



SOCIETE DES PRODUITS NESTLE S.A.,
Opposer,

-versus-

IN-GENUITY CORPORATION,
Respondent- Applicant.

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IPC No. 14-2013-00348
Opposition to:
Appln. Serial No. 4-2013-000826
Date Filed: 25 January 2013
TM: "MAJI"

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NOTICE OF DECISION

BENGZON NEGRE UNTALAN

Counsel for the Opposer
2nd Floor, SEDCCO Building
Rada St., Legaspi Village
Makati City

JOSEPHINE G. TAN

Agent of Respondent-Applicant
No. 160 Macabagdal Street
Caloocan City

GREETINGS:

Please be informed that Decision No. 2017 - 26 dated February 01, 2017 (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, February 01, 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph

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IPC No. 14-2013-00348
Opposition to:

Appln. No. 4-2013-000826
Date Filed: 25 January 2013
Trademark: "MAJI"

Decision 2017-26

DECISION

SOCIETE DES PRODUITS NESTLE S.A. or SPN for brevity ("Opposer"),¹ filed a verified opposition to Trademark Application Serial No. 4-2013-000826. The application, filed by IN-GENUITY CORPORATION ("Respondent-Applicant")², covers the mark "MAJI" for use on goods namely: *"meat, fish, poultry and game, meat extracts, preserved, frozen, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils, and fats; and, "coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices, ice"*, under classes 29 and 30 respectively, of the International Classification of Goods.³

The Opposer alleges that its trademark MAGGI comes from the name of its creator, Julius Maggi, a Swiss inventor of the first products to bear the brand. In 1863, he created a recipe to bring added taste to meals. The Swiss government asked him to create a product that is quick to prepare. In 1884, Maggi and Cie, a company by Julius Maggi, adopted, used and registered the trademark MAGGI for its food inventions. In 1947, Opposer SPN acquired the MAGGI brand when it merged with Maggie and Cie. Since then, Opposer has been manufacturing, selling, marketing, licensing and creating a myriad of products bearing MAGGI and MAGGI related marks worldwide. After which, Opposer introduced MAGGI products such as soups and bean soups, liquid seasoning, and bouillon cubes. The range of MAGGI products are continuously expanding and evolving. In the Philippines, MAGGI products were introduced in the 1930s. This includes MAGGI Liquid Seasoning and bouillon cubes. In fact, its predecessor in the Philippines applied for the Philippine trademark registration of MAGGI and was granted on 28 November 1936. Soon, the Philippine MAGGI product line expanded and are widely available supermarkets, convenience stores, market stalls and the ubiquitous sari-sari stores.

The Opposer enumerates the following grounds for opposition:

"A. Opposer SPN is the first to adopt, use and register 'MAGGI' and 'MAGGI'-related marks in the Philippines.

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- ¹ A corporation organized and existing under the laws of Switzerland, with office address at CH-1800 Vevey, Switzerland.
² A corporation organized under the laws of the Republic of the Philippines, with principal place of business at Block 26, Lot 3, Katipunan Avenue, Barangay Bagbag, Quezon City, Philippines.
³ 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.

- "B. Opposer SPN's 'MAGGI' and 'MAGGI'-related marks are well-known in the world and must be protected. Thus, the registration of the "MAJI" mark must be denied.
- "C. Opposer SPN's 'MAGGI' and 'MAGGI'-related marks are inherently distinctive and must be protected. Thus, the registration of the "MAJI" mark must be denied.
- "D. The mark 'MAJI' must be denied registration because it is aurally and phonetically identical to Opposer SPN's 'MAGGI' and 'MAGGI'-related marks.
- "E. The mark 'MAJI' must be denied registration because it so closely resembles Opposer SPN's registered 'MAGGI' and 'MAGGI'-related marks that likelihood of confusion exists between the competing marks for identical goods.
- "F. Assuming without conceding that the 'MAJI' mark is considered by this Honorable Office as not exactly the same as Opposer SPN's 'MAGGI' and 'MAGGI'-related marks, it should still be denied registration as the likelihood of confusion between them is very high.
- "G. The mark 'MAJI' must be denied registration as it colorably imitates Opposer SPN's 'MAGGI' and 'MAGGI'-related marks because of aural and phonetic similarity."

The Opposer's evidence consists of the following:

1. Certificate of Authentication executed by Lilibeth V. Pono, Consul;
2. Special Power of Attorney executed by Opposer SPN;
3. Authentication executed by Elizabeth Te, Consul;
4. General Power of Attorney executed by Opposer SPN;
5. Certification by the Bureau of Legal Affairs re: Trademark Application No. 4-2013-000826;
6. Copy of Certificate of Incorporation of In-Genuity Corporation including Articles of Incorporation, General Information Sheet for the year 2013;
7. Philippine Registration No. 000343 for the mark MAGGI for goods under class 30;
8. Philippine Registration No. 4-2008-2402 for the mark MAGGI for goods under classes 29 and 30;
9. Philippine Registration No. 4-2001-2332 for the mark MAGGI CUP SARAP for goods under class 30;
10. Philippine Registration No. 4-1995-105795 for the mark MAGGI NOODLE EXPRESS for goods under class 30;
11. Philippine Registration No. 4-1995-1921 for the mark MAGGI (YELLOW) with BUBBLE DEV. (RED) for goods under classes 29 and 30;
12. Philippine Registration No. 4-2004-007824 for the mark MAGIC SARAP for goods under class 30;
13. Philippine Registration No. 4-2009-500291 for the mark MAGIC SINIGANG for goods under class 30;
14. Philippine Application No. 4-2010-500116 for the mark MAGIC RICE for goods under class 30;
15. Philippine Application No. 4-2011-500184 for the mark MAGIC SABAW for goods under classes 29 and 30;
16. Philippine Application No. 4-2012-501990 for the mark MAGIC MEALS for goods under classes 29 and 30;
17. Philippine Application No. 4-2012-501991 for the mark MAGIC MEALS SL IN 'RICE COOKER' DV (COL) for goods under classes 29 and 30;
18. Notarized Affidavit dated 11 October 2013 executed by Jean G. Villapando, Maggi Consumer Marketing Manager of Nestle Philippines, Inc.

19. History of MAGGI (source: Nestle official website);
20. Opposer SPN's latest MAGGI mark Protection List;
21. Copies of international trademark registrations of MAGGI and MAGGI related marks in Australia, Brazil, United States of America and the Office for Harmonization in the Internal Market (OHIM) of the European Union;
22. Copies of actual trade dress and/or product packaging and/or labels used for products bearing MAGGI and MAGGI related marks available in the Philippines;
23. Print-out of images of internationally available MAGGI products;
24. Copy of Opposer's 2013 Half-Yearly Report;
25. Copy of Opposer's 2012, 2011, 2010 Annual Financial Statement;
26. Print-outs of sample print advertisements and promotional materials of the mark MAGGI;
27. Compact disc of advertisement, magazine articles, commercials, etc. of the mark MAGGI; and,
28. Copy of Opposer's 2012 Annual Report.

This Bureau issued a Notice to Answer and served a copy to Respondent-Applicant on 27 November 2013. For failure of Respondent-Applicant to file an Answer, it is declared in default.⁴ Hence, this case is submitted for decision.

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

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 out into the market a superior 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

Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code ("IP Code") provides:

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 Respondent-Applicant filed its application for the trademark MAJI on 25 January 2013⁶, herein Opposer already has applied and registered its trademark MAGGI and variances in several countries, including the Philippines⁷, Australia⁸, Brazil⁹, the United States of

⁴ Order No. 2014-510 dated 22 April 2014.

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

⁶ Filewrapper records.

⁷ Exhibits "F" and series, "G" and series, "J" and series of Opposer.

⁸ Exhibits "S" to "S-6" of Opposer.

⁹ Exhibits "T" to "T-7" of Opposer.

America¹⁰, and the Office for Harmonization in the Internal Market (OHIM) of the European Union¹¹. The mentioned applications and registrations of Opposer's marks were all dated prior to Respondent-Applicant's filing date. In the Philippines, a certificate of registration constitutes a 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.¹²

The competing marks are reproduced below for comparison and scrutiny:

MAGGI



Opposer's Trademarks



Respondent-Applicant's Trademark

It appears that the competing marks have striking aural and phonetic similarities. Opposer's MAGGI may be pronounced with a hard "g" or a soft "g" sound, which is similar to the "j" sound of MAJI. While it also appears that the subject mark bears some dissimilarities in font and color, it can be observed as a way of hiding the intent to copy Opposer's trademarks.

The device adopted by Respondent-Applicant appears as a derivative of Opposer's word mark MAGGI. The allowance of Respondent-Applicant's application in this instance, will likely cause confusion to the consuming public, taking into consideration the wide market where Opposer's products are being sold. Moreover, considering the similarity or relatedness of goods carried by the contending marks, the consumers will have the impression that these products, particularly goods falling under classes 29 and 30, originate from a single source or origin or they are associated with one another. Thus, the likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:¹³

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

¹⁰ Exhibits "U" to "U-3" of Opposer.

¹¹ Exhibits "V" and series; and "W" and series of Opposer.

¹² Sec. 138, IP Code.

¹³ Id.

A handwritten signature in blue ink, appearing to be "J. S. B.", is located in the bottom right corner of the page.

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. Hence, 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.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. 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 purchaser as to cause him to purchase the one supposing it to be the other.¹⁴ Colourable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colourable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark with that of the other mark or trade name in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.¹⁵

In this instance, the Opposer's prior use and registration of its trademark MAGGI and variances demonstrate ownership thereof. It has verily shown evidence of its history¹⁶, continuous presence and use in Philippine and international markets¹⁷, and enormous advertisements and publicities in different forms¹⁸.

As such, considering the probable purchaser's attitude and habits, marketing activities, and commercial impression, there is a high likelihood that the trademarks of the Opposer and the Respondent-Applicant pertain to related fields of manufacture, distribution and marketing under similar conditions. Both are likely to be conveyed and move in the same channels of trade. Thus, the goods of the Opposer and the Respondent-Applicant are of a character which purchasers would be likely to attribute to a common origin.

In contrast, the Respondent-Applicant despite the opportunity given, failed to explain how it arrived at using the mark MAJI. The Opposer's mark MAGGI and variances are unique and highly distinctive with respect to the goods or service it is attached with. It is incredible for the Respondent-Applicant to have come up with the same mark by pure coincidence.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-000826 is hereby **SUSTAINED**. Let the file wrapper 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. 07 FEB 2017



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

¹⁴ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 200, 356 SCRA 207, 217.
¹⁵ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.
¹⁶ Exhibits "Q" and series of Opposer.
¹⁷ Exhibits "R" to "R-47", "X" and series, and "Y" and series, "Z", "AA" to "CC", "FF" to "HH" of Opposer.
¹⁸ Exhibits "DD" and series, "EE" of Opposer.