



MARS, INCORPORATED,
Opposer,

-versus-

**MARKVENTURE DISTRIBUTOR
SALES, INC.,**
Respondent-Applicant.

} **IPC No. 14-2011-00013**
} Opposition to:
} Appln. Serial No. 4-2009-07802
} Date Filed: 04 August 2010
} TM: "**MISTER EGEE &**
} **DESIGN**"

X-----X

NOTICE OF DECISION

QUISUMBING TORRES

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GREETINGS:

Please be informed that Decision No. 2015 - 127 dated June 29, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 29, 2015.

For the Director:


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



MARS, INCORPORATED,	}	IPC No. 14-2011-00013
	Opposer,	}
	}	Opposition to:
-versus-	}	Application No. 4-2009-07802
	}	Date Filed: 04 August 2010
	}	Trademark: "MISTER EGSEE &
MARKVENTURE DISTRIBUTOR	}	DESIGN"
SALES, INC.,	}	
	Respondent-Applicant.	}
x-----x		Decision No. 2015- <u>127</u>

DECISION

MARS, INCORPORATED¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-07802. The application, filed by MARKVENTURE DISTRIBUTOR SALES, INC.² ("Respondent-Applicant"), covers the mark "MISTER EGSEE & DESIGN" for use on "coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes, flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; pepper, vinegar, sauces; spices; ice" under Class 30 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"1. The grounds for opposition are as follows:

"1. The registration of the mark MISTER EGSEE & DESIGN is contrary to the provisions of Sections 123.1 (d) of Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines ('IP Code'), as amended, which prohibit the registration of a mark that:

"2. Opposer is the owner of the well known M&M's mark and associated marks such as the M&M's Characters. These include the following marks that are registered in the Opposer's name with the Philippine Intellectual Property Office in various classes:

"3. The Opposer has likewise adopted the M&M's Character in the Philippines in green as shown in photographs taken of actual M&M's products below:

¹A foreign corporation duly organized and existing under and by virtue of the laws of the State of Delaware, United States of America, with its principal place of business at 6885 Elm St., McLean, Virginia, U.S.A.

²With address at 26-C JP Rizal Street, Barangay Tugatog, Malabon City.

³The 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

"4. Respondent-Applicant's mark, MISTER EGGEE & DESIGN, is shown below:

"5. Respondent-Applicant's mark is confusingly similar to the Opposer's M&M's Characters and trademarks as to be likely to deceive or cause confusion. The humanized candy character in Respondent-Applicant's mark is visually identical or similar to the above M&M's Characters and trademarks. Hence, the registration of the Respondent-Applicant's mark will be contrary to Section 123.1 (d) of the IP Code.

"6. The Opposer is entitled to the benefits granted to foreign nationals under Section 3 of Republic Act No. 8293, which provides:

"7. Opposer has used the M&M's Characters and trademarks in the Philippines and elsewhere prior to the filing date of the application subject of this opposition. The Opposer continues to use the M&M's Characters and trademarks in the Philippines and in numerous other countries.

"8. The M&M's products which bear the M&M's Characters and trademarks may be purchased in almost all major department stores, groceries and supermarkets all over the Philippines.

"9. The Opposer has also extensively promoted the M&M's Characters and trademarks. Over the years, the Opposer has obtained significant exposure for the goods upon which the M&M's Characters and trademarks are used in various media, including television commercials, outdoor advertisements, print publications, and other promotional events. The Opposer also promotes its goods over the internet at the website www.mms.com.

"10. Opposer has not consented to the Respondent-Applicant's use and registration of the MISTER EGGEE & DESIGN, or any other mark identical or similar to the Opposer's M&M's Characters and trademarks.

"11. The use by the Respondent-Applicant of the mark subject of this opposition in connection with 'coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes, flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; pepper, vinegar, sauces; spices; ice' in Class 30 which are the same or closely-related products offered by Opposer in connection with its business using the M&M's Characters and trademarks, will mislead the purchasing public into believing that the Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer.

"12. Potential damage to the Opposer will be caused as a result of its inability to control the quality of the products offered or put on the market by Respondent-Applicant (or associated companies) under the mark MISTER EGGEE & DESIGN mark.

"13. The use by the Respondent-Applicant of the mark subject of this opposition in relation to its goods, whether or not identical, similar or closely related to the Opposer's goods will take unfair advantage of, dilute and diminish the distinctive character or reputation of the Opposer's M&M's Characters and trademarks.



"14. The use by Respondent-Applicant of the mark subject of this Opposition also encroaches on the zone of natural expansion of the Opposer's business in connection with which the Opposer's M&M's Characters and trademarks are used.

"15. The denial of the application subject of this opposition is authorized by the provisions of the IP Code.

x x x

The Opposer's evidence consists of a the Verified Notice of Opposition; the affidavit of Mr. Joseph Lyle K. Sarmiento; the affidavit of Henry P. Azcarraga; copy of the legalized certificate and power of attorney signed by Ms. Fernanda Magalhaes, Assistant Secretary of Opposer constituting and appointing Quisumbing Torres or any of its individual members and associates to represent Opposer in this opposition case; and copy of legalized Assistant Treasurer's Certificate showing that Ms. Fernanda Magalhaes is an Assistant Secretary of the Opposer.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 11 May 2011. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark MISTER EGEE & DESIGN?

The Opposer anchors its opposition on Sections 123.1, paragraphs (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

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

x x x

(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 04 August 2009, the Opposer has an existing trademark registrations for the marks M&M'S LABEL (WITH CHARACTER) IN YELLOW & BROWN under Certificate of Registration No. 4-2004-008348 issued on 18 December 2006, M&M'S PEANUT LABEL (IN COLOUR) under Certificate of Registration No. 4-2001-002420 issued on 25 December 2005, YELLOW CHARCTER WITH ARM RAISED under Certificate of Registration No. 4-2004-008353 issued on 18 December 2006, RED

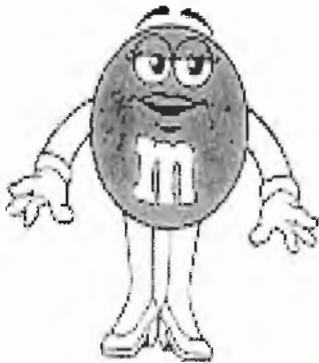
⁴ Marked as Exhibits "A" to "DL", inclusive.

CHARACTER WITH ARM RAISED under Certificate of Registration No. 4-2004-008354 issued on 18 December 2006, M&M'S YELLOW CHARACTER DEVICE under Certificate of Registration No. 4-1998-005661 issued on 18 January 2004, M&M'S YELLOW CHARACTER (WITH "M") (IN COLOUR) under Certificate of Registration No. 4-2001-007472 issued on 16 July 2006, M&M'S RED CHARACTER (WITH M) DEVICE under Certificate of Registration No. 4-1998-005653 issued on 18 January 2004, M&M'S RED CHARACTER (WITH "M") (IN COLOUR) under Certificate of Registration No. 4-2001-007467 issued on 16 July 2006, M&M'S BLUE CHARACTER (W/ "M") DEVICE under Certificate of Registration No. 4-1998-005655 issued on 18 January 2004, M&M'S BLUE CHARACTER (W/ "M") in COLOUR under Certificate of Registration No. 4-2001-007468 issued on 16 July 2006, M&M'S BLUE CHARACTER WITHOUT "M" (IN COLOUR) under Certificate of Registration No. 4-2002-005148 issued on 05 August 2004, M&M'S LABEL (IN COLOR) WITH BLUE BACKGROUND under Certificate of Registration No. 4-2001-002421 issued on 25 December 2005, M&M'S GREEN CHARACTER (W/ "M") DEVICE under Certificate of Registration No. 4-1998-005659 issued on 18 January 2004, M&M'S GREEN CHARACTER (W/ "M") IN COLOUR under Certificate of Registration No. 4-2001-007470 issued on 16 July 2006, M&M'S GREEN CHARACTER WITHOUT "M" (IN COLOUR) under Certificate of Registration No. 4-2002-005145 issued on 18 September 2004, M&M'S LABEL (WITH CHARACTER) IN RED & BROWN under Certificate of Registration No. 4-2004-008349 issued on 18 December 2006, M&M'S LABEL BLUE ORANGE & BROWN under Certificate of Registration No. 4-2004-008347 issued on 04 December 2006, M&M'S MINIS TUBE DEVICE under Certificate of Registration No. 4-2004-001468 issued on 15 January 2007, M&M'S ORANGE CHARACTER (W "M") IN COLOUR under Certificate of Registration No. 4-2001-007471 issued on 16 July 2006 and M&M'S RED CHARACTER WITHOUT "M" (IN COLOUR) under Certificate of Registration No. 4-2002-005144 issued on 18 September 2004. The registration covers generally rice, pasta, noodles; meals made predominantly from rice, pasta or noodles; cereals and cereal preparations; prepared entrees and meals including spring rolls, curry puffs, dim sims, samosas, wontons, wonton skins; rice cakes, rice crackers; tea, coffee, cocoa; coffee essence, coffee extracts, mixtures of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee non-medicated confectionery, chewing gum, bubble gum, lollipops; pastries, cakes, biscuits, crackers, crispbread; icing for cakes, icing powder, icing sugar; ices, ice cream, ice cream products, frozen confections, frozen yogurt; desserts, chilled desserts, mousses, sorbets; desserts toppings; bread; pastry; drinks in this class; capers; fillings in this class; sweet spreads, honey, treacle, maple syrup, savoury spreads, mustards, relishes, yeast extract spreads; chocolate, chocolates, chocolate products, sauces, ketchup, tomato cause, worcestershire sauce, mint sauce, barbecue sauce; gravy; pizza, pizza bases, cooking sauces; sauces and toppings for pizzas; sauces for pasta and rice; salad dressings; vinegar, vinaigrette, mayonnaise; dips; spices and seasonings, flavourings, marinades, condiments, couscous; salsa; all included in Class 30. This Bureau noticed that the goods indicated in the Respondent-Applicant's trademark application, i.e. coffee, tea, cocoa, sugar, rice, tapioca, sago,



coffee substitutes, flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey, treacles; yeast, baking powder; salt, mustard; pepper, vinegar, sauces; spices; ice under Class 30, are similar to the Opposer's.

A comparison of the competing marks reproduced below:



Opposer's trademark



Respondent-Applicant's mark

shows that confusion is likely to occur. The distinctive feature of the Opposer's mark is the use of an egg device colored in blue or red or yellow or green or orange having human features comprising a pair of eyes, a pair of hands and a pair of feet with shoes. The Respondent-Applicant's mark is a colorable imitation of the Opposer's mark is evident in the way it was coined. It also consists of "an egg having human features comprising a pair of eyes with eyeglasses, a pair of hands, a pair of feet with sneakers and a cap xxx" Because the Respondent-Applicant's trademark application covers goods that are similar to the Opposer's, particularly, coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes, flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey, treacles; yeast, baking powder; salt, mustard; pepper, vinegar, sauces; spices; ice under Class 30, it is likely that the consumers will have the impression that these goods originate from a single source or origin or the MISTER EGGEE being a variation of the M&M'S marks. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief



or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁵

It is emphasized that 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.⁶ This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet the function.

Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁷ The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-007802 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 June 2015.



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

⁵*Converse Rubber Corp. v. Universal Rubber Products, Inc. et al.*, G.R. No. L-27906, 08 Jan. 1987.

⁶*Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepa v. Director of Patents, supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

⁷*American Wire & Cable Company v. Director of Patents*, G.R. No. L-26557, 18 Feb. 1970.