



OFFICE OF THE DIRECTOR GENERAL

BIG BUDDHA RESTAURANT, INC.
Respondent-Applicant-Appellant,

APPEAL NO. 14-08-38
IPC NO. 14-2007-00213

-versus-

NFL PROPERTIES EUROPE, B.V.,
Opposer-Appellee.

Opposition to:
Serial No. 4-2006-004156
Date Filed: 20 April 2006
Trademark: SUPER BOWL
OF CHINA & DEVICE

x-----x

NOTICE OF DECISION

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

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GREETINGS:

Please be informed that on 26 June 2009, the Office of the Director General rendered a Decision in the above-titled case (copy attached).

Makati City, 26 June 2009.

Very truly yours,

[Signature]
ATTY. NATHANIEL S. AREVALO
Attorney VI/Head, Office of Legal Counsel

CERTIFIED TRUE COPY:

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Robert Nereo B. Samson
Attorney IV
Office of the Director General



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INTELLECTUAL PROPERTY
PHILIPPINES
OFFICE OF THE DIRECTOR GENERAL

NFL PROPERTIES EUROPE, B. V.,
Opposer-Appellee,

-versus-

BIG BUDDHA RESTAURANT, INC.,
Respondent-Appellant.

x-----x

Appeal No. 14-38-08

Inter Partes Case No. 14-2007-00213

Application No. 4-2006-004156

Date Filed: 20 April 2006

Trademark: SUPER BOWL OF CHINA
AND DEVICE

DECISION

BIG BUDDHA RESTAURANT, INC. ("Appellant") appeals Decision No. 2008-142, dated 10 July 2008, of the Director of the Bureau of Legal Affairs ("Director"). The Director sustained the opposition of NFL PROPERTIES EUROPE, B. V. ("Appellee") to the Appellant's application for the registration of the mark "SUPER BOWL OF CHINA AND DEVICE".

Records show that the Appellant filed on 20 April 2006 its trademark application covering restaurant services under Class 41 of the Nice Classification.¹ The application was published in the "IPO e-Gazette" for Trademarks on 23 March 2007. On 20 July 2007, the Appellee filed a "NOTICE OF OPPOSITION" alleging the following:

1. It is the prior user and the registered owner of the mark "SUPER BOWL" in the Philippines under Cert. of Reg. No. 4-2002-008157 issued on 02 October 2006 covering education and entertainment services namely, organization of sports and sports events, entertainment services provided during intervals at sports events, arranging and organizing of competitions, physical education programs, production of radio and television programs, live shows and display, provisions of information related to entertainment and sports via internet;
2. It has used SUPER BOWL in the Philippines since 1979 long before the Appellant appropriated the confusingly similar mark SUPER BOWL OF CHINA AND DEVICE;
3. It has registered SUPER BOWL in the U.S.A. since 1967 and is the producer of the popular American football games, like the Super Bowl Championship games, which are broadcast in over two hundred (200) countries including the Philippines, and has used and registered or applied for registration thereof in many other countries;

¹ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

4. Its mark is entitled to broad legal protection against unauthorized users like the Appellant which has appropriated a deceptively similar mark;
5. The Appellant's mark resembles the Appellee's because the dominant and distinctive elements of the marks are identical that when applied to or used in connection with the Appellant's services will likely cause confusion, mistake and deception upon the public by misleading them into thinking that the Appellant's services either come from or are sponsored or licensed by the Appellee;
6. The Appellant intends to trade and is trading on the Appellee's goodwill and its registration and use of the mark will diminish the distinctiveness and dilute the goodwill of the Appellee's mark which is an arbitrary mark;
7. The approval of the Appellant's mark is based on the representation that it is the originator, true owner and first user of this mark, which was merely derived from the Appellee's SUPER BOWL;
8. The Appellant's use of its mark infringes upon the Appellee's exclusive right to use SUPER BOWL which is a well-known mark protected under Secs. 147 and 123.1 (d) and (f) of the Intellectual Property Code of the Philippines ("IP Code"), Art. 6bis of the Paris Convention for the Protection of Industrial Property and Art. 16 of the Agreement on Trade-Related Aspects of Intellectual Property Rights;
9. The Appellant's use of the mark is to gain public acceptability for its services through its association with the famous mark SUPER BOWL, which has attained well-known status and international renown; and
10. In appropriating SUPER BOWL OF CHINA AND DEVICE, the Appellant betrayed its awareness of the Appellee's existence and the prior use and renown of the mark and the Intellectual Property Office must implement the provisions of the Paris Convention and the IP Code by confirming the Appellee's rightful ownership of SUPER BOWL.

The Appellant filed its "ANSWER" on 03 September 2007 alleging the following:

1. The competing marks are not confusingly similar as the Appellee's registration is for a different class of goods and services and its alleged application and/or registration in the U.S.A. cannot prevent the application of the lawful and original creator and user of SUPER BOWL OF CHINA AND DEVICE;
2. There is no identity in the mark and no confusing similarity will arise if the current application would be allowed registration and there is no likelihood that the public will be misled into thinking that the parties' respective marks are related;

mk

3. The registration of its mark will not dilute or diminish the goodwill of the Appellee's mark;
4. "SUPER" connotes big portions or big sizes in terms of its food servings, "BOWL" is related to food being a kitchen utensil for serving and eating food or soup, "CHINA" relates to the type of cuisine specialized in and served by the Appellant which is Chinese Cuisine, and the font, coloring, and general layout of the logo in no way lends anyone to believe that the competing marks are related;
5. Its mark is original which was created and conceptualized without any regard or reference, either directly or indirectly to the Appellee's mark that applies to an American football game that is not generally known in the Philippines;
6. There is no infringement and the Appellee's mark should not be given the protection and status of a well-known mark; and
7. It has already built goodwill in the Philippine market through substantial investments in terms of its marketing and franchising efforts, not to mention that it has enjoyed "word-of-mouth" advertising through its reputation for serving quality Chinese food, with big portions or servings, and at affordable prices, with friendly and efficient service, including its delivery service through its "Super Delivery" food delivery service and catering services;

The Appellee submitted the following evidence to support its opposition:

1. Affidavit of Gary M. Gertzog executed on 16 July 2007;
2. Chart of NFL International Television Sales;²
3. Printouts of the international television broadcast coverage of NFL football games;³
4. Articles on the high ratings of SUPER BOWL games and being the most valuable sporting events brand in the world;⁴
5. Catalogs for SUPER BOWL;⁵
6. Printouts from its website and other websites;⁶
7. Articles and publications on SUPER BOWL games;⁷
8. Copy of a decision from the Trademark Office of Thailand;⁸ and
9. Details of SUPER BOWL marks filed and registered in various countries and the representative samples of copies of certificates of registrations;⁹

On the other hand, the Appellant's evidence consists of the following:

² Exhibit "A".

³ Exhibit "B".

⁴ Exhibits "C" and "D".

⁵ Exhibit "E".

⁶ Exhibits "F" and "G".

⁷ Exhibit "H".

⁸ Exhibit "I".

⁹ Exhibits "J" to "M".

1. Affidavit of Luis L. Vera, Jr. executed on 30 August 2007;
2. Copy of the Menu of the Appellant;¹⁰
3. Articles from the Manila Bulletin, Women's Journal, The Daily Tribune, Philippine Star, Malaya and Women's Magazine;¹¹ and
4. Promotional and advertising materials;¹²

In sustaining the opposition, the Director ruled that there is a duplication and imitation of the Appellee's mark SUPER BOWL which would result to confusion and deception. According to her, while the goods of the Appellant are not exactly the same as those enumerated in the Appellee's certificate of registration, it is very likely that the Appellant's goods/services would be assumed to have originated from the Appellee.

Dissatisfied, the Appellant filed a "MEMORANDUM ON APPEAL (for Respondent-Applicant)" on 09 September 2008 reiterating its arguments in the proceedings in the Bureau of Legal Affairs and further alleges the following:

1. Its mark includes the words "OF CHINA" and belongs to different classes of goods;
2. The "Holistic" Test is the more appropriate test and it is easy to see that if the marks are taken as a whole, there can never be any confusing similarity between them;
3. The dominant and distinctive elements of the parties' respective marks are not identical and will not cause confusion, mistake and deception and will not mislead the public into thinking that its mark is related to the Appellee's mark;
4. In a previous *Inter Partes* case decided by this Office, it was held that due course is to be given a trademark application if the goods are dissimilar, non-competing and unrelated and will not cause confusion, mistake, or deceive purchasers;¹³
5. In this case, the goods and services are obviously dissimilar, non-competing and even unrelated and there it is unlikely that the public will be misled into thinking that the parties' respective marks are related and the claim that the allowance for registration of its mark will dilute or diminish the goodwill of the Appellee's mark is purely imagined and without legal and factual basis; and
6. The Appellee's mark is not well-known in the Philippines and even if it is an internationally well-known mark, this should still not prevent the application of another mark if the other mark has no connection with the other mark, and if the other mark will not cause damage to the well-known mark.

The Appellee filed its "COMMENT (to the Memorandum on Appeal dated September 2, 2008)" on 19 November 2008 maintaining its allegations in its opposition and further argues that:

¹⁰ Annex "1".

¹¹ Annexes "2" to "10".

¹² Annexes "11" to "28".

¹³ *Advance Magazine Publisher, Inc. vs. Cosway (M) SDN. BHD., Inter Partes* Case No. 14-2002-00070, Appeal No. 14-05-07.

1. The Appellant's unauthorized appropriation of its mark is not due to mere chance but a deliberate effort to trade upon the goodwill and favorable reputation earned by its mark SUPER BOWL;
2. The Appellant's use and registration of SUPER BOWL OF CHINA AND DEVICE would indicate a connection to its services and that it is likely to be damaged by such use and registration;
3. As the originator, owner and first user of SUPER BOWL, it has the exclusive right to exploit its reputation and popularity either by using the marks on other products, or by licensing its use on any products by other parties;
4. To allow the Appellant to register SUPER BOWL OF CHINA AND DEVICE would deprive it of the right to expand the use of SUPER BOWL on other products and the Appellant would be beyond its control as it has no means of ensuring the quality of the Appellant's products and services;
5. The Appellant is not a prior user in good faith and is not entitled to any form of legal protection under the IP Code; and
6. With the international popularity of SUPER BOWL, it is inconceivable that the Appellant had been unaware of this mark at the time it appropriated and used it.

The issue in this appeal is whether the Director was correct in sustaining the Appellee's opposition to the Appellant's trademark application.

In this regard, 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.¹⁴

Thus, Sec. 123.1, paragraphs (d), (e) and (f), of the IP Code provide 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;"

¹⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

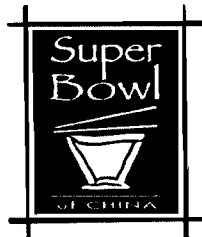
(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the 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 knowledge of the relevant sector of the public, rather than 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 or 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;

To avail of the protection under the afore-quoted provisions of law, and, thus, prevent the registration of the Appellant's mark, it must first be established that the competing marks are identical or closely resembling each other and are used on identical, similar or closely related goods or otherwise would indicate a connection between the competing marks or the parties.

Are the competing marks identical?

For comparison, the competing marks are reproduced below:



Appellant's mark

SUPER BOWL

Appellee's mark

Obviously, the phrase "Super Bowl" in the Appellant's mark is identical to the Appellee's. However, there are distinctive features in the Appellant's mark which would also promptly draw the eye and attention of the consuming public.

The next question is: Are the competing marks used on identical or similar goods?

The Appellee owns a certificate of registration for SUPER BOWL for use on education and entertainment services while the Appellant's mark SUPER BOWL OF CHINA AND DEVICE is used for restaurant services. Accordingly, the competing marks are used on different and unrelated goods or services.

Consequently, would the Appellant's use of SUPER BOWL OF CHINA AND DEVICE would likely deceive or cause confusion?

It must be emphasized that in trademark cases, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set of rules can be deduced. Each case is decided on its own merits.¹⁵ As the likelihood of confusion of goods or business is a relative concept, to be determined only according to the particular, and sometimes peculiar, circumstances of each case,¹⁶ the complexities attendant to an accurate assessment of likelihood of such confusion requires that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined.¹⁷

In this regard, this Office does not agree with the Director that the Appellant's use of its mark would have the public assuming that its restaurant services are connected with the Appellee. Even in the assumption that the Appellee's mark is well-known internationally, there is no cogent reason to believe that the public would think that the "Chinese food" offered by the Appellant comes from the Appellee. The parties' respective businesses or services are non-competitive and so unrelated that there is a very remote possibility that the public would be confused or deceived, much less associate the Appellant's mark to the Appellee's or mistake one as the source or origin of the service of the other. On the issue of deception or confusion, the ordinary purchaser must be thought of as having and credited with, at least, a modicum of intelligence.¹⁸ It does not defy common sense to assert that a purchaser would be cognizant of the product he is buying.¹⁹

Neither is there an indication that the Appellant deliberately imitated or copied the Appellee's mark so that it can ride on the supposed popularity and goodwill thereof. While the mark SUPER BOWL is distinctive, an arbitrary mark as used in the Appellee's services, the words "super" and "bowl" are ordinary words in the English lexicon. In this regard, the Appellant's use of the word "bowl" coupled with the presence of the devices of the "bowl" and "chopsticks", is directly related to the services it offers. As ably explained by the Appellant:

9. The current application for SUPER BOWL OF CHINA & DEVICE is appropriate when applied to Respondent-Applicant's restaurant services, as "SUPER" connotes big portions or big sizes in terms of the food servings of the Respondent-Applicant, "BOWL" is related to food being a kitchen utensil for serving and eating food or soup, "CHINA" related to the type of cuisine specialized in and served by the Respondent-Applicant, which is Chinese cuisine. Finally, the font, coloring, and general layout of the logo of Respondent-Applicant in no way lends anyone to believe that the two marks of the parties are related.²⁰

Accordingly, the Appellee has not submitted evidence or convincing argument that the Appellant in using its mark in its restaurant services will gain undue benefit or advantage at the expense of the Appellee. It is hard to believe that the public will be enticed to dine in the Appellant's restaurant because of a supposed belief or mistaken notion that the Appellant's restaurant and services are connected with the Appellee.

¹⁵ *Emerald Garment Manufacturing Corporation v. Court of Appeals*, 251 SCRA 600 (1995).

¹⁶ *Esso Standard Eastern, Inc. v. Court of Appeals*, 116 SCRA 336 (1982).

¹⁷ *Societe Des Produits Nestle, S.A., et al v. Court of Appeals, et al.*, G.R. No. 112012, 04 Apr. 2001.

¹⁸ *Fruit of the Loom, Inc. v. Court of Appeals, et al.*, G.R. No. L-32747, 29 Nov. 1984.

¹⁹ *Acoje Mining Co., Inc. v. Director of Patents*, 38 SCRA 480 (1971).

²⁰ MEMORANDUM ON APPEAL (for Respondent-Applicant), dated 02 Sept. 2008, page 7.

Likewise, the Appellee's claim that the Appellant should not be allowed to register its mark because it will prevent the Appellee from expanding into restaurant or food business is untenable. As a registrant, the Appellee's exclusive use of its mark is defined under Sec. 138 of the IP Code, to wit:

A certificate of registration of a mark shall be prima facie evidence to the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate (Sec. 20, R.A. 165)

Thus, the Appellee's argument would have merit only if the Appellant's restaurant services are similar or closely related to the goods or services covered by the Appellee's trademark registration. But, as discussed above, they are not. Besides, the Appellee's intention, if any, to expand into the food or restaurant business should have been more real than apparent. There is no evidence that the Appellee has ventured into the food or restaurant business or other similar businesses directly or even indirectly through licensing or sponsorship.

To conclude, this Office finds that the Appellant's use of SUPER BOWL OF CHINA AND DEVICE for use on restaurant services will not cause any damage or show any connection with the Appellee. Accordingly, there is no reason not to allow the registration of the Appellant's mark.

WHEREFORE, premises considered, the instant appeal is hereby GRANTED. The Appellant's Trademark Application No. 4-2006-004156 for SUPER BOWL OF CHINA AND DEVICE for use on restaurant services is hereby GIVEN DUE COURSE. Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Legal Affairs for appropriate action. Further, let also the Director of the Bureau of Trademarks and the library of the Documentation, Information and Technology Transfer Bureau be furnished a copy of this Decision for information, guidance, and records purposes.

SO ORDERED.

JUN 26 2009 Makati City


ADRIAN S. CRISTOBAL, JR.
Director General