

**MCDONALD'S CORPORATION,**  
*Opposer,*

**-versus-**

**FUTURE ENTERPRISES PTE LTD.,**  
*Respondent-Applicant.*

X-----X

} **IPC No. 14-2013-00439**  
} Opposition to:

} Appln. Serial No. 4-2013-500049  
} Date Filed: 07 January 2013

} **TM: MACCHOCOLATE**

**NOTICE OF DECISION**

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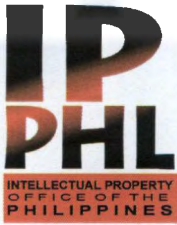
**GREETINGS:**

Please be informed that Decision No. 2016 - 501 dated 23 December 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 03 January 2017.

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



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- versus -

**FUTURE ENTERPRISES PTE LTD,**  
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**IPC NO. 14-2013-00439**

Opposition to:

Application No. 4-2013-500049

Date Filed : 07 January 2013

Trademark: "**MACCHOCOLATE**"

Decision No. 2016 - 501

**DECISION**

MCDONALD'S CORPORATION ("Opposer")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2013-500049. The application filed by FUTURE ENTERPRISES PTE LTD ("Respondent-Applicant")<sup>2</sup>, covers the mark "MACCHOCOLATE" for use on "*instant chocolate drink, cocoa*" under Class 30 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges that it is the owner of a family of internationally known marks incorporating "Mc" and "Mac" as prefix or suffix (hereinafter referred to as "family of marks"). It has developed a reputation and identity through its products, services, marketing, and presence in the market such that the public has identified as coming from and belonging exclusively to the Opposer the goods or services that bear the trademarks consisting of the "Mc" or "Mac" prefix/suffix and generic name combination. As the owner of the "Mc" mark and other marks with the prefix "Mc", it has practiced a method of combining "Mc" or "Mac" with a common word descriptive of or the generic name of the goods or services Opposer is offering or has designated in its trademark applications or registrations. Some of these marks use stylized letters or incorporate a device or design.

To illustrate, the Opposer avers that in the Philippines and in various countries around the world, "McDonald's" has registered, used and promoted its internationally well-known family of marks, including but not limited to "HAPPY MEAL", "Big MAC", "Mc Donald's", "McDo", "Mac Fries", "Chicken McNuggets", "Egg McMuffin", "Mc Savers", "McFlurry", "McCafe", "McDip", "McMuffin", "McChicken", "Burger McDo", and "McSpaghetti", for various foods, beverages, and restaurant services under Classes 28-30, 32, 42 and 43. The aforementioned family of marks clearly show the method of combining "Mc" or "Mac" with a descriptive word or generic name of the goods or services upon which the mark is used. For example, "Mac Fries" is used for the Opposer's French fries, "McChicken" for chicken, "Burger McDo" for burgers, "McSpaghetti" for spaghetti.

<sup>1</sup> A corporation organized and existing under the laws of Delaware, U.S.A., with office address at One McDonald's Plaza, Oak Brook, Illinois, U.S.A.  
<sup>2</sup> A company with address at 31 Harrison Road, 08-01 Singapore.  
<sup>3</sup> 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.

Thus, being the registered owner and exclusive proprietor of the family of marks, under Section 147 of the Intellectual Property Code ("IP Code"), the Opposer has the exclusive right to register and use its family of marks and to prevent others, such as the Respondent-Applicant in this case, from using and/or registering an identical or confusingly similar mark for the same or related goods or services and, in the case of internationally known marks registered in the Philippines, for goods and services which are not similar to those in respect of which the marks are registered. As the rightful owner and prior user of the aforementioned marks and their variants, Opposer should be given protection against entities that merely wish to take advantage of the goodwill its marks have generated.

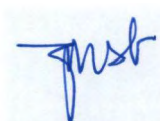
In this case, the Opposer respectfully submits that the "MacChocolate" trademark application of the Respondent-Applicant cannot be granted or registered under Section 123 (d) (e) and (f) of the IP Code because it is confusingly similar to Opposer's family of marks and will likely to lead to confusion of goods and business to the damage and detriment of the Opposer. Like the Opposer's family of marks, the subject "MacChocolate" trademark consists of the prefix "MAC" followed by the descriptive word or generic name of the designated goods, i.e. chocolate. That the subject trademark includes a label, design or device is of little consequence because the dominant feature of the mark is the mark "MacChocolate", and the public will easily remember and identify the said dominant feature, instead of the label, device or design. Considering that some of Opposer's marks also include stylized letters, devices or design, the subject mark is similar to Opposer's marks in that it also includes a design.

The Opposer's evidence consists of the following:

1. Duplicate original of the "MC/MAC Prefix Worldwide" Report with details of the existing trademark registrations of the Opposer in the United States of America and other parts of the world, such as but not limited to trademarks that use the Mc or Mack trademark as a prefix or suffix and one that includes "MCCHOCOLATE";
2. Copy of Certificate of Registration of the mark "CRISPY MCCHOCOLATE" dated 21 March 2001 under Class No. 30 in Benelux (Belgium, Netherlands, Luxembourg);
3. Copy of Certificate of Registration of the mark "SAUSAGE MCMUFFIN" dated 01 September 1987 under Class Nos. 30 and 24 in United States of America with Registration No. 1455616;
4. Copy of Certificate of Registration of the mark "MCHOT DOG (STYLIZED)" dated 7 August 2009 under Class No. 30 in Japan with Registration No. 5254497;
5. Copy of Certificate of Registration of the mark "MCDOG" dated 2 May 2007 under Class No. 30 in Brazil with Registration No. 824913078;
6. Copy of Certificate of Registration of the mark "MAC" dated 24 November 1981 under International Class Nos. 29 and 30 in France with Registration No. 1705318;
7. Copy of Certificate of Registration of the mark "MAC" dated 7 June 1988 under Class Nos. 29, 30 and 33 in Venezuela with Registration No. 134 770;
8. Copy of Certificate of Registration of the mark "MAC" (IN ENGLISH AND KATAKANA) dated 28 November 1989 under Class Nos. 29 and 30 in Japan with Registration No. 2188713;
9. Copy of Certificate of Registration of the mark "MCMUFFIN" dated 7 October 1985 under Class Nos. 29 and 30 in Republic of Korea with Registration No. 0118094;
10. Copy of Certificate of Registration of the mark "MCBACON (STYLIZED)" dated 4 February 1994 under Class Nos. 29 and 30 in Sweden with Registration No. 255044;



11. Copy of Certificate of Registration of the mark "MCBAGEL (STYLIZED)" dated 16 May 2003 under Class No.30 in Japan with Registration No. 5254497;
12. Copy of Certificate of Registration of the mark "MCBARBEQUE" dated 2 November 1984 under Class Nos. 29 and 30 in Canada with Registration No. TMA296686;
13. Copy of Certificate of Registration of the mark "MCBURGER (STYLIZED)" dated 20 January 1992 under Class Nos. 29, 30 and 31 in Venezuela with Registration No. 145401;
14. Copy of Certificate of Registration of the mark "MACBURGER (STYLIZED)" dated 27 August 1992 under Class Nos. 29 and 30 in Monaco with Registration No. R9214402;
15. Copy of Certificate of Registration of the mark "MCCHICKEN (STYLIZED)" dated 26 November 1990 under Class Nos. 29 and 30 in Greece with Registration No. 101754;
16. Copy of Certificate of Registration of the mark "MCCROISSANT (STYLIZED)" dated 6 December 2010 under Class Nos. 29, 30 and 43 in the European Community with Registration No. 009194382;
17. Copy of Certificate of Registration of the mark "MCDONUT" dated 29 March 2005 under Class Nos. 29 and 30 in the Czech Republic with Registration No. 270943;
18. Copy of Certificate of Registration of the mark "MCFISH" dated 20 July 2007 under Class Nos. 29 and 30 in the European Community with Registration No. 005056429;
19. Copy of Certificate of Registration of the mark "MAC FISH" dated 04 September 1997 under Class No. 30 in Israel with Registration No. 101667;
20. Copy of Certificate of Registration of the mark "MAC FRIES" dated 20 July 1984 under Class Nos. 29 and 30 in Turkey with Registration No. 82449;
21. Copy of Certificate of Registration of the mark "MCNUGGETS" dated 31 January 1992 under Class Nos. 29, 30, 31 and 42 in Canada with Registration No. TMA393609;
22. Copy of Certificate of Registration of the mark "MCPIZZA" dated 17 December 1985 under Class Nos. 29, 30 and 31 in Benelux with Registration No. 414855;
23. Copy of Certificate of Registration of the mark "MCSALAD" dated 23 December 1988 under Class Nos. 29 and 30 in Canada with Registration No. TMA349411;
24. Copy of Certificate of Registration of the mark "MCSANDWICH (STYLIZED)" dated 10 May 2000 under Class Nos. 29 and 30 in Germany with Registration No. 30023777;
25. Copy of Certificate of Registration of the mark "MCSUNDAE" dated 30 July 1998 under Class Nos. 29 and 30 in Benelux with Registration No. 0634743;
26. Copy of Certificate of Registration of the mark "MCTOAST" dated 20 April 2007 under Class Nos. 29, 30 and 43 in European Community with Registration No. 004699054;
27. Certified true copy (Ctc) of Trademark Registrations issued by the IPOPhil for the following marks: "BIG MAC" for Class No. 30; "McDonald's" for Class Nos. 29, 32, 30; "McDo" for Class No. 42; "Mac Fries" for Class No. 29; "Chicken McNuggets for Class No. 29; "Egg McMuffin" for Class No. 29; "McSaver's" for Class No. 42; "McFlurry" for Class No. 29; "McCafe" for Class No. 42; "McDip" for Class Nos. 29 and 30; "McMuffin" for Class No. 30; "McChicken" for Class No. 29; "Burger McDo" for Class No. 30; "McSpaghetti" for Class No. 30;



28. Copy of sample of advertisements used in various countries in the promotion of products bearing the McDonald's family of marks incorporating "Mc" or "Mac" as prefix or suffix followed by a word descriptive of the products;
29. Copy of the sample of TV prints, articles, webpages used in the promotion of products bearing the McDonald's family of incorporating "Mc" or "Mac" as prefix/suffix followed by a word descriptive of the products;
30. Copy of the sample of merchandise or packaging marketed in relation to products bearing the McDonald's family of marks incorporating "Mc" or "Mac" as prefix/suffix followed by a word descriptive of the products;
31. Copy of sample decisions favorable to McDonalds declaring that its "MC" and "MAC" trademark, as well as its other trademarks which use "Mc" and the "Mac" as a prefix/suffix, are well-known marks;
32. Copy of sample decisions favorable to McDonald's issued by IPOPhil denying various trademark applications for being identical or confusingly similar to the marks of McDonalds; and,
33. Original of the duly executed, notarized and authenticated Affidavit of Shiela Lehr, Opposer's Managing Counsel.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 13 January 2014. Respondent-Applicant failed to file its Answer in accordance to the Amended Rules and Regulations on Inter Partes Proceedings.<sup>4</sup> Thus, it is declared in default<sup>5</sup> and this instant case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark MacChocolate?

The records reveal that at the time Respondent-Applicant filed for an application for registration of its mark "MacChocolate" on 07 January 2013, the Opposer has valid and existing registrations of marks bearing the prefixes "Mc" or "MAC" in various countries including the Philippines. In fact, it was issued as early as 1985 in the Intellectual Property Office of the Philippines, registration for the mark "BIG MAC"<sup>6</sup>.

The Supreme Court in the case of McDonald's Corporation vs. MacJoy Fast Food Corporation<sup>7</sup> has noted and upheld as characteristic the Opposer's trend of adopting marks that appropriate either its "M" logo or the prefixes "Mc" or "MAC", to wit:

"To begin with, both marks use the corporate 'M' design logo and the prefixes "Mc" and/or "Mac" as dominant features. The first letter 'M' in both marks puts emphasis on the prefixes 'Mc" and/or 'Mac' by the similar way in which they are depicted i.e. in an arch-like, capitalized and stylized manner.

For sure, it is the prefix 'Mc,' an abbreviation of 'Mac,' which visually and aurally catches the attention of the consuming public. Verily, the word 'MACJOY' attracts attention the same way as did 'McDonalds,' 'MacFries,' 'McSpaghetti,' 'McDo,' 'Big Mac' and the rest of the MCDONALD'S marks which all use the prefixes Mc and/or Mac.

<sup>4</sup> Rule 2, Secs. 9 (d) and 10, Office Order No. 99 s. 2011.

<sup>5</sup> Order Dated 31 July 2015.

<sup>6</sup> Exhibit "B" of Opposer.

<sup>7</sup> G.R. No. 116115, 02 February 2007.

Besides and most importantly, both trademarks are used in the sale of fastfood products. Indisputably, the respondent's trademark application for the 'MACJOY & DEVICE' trademark covers goods under Classes 29 and 30 of the International Classification of Goods, namely, fried chicken, chicken barbeque, burgers, fries, spaghetti, etc. Likewise, the petitioner's trademark registration for the MCDONALD'S marks in the Philippines covers goods which are similar if not identical to those covered by the respondent's application.

Thus, we concur with the IPO's findings that:

In the case at bar, the predominant features such as the 'M,' 'Mc,' and 'Mac' appearing in both McDonald's marks and the 'MACJOY & DEVICE' easily attract the attention of would-be customers. Even non-regular customers of their fastfood restaurants would readily notice the predominance of the 'M' design, 'Mc/Mac' prefixes shown in both marks. Such that the common awareness or perception of customers that the trademarks McDonalds mark and MACJOY & DEVICE are one and the same, or an affiliate, or under the sponsorship of the other is not far-fetched.

The differences and variations in styles as the device depicting a head of chicken with cap and bowtie and wings sprouting on both sides of the chicken head, the heart-shaped 'M,' and the stylistic letters in 'MACJOY & DEVICE;' in contrast to the arch-like 'M' and the one-styled gothic letters in McDonald's marks are of no moment. These minuscule variations are overshadowed by the appearance of the predominant features mentioned hereinabove.

Thus, with the predominance of the letter 'M,' and prefixes 'Mac/Mc' found in both marks, the inevitable conclusion is there is confusing similarity between the trademarks Mc Donald's marks and 'MACJOY AND DEVICE' especially considering the fact that both marks are being used on almost the same products falling under Classes 29 and 30 of the International Classification of Goods i.e. Food and ingredients of food." (Emphasis supplied.)"

Perusing Respondent-Applicant's mark below,



inevitably leads this Bureau to the same conclusion reached by the Supreme Court in the above-quoted case. Despite the absence of ornaments surrounding the applied mark, the word "MacChocolate" alone will attract the attention of a purchaser considering the three letters M, A and C or MAC/Mac which is a well-known mark of the Opposer. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.<sup>8</sup> In this case, the words "MacChocolate" as Respondent-Applicant's mark are clearly consonant with Opposer's family of marks in which "Mc" or "Mac" is attached to a generic or descriptive word pertaining to the particular

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<sup>8</sup> Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.



segment of its food and restaurant business which the mark will be used. Aptly, the Supreme Court in *American Wire & Cable Company vs. Director of Patents*<sup>9</sup> ruled that:

“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 appellee had to choose those so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark.”

Succinctly, since the Respondent-Applicant will use or uses the mark “MacChocolate” on Class 30, which is also covered by the Opposer’s registration, it is highly probable that the purchasers will be led to believe that Respondent-Applicant’s mark is sponsored by, affiliated with or in any way connected with the Opposer. Noteworthy, in a much earlier *McDonald’s* case<sup>10</sup>, the Supreme Court pronounced that the registered trademark owner may use his mark on the same or similar products, in different segments of the market, and at different price levels depending on variations of the products for specific segments of the market. 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.

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser’s perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the *confusion of goods* “in which event the ordinarily 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist.”<sup>11</sup>

Furthermore, 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>12</sup> Based on the above discussion, Respondent-Applicant’s trademark fell short in meeting this function. The latter was given ample opportunity to defend its trademark application but Respondent-Applicant failed to do so.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor with an earlier filing or priority date, with respect to the same or closely related goods or services, or has a near resemblance to such mark as to likely deceive or cause confusion.<sup>13</sup>

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<sup>9</sup> G.R. No. L-26557, 18 February 1970.

<sup>10</sup> *McDonald’s Corporation vs. L.C. Big Mak Burger, Inc.*, G.R. No. 143993, 18 August 2004.

<sup>11</sup> *Societe des Produits Nestle, S.A. vs. Dy*, G.R. No. 172276, 08 August 2010.


<sup>12</sup> *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 November 1999.

<sup>13</sup> *Great White Shark Enterprises, Inc. vs. Danilo M. Caralde*, G.R. No. 192294, 21 November 2012.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-500049 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. **23 DEC 2016**



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