



SOCIETE DES PRODUITS NESTLE,
Opposer,

-versus-

SILVER SWAN MANUFACTURING CO., INC.,
Respondent-Applicant.

} **IPC No. 14-2011-00049**
} Opposition to:
} Application No.4-2010-000152
} Date filed: 06 January 2010
} **TM: "SILVER SWAN MAGIK**
} **SEASONING AND SWAN**
} **DEVICE LABEL MARK"**

X-----X

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 54 dated April 17, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 17, 2015.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



SOCIETE DES PRODUITS NESTLE,

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**SILVER SWAN MANUFACTURING
CO., INC.,**

Respondent-Applicant.

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IPC No. 14-2011-00049

Opposition to Trademark

Application No. 4-2010-000152

Date Filed: 06 January 2010

Trademark: "**SILVER SWAN**

**MAGIK SEASONING AND SWAN
DEVICE LABEL MARK"**

Decision No. 2015- 54

DECISION

Societe Des Produits Nestle¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-000152. The contested application, filed by Silver Swan Manufacturing Inc., Co.² ("Respondent-Applicant"), covers the mark "SILVER SWAN MAGIK SEASONING AND SWAN DEVICE LABEL MARK" for use on "*seasoning*" under Class 30 of the International Classification of Goods³.

The Opposer alleges that it is the first one to adopt, use and register the trademark "MAGIC SARAP" for goods under Class 30 and the trademark "MAGGI" for goods under Classes 1, 2, 3, 4, 5, 29, 30, 31, 32, 35, 37, 39, 41 and 42. It contends that the mark "SILVER SWAN MAGIK SEASONING AND SWAN DEVICE LABEL MARK" is confusingly similar to its own trademarks "MAGGI" and "MAGIC SARAP" in terms of sound, sight and connotation. In the Philippines, the Opposer was able to obtain registration for the following:

1. "MAGGI" under Certificate of Registration No. 000343 issued on 28 November 1986;
2. "MAGGI" under Certificate of Registration No. 4-2008-002402 issued on 07 July 2008;
3. "MAGGI (YELLOW) WITH BUBBLE DEVISE (RED)" under Certificate of Registration No. 4-1999-001921 issued on 16 July 2006;
4. "MAGGI CUP SARAP" under Certificate of Registration No. 4-2001-002332 issued on 16 April 2007; and
5. "MAGGI NOODLE EXPRESS" under Certificate of Registration No. 4-1995-105795 issued on 04 September 2000.

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

² A domestic corporation with address at 164 Panghulo Rd., Bo. Panghulo, Malabon City..

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

According to the Opposer, its "MAGGI" trademark is over one hundred (100) years old and its "MAGGI" products were produced even before 1886 in Switzerland. Maggi and Cie was founded in 1886 with the object of producing and marketing popular food products and within three years, warehouses of "MAGGI" products were built in Paris, Berlin, Vienna and London. Then in 1890, Maggi and Cie became a limited company under the name "Fabrique des Produits Alimentaires Maggi". In 1938, the daily production reached 1.8 million "MAGGI" bouillon cube and ten thousand (10,000) kilos of vegetable cooked soups. Thereafter in 1947, the company merged with Opposer, allowing worldwide sale of "MAGGI" products.

In support of its Opposition, the Opposer submitted the following:

1. list of the Opposer's registrations and pending applications;
2. copy of the "Reputation of Trademark MAGGI";
3. affidavit of Sheila Imperial, with annexes; and
4. other evidence including affidavit of witness, history of the "MAGGI" trademark, sales figures, actual labels and sales receipt⁴.

The Respondent-Applicant filed its Answer on 27 June 2011. It denies that its mark is confusingly similar to the Opposer's. It asserts that the competing marks present glaring dissimilarities in terms of their overall appearance, impression and pronunciation from the point of view of the target market. It also avers that the mark "SILVER SWAN MAGIK SEASONING AND SWAN DEVICE" has been registered since 1971 and from that time, it has been continuously the same mark up to the present. As evidence, it submitted a photocopy of Certificate of Registration No. 54775 issued by then Bureau of Patents, Trademarks and Technology Transfer (BPTTT)⁵.

Pursuant to Office Order No. 154, s. 2010, the case was referred to mediation. The parties, however, failed to settle amicably. On 19 January 2012, a Preliminary Conference was conducted and terminated. Only the Opposer, however, filed its position paper.

The issue to be resolved is whether the Respondent-Applicant's trademark application should be registered.

Section 123.1 (d) of the IP Code provides that:

"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:

⁴ Marked as Exhibits "A" to "H", inclusive.

⁵ Marked as Exhibit "1" to "1-A".

- (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; xxx."*

Records reveal that the Opposer secured registration for its mark "MAGGI" as early as 28 November 1986. Its mark "MAGIC SARAP" was allowed registration on 21 January 2006. On the other hand, the Respondent-Applicant filed its application for the mark "SILVER SWAN MAGIK SEASONING AND SWAN DEVICE LABEL MARK" on 06 January 2010. However, it was previously granted registration for the mark "MAGIK" on 10 February 1988. The registration expired on 11 February 2008.

The competing marks are reproduced below for comparison:

Opposer's Marks:

MAGGI

MAGGI CUP SARAP



**NOODLE
EXPRESS**



MAGIC SARAP

Respondent-Applicant's Mark:



The prominent feature of the Opposer's mark is the word "MAGGI". This is what is retained in the eyes and mind when one looks at the Opposer's marks. However, the word "MAGGI" is not confusingly similar to the word "MAGIK" in the Respondent-Applicant's mark. The Respondent-Applicant's mark is highly distinguishable from the Opposer's visually, aurally and even in connotation. Noteworthy, in **Societe Des Produits Nestle, S.A. vs. Nature's Harvest Corporation**⁶, docketed as IPC Case No. 14-2008-00362, this Bureau ruled that:

"The visual and aural differences between the marks negate the likelihood or deception. The configuration of 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 (magg-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'. x x x"

In the same vein, this Bureau holds that the Respondent-Applicant's mark is not confusingly similar with the Opposer's mark "MAGIC SARAP". As aptly stated in the above decision, the word "magic" is a common English word. In fact, the Trademark Registry of this Office has registered various marks appropriating the word "magic". What will then determine whether the competing marks are confusingly similar are the words and/or device that precede or succeed the said word. In this instance, the Opposer's mark is composed of the words "magic" and "sarap". This is easily distinguishable from the phrase "silver swan" and the swan device which is attached to the word "magik" in Respondent-Applicant's applied mark. Thus, while "magic" and "magik" are pronounced and read identically, Respondent-Applicant succeeded in lending distinctiveness in its mark by words "silver swan" and swan device such that the term "magik" pale into significance.

Noteworthy, the Respondent-Applicant's previously holds a registration of the contested mark since 1971, which expired only in 2008. The Opposer, on the other hand, only registered its first mark appropriating the word "MAGIC", in 2006 when it

⁶ Decision No. 2012-27.


was issued registration for the mark "MAGIC SARAP". Therefore, between the period 2006 to 2008, the two competing marks has co-existed in commerce and no confusion and/or deception to the public was shown to have occurred. More importantly, it is underscored that the Respondent-Applicant's mark bears it's the manufacturer's name "SILVER SWAN" alongside the words "MAGIK SEASONING". Where the trademark sought to be registered includes the name of the manufacturer, the threshold in determining the possibility of confusion is much higher as it gives notice and information to the consumers of the source thereof.

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁷ Based on the above discussion, Respondent-Applicant's trademark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-000152 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 April 2015.


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

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.