



INTELLECTUAL PROPERTY  
OFFICE OF THE PHILIPPINES

**ARJOLAN PREMIER CORPORATION,**  
(doing business under the name and style of  
KERRIMO AND SHOP N SAVE SUPERSTORE),  
*Opposer,*

**-versus-**

**MYLENE L. FERNANDEZ,**  
*Respondent-Applicant.*

**IPC No. 14-2016-00491**

Opposition to:

Appln. Serial No. 4-2016-003190  
Date Filed: 28 March 2016

**TM: K KERIMOTO CARRY MO TO!**

**NOTICE OF DECISION**

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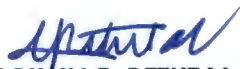
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**GREETINGS:**

Please be informed that Decision No. 2017 - 356 dated 12 October 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, 19 October 2017.

  
**MARILYN F. RETUAL**  
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IPC No. 14-2016-00491  
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Date Filed: 28 March 2016

Trademark: "**K KERIMOTO  
CARRY MO TO!**"

Decision No. 2017 - 356

## DECISION

ARJOLAN PREMIERE CORPORATION [doing business under the name and style of, Kerrimo and Shop n Save Supermarket] ("Opposer")<sup>1</sup>, filed a verified opposition to Trademark Application Serial No. 4-2016-00491. The application, filed by MYLENE L. FERNANDEZ ("Respondent-Applicant")<sup>2</sup>, covers the mark "K KERIMOTO CARRY MO TO!" for use on the following classes of goods<sup>3</sup>: 29 namely: *meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats*; 30 namely: *coffee, tea, cocoa, sugar, rice tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder, salt, mustard; vinegar, sauces (condiments); spices; ice*; 32 namely: *beers, mineral and aerated water and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages*; and, 43 namely: *services for providing food and drink; temporary accommodation*.

The Opposer alleges that it is the prior applicant of the mark "KERRIMO" in the Philippines having filed its trademark application on 08 October 2013 or more than three (3) years before Respondent-Applicant filed its application for the mark "K KERIMOTO CARRY MO TO!" on 28 March 2016. It has also a prior valid and existing trademark registration in the Philippines for the mark "KERRIMO" which was granted on 02 January 2014 or more than two (2) years before the subject trademark application.

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- <sup>1</sup> A corporation duly organized and existing under the laws of the Philippines with principal place of business at Blk. 1, L20 City Park Subdivision, Lipa City, Batangas.
- <sup>2</sup> With registered address at Block 14 Lot 53 Citta Maria Darasa, Tanauan, Batangas, Philippines.
- <sup>3</sup> 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.

The Opposer recounts that its predecessor-in-interest, Inokim Corporation, designed and developed a franchise system known as "KERRIMO", a food cart business offering a "snack and drink in one cap" concept which grants franchise and license to entities and individuals that meet the qualifications. KERRIMO is an arbitrary coined mark created to suggest "carry-out" or "take-away". On 05 September 2011, Inokim Corporation sold and transferred all its rights, titles and interest including all intellectual property rights, goodwill, franchise system, websites to the "KERRIMO" food cart franchise system to herein Opposer.

Accordingly, Opposer started as the exclusive territory franchisee/distributor for Batangas and Quezon. The Opposer set-up stores in the territory and invested time, money and effort to develop, maintain and promote the "KERRIMO" trademark and goodwill in the market. Opposer then decided to change from sole proprietorship to the incorporation of ARJOLAN PREMIERE CORPORATION.

Sometime in 2016, the Opposer learned that Respondent-Applicant opened several "Kerimoto" food cart business using the same concept and selling the same food items which directly competes with the food cart business of the Opposer. It also used a confusingly similar mark "K KERIMOTO CARRY MO TO!" or "KERIMOTO" for its food cart business which is a colorable imitation of the "KERRIMO" trademark of the Opposer for the same and related class.

Thus, to protect and enforce its intellectual property rights, the Opposer seek the assistance of the IPRD-NBI for the infringement of its rights. The IPRD-NBI was able to secure search warrant and conducted search and seizure operations at "KERIMOTO" branches in Tanauan City, Batangas and Muntinlupa City.

This instant case opposes Respondent-Applicant's mark "K KERIMOTO CARRY MO TO!", alleged as confusingly similar with the Opposer's mark "KERRIMO" since it is very likely to cause confusion, mistake and deception on the part of the purchasing public used in connection with the goods and services of Respondent-Applicant. The Opposer claims protection under Section 123.1 (d) of R.A. No. 8293 on the ground of the latter's earlier date and a prior valid and still existing trademark registration for the "KERRIMO" mark under class 43. Thus, the adoption by the Respondent-Applicant of the "K KERIMOTO CARRY MO TO!" mark is designed to ride on the goodwill of Opposer's mark, to diminish the distinctiveness and to dilute the goodwill established by the well-known "KERRIMO" mark.

The Opposer submitted the following evidence:

1. Certified true copy (Ctc) of Registration No. 4-2013-012178 for the mark KERRIMO;
2. Exclusive Territory Franchise Agreement for Batangas and Quezon of INOKIM Corporation (Kerrimo Food Stuffs and Drinks in One);
3. Certificate of Business Name Registration for ARJOLAN Enterprises;
4. Sanitary Permit to Operate for ARJOLAN Enterprises;
5. Certificate of Registration issued by the Bureau of Internal Revenue to Edmundo Tisbe Lanto;
6. Barangay Clearance for ARJOLAN Enterprises;

7. Certificate of Incorporation of ARJOLAN PREMIERE CORPORATION;
8. Memorandum of Agreement between INOKIM Corporation and ARJOLAN PREMIERE CORPORATION;
9. Promotional leaflets, pictures and advertisements of KERRIMO Franchise Packages;
10. Amended Articles of Incorporation of ARJOLAN PREMIER CORPORATION;
11. Photographs of Respondent-Applicant's Kerimoto food cart business;
12. Application for K Kerimoto Carry Mo To! trademark registration;
13. Globe text messages and letter of intent on inquiry of KERRIMO and/or KERIMOTO franchises;
14. Photograph of KERIMOTO snack and drink in one cup;
15. Photograph of Opposer's "Auxiliary Cup for Drinking Container" under Industrial Design Registration Nos. 3-2007-000310 and 3-2007-000311;
16. Letter dated 16 August 2016 to IPRD, National Bureau of Investigation; and,
17. Search Warrant issued by Judge Rainelda H. Estacio Montesa, Branch 47, Regional Trial Court, Manila.

On 22 December 2016, Respondent-Applicant submitted her Answer. She alleges that the mark "KERIMOTO" is not confusingly similar and identical to the mark "KERRIMO". Using the Dominance Test, the dominant marks of "KERRIMO" and "KERIMOTO" are glaringly not similar and colorable imitation of each other. The appearance and presentation of the mark is grossly divergent from each other. They have both distinct and special features that a purchaser can readily identify, and they have their own respective peculiarities that distinguish one from the other.

The Respondent-Applicant further alleges that the "KERRIMO" logo circulated in the market is not the one registered with this Honorable Office. "KERRIMO" is plainly stylized word mark, printed in capital letters with no distinguishing marks. In contrast, the "KERIMOTO" mark bears the dominant letter "K", which is presented in bold red color sign with a by-line "KERIMOTO CARRY MO!" In fact, confusion does not exist even if the Holistic Test is applied, which entails a consideration of the entirety of the marks as applied to the products, including labels and packaging, in determining confusing similarity. In relation to the jurisprudential yardstick, the "KERRIMO" and the "KERIMOTO" marks have different and distinctive packaging and setting by which they appear and are presented. The mark "Kerrimo" is presented with a white background with consistent color red in all of its letter-components. On the other hand, the mark "Kerrimoto" is made to appear with a purple background with distinguishing stars scattered in four corners.

In addition, the Respondent-Applicant avers that the Idem Sonans Test alone is insufficient to find confusion. The Opposer cannot rely on the ruling of the Honorable Supreme Court in the case of McDonald's Corporation vs. MacJoy Fastfood Corporation which said that the subject marks were arbitrary contractions of composite words, which are not ordinarily and commonly used or generic. In the instant case, the mark "KERRIMO" is a contraction of the phrase "CARRY MO". The pronunciation or sound of said phrase is generic and descriptive of the food product such that Opposer cannot claim exclusive right for the use thereof. The phrase "Carry Mo", where the supposed contracted word "Kerrimo" is derived, is a common phrase that one can readily utter or formulate.

Finally, the Respondent-Applicant maintains that the evidence supposedly seized pursuant to the search warrant is subject to a Motion to Quash filed by Respondent-Applicant.

The Preliminary Conference was held and terminated on 06 July 2017. Thereafter, the Opposer and the Respondent-Applicant submitted their respective position papers on 22 and 17 August 2017. This case is now submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark K KERIMOTO CARRY MO TO! ?

Prefatorily, 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 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 imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.<sup>4</sup>

Records reveal that at the time the Respondent-Applicant filed an application for registration of the subject mark "K KERIMOTO CARRY MO TO!" on 28 March 2016, the Opposer already has valid and existing registration of its "KERRIMO" mark filed on 08 October 2013, and issued as early as 02 January 2014 under Certificate of Registration No. 42013012178.<sup>5</sup>

But are the competing marks, as shown below, confusingly similar?

**KERRIMO**

Opposer's Trademark



Respondent-Applicant's Trademark

The foregoing shows the Opposer's word mark "KERRIMO" in plain stylized font; and Respondent-Applicant's mark with a big letter "K", the word mark "KERIMOTO" and the words "CARRY MO TO!" in smaller fonts. An examination of these marks reveals that the entire word mark "KERRIMO" is contained in "KERIMOTO CARRY MO TO!" mark. Obviously, it projects both aural and visual similarity. Moreover, the word "CARRY MO TO!" when pronounced, produces the same aural resonance because of the same sound of the letters "C" and "K". While it is true that the letter "K" in Respondent-Applicant's mark exists in bigger font, this

<sup>4</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

<sup>5</sup> IPPHL Philippine Trademark Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 10 October 2017).

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is an insignificant factor to establish the independent character and impression of the subject mark.

In fact, when one looks at the letter "K" of Respondent-Applicant's "K KERIMOTO CARRY MO TO!", what is retained in the eyes and mind is its reference or association with the contending marks, both with initial letter "K". While Respondent-Applicant's mark has the additional words "CARRY MO TO!", again, it is almost negligible that one cannot help but at least be reminded of the Opposer's registered mark. Further, the argument of Respondent-Applicant that the sound of "KERRIMO" is generic and descriptive of the food product such that the phrase "Carry Mo", where the supposed contracted word "Kerrimo" is derived, is a common phrase that one can readily utter or formulate, and therefore cannot be exclusively used by the Opposer is untenable. The word mark "KERRIMO" does not appear as a contracted word<sup>6</sup> from "Carry Mo". It is a coined or fanciful word mark which is not commonly uttered and used in ordinary commerce.

Thus, it is likely that consumers will be confused or have the wrong impression that the contending marks and/or the parties are connected or associated with one another. After all, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.<sup>7</sup> As held by the Supreme Court in **Del Monte Corporation vs. Court of Appeals**<sup>8</sup>:

"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."

Further, the illustrated marks cover similar and/or related goods, more particularly class 43 for food and drinks services. Indeed, they are found in the same channels of business and trade and/or cater its products to the same segment of consumers. Thus, the consumers will have the impression that the service and the goods originate from a single source or origin or they are associated with one another. The likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:<sup>9</sup>

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

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<sup>6</sup> A shortened form of a word or group of words, with the omitted letters often replaced in written English by an apostrophe, as e'er for ever, isn't for is not, dep't for department. Definition of Contraction. Available in Dictionary.com <http://www.dictionary.com/browse/contraction> (last accessed 11 October 2017).

<sup>7</sup> Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

<sup>8</sup> G.R. No. L-78325, 25 January 1990.

<sup>9</sup> Id.

plaintiff's 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.

Corollarily, Section 123.1 paragraph (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides that 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:

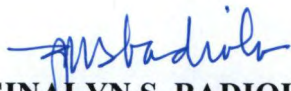
- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Hence, the registration of the mark applied for registration by the Respondent-Applicant must not be allowed pursuant to Section 123.1 of the IP Code.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2016-003190 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. **12 OCT 2017**

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