

**GRISI HNOS. S.A. de C.V.,**  
*Opposer,*

**-versus-**

**TUPPERWARE PRODUCTS SA.,**  
*Respondent-Applicant.*

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**IPC No. 14-2012-00377**

Opposition to:

Appln. Serial No. 4-2012-001424

Date Filed: 06 February 2012

**TM: COUTURE BY MAJA**

**NOTICE OF DECISION**

**VERALAW (Del Rosario Raboca Gonzales Grasparil)**

*Counsel for Opposer*  
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**QUISUMBING TORRES**

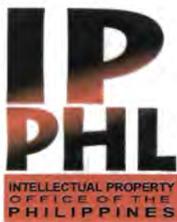
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Taguig, Metro Manila

**GREETINGS:**

Please be informed that Decision No. 2016 -386 dated 18 October, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 18 October 2016.

**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs



**GRISI HNOS. S.A. de C.V.,**  
*Opposer,*

IPC No. 14-2012-00377  
Opposition to:

- versus -

Appln. No. 4-2012-001424  
Date Filed: 06 February 2012  
Trademark: "**COUTURE BY MAJA**"

**TUPPERWARE PRODUCTS S.A.,**  
*Respondent-Applicant.*

Decision No. 2016 - 386

X ----- X

### DECISION

GRISI HNOS. S.A. DE C.V. ("Opposer")<sup>1</sup> filed a verified opposition to Trademark Application Serial No. 4-2012-001424. The application, filed by TUPPERWARE PRODUCTS S.A. ("Respondent-Applicant")<sup>2</sup>, covers the mark "COUTURE BY MAJA" for use on goods under the class 03<sup>3</sup> namely: *perfumery; fragrances, colognes; eau de toilette; scented body sprays, deodorants and anti-perspirant, lotion and powder.*

The Opposer alleges that the mark MAJA was first used in Spain in 1926. The popularity of MAJA products gradually spread out to Spain's neighboring countries and through zealous marketing effort, reached other countries in other continents. After more than eight decades, the mark continues to enjoy the following of soap and perfume enthusiasts around the world. The Opposer acquired the mark MAJA from Antonio Puig, S.A. by virtue of an assignment. At present, the mark MAJA is registered and have pending applications in various countries and jurisdictions. In the Philippines, Opposer first used the mark MAJA as early as 1973 through its predecessor-in-interest, Antonio Puig S.A. It was also issued Registration Nos. 021050 on 27 December 1973 and 42003007 on 13 January 2006.

The Opposer has been allocating substantial amount of its budget in promotional activities and advertisement. In order to reach a wider market, the Opposer has set-up the website <http://www.majaproducts.com/> to advertise the products bearing the mark MAJA. Other third-party websites are also established to promote and sell products bearing the brand MAJA. In addition to the above-mentioned websites, the products of the Opposer are also being sold in the Philippines through local entrepreneurs. The write-ups from the internet narrates Opposer's MAJA soap as a classical souvenir from Spain. It lauds the combination of citrus, lavender, spicy and woody scent of the Maja products that one might associate with Spain. Finally, the Opposer claims that the mark MAJA is a well-known mark and should therefore be protected under the law because the registration of the subject mark is confusingly similar to Opposer's MAJA and it would likely mislead the public as to the source or origin of the goods.

<sup>1</sup> A corporation duly organized and existing under and by virtue of the laws of Mexico with office address at Amores 1746, Colonia Del Valle, C.P. 03100, Delegacion Benito Juarez, Mexico, Distrito Federal, Mexico.

<sup>2</sup> With address at Route du Jura 37, Fribourg, Switzerland.

<sup>3</sup> The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

The Opposer's evidence consists of the following:

1. duly executed Special Power of Attorney;
2. Verification and Certification Against Forum Shopping;
3. printout of Respondent's application details;
4. Copy of Assignment of the mark MAJA by Antonio Puig, S.A.;
5. printouts from the website of Intellectual Property Office of the Trademark Registration of MAJA;
6. statement of advertising expenses in various countries for the year 2009;
7. third party websites to promote and sell products bearing the mark MAJA;
8. print-outs downloaded from sites selling products bearing the mark MAJA;
9. print-outs downloaded from the internet discussing the Opposer's mark MAJA and the MAJA soap and,
10. Affidavit Direct Testimony of Opposer's designated representative, Guillermo Alejandro Grisi de Lara;

On 05 February 2015, Respondent-Applicant filed its Answer. It alleged that based on the records of the Intellectual Property Office, the Opposer has no legal capacity to institute the opposition. It is not the owner of record of the mark MAJA because Registration Nos. 021050 and 42003007483 are registered in the name of Antonio Puig S.A.. Moreover, the Opposer did not make any allegation nor present any evidence or document showing that such assignment has been recorded in this Office. Therefore, the assignment, which is not in proper form or not notarized, is not valid and binding against third parties, including herein Respondent-Applicant. Moreover, contrary to Opposer's averments, Registration No. 42003007483 has already been cancelled for failure of the alleged Opposer or through its predecessor-in-interest to file the 5th anniversary Declaration of Actual Use (DAU).

Respondent-Applicant affirmed that it belongs to the same group of companies as Tupperware Brands Corporation. It is a global direct seller of innovative, premium products across multiple brands and categories through an independent sales force. Tupperware was introduced in the Philippines in 1966 and has since become a household name. It offers for direct selling a wide variety of home and consumer products including, baby care products, cosmetics, fashion, fragrances for men and women, home products, personal care and skin care products. To help promote its products in the Philippines, Tupperware engages brand ambassadors and celebrity endorsers for its marketing and ad campaigns. Tupperware's celebrity endorsers in the Philippines include: Maja Salvador, Sam Milby, Marvin Agustin, Aljur Abrenica, Toni Gonzaga, and Marian Rivera, among others. These celebrities have also launched, or are planning to launch, their own signature fragrances in collaboration with Tupperware. Some of the celebrity fragrances that have been launched by Tupperware include Sam Milby for SAM MILBY INTENSE, Marian Rivera for FOREVER BY MARIAN and Maja Salvador for MAJA and SHINE BY MAJA. Respondent-Applicant raised the defense that the subject mark is not identical nor confusingly similar to the alleged Opposer's MAJA mark which falls short of the requirement for a well-known mark declaration under the Intellectual Property Code.

The Respondent-Applicant's evidence consists of the following:

1. original notarized Verified Answer;
2. scanned copy of Special Power of Attorney executed by the Intellectual Property Counsel and Attorney Under Power of the Respondent-Applicant, Ms. Kimberly K. Weate;
3. notarized Affidavit by Atty. Bienvenido A. Marquez III;
4. Certification issued by the Bureau of Trademarks;
5. Tupperware's 2010 and 2009 Sustainability Report;

6. part I of the Annual Report (Form 10k-A) filed by Tupperware with the U.S. Securities and Exchange Commission;
7. copies of newspaper and magazine articles regarding Tupperware brand endorsers;
8. copy of internet blog on the launch of signature fragrances of Maja Salvador and other celebrities;
9. copies of photographs/publicity stills featuring Maja Salvador and other celebrities;
10. copies of screenshots of Tupperware Philippines' website featuring various Tupperware fragrances endorsed by Maja Salvador;
11. copies of Paper No. 3, Tupperware's response to Paper No. 3 and the Notice of Allowance;
12. screenshots taken from www.tienda.com; www.majasoap.com; www.amazon.com;
13. screenshot taken from yahoo! search engine; and,
14. screenshot taken from www.google.com.

The Preliminary Conference was held and terminated on 23 September 2014. The Opposer and the Respondent-Applicant submitted their position papers on 14 and 20 October 2014, respectively.

Should the Respondent-Applicant be allowed to register the trademark COUTURE BY MAJA?

Respondent-Applicant disputed the legal capacity of the Opposer in instituting this instant opposition case. It likewise raised the issue on ownership of the registered mark MAJA, and the validity or invalidity of the assignment of trademarks. Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

"Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2, file with the Office an opposition to application. x x x<sup>4</sup>"

The law makes no qualification as to who has the capacity to institute an opposition to the application of a trademark. Any person, natural or juridical, whether he has previous rights and/or has reasons to believe that he would be damage by the registration of a pending trademark application may file an opposition case. Such opposition must however, comply with the requirements set forth by the law.<sup>5</sup>

As regards Respondent-Applicant's contention on the invalidity and unenforceability of Opposer's trademark MAJA, the Philippine Trademark Database shows that Registration No. 42003007483 for MAJA has been removed from registry for failure to file the Declaration of Actual Use (DAU). Registration No. 021050 for another MAJA trademark remains registered under herein Opposer. Thus, on this latter registration, the Opposer continues to enjoy the benefit of a holder of a Certificate of Registration, which 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.<sup>6</sup>

Turning now to the main issue of this instant case, culled from the records and evidence, the Opposer's valid and existing registration for the mark "MAJA"<sup>7</sup> dated 27 December 1973<sup>8</sup> covers class 03 for soap of all kinds, including toilet, laundry, detergents and soap. On the other hand, Respondent-Applicant filed its application for the subject trademark "COUTURE BY MAJA" only on 06 February 2012.

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<sup>4</sup> Sec. 134, IP Code.

<sup>5</sup> Id.

<sup>6</sup> Sec. 138, IP Code.

<sup>7</sup> Registration No. 021050.

<sup>8</sup> Exhibit "E-1" of Opposer.

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But are the competing marks, as shown below, confusingly similar?

Opposer's Trademark

COUTURE BY MAJA

Respondent-Applicant's Trademark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.<sup>9</sup> Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The eyes can easily see that the marks are different. The similarity between the marks manifests in the word MAJA which is contained in the aforesaid marks. Such resemblance, however, is not sufficient to conclude that confusion is likely to occur. The appearance of the respective marks, particularly the stylized font used in Opposer's MAJA mark, and the Respondent-Applicant's mark which consists of the additional words "COUTURE" and "BY" in block face and simple font, creates a distinguishable visual and aural presentation of the marks.

While it appears that the goods covered by the marks belong to the same classification, a consumer could easily discern that the goods are not related because they are catered to different purchasers and are displayed in separate shelves in the grocery and department stores. It also appears that despite the use of the identical word MAJA, the commercial impressions are characteristically independent. Opposer's MAJA are various kinds of soaps in distinct packaging of black and red, typical of a classic Spanish nature<sup>10</sup>; while Respondent-Applicant's MAJA refers to its celebrity endorser, Maja Salvador, whose image also appears in various advertisements, promotional items and publications.<sup>11</sup> Moreover, Respondent-Applicant has shown other celebrity endorsers, in addition to MAJA SALVADOR, who are also product endorsers of body lotion, body mist and other personal hygiene products, and whose first names also appear in their respective product endorsements.<sup>12</sup>

Corollarily, the enunciation of the Supreme Court in the case of *Mighty Corporation vs. E. & J. Gallo Winery*<sup>13</sup> aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the

<sup>9</sup> *Etepha A.G. vs. Director of Patents*, G.R. No. L-20635, 31 March 1966.

<sup>10</sup> Annexes to Opposer's evidence consisting of photographs of Opposer's MAJA products.

<sup>11</sup> Exhibits "8-series" to "11-series" of Respondent-Applicant.

<sup>12</sup> *Id.*

<sup>13</sup> G.R. No. 154342, 14 July 2004.

source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. he is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

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.<sup>14</sup> This Bureau finds that the Respondent-Applicant's mark meets this function.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-001424be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City. 18 OCT 2016

**Atty. GINALYN S. BADIOLA, LL.M.**  
*Adjudication Officer, Bureau of Legal Affairs*

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<sup>14</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.