhibit "C"

¹⁸ Exhibit "D"