

MC CORMICK & COMPANY, INC.
Opposer,
- versus -

IPC 14-2006-00100

Opposition to:
TM Application No. 4-2004-008184
(Filing Date: 03 September 2004)

GLOBAL PARTNERS, INC.,
Respondent-Applicant.
x-----x

TM: "McSPICE"

Decision No. 2007-15

DECISION

This is an opposition to the registration of the mark "McSPICE" bearing Serial No. 4-2004-008184 filed on 03 September 2004 covering the goods "food seasoning flavour enhancer" under class 30 of the International Classification of goods which trademark application was published on March 28, 2006.

The Opposer in the instant opposition is "McCormick & Company, Incorporated", a foreign corporation organized and existing under the laws of the State of Maryland, with headquarters located at 18 Loveton Circle, Sparks, Maryland 21152-6000, United States of America and doing business in the Philippine through its local licensee and affiliate, McCormick Philippines, Inc., with principal office at the 4th Floor SYSU Center, 145 Panay Avenue corner Sgt. Esguerra St., Quezon City.

Respondent-Application on the other hand is "Global Partners, Inc.", a domestic corporation with address at General Milling Compound, Magsaysay Road, Barangay San Antonio, San Pedro, Laguna.

The grounds for the opposition are as follows:

- "1. The grounds primarily relied upon in this Opposition are the following pertinent provisions of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, viz.:

x x x

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

x x x

- (f) Is identical with a registered mark belonging to a different proprietor or 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;

- (g) Is identical with, or confusingly similar to, or constitute a mark which is considered by a 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 than the applicant for registration, and used for identical or similar goods or services.;

x x x

(h) Consist exclusively of signs that are generic for the goods or services that they seek to identify.

x x x

(j) Consist exclusively of signs or of indications that may serve in trade to designative 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;

x x x

Sec. 165. Trade Name of Business Name. – 165.1. x x x

165.2 (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark a collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be unlawful.

x x x

“2. Relief is also sought the provisions or Article 6bis of the Paris Convention, relating to well-known marks, because of the international repute of Opposer’s “Mc” marks. Indeed, there is no gainsaying the worldwide popularity of Opposer’s mark as the goods they cover have become common household/kitchen fixtures.

“3. The slovenly attempt of the Respondent-Applicant to ride on the popularity of Opposer’s trademark is plainly apparent in its choice of the prefix “Mc” to prop up the generic (and therefore inherently unregistrable) term “SPICE”. As the buying public has already indentified the origin and ownership of the goods covered by the Opposer’s various “Mc” marks (‘spices’ being one of them), allowing the registration of Respondent-Applicant’s “McSPICE” would falsely suggest a connection between the latter’s goods and the Opposer’s, more so in this case where the marks are used (or, in the case of Respondent-Applicant, intended to be used) on identical goods.

The Bureau of Legal Affairs issued Notice to Answer which was sent to the Respondent-Applicant through registered mail with return card on August 16, 2006, bearing Return Card No. J-06-463.

Despite receipt of the Notice to Answer, Respondent-Applicant did not file the required answer, together with the affidavit of its witness and other documents in support of its application; hence the same is considered waived.

Section 11 of the Summary Rules (Office Order No. 79, Series of 2005) provides:

Section 11. Effect of failure to file answer. – In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the petition or opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

The Opposer submitted the following exhibits as its evidence.

Exhibits “A” to “P”, inclusive of sub-markings.

On the other hand, Respondent-Applicant failed to file the required Answer and so with the affidavits of its witnesses and the documents in support of its application subject of the instant opposition.

The only issue to be resolved is:

WHETHER OR NOT THE RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK “McSPICE”.

The applicable provisions of law are, Section 123 (d) of Republic Act. No. 8293, which provides:

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

- (d) Is identical with a registered mark belonging to a different proprietor or mark with an earlier filing or priority date, in respect of:
 - a. The same goods or services, or
 - b. Closely related goods or services, or
 - c. If it nearly resembles such a mark as to be likely to deceive or cause confusion;

Records will show that the mark “MC Cormick” has been registered with the Intellectual Property Philippines (IPP) in the name of the herein Opposer bearing Certificate of Renewal of Registration No. 32146 for goods “spices, extracts, seasonings, tea, seasoning mixes, sauce mixes and cake decoration under class 30 of the International Classification of goods. (Exhibit “A”)

It is observed that Respondent-Applicant’s mark “McSPICE” contained the letters “MC” which is the dominant feature of the Opposer’s mark “MC McCormick”. Another point of consideration is the word “SPICE” as contained in the Respondent-Applicant’s mark is one of the goods or products covered by the Opposer’s Certificate of Renewal of Registration No. 32146 (Exhibits “A”) specifically “spices”.

In totality, the Respondent-Applicant appropriated or copied the letters or phrase “Mc” of the Opposer’s mark including the goods “spices” covered by it. Under this circumstances, it is concluded that the Respondent-Applicant is taking advantage of the popularity or goodwill of the Opposer’s mark not to mention the fact that the Opposer’s mark “MC McCORMICK” AND “MC (stylized)” has been circulating in commerce in the Philippines since 1963 (Exhibit “E”), or in the Declaration of Actual use, for more than forty (40) years, it is likewise noted that the goods covered by the competing marks fall under the same class 30 of the International Classification of goods.

There is no doubt that the trademark “McSPICE” which Respondent-Applicant seeks to be registered in its name is confusingly similar to the registered mark “Mc (stylized)” and “McCORMICK” of the Opposer.

Being confusingly similar, the consuming public, particularly, the unwary consumers will be deceived, confused and mistaken into believing that the goods of Respondent-Applicant come from or are authorized by the Opposer.

It is unthinkable and truly difficult to understand why, of the million of terms and combination of letters and designs available, the Respondent-Applicant had to choose exactly the same as those of the Opposer, if there was no intent to take advantage of the goodwill of the Opposer's mark.

In connection with the use of confusingly similar or identical mark, our Supreme Court on several occasions ruled thus:

“Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty of the English language or paucity of signs, symbols, numerals, etc., as to justify one who really wishes to distinguish his products from those of all others entering the twilight zone of a filed already appropriated by another.”
(Weco Products Co., vs. Milton Ray Co., F, 2d 985, 32 C.C.P.A. Patents, 1214)

WHEREFORE, viewed in the light of all the foregoing, this Bureau finds and so holds that Respondent-Applicant's mark “McSPICE” is confusingly similar to Opposer's mark “Mc (stylized)” and “McCormick” and that the word SPICE is generic of the goods of Respondent-Applicant, i.e. “food seasoning flavour enhancer”. As such, the opposition is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 4-2004-008184 filed on 03 September 2004 for the registration of the mark “McSPICE” is hereby REJECTED.

Let the filewrapper of the trademark “McSPICE” subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 20 February 2007.

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