



BINALOT FIESTA FOODS, INC.,

Opposer,

-versus-

JENNIFER A. ROBLES,

Respondent-applicant.

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Intellectual Property Office Case No. 14-2007-00208

Opposition to:

Application Serial No. 4-2006-011541

Date Filed: October 23, 2006

Trademark: **"BLT REPUBLIC**

MEALS IN BANANA

LEAVES AND DEVICE"

Decision No. 09-34

DECISION

For decision is the Notice of Opposition filed by Binalot Fiesta Foods, Inc., hereinafter referred to as opposer, a corporation organized and existing under Philippine laws with address at No. 3841 Daffodil Street, Sun Valley Subdivision, Paranaque City against Application Serial No. 4-2006-011541 for the registration of the trade name "BLT REPUBLIC MEALS IN BANANA LEAVES AND DEVICE" for use in restaurant/catering under Class 43 filed on 23 October 2006 by Jennifer A. Robles, hereinafter referred to as respondent-applicant, with address at 85-A P. Tuazon Street, Cubao, Quezon City. The grounds for the opposition are the following:

"1. The dominant feature or part of Respondent-Applicant's trade name **BLT REPUBLIC MEALS IN BANANA LEAVES AND DEVICE** is confusingly similar, if not outright identical to the dominant feature or part of Opposer's corporate name **BINALOT FIESTA FOODS, INC.**

2. Respondent-Applicant's trade name **BLT REPUBLIC MEALS IN BANANA LEAVES AND DEVICE** is confusingly similar, if not outright identical to the following:

a.) The registered trade name **BINALOT & REPRESENTATION OF PINOY MEAL** of Opposer for use on catering services, formerly classified under Class 42, now Class 43;

b.) The registered trade name **BINALOT AND DEVICE** of Opposer for use on fast food chain store falling under Class 43;

c.) The registered trademark **BINALOT IN STYLIZED PRINT AGAINST A BANANA LEAF AND REPRESENTATION OF BINALOT MASCOT** of Opposer for use on various food products, namely: fiesta adobo, vivo tocino, pork bongga longanisa, no bones daing na bangus, bistek walastik, tapa rap sarap, anytime inihaw na baboy, may dinuguan and only, bopisticated, tenderloin tips, adobo rice falling under Class 30;


3. The registration of the trade name BLT REPUBLIC MEALS IN BANANA LEAVES AND DEVICE in favor of Respondent-Applicant violates Section 123.1 (d) and Section 147 of the Intellectual Property Code of the Philippines (IP code), since Opposer has existing registrations for the trade names **BINALOT & REPRESENTATION OF PINOY MEAL**; and **BINALOT AND DEVICE**; and the trademark **BINALOT IN STYLIZED PRINT AGAINST A BANANA LEAF AND REPRESENTATION OF BINALOT MASCOT**, all of which are in full force and effect;

4. Respondent-Applicant filed Application Serial No. 4-2006-011541 fraudulently and in bad faith;

5. The registration of the trade name BLT REPUBLIC MEALS IN BANANA LEAVES AND DEVICE in the name of Respondent-Applicant will cause great and irreparable damage and injury to Opposer within the meaning of Section 134 of the IP Code."

Opposer submitted the following evidence in support of its opposition:

EXHIBIT	DESCRIPTION
A	Certified true copy of the Certificate of Incorporation and Articles of Incorporation of BINALOT FIESTA FOODS, INC. ;
B	Certified true copy of Certificate of Registration No. 4-1996-108867 issued on May 30, 2003 in favor of Opposer for the tradename BINALOT & REPRESENTATION OF PINOY MEAL ;
C	Certified true copy of Certificate of Registration No. 4-2005-001022 issued on January 11, 2007 in favor of Opposer for the trademark BINALOT AND DEVICE ;
C-1	Certified true copy of Application Serial No. 4-2005-001022 for the trade name BINALOT AND DEVICE ;
D	Certified true copy of Certificate of Registration No. 4-2003-009928 issued on October 24, 2005 in favor of Opposer for the trademark BINALOT IN STYLIZED PRINT AGAINST A BANANA LEAF AND REPRESENTATION OF BINALOT MASCOT ;
E to E-5	Certified true copies of the Certificates of Registration issued to Opposer by the Bureau of Internal Revenue on May 22, 1996; Mayor's Permit issued on May 21, 1996 by the Mayor of Mandaluyong City; and Special Bank Receipts of Premium payments to SSS;
F	Lease Contract with Ayala Land Corp. for the first BINALOT outlet opened in Greenbelt Park, Ayala Center, Makati City;
F-1	A sample of BINALOT Greenbelt's flyer;


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G	A representative sample of a Franchise Agreement of a BINALOT outlet;
H to H-34	Representative commercial documents such as check vouchers, sales invoices, purchase orders of Opposer BINALOT Fiesta Foods, Inc.;
I to I-1	BINALOT labels;
J to J-1	BINALOT wrappers;
K	Duly notarized affidavit of Rommel T. Juan, President of BINALOT Fiesta Foods, Inc. dated January 23, 2006;
L	Certified copy of Decision No. 2006-94 in Inter Partes Case No. 14-2006-00007;
M	Computer print-out of Application Serial No. 4-2004-00100 of Respondent-Applicant for the trade name BALOT BALOT REPUBLIC MEALS IN BANANA LEAVES AND DEVICE;
M-1	Computer print-out of Application Serial No. 4-2006-011541 of Respondent-Applicant for the trade name BLT REPUBLIC MEALS IN BANANA LEAVES AND DEVICE;
N	Duly notarized affidavit of Rommel T. Juan, President of BINALOT Fiesta Foods, Inc.

Respondent–applicant filed its Answer on January 02, 2008 which raised the following affirmative allegations and defenses:

“1. Opposer merely claims and assumes that it is likely to be damaged and prejudiced by the approval of Respondent-Applicant's application. Far from being an imitation of Opposer's mark, BLT Republic Meals in Banana leaves was coined by Respondent-Applicant specifically for future use on her own line of services and goods. Unlike Opposer's “Binalot”, the applied mark BLT does not derive its meaning from any word found in the dictionary nor used in any language or vernacular.

2. In fact, in box ten (10) of Respondent-Applicant's Trademark Application it was expressly manifested that the word BLT does not have any literary meaning or translation. The word BLT is merely a fanciful word. Therefore, Opposer's assumption that the word BLT means “Balot” is totally baseless and unfounded (a photocopy of Respondent-Applicant's Application Form is hereto attached as **Annex “1”**).

3. A comparative presentation of both marks would show that the contending marks have no similarity at all. It must be noted that Respondent-Applicant's trademark actually consists only of the words BLT Republic Meals in Banana Leaves, with the letters BLT as the most noticeable feature, unlike Opposer's trademark which depicts the common and solitary word Binalot. Moreover, even the backgrounds of the two

marks are distinct and different from one another. While the words BLT Republic are simply encased in a circular or oval sphere, Opposer's trademark is set amid a leaf background. Neither are the prints, slant or font of the letters similar. These striking differences are enough to negate Opposer's assertion that Respondent-Applicant's trademark is confusingly similar and is likely to damage or prejudice the Opposer.

4. It is true that Respondent-Applicant is also the applicant for the mark "Balot Balot Republic Meals in Banana Leaves" which was contested in IPC No. 14-2006-00007, and that an adverse Decision was actually promulgated by the Bureau of Legal Affairs on 27 September 2006.

5. However, said decision of the Bureau of Legal Affairs has no bearing in the present application considering that the instant application must be treated as a separate and independent trademark application. After all, it must be stressed that there is still no final conclusion on IPC No. 14-2006-00007 for the mark "Balot Balot Republic Meals in Banana Leaves" as the same was seasonably appealed by Respondent-Applicant.

6. Therefore, there is no basis in fact and in law to bar the present application of Respondent-Applicant solely on the ground of a pending appeal before the Office of the Director General. To reiterate, the subject of the previous controversy between Respondent-Applicant and Opposer was an applied mark different, separate and distinct from the mark presently applied for by Respondent-Applicant.

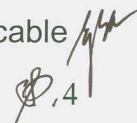
7. Opposer is simply stretching the interpretation of the mark BLT Republic by substituting his own baseless interpretation and assumption thereof. The claim of alleged striking similarity between the contending marks is purely in the eyes of Opposer for even the ordinary consumer could easily discern the difference between the marks "BLT Republic" and "Binalot".

8. Besides, Opposer's claim that the public has associated the trade names Binalot & Representation of Pinoy Meal and Binalot and Device and the trademark Binalot in Stylized Print Against A Banana Leaf and Representation of Binalot Mascot with the food services and food products of Opposer is merely self-serving.

9. Respondent-Applicant clearly has a right to use and register the mark BLT Republic Meals in Banana Leaves. Indeed, there can be no confusion nor damage or prejudice to Opposer should BLT Republic Meals in Banana Leaves be registered in the name of Respondent-Applicant."

Respondent –applicant submitted a copy of her Trademark Application (Annex "1") for the challenged mark as evidence.

The preliminary conference was set on 11 February 2008 but no amicable

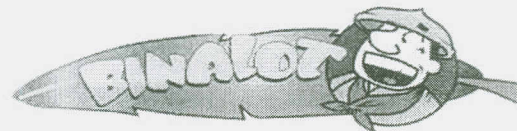
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settlement was obtained between the parties. The issue whether the tradename BLT Republic appropriates the dominant feature of opposer's registered mark.

The marks of the contending parties are set below for reference.



Respondent-Applicant's trademark



Opposer's trademarks

Opposer's marks namely "BINALOT & Representation of Pinoy meal" under Certificate of Registration No. 4-1996-108867 issued in 30 May 2003 for catering services under Class 42 (Exhibit "B") and "Binalot and Device Banana Leaf with Binalot Name inscribed in the middle of the leaf, mascot on the right side of the Leaf" under Certificate of Registration No. 4-2005-001022 issued in 11 January 2007 for fastfood chain under Class 43 are registered for similar services as that of respondent-applicant's application of its BLT Republic mark for restaurant/catering services under Class 43.

However, by examination of the appearance of the marks, this Bureau is unconvinced that the dominant feature of the opposer's mark has been appropriated by the respondent-applicant's adoption of the letter's BLT. As correctly pointed out by the respondent-applicant, the letters BLT has no dictionary meaning. Therefore, it is a coined and fanciful word and can be appropriately adopted as a mark. It is not similar or remotely identical with the word BINALOT. Even upon examination of the color scheme or design of the contending marks, there is no showing of respondent-applicant's mark being a colorable imitation of the other.

A mark cannot be registered in the Philippines if it is confusingly similar to a mark which has already been previously registered in the Philippines. This is to prevent confusion and deception upon the public on account of the possibility of a second registration of a

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confusingly similar or identical mark. The law provides:

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

(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”

In determining that no confusion will result in the contemporaneous use of the marks finds support in Phillip Morris, Inc. Benson & Hedges (Canada), Inc and fabriques de Tabac Reunies , S.A. v. Fortune Tobacco Corporation, Gr. No. 15859, 27 June 2006, it was held:

“although the perceived offending word "MARK" is itself prominent in petitioners' trademarks "MARK VII" and "MARK TEN," **the entire marking system should be considered as a whole and not dissected, because a discerning eye would focus not only on the predominant word but also on the other features appearing in the labels.** But, even if the dominancy test were to be used, as urged by the petitioners, but bearing in mind that a trademark serves as a tool to point out distinctly the origin or ownership of the goods to which it is affixed, the likelihood of confusion tantamount to infringement appears to be farfetched. The reason for the origin and/or ownership angle is that unless the words or devices do so point out the origin or ownership, the person who first adopted them cannot be injured by any appropriation or imitation of them by others, nor can the public be deceived.”

In the instant case, respondent-applicant's mark is not identical to the registered mark and neither is it a colorable imitation of the other. The Supreme Court in Etepha v. Director of Patents and Westmont Pharmaceuticals, Inc., No. L-20635, March 31, 1966 defines colorable imitation, it held:

“The validity of a cause for infringement is predicated upon colorable imitation. The phrase “colorable imitation” denotes such “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 one supposing it to be the other.”

Handwritten signature and initials in black ink, located at the bottom right of the page.

WHEREFORE, premises considered the **OPPOSITION** filed by Binalot Fiesta Foods Inc., opposer is, as it is hereby, **DENIED**. Accordingly, Application Serial No. 4-2006-11541 filed by Jennifer Robles, Respondent-Applicant, for the mark "BLT REPUBLIC MEALS IN BANANA LEAVES AND DEVICE" for use in restaurant/catering under Class 43 and filed in 23 October 2006, is as it is hereby, **GIVEN DUE COURSE**.

Let the filewrapper of "BLT REPUBLIC MEALS IN BANANA LEAVES AND DEVICE", subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

Makati City, March 19, 2009.



ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs

