

THAI PRESIDENT FOODS PUBLIC
COMPANY LTD.,
Opposer,

IPC No. 14-2008-00109
Case Filed on:

Opposition to:

- versus -

Appln. Ser. No.: 4-2007-005385
Date Filed: 28 May 2007
Trademark: "MAMA MIA"

UNIVERSAL ROBINA CORPORATION
Respondent-Applicant,
X-----X

Decision No. 2009-93

DECISION

For decision is the Notice of Opposition filed by Thai President Food Public Company Ltd. (Opposer), a corporation organized and existing under the laws of Thailand, with address at 27 Srinkrin Road, Kwang Huamark Khet Bangkok, Bangkok, Thailand, against Application Serial No. 4-2007-005385 for the registration of the trademark MAMA MIA for goods under Class 30 namely: "pasta, pasta products namely spaghetti, macaroni and noodles made of wheat flour" filed in the name of Universal Robina Corporation, a corporation organized in the Philippines with address at 110 E. Rodriguez Jr. Avenue Libis, Quezon City.

The grounds for the opposition are as follows:

"1. Opposer is filling the present Opposition under the following laws:

a. Section 123 (d) of the Intellectual Property Code (Republic Act No. 8293) which states that 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:

- (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;"

b. Section 123 (f) of the Intellectual Property Code (Republic Act No. 8293) - a mark cannot be registered if it:

"(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;

c. Section 138 of Republic Act No. 8293, which read:

"Section 138. Certificates of Registration. - A certificate of registration of a mark shall be prima facie evidence of 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."

d. Section 3 and 160, et. Seq., Republic Act No. 8293 which read:

“Section 3. *International Conventions and Reciprocity.* - Any person who is a national or who is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law, shall be entitled to benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by this Act.”

“Section 160. *Right of Foreign Corporation to Sue in Trademark or Service Mark Enforcement Action.* – Any foreign national or juridical person who meets the requirements of Section 3 of this Act and does not engage in business in the Philippines may bring a civil or administrative action hereunder for opposition, cancellation, infringement, unfair competition, or false designation of origin and false description, whether or not it is licensed to do business in the Philippines under existing laws.”

“2. Opposer applied for the registration of the mark “MAMA” over the goods classified under Class 30 (Staple foods: *coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made of cereals, bread pastry and confectionary, ices; honey, treacle; yeast, baking-powder, salt, mustard; vinegar, sauces (condiments); spices; ice*) on 24 October 1996 which was granted registration on 11 March 2004, as evidence by its Certificate of Registration for the mark “MAMA” issued on 21 December 2004 by the Intellectual Property Office.

On the other hand, Respondent-Applicant applied for the registration of the mark “MAMA MIA” for the following goods: pasta, pasta products namely spaghetti, macaroni and noodles made of wheat flour, all under Class 30, only on 28 May 2007.

Evidently, at the time the Respondent-Applicant filed its application for the registration of its trademark “MAMA MIA” over its pasta, pasta products and NOODLES, the trademark “MAMA” has already been exclusively used and duly registered in the Philippines by the Opposer for its NOODLES of several flavors.

“3. Opposer, which was established in 1972, as proven by a copy of its Articles of Incorporation attached to this Opposition (Annex “A”), is a leading food manufacturer in Thailand of instant noodles, biscuits, wafers, cookies, bakery goods, dairy products, drinks and fruit juice and other food products, all under Class 30.

“4. Being the leading food manufacturer in Thailand since 1972, Opposer is the owner of the trademark “MAMA” in Thailand as early as 29 May 1973. And in the Philippines, Opposer first introduced its products bearing the mark “MAMA” on 18 July 2006.

“5. Since the first use of the mark “MAMA” in Thailand in 1973, Opposer has exclusively, extensively and consistently used its mark “MAMA” to distinguish its goods from others. Products bearing the mark “MAMA” have been sold and exported to many countries such as the Philippines, United States, Canada, Germany, Finland, the Netherlands, United Kingdom, France, Hong Kong, Singapore, Taiwan and Kuwait since 1985.

“6. Obviously, when the Respondent-Applicant submitted its application for the registration of the mark “MAMA MIA” for its products, Opposer, being the owner of the subject mark, ALREADY have the exclusive right to use the mark “MAMA” in connection with the goods (instant noodles of several flavors and instant rice vermicelli) and those that are related thereto (Staple foods: *coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made of cereals, bread pastry and confectionary, ices; honey, treacle; yeast, baking-powder, salt, mustard; vinegar, sauces (condiments); spices; ice*) SPECIFIED in its Certificate of registration, pursuant to Section 138 of the IP Code.

“7. Opposer, as the owner of the registered mark “MAMA” has the exclusive right to prevent all third parties, including the Respondent-Applicant, from using in the course of trade identical or similar signs or containers for goods which are identical or similar to those in respect of which the trademark “MAMA” is registered where such use would result in a likelihood of confusion. The Respondent-Applicant’s use of the mark “MAMA MIA” for its pasta, pasta products and NOODLES would result to a likelihood of confusion with the Opposer’s NOODLES bearing the registered mark “MAMA”, which, under Section 147 of the Intellectual Property Code, is presumed.

“8. Also, products over which Respondent-Applicant seeks to use its mark, i.e., pasta, pasta products namely spaghetti, macaroni and NOODLES made of wheat flour, belong to the SAME Class 30 (staple foods) and are therefore RELATED to the goods over which Opposer have prior exclusive right to use the mark “MAMA”. Hence, Respondent-Applicant’s application should not be allowed, pursuant to Section 123 (d) of the Intellectual Property Code.

Opposer presented the following evidence in support of its opposition:

EXHIBIT	DESCRIPTION
“A”	Verified Notice of Opposition
“B”	Affidavit testimony of Suchai Ratanjajaroen
“C”	Certificate of Registration dated 21 December 2004 for the mark MAMA
“D”	Articles of Incorporation
“E”-“F”	Brochures and products labels
“G”	Copies of registrations
“H”-“I”-“J”	Copies of receipts and invoices
“K”	Bill of lading
“L”	Certificate of Registration
“M”, “N”, “O” “P”, “Q”, “R”, “S”	Commercial Invoices
“T”, “V”, “W”	Copies of Citations, Awards
“X”, “U”	Magazines, catalogues, print-outs
“Y”	Special Power of Attorney

On 25 September 2008, respondent-applicant filed its Answer and raised the following affirmative allegations:

“20. On 08 January 1982, CFC Corporation, a corporation duly organized and existing under the laws of the Philippines and a wholly owned subsidiary of Respondent-Applicant URC, with office address at CFC Building, Bagong Ilog, Pasig, Metro Manila, filed before the then Philippine Patent Office an application for the registration of the mark “MAMA MIA AND DEVICE”

to designate its goods which consisted of pasta products. A copy of the executed Trademark Application is attached hereto as "Annex "1" and made an integral part hereof.

"21. The choice of the mark "MAMA MIA AND DEVICE" to designate the pasta products of CFC Corporation came about and was primarily based on the words "MAMMA MIA" (literally, meaning "mother of mine" or "my mother"), an interjection which means "my goodness", and which is a popular expression of awe and surprise typically used by Italians. The said expression is commonly associated with Italian chefs passionately expressing their satisfaction over a tasty kitchen concoction, which usually has pasta in it; pasta being the pride and glory of the rich Italian cuisine.

"22. Having said thus, it goes without saying that CFC Corporation used and applied for the registration of the mark "MAMA MIA AND DEVICE" primarily in order to impress upon the kind of the Filipino consumers that the quality of its pasta products conformed to the standards set by the Italians who are known to the world for great pasta.

"23. In the aforementioned Trademark Application, it was expressly declared by applicant CFC Corporation that, and to pertinently quote thus: "The mark was first used on the goods on September 1, 1981, was first used in the Philippines on September 1, 1981 and is now used in commerce." A label of the mark which was actually used to designate the goods of applicant CFC Corporation is attached hereto as Annex "2" and made an integral part hereof.

"24. Finding the Trademark Application of CFC Corporation to be regular and compliant with the applicable laws, rules and regulations, the then Philippine Patent Office issued on 01 January 1984 a Notice of Allowance and Payment of Issuance and Publication Fee, a copy of which is attached hereto as Annex "3" and made an integral part hereof. It bears emphasis that the foregoing was issued by the Philippine Patent Office after finding that the following marks, Le. (a) "MAMMA" for noodles owned by Tristar Commodities Sales Corporation, (b) "MAMA AND DEVICE" for water bottle ice box vacuum bottle owned by Mama Industries Corporation, are not confusingly similar to the mark "MAMA MIA AND DEVICE" of CFC Corporation.

"25. The Bureau of Patents, Trademarks and Technology Transfer thereafter issued a Certificate of Registration in favor of CFC Corporation for the mark "MAMA MIA AND DEVICE" bearing Registration NO. 41869, and the same to be effective for a term of twenty (20) years commencing on 14 November 1988. A copy of the aforementioned Certificate of Registration is attached hereto as Annex "4" and made an integral part hereof.

"26. On 17 November 1993, CFC Corporation filed before the Bureau of Patents, Trademarks and Technology Transfer and Affidavit of Use dated 15 November 1993 attesting to the fact that the registered mark "MAMA MIA DEVICE" was still in use in the Philippines and that the goods which it designate are still available in the Philippine market. A copy of the foregoing affidavit is attached hereto as Annex "5" and made an integral part hereof.

"27. In the interest of effectively cutting down operating costs and maximizing revenues, the Board of Directors of Respondent-Applicant URC and CFC Corporation, by a majority vote, adopted a resolution on 21 May 1997 approving the cessation of the food manufacturing operations of the latter under its own charter and the assumption by the former of the said food manufacturing operations. By virtue of the aforementioned resolution which was duly ratified by the stockholders representing at least two-thirds (2/3) of the outstanding capital stock of the respective corporations and which took effect on 01 June 1997, CFC Corporation sold, conveyed and transferred its property, assets and liabilities to Respondent-Applicant URC. Copies of the Secretary's Certificates of Respondent-Applicant URC and CFC Corporation attesting to the adoption by its respective Board of Directors of the aforementioned resolutions are attached hereto as Annex "6" and Annex "7" respectively and made an integral park hereof.

"28. Being the successor in interest of CFC Corporation, Respondent-Applicant URC, with the intent to revive and further promote the production of its predecessor's quality pasta in

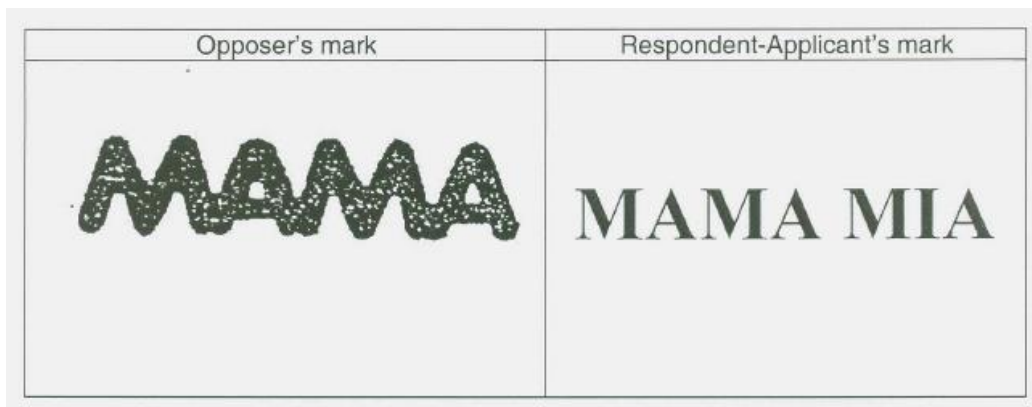
the Philippines, filed on 28 May 2007 a Trademark Application for the mark "MAMA MIA" with the Intellectual Property Office (IPO) bearing Application NO. 4-2007-005385. A copy of the foregoing application is attached hereto as Annex "8" and made an integral part hereof.

"29. Finding the application of Respondent-Applicant URC's to be in order and with compliance with the requirements prescribed by law, the IPO issued a Notice of Allowance on 17 December 2007. A copy of the aforementioned Notice of Allowance is attached hereto as Annex "9" and made an integral part hereof.

In support of its defense, it submitted the following evidences, to wit:

ANNEX	DESCRIPTION
"1"	Application for registration of the mark MAMA MIA & DEVICE
"2"	label of the mark
"3"	Notice of Allowance
"4"	Trademark Certificate of Registration No. 41869
"5"	Affidavit of Use dated November 15, 1993
"6", "7"	Copies of Secretary's Certificate
"8"	Trademark Application for the mark MAMA MIA
"9"	Notice of Allowance dated December 17, 2007
"10", "11"	Sample of Actual Package

A preliminary conference was held on 5 November 2008 but there being no amicable settlement reached, the parties were directed to submit their position papers. The issue is whether the marks are confusingly similar and whether the mark MAMA MIA can be validly registered. In order to arrive at a just and fair conclusion on whether the contending marks are confusingly similar, both are reproduced below for comparison and scrutiny.



The Intellectual Property Code states:

"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”

Opposer asserts that it is a leading food manufacturer in Thailand. Opposer submitted evidence of its fame through various citations and awards. (Exhibits “T”, “V” and “U”). In the Philippines, opposer applied for registration of the mark and was issued Certificate of Registration No. 4-1996-115040 on March 11, 2004 (Exhibit “C”) for the mark MAMA used for goods under class 30, namely: “instant noodles of several flavors, namely chicken, egg, pork, shrimp, meat and instant rice vermicelli. Opposer has sold its products bearing the MAMA brand through documents evidencing shipments of goods into the Philippines with the mark MAMA. (Exhibit “K”) Relying on its registration for the mark, it believes it has exclusive right over its symbol. Sec. 138 which gives the registrant certain statutory presumptions such as validity of the registration, ownership of the mark and exclusive right to use the mark in relation to the goods specified in the certificate and those related thereto. Opposer believes that respondent-applicant’s adoption of the mark MAMA MIA for goods under class 30 namely: “pasta, pasta products namely spaghetti, macaroni and noodles made of wheat flour” will lead to confusion as to source.

A cursory examination of the marks show that opposer’s mark consists of one word, MAMA while respondent-applicant’s mark consist of two words, MAMA and MIA. In *McDonald’s Corporation v. L.C. Big Mak Burger, Inc.*, G.R. No. 143993, dated 18 August 2004, the Supreme Court held:

“In determining likelihood of confusion, jurisprudence has developed two tests, the dominance test and the holistic test. The dominance test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion. In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity. xxx

This Court, however, has relied on the dominance test rather than the holistic test. The dominance test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominance test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments. (Emphasis supplied)

The test of dominance is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the “colorable imitation of a registered mark xxx or a dominant feature thereof.” The High Court in *Societe Des Produits Nestle S.A. v. Court of Appeals* [G.R. No. 112012. April 4, 2001.], explained:

“Moreover, the totality or holistic test is contrary to the elementary postulate of the law on trademarks and unfair competition that confusing similarity is to be determined on the basis of visual, aural, connotative comparisons and overall impressions engendered by the marks in controversy as they are encountered in the realities of the marketplace. The totality or holistic test only relies on visual comparison between two trademarks whereas the dominance test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks.

Applying the foregoing principles to the instant case, the dominant feature of opposer’s mark is the word MAMA. Respondent-applicant’s mark has two distinct word elements, the first word is identical to the central, most dominant feature of opposer’s mark which is MAMA. The

addition of the word MIA does not detract from the fact that the main component of opposer's mark is phonetically and visually the same as respondent-applicant's MAMA MIA word mark. Moreover, when applied to goods under the same class which possess the same physical attributes and characteristics, confusion is likely to result.

The Bureau believes that confusion of source is likely to happen even if the respondent-applicant adopts the word MIA in addition to the word MAMA. The Supreme Court in *McDonald's Corporation v. L.C. Big Mak Burger, Inc.*, G.R. No. 143993, dated 18 August 2004 discussed the principle of confusion of as to source, to wit:

The Court has recognized that the registered trademark owner enjoys protection in product and market areas that are the normal potential expansion of his business. Thus, the Court has declared:

Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade-mark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148 ALR 56 et seq; 53 Am Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business (v. 148 ALR, 77, 84; 52 Am. Jur. 576, 577).

Evidence show that respondent has used the mark MAMA MIA in commerce through its predecessor in interest, CFC Corporation. A trademark application for the mark MAMA MIA & DEVICE was applied for way back in 1982. (Annex "1") The mark MAMA MIA & DEVICE was registered in the principal register in November 14, 1988 for goods under class 42 namely: "pasta products, spaghetti, and macaroni made of wheat flour" (Annex "4".) It also submitted an actual package of its MAMA MIA & device used on quick cooking spaghetti. (Annex "4"). However, this use has already been discontinued by virtue of a resolution on May 21, 1997 by the Board of Directors of URC and CFC approving cessation of its food manufacturing operations and the opposer in the meantime has secured registration for its mark MAMA. Besides, the label (Annex "4") is visually different from the word mark being applied for by the respondent-applicant.

As regards to the contention that MAMA is well known mark, the Bureau disagrees with this contention. Section 123 of the Intellectual Property Code of the Philippines (Republic Act No. 8293, hereafter "IP Code") also provides:

"Sec. 123. *Registrability.* - 123.1 A mark cannot be registered if it:

x x x

(e) Is identical with, or confusingly similar to, or constitute 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; x x x"[Underscoring supplied.]

Also, Rule 102 of the Rules and Regulations on Trademarks contain the criteria to be taken into account in determining well-knownness of a trademark. Thus, Rule 102 provides:

"Rule 102. Criteria for determining whether a mark is well-known. In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark”

The registration of opposer’s mark (Exhibit “G”) and the commercial invoices showing sales abroad and in the Philippines (Exhibits “H”- to “J”; “M” to “S”) and the awards and citations (Exhibits “T”, “V” and “W”) prove that the mark has obtained goodwill. However, in order to prove that a mark has obtained well known status, the fame and the reputation must be shown to have been obtained not only in a few countries but in the Philippines and internationally.

WHEREFORE, premises considered the OPPOSITION filed by Thai President Foods Public Company Limited., opposer is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 4-2007-005385 filed by Universal Robina Corporation, Respondent-Applicant, for the mark “MAMA MIA” for goods under class 30 namely: “pasta, pasta products namely spaghetti, macaroni and noodles made of wheat flour” and filed in 28 May 2007, is as it is hereby, DISALLOWED.

Let the filewrapper of “MAMA MIA”, 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, 22 July 2009.

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