



SOCIETE DES PRODUITS NESTLE S.A.,
Opposer,

-versus-

NATURE'S HARVEST CORPORATION,
Respondent-Applicant.

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IPC NO. 14-2008-00362
Case Filed: 19 December 2008
Opposition to:
Appln. Serial No. 4-2008-001657
Date Filed: 11 February 2008
Trademark: "MAGIC"

Decision No. 2012-27

DECISION

SOCIETE DES PRODUITS NESTLE S.A. ("Opposer")¹ filed on 19 December 2008 an opposition to Trademark Application Serial No. 4-2008-001657. The application, filed by Nature's Harvest Corporation ("Respondent-Applicant")², covers the mark MAGIC for use on "cooking oil" under Class 29 of the International Classification of Goods.³ The Opposer alleges the following:

"1. Opposer and its predecessor are the first to adopt, use and register worldwide including the Philippines, the 'MAGGI' trademark for goods/products falling under International Classes 1, 2, 3, 4, 5, 29, 30, 31, 32, 35, 37, 39, 41 and 42, and therefore, enjoys under Section 147 of Republic Act (R.A.) No. 8293 the right to exclude others from registering or using identical or confusingly similar marks such as Respondent-Applicant's trademark 'MAGIC' for goods falling under international class 29.

"2. There is a likelihood of confusion between Opposer's 'MAGGI' because the latter trademark so resembles Opposer's 'MAGGI' trademark in terms of sound, sight, and connotation as to likely, when applied to or used in connection with the goods of Respondent-Applicant, cause confusion, mistake and deception on the part of the purchasing public as being a trademark owned by the Opposer, hence, the Respondent-Applicant's 'MAGIC' trademark cannot be registered in the Philippines pursuant to the express provision of Section 147.2 of R.A. No. 8293. No doubt, the use of Respondent-Applicant's 'MAGIC' trademark for its products will indicate a connection between its products and those of the Opposer's.

"3. The Opposer's 'MAGGI' trademark for goods falling under International Classes 1,2,3,4,5,29, 30, 31, 32, 35, 37, 39, 41 and 42 are well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being a trademark owned by the Opposer.

"4. Respondent-Applicant, in adopting 'MAGIC' for its goods, is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association with the Opposer, or as to origin, sponsorship, or approval of its goods and services by the Opposer, for which it is liable for false designation of origin, false description or representation under Section 169 of R.A. No. 8293.

"5. Respondent-Applicant's appropriation and use of the trademark 'MAGIC' infringes upon the Opposer's exclusive right to use as registered owner its 'MAGGI' trademark, which is protected under R.A. 8293 particularly Section 147 thereof.

¹ A corporation organized and existing under the laws of Switzerland, with business address at Vevey, Switzerland

² with business address at Rm. 504 Kim Siu Ching Building, 473 Sto. Cristo cor. Jaboneros Streets, Binondo, Manila

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. The 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.

“Opposer relies on the following facts to support its opposition, reserving the right to present other evidence to prove these facts and others as may appear necessary or expedient in the course of the proceedings:

“1) Opposer is the exclusive owner of the ‘MAGGI’ trademark.

“Opposer and its predecessor are the exclusive owner of the ‘MAGGI’ trademark. It has adopted and used the ‘MAGGI’ trademark all over the world. The mark ‘MAGGI’ was first used in the Philippines since the 1930’s.

“The trademark ‘MAGGI’ is over one hundred (100) years old. Maggi and Cie was founded in 1886 with the object of producing and marketing popular food products. The first ‘MAGGI’ products were produced even before 1886 in Switzerland. The range of products was extended to vegetable meals and assortment of dried soups in 1886. Within three years, warehouses for the ‘MAGGI’ products were built in Paris, Berlin, Vienna and London. In 1890, Maggi and Cie became a limited company under the name ‘Fabrique des Produits Alimentaires Maggi’. Also, the production centers were subsequently built in many countries including Germany (1897), France (1897), Austria (1907) and Italy (1908). The famous ‘MAGGI’ bouillon cube was launched in 1908. In 1938, the daily production already reached 1.8 million ‘MAGGI’ bouillon cube and 10,000 kilos of vegetable cooked soups. In 1947, the company merged with herein Opposer. The merger allowed the worldwide sales of the ‘MAGGI’ products.

“In the Philippines, Opposer was issued by the IPO the following certificates of trademark registration:

TRADEMARK	REGISTRATION NO.	DATE ISSUED	CLASSES OF GOODS
MAGGI	00343	November 28, 1986	30
MAGGI	4-2008-002402	July 7, 2008	29, 30
MAGGI (YELLOW) WITH BUBBLE DEV. (RED)	4-1999-001921	July 16, 2006	29, 30
MAGGI CUP SARAP	4-2001-002332	April 16, 2007	30
MAGGI NOODLE EXPRESS	4-1995-105795	September 4, 2000	30

“The above enumerated registrations are still valid and existing. Copies of the abovementioned certificates of registration are hereto attached as Exhibits ‘A’, ‘B’, ‘C’, ‘D’ and ‘E’.

“The ‘MAGGI’ trademark is also registered and/or applied for registration in over one hundred eighty (180) countries worldwide long before the appropriation and filing of the application by Respondent-Applicant for the registration of the trademark ‘MAGIC’ in the Philippines.

“2) There is confusing similarity between Opposer’s ‘MAGGI’ trademark and Respondent-Applicant’s trademark ‘MAGIC’.

“Respondent-Applicant’s trademark ‘MAGIC’ is confusingly similar to Opposer’s ‘MAGGI’ trademark in spelling, sound and connotation as to likely cause confusion.

“Moreover, the likelihood of confusion and deception are even greater since the goods of Opposer and Respondent-Applicant are the identical and/or related, and are made available to the same consuming public and in the same channels of distribution. Respondent-Applicant’s ‘MAGIC’ trademark covers goods belonging to International Class 29 while Opposer’s ‘MAGGI’ trademark is also registered for products falling under International Classes 1, 2, 3, 4, 5, 29, 30, 31, 32, 35, 37, 39, 41 and 42. Particularly, Respondent-Applicant’s ‘MAGIC’ mark covers cooking oil (Class 29), while those of Opposer’s products bearing its ‘MAGGI’ mark include edible oils and fat (Class 29), among

other related goods. Respondent-Applicant's goods are evidently identical and/or related to Opposer's goods. Therefore, confusion is very likely.

"3) The Opposer's trademark 'MAGGI' is internationally well-known.

"The trademark 'MAGGI' which Opposer adopted and exclusively owned is internationally well-known. Opposer's 'MAGGI' mark has obtained trademark registrations and pending applications for trademark registration in more than one hundred eighty (180) countries around the world such as the Philippines, Malaysia, China, Taiwan, Thailand, United States of America, United Kingdom, Switzerland, Germany, Australia, Japan, Jordan, Kuwait, Italy, Iran, Brunei, Mexico, South Korea, India, among many others. The list of these registrations and pending applications for registration of the mark 'MAGGI' worldwide is hereto attached as Exhibit 'F' series.

"More than 7 billion 'MAGGI' bouillon cubes, 1.2 billion packets of 'MAGGI' noodles and 700 million packets of 'MAGGI' soup are consumed annually globally including the Philippines. These only pertain to three of the many other wide ranges of 'MAGGI' products.

"Opposer's 'MAGGI' trademark has further expanded during the last five decades in terms of its geographical standpoint and product segments. Specifically, in terms of geography, the 'MAGGI' mark is literally used in all member states of the European Union. Also, the 'MAGGI' brand made substantial growth and exposure in Asia, Oceania and Africa. On the other hand, in terms of products, the mark 'MAGGI' has expanded to other segments such as chilled and frozen food and culinary products as well as "our-of-home" food segment intended for chefs, restaurants and catering services. It is thus, reaching to a very broad spectrum of consumers.

"The trademark 'MAGGI' is one of Opposer's most valuable brands. It has become part of the national culture in its established markets. Opposer's 'MAGGI' mark has been advertised through all relevant media intensively during a long period of time. As early as the 1900, almost all relevant consumers were aware of the 'MAGGI' trademark.

"In the Philippines, Opposer's 'MAGGI' trademark has been used, promoted and advertised for a considerable duration of time and over wide geographical areas having been in use for many years. Since its first use, Opposer has invested significant amount of resources in the promotion of its trademark 'MAGGI'.

"4) The use of Respondent-Applicant's trademark 'MAGIC' would indicate a connection with the goods covered in Opposer's 'MAGGI' mark hence, the interests of the Opposer are likely to be damaged.

"Respondent-Applicant's products are clearly similar and/or related to Opposer's products covered by its 'MAGGI' trademark. Undoubtedly, the use of Respondent-Applicant's trademark 'MAGIC' definitely misleads the public into believing that its goods originate from or are licensed or sponsored by Opposer or that Respondent-Applicant is associated with or an affiliate of the Opposer.

"Respondent-Applicant has appropriated the trademark 'MAGIC' for the obvious purpose of capitalizing upon or riding on the valuable goodwill and popularity of the 'MAGGI' trademark which Opposer gained through tremendous effort and expense over a long period of time. This clearly constitutes an invasion of Opposer's intellectual property rights.

"The use by Respondent-Applicant of 'MAGIC' will dilute the distinctiveness of Opposer's 'MAGGI' trademark.

"The use, sale and distribution by the Respondent-Applicant of goods bearing the 'MAGIC' trademark are inflicting considerable damage to the interests of the Opposer. To allow Respondent-Applicant to register 'MAGIC' will constitute a mockery of our laws protecting intellectual property rights; it will legitimize its unfair and unlawful business practice.

"5) Enclosed as Exhibits 'G' to 'L' are the other documentary evidence including the certified true copies of the foreign registrations and actual labels of Opposer's trademark 'MAGGI' which shall constitute as integral parts of this Opposition.

"6) Opposer reserves the right to present such other documents as may be necessary to prove the foregoing allegations in the course of the proceedings.

The Respondent-Applicant filed its Answer on 05 July 2010 alleging the following:

"1.1 Paragraph 1, for lack of knowledge sufficient to form a belief as to the truth or falsity of opposer's claim that it and its predecessor are the first to adopt, use and register worldwide the 'MAGGI' trademark. The allegations in the same paragraph are further specifically denied insofar as it is made to appear that respondent-applicant has no right to adopt, use and register its 'MAGIC' trademark. The truth of the matter is, and as asserted in the Affirmative Allegations and Affirmative Defenses, Nature's Harvest is already the registered owner of trademark 'MAGIC FRY' with Certificate of Registration No. 4-2008-001658 (pls. see Exhibit '3,' annexed to the Affidavit of Ms. Rebbie L. Chua, attached hereto as Exhibit '1;'). The trademark MAGIC subject of the Opposition was merely derived from the already registered trademark of Nature's Harvest.

"1.2. Par. 2, the truth of the matter being that there is absolutely no likelihood of confusion between opposer's MAGGI trademark and Nature's Harvest's MAGIC trademark. A simple side-by-side comparison of the marks as they appear on their respective products, all dispel any likelihood of confusion, mistake or deception on the part of the purchasing public. There is no way that ordinary purchasers of MAGIC cooking oil can confuse said cooking oil to be connected to MAGGI and/or to the oppose. Further, MAGGI is not and cannot be a well-known trademark under Section 147.2 of the Intellectual Property Code of the Philippines (the 'IP Code,' Republic Act No. 8293).

"1.3. Par. 3, in that opposer's MAGGI trademark is not well-known internationally and in the Philippines within the meaning of Section 147.2 of the IP Code and Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames or Marked or Stamped Containers (hereinafter the 'Rules'), especially with respect to International Class 29. Opposer's Exhibits do not and cannot prove that MAGGI is a well-known trademark. Many of the said Exhibits, as discussed in the Affirmative Defenses, are in fact inadmissible and/or prove that Opposer have never used its MAGGI trademark for cooking oil.

"1.4. Par. 4, the truth of the matter being that Nature's Harvest has all the right to adopt and use its MAGIC trademark and there is no likelihood of confusion, mistake or deception as to affiliation, connection, or association of the said trademark with the opposer, or as to its origin, sponsorship, or approval of goods. Ordinary purchasers can very well see from a simple visual and casual examination of MAGIC cooking oil that this product is not that of Nestle or connected in any way with Nestle or its alleged MAGGI trademark.

"1.5. There is and cannot be any false designation or origin, false description or representation under Section 169 of the IP Code. Respondent-applicant's MAGIC cooking oil, based on the use of the MAGIC trademark and the general trade dress of respondent-applicant's products bearing such trademark (pls. see Exhibits '11,' '12' and '13' attached to Ms. Chua's Affidavit, Exhibit '1') cannot even be mistaken to originate from oppose.

"1.6. Par.5, the truth being that the use by respondent-applicant of its MAGIC trademark does not and cannot infringe the opposer's alleged MAGGI trademark. As stated above and discussed in the Affirmative Allegations and Affirmative Defenses, respondent-applicant has the right to use and register the said MAGIC trademark which was merely derived from its registered MAGIC FRY trademark. Secondly, there is no confusing similarity between respondent-applicant's MAGIC trademark and opposer's alleged MAGGI trademark.

“Further, opposer cannot reserve any right to present other evidence or to add evidence other than those to rebut new matters raised in this Answer. Under Rule 2, Section 7 of the Regulations on Inter Partes Proceedings, as amended by Office Order No. 79, series of 2005 (hereinafter the ‘Inter Partes Regulations’), the Opposition must already be accompanied by ‘affidavits or witnesses’, ‘originals of the documents and other requirements’ and/or certified copies in the case of public documents.

“1.7. Paragraph I, under the subheading ‘Opposer is the exclusive owner of the ‘MAGGI’ trademark.’ Respondent-applicant has no knowledge sufficient to form a belief as to the truth or falsity of the opposer’s allegation in respect of its adoption of and the history of the MAGGI trademark. In fact, as discussed above opposer’s Exhibits ‘A’, ‘B’ and ‘C’ are inadmissible, and are nothing more than hearsay and self-serving documents.

“1.8. Par. 2, under the subheading ‘There is confusing similarity between Opposer’s ‘MAGGI’ trademark and Respondent-Applicant’s trademark ‘MAGIC.’ There is no such confusing similarity, as discussed above and in the Affirmative Defenses.

“1.9. Par. 3, under the subheading ‘The Opposer’s trademark ‘MAGGI’ is internationally well-known. As discussed above and in the Affirmative Defenses, opposer’s MAGGI trademark is not a well-known mark or ‘a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines’ (Section 123 [e] and [f], IP Code). It does not pass the criteria set under Rule 102 of the Rules. Respondent-applicant also has no knowledge sufficient to form a belief as to the truth or falsity of opposer’s claims under the said paragraph. Opposer’s Exhibit ‘F’ with submarkings are unauthenticated self-serving write-ups which are inadmissible and have no value as evidence.

“1.10. Par. 4, under the subheading ‘[T]he use of Respondent-Applicant’s trademark ‘MAGIC’ would indicate a connection x x x.’ Respondent-applicant appropriated the trademark MAGIC as a distinctive mark with absolutely no intention of capitalizing or riding on the goodwill of any other trademark or product. The distinctiveness of the MAGIC trademark is proven simply by the registration of respondent-applicant’s MAGIC FRY trademark from which MAGIC was clearly derived.

Further, the use, sale and distribution of respondent-applicant’s products bearing the MAGIC trademark do not and cannot inflict any damage to any interest of opposer. Registration of MAGIC, in the same way that MAGIC FRY was registered, will be in accordance with the IP Code. No confusing similarity or alleged dilution of opposer’s trademark can result from the use of respondent-applicant’s MAGIC trademark.

“1.11. Par. 5, under the same subheading above. Opposer’s Exhibits ‘G’ to ‘L’ are either inadmissible as evidence or have no value as evidence to prove that the MAGGI trademark is a well-known mark, as discussed in the Affirmative Defenses.

“II.

AFFIRMATIVE ALLEGATIONS

“2.1. Respondent-applicant Nature’s Harvest is a corporation duly organized and existing under Philippine law in 1988.

“2.2. Nature’s Harvest has been marketing, advertising, distributing and selling cooking oil in the Philippines under the ‘MAGIC FRY’ trademark since 1989. The said trademark was registered before the old Bureau of Patents, Trademarks and Technology Transfer (‘BPTTT’) on 13 May 1991 (please see Exhibit ‘2’ attached to the Affidavit of Ms. Rebbie L. Chua, General Manager of respondent-applicant, attached hereto as Exhibit ‘1’).

"2.3. Sometime in 2008, Nature's Harvest discovered that the said trademark registration for MAGIC FRY was cancelled. Nature's Harvest thus refiled a trademark application for the said trademark, which was again registered on 22 September 2008. Attached to the Affidavit of Ms. Chua as Exhibit '3' is a certified true copy of Certificate of Registration No. 4-2008-001658 for the trademark 'MAGIC FRY' issued by the Intellectual Property Office.

"2.4. The MAGIC FRY cooking oil of Nature's Harves gained popular acceptance in the market and has established goodwill among ordinary purchasers of cooking oil and institutional consumers like hotels, restaurants, factories, etc. (Pls. see Exhibits '4' to '10' attached to the Affidavit of Ms. Chua).

"2.5. Nature's Harvest sold and sells its MAGIC FRY cooking oil in, among others, seventeen (17) kilogram containers net weight, i.e., that total weight excluding the one-kilogram container. This is in accordance with industry practice where the weight of the contents is indicated.

"2.6. In early 2000, some competitors of Nature's Harvest started marketing and selling cooking oil with sixteen (16) kilogram net weight, at a lesser price. This was eventually accepted by the market.

"2.7. As a marketing strategy, in order to capture what became a sixteen (16) kilogram market, Nature's Harvest started marketing and selling a sixteen (16) kilogram net cooking oil. However, in order not to confuse the market considering that Nature's Harvest still sold its seventeen (17) kilogram net cooking oil under the MAGIC FRY trademark, Nature's Harvest marketed and sold its sixteen (16) kilogram net cooking oil under a derivative trademark - the MAGIC trademark subject of the present Opposition.

"2.8. The MAGIC trademark, like the registered MAGIC FRY trademark, has gained recognition and established goodwill in the market. It became very ordinary or common for customers of Nature's Harvest to order 'MAGIC' cooking oil from it. Nature's Harvest therefore filed before the Intellectual Property Office on 11 February 2008, Trademark Application No. 4-2008-001657 for registration of MAGIC as a separate trademark (pls. see Exhibits '11,' '12' and '13.' Attached to Affidavit of Ms. Chua.).

"2.9. Nature's Harvest has never encountered any MAGGI cooking oil in the market. It is informed, and thus alleges, that there is no cooking oil sold in the market under the trademark MAGGI. Neither has Nature's Harvest ever received any inquiry on whether its MAGIC cooking oil is related to MAGGI brand or to its known manufacturer, Societe Des Produits Nestle, S.A.

Attached hereto as Exhibit '1' is the Affidavit of respondent-applicant's General Manager and principal stockholder, Ms. Rebbie L. Chua. Attached to the said Exhibit are the other Exhibits referred to above.

"III.

**"AFFIRMATIVE DEFENSES
AND GROUNDS TO DENY THE OPPOSITION**

"A.

NATURE'S HARVEST IS THE REGISTERED OWNER OF THE 'MAGIC FRY' TRADEMARK. THE MAGIC TRADEMARK SUBJECT OF THE PRESENT OPPOSITION WAS DERIVED FROM SUCH REGISTERED MARK. NATURE'S HARVEST ALREADY HAS THE EXCLUSIVE RIGHT TO USE THE MAGIC TRADEMARK.

"3.1. As stated above, respondent-applicant is the registered owner of the MAGIC FRY trademark, under Certificate of Registration No. 4-2008-001658 issued by this Honorable Office

on 20 November 2008 (Exhibit '3'). The Certificate expressly indicates that the word 'FRY' was disclaimed by respondent-applicant.

"3.2. It is thus clear that the word and mark 'MAGIC' is the principal subject of respondent-applicant's registration. This is the dominant feature of the registered mark and the principal object of respondent-applicant's exclusive rights. Respondent-applicant has registered MAGIC and therefore has exclusive rights to use the same.

"3.3. The MAGIC trademark subject of this Opposition is exactly the same 'MAGIC' in the registered MAGIC FRY trademark of respondent-applicant. The MAGIC trademark was merely derived from the registered MAGIC FRY trademark where the word 'FRY' was disclaimed.

"3.4. Opposer never opposed the registration of MAGIC FRY. It cannot now claim confusing similarity with MAGIC or damage from the use by respondent-applicant of the MAGIC trademark. Opposer cannot be given another opportunity to oppose the MAGIC FRY registration.

"3.5. Indeed, the Opposition is suspicious and opposer's intentions are questionable. Opposer not only seeks to belatedly oppose the MAGIC FRY trademark, it also seeks an over-extension of protection for its alleged MAGGI trademark. Opposer's asserted Exhibit L-4 in fact is revealing. It is clear that Opposer uses the word 'MAGIC' as part of 'MAGIC SARAP' for its products in conjunction with the MAGGI trademark, but did not and could not separately register the same because respondent-applicant already has the exclusive right to use MAGIC as a trademark. The present Opposition is a clear strategy to over-extend protection to the very different MAGGI trademark and to pave the way for opposer to continue using MAGIC in the market. It is in fact oppose who should be stopped from using MAGIC in violation of respondent-applicant's rights to the said mark.

"3.6. There is actually no proof of registration of 'MAGGI' alone as a trademark. Opposer's Exhibits 'A,' 'B' and 'C' are neither original nor certified true copies of trademark registrations, as required by Section 5, IPO Office Order No. 79, series of 2005. They are mere printouts of information referring to purported registrations. They do not even comply with the Electronic Evidence Rules which require proof of authenticity of electronically generated documents (Rule 5, Electronic Evidence Rule, A.M. 01-7-01-SC, 17 July 2001).

Opposer attached to its Opposition, only purported certified copies of registrations for 'MAGGI CUP SARAP,' (Exhibit 'D') and 'MAGGI NOODLE EXPRESS' (Exhibit 'E').

"B.

CONTRARY TO THE OPPOSER'S CLAIM, MAGGI IS NOT A WELL-KNOWN TRADEMARK. OPPOSER'S PURPORTED EVIDENCE TO SHOW THIS ARE EITHER INADMISSIBLE OR DO NOT PROVE OR SUPPORT OPPOSER'S CONTENTIONS.

"3.7. It is quite obvious why opposer insists on MAGGI to be a well-known trademark. Opposer wants to be able to use Section 147.2 of the IP Code which provides that the exclusive right of a well-known trademark which is registered in the Philippines shall extend to goods and services which are not similar to those covered by its registration. Opposer cannot and should not be allowed to capitalize on such argument because MAGGI is not a well-known trademark. Further, any registration of MAGGI as a trademark (assuming there is any such registration) cannot extend to cooking oil or to a completely different trademark.

"3.7. Under Rule 102 of the Rules, the following factors must be considered in determining whether a mark is well-known: x x x

“3.8. None of the Exhibits of oppose attached to its Opposition proves that MAGGI is a well-known mark under the above-listed factors or criteria. Consider the following:

Opposer's Exhibit	Description	Remarks
F	Protection List that purportedly shows the registrations and pending applications for registration of the mark 'MAGGI' worldwide'	1. This Exhibit appears to consist of entries made in the course of business. This is inadmissible hearsay evidence as there is no proof of its authenticity (Sec. 43, Rule 130 of the Rules of Court). 2. This Exhibit also has no relation, and cannot prove that the mark MAGGI is allegedly well-known (See Verified Notice of Opposition, p. 5). The Protection List does not contain 'account x x x 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 x x x' opposer's mark. There is also nothing in opposer's Exhibit 'F' which shows that the mark MAGGI is 'x x x considered by competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered x x x as x x x the mark of a person other than the applicant x x x in determining whether a mark is well-known' (Sec. 123[e], Intellectual Property Code).
G	Unsigned document entitled, 'Reputation Trade Mark Maggi'	This is an inadmissible self-serving private document that was not authenticated (See Sec. 20, Rule 132 of the Rules of Court).
H	Print out of an alleged brochure entitled 'Julius Maggi [1846-1912]: Life with a touch of spice'	1. Same remarks as Exhibit "G" above. 2. Considering that this Exhibit is a mere print out of an electronic document, it is not the original document required by Sec. 5 of IPO Office Order No. 79, series of 2005 (the Amendments to the Inter Partes Rules). Neither does this comply with the Electronic Evidence Rules.
I	Print out of an alleged article entitled 'Maggi, L'Expertise Culinaire Depuis Plus d'un Siecle'	This Exhibit is likewise a mere print out of a copy of a purported article that purportedly appeared in a publication entitled 'La Revue des Marques'. It is not the original document required by Sec. 5 of the Amendments to the Inter Partes Rules.
J	Sales Figures of the Maggi Brand (2002-2006)	Same comments as Exhibit 'F' above.
K	Copy of alleged Certificates of Registration in Australia of the mark 'MAGGI' certified by a Swiss notary.	This Exhibit is not the certified copies of public documents contemplated by Sec. 5 of the Amendments to the Inter Partes Rules. The Swiss notary who supposedly executed the certification merely attested that this Exhibit are copies of the documents presented to him. It is not certified as a true copy of the actual public document issued by, and in the custody of, the concerned public officer or government office.
K-1	Copy of what vaguely appears to be Certificates of Registration in Brazil certified by a Swiss notary.	1. Same comment as Exhibit 'K' above. 2. These Exhibits cannot be admitted as evidence without a translation in English or Filipino as the language employed in said Exhibits are not the official language (Sec. 33, Rule 132 of the Rules of Court).
K-2	Copy of what vaguely appears to be Certificates of Registration in Colombia certified by a Swiss notary.	
K-3	Copy of what vaguely appears to be a certification issued by the Organisation Mondiale de la Propriete Intellectuelle certified by a Swiss notary.	
K-4	Copy of alleged Certificates of Registration in North Borneo certified by a Swiss notary.	1. This Exhibit is irrelevant as opposer's name does not even appear on this exhibit. Another entity by the name 'Nestle's Products, Ltd.' Appears on said Exhibit. 2. Same remarks as Exhibits 'K-1' t 'K-3' above.
K-5	Copy of alleged Certificates of Registration of the mark 'MAGGI' certified by a Swiss notary.	1. Based on this Exhibit, the sole registered user of the MAGGI trademark covered by said Certificates is another entity by the name of 'The Nestle Company (New Zealand) Limited.' 2. Same remarks as Exhibit 'K-1' to 'K-3' above.
K-6	Copy of what vaguely appears as an alleged attestation on registration issued by the Swiss Federal Institute of	Same remarks as Exhibits 'K-1' to 'K-3' above.

[Handwritten signature]

[Handwritten mark]

	Intellectual Property	
L	Packaging of shrimp bouillon cubes bearing the mark MAGGI	These Exhibits do not prove that the mark MAGGI is allegedly well-known. These contain no 'account[s] x x x of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge n the Philippines which has been obtained as a result of the promotion of x x x' the mark 'MAGGI'. Neither do these exhibits show that the mark MAGGI is 'x x x considered by competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered x x x as x x x the mark of a person other than the applicant x x x in determining whether a mark is well-known' (Sec. 123 [e], Intellectual Property Code).
L-1	Packaging of chicken bouillon cubes bearing the mark MAGGI	
L-2	Packaging of beef bouillon cubes bearing the mark MAGGI	
L-3	Packaging of Sinigang mix bearing the mark MAGGI	
L-4	Packaging of seasoning granules bearing the mark 'MAGGI' and the words 'MAGIC SARAP'	
L-5	Packaging of mami noodles bearing the mark MAGGI	
L-6	Receipt showing purchase of various food products	

“3.9. It is thus clear that MAGGI is not a well-known mark. Respondent-applicant’s MAGIC trademark is not ‘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’ (Section 123 [e] and [f], IP Code). Any registration of the MAGGI trademark in the Philippines cannot extend to goods which are not similar to those covered by such registration.

“3.10. Further, while there are two (2) alleged registrations of MAGGI in the Philippines covering Class 29, such registration do not cover cooking oil as opposer never used and does not use its MAGGI trademark for cooking oil. Indeed, opposer’s Exhibits ‘L,’ ‘L-1’ to ‘L-6’ show that oppose never ventured into cooking oil and/or that MAGGI has never been used for this product.

“C.

THERE IS NO CONFUSING SIMILARITY BETWEEN THE MAGIC TRADEMARK AND THE ALLEGED MAGGI TRADEMARK OF OPPOSER. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE MAGGI TRADEMARK AND RESPONDENT-APPLICANT’S MAGIC TRADEMARK. NEITHER CAN THERE BE CONFUSION AS TO SOURCE OF THE MAGIC COOKING OIL.

“3.11. As this Honorable Office very well knows, ‘[I]n determining similarity and likelihood of confusion, jurisprudence has developed two tests, the *dominancy test* and the *holistic test*. The dominancy test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion or deception. 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. Under the latter test, a comparison of the words is not the only determinat factor’ (McDonald’s Corporation vs. MacJoy Fastfood Corporation, 514 SCRA 95, 106 [2007]).

“3.12. There is no confusing similarity between the MAGIC trademark of respondent-applicant and the alleged MAGGI trademark of opposer, under both the dominancy and holistic tests.

a) ‘MAGGI’ and ‘MAGIC’ are two very different words. In fact, MAGIC is an actual word and not a mark simply invented to resemble the alleged MAGGI trademark. Therefore, using the test of dominancy, the prevalent features of the competing marks are very different and distinct from each other, especially considering that MAGIC is in script, i.e. ‘Magic.’

b) Neither is there similarity in spelling, sound and connotation, contrary to the assertion of oppose (at p. 5, Opposition). The spelling of MAGGI and MAGIC are definitely different. In sound, the pronunciation of the letter ‘G’ in MAGIC (like ‘j’) is different from the pronunciation of ‘G’ of ‘GG’ in MAGGI. The two marks also have different meanings or connotations.

c) In the case of Societe Des Produits Nestle, S.A. vs. Court of Appeals (356 SCRA 207) which opposer obviously capitalizes, the Supreme Court ruled in favor of opposer because the FLAVOR MASTER opposed therein contained an identical dominant word which is part of opposer's registered marks MASTER ROAST and MASTER BLEND. It was clear in that case that in terms of spelling, pronunciation and connotation of the dominant word 'MASTER,' there was confusing similarity. This is certainly not the situation in the present case. Here, as discussed, there is no similarity at all between the trademark MAGIC and the MAGGI trademark.

d) The entirety of the marks as they are applied to the respective products of the parties, are very different (pls. see Exhibits 'L,' 'L-1' to 'L-5' of oppose and Exhibits 'II', '12' and '13' of respondent-applicant). Indeed, opposer's exhibits show that the MAGGI trademark as actually used, is always presented inside a balloon-like or an inverted teardrop shape. Certainly, opposer's alleged MAGGI trademark is not and never used as a word mark. It is not and never used in script or in the same peculiar font as respondent-applicant's Magic trademark. The packaging of respondent-applicant's MAGIC cooking oil (pls. see Exhibit '11', '12', '13') is very different from that of the opposer, and cannot never be mistaken as that of the opposer or its alleged MAGGI products.

e) 'ALACTA' was found not confusingly similar to 'ALASKA' (Mead Johnson & Co. vs. N.V.J. Van Dorp, Ltd., 7 SCRA 768 [1963]); no confusing similarity was found in the use and adoption of 'BIOFERIN' and 'BUFFERIN' (Bristol Myers Co. vs. Director of Patents, et al., 17 SCRA 128 [1966]). Similarly, the Supreme Court found 'STYLISTIC MR. LEE' not to be confusingly similar to 'LEE' covering exactly the same products (Emerald Garment Manufacturing Corporation vs. Court of Appeals, 251 SCRA 600).

Surely, if the above-stated trademarks which have several commodities in spelling, sound and products were found to be different and distinctive, there is absolutely no reason to find any confusing similarity between respondent-applicant's MAGIC trademark and opposer's alleged MAGGI trademark.

"3.13. In the present Opposition, confusion, whether confusion of goods or confusion of business or source, is very remote if not completely absent. There is absolutely no basis for the Opposition and no basis to deny the registration of the trademark MAGIC in favor of respondent-applicant.

"3.14. There is also no likelihood of confusion because the MAGIC trademark covers goods that are different from those on which the MAGGI trademark is used. As discussed above, MAGGI is not and never used for cooking oil. Indeed, opposer's alleged evidence of registration under International Class 29 (Exhibits 'B' and 'C') are not certified true copies in violation of Sec. 5 of IPO Office Order No. 79, series of 2005, which requires certified true copies of public documents to be filed with the Opposition. This is the same case with respect to the alleged registration of MAGGI under Class 30 (Exhibit 'A').

Opposer's Exhibits 'A,' 'B' and 'C' do not even comply with the Electronic Evidence Rule which requires proof of authenticity of such electronically generated exhibit (Rule 5, Rules on Electronic Evidence, A.M. 01-7-01-SC, 17 July 2001)."

Sec. 123.1(d) of Rep. 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;


Records show that at the time the Respondent-Applicant filed its trademark application on 11 February 2008, the Opposer has existing registrations for the mark MAGGI, to wit:

1. No. 00343 for the mark "MAGGI", issued on 28 November 1986 for use on goods under Class 30, namely "soups, consomes, bouillons, sauces, gravies, meat extracts, flours, seasonings for improving soaps, sauces, gravies and other dishes, spices and condiments";
2. No. 4-1999-001921 for the mark "MAGGI (YELLOW) WITH BUBBLE DEV. (RED)", issued 16 July 2006, for goods under Classes 29, namely "vegetables, fruit, meat, poultry, game, fish and seafood (all these products also in the form of extracts, soups, jellies, pastes, preserves, ready-made dishes, frozen or dehydrated; jams; eggs; milk, cheese and other food preparation having a base of milk, milk substitutes; soya milk and soya-based preparations; edible oils and fats; proteins preparation for food"; and under Class 30, namely, "coffee, coffee extracts and coffee-based preparations; coffee substitutes and extracts of coffee substitutes; tea, tea extracts and tea-based preparations; cocoa and preparations having a base of cocoa, chocolate, chocolate products, bread, yeast, pastry, biscuits, cakes, desserts, puddings; ice cream, products for the preparation of ice cream; honey and honey substitutes; breakfast cereals, rice, pasta, foodstuffs having a base of rice, of flour or of cereals, also in the form of ready made dishes; sauces; aromatizing or seasoning products for food, salad dressings, mayonnaise";
3. No. 4-2001-002332 for the mark "MAGGI CUP SARAP", issued on 16 April 2007 for goods under Class 30, specifically, "foodstuffs having a base of rice, of flour or of cereals, also in the form of ready made dishes, noodles, pasta"; and
4. No. 4-1995-105795 for the mark "MAGGI NOODLE EXPRESS", issued on 30 September 4, 2000, for use on goods under Class 30, specifically "noodles seasoning for noodles".

Although the Respondent-Applicant's application covers "cooking oil" which belong to Class 29, this does not mean that it is, automatically, similar or closely related to the other goods that fall under same class. The Supreme Court in *Philippine Refining Co., Inc. v. Ng Sam*⁴ held,

"In determining whether goods are dissimilar, emphasis must be placed on the similarity of goods and not on the arbitrary classification of the goods. xxx

"While Respondent's product, ham and some of the products of Petitioner are classified under Class 47 (Food and Ingredients of Food), this alone cannot serve as the decisive factor in the resolution of whether or not they are related goods. Emphasis should be on the similarity of the products involved and on the arbitrary classification or general description of their properties or characteristics. The particular goods of the parties are so unrelated that consumers would not in any probability mistake one as the source or origin of the product of the other."

But even if this Bureau considers the Respondent-Applicant's "cooking oil" closely related to "edible oils and fat" covered by one of the Opposer's trademark registration, the Respondent-Applicant should be allowed to register the mark MAGIC. The competing marks, as shown below, are not identical nor resemble each other: 

⁴ G.R. No. L-26676, 30 Jul. 1982.

MAGGI

Magic

Opposer's Mark

Respondent-Applicant's Mark

The visual and aural differences between the marks negate the likelihood of confusion or deception. The configuration of a double "G" followed by "I" in MAGGI is in stark contrast with the "GIC" in MAGIC. The eyes and ears can easily distinguish between MAGGI and MAGIC. While MAGGI is pronounced as spelled (mag-gi), MAGIC is pronounced as "ma-jik". The word "magic", in the first place, is a common English word, and a popular one for that matter, such that it is very remote for one to confuse it with the mark MAGGI. Moreover, the way the marks are presented also diminishes the chances of committing mistake or confusion. The letters in the Opposer's mark are all capital letters and in upright, perpendicular and static positions. This, while the letters in the Respondent-Applicant's mark are stylized, in distinctive script, with the letters in lower case except the letter "M", and in diagonal position connoting dynamism or action.

Succinctly, 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.⁵ This Bureau finds the Respondent-Applicant's mark consistent with this function.

With the finding and conclusion that the competing marks are not confusingly similar, this Bureau deems that there is no need to delve on whether or not the Opposer's mark could be considered as a well-known mark under the applicable provisions of law and pertinent rules.

WHEREFORE, premises considered, the instant opposition case is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2008-001657 be returned, together with a copy of this Decision, to the Bureau of Trademarks, for information and appropriate action.

SO ORDERED.

Taguig City, 15 February 2012.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.