

McDONALD'S CORPORATION,
Opposer,

INTER PARTES CASE NO. 3764
Opposition to:

- versus-

Serial No: 70674
Date Filed: 26 January 1990
Trademark: "MICKY D's"

GOLDEN DRAGON FOODS
SERVICE CO.,

X-----X

DECISION NO. 97-11

DECISION

This pertains to a Verified Notice of Opposition to the registration of the mark "MICKY D's" for restaurant and catering services with Serial No. 70674 filed on January 26, 1990 and which application was published for Opposition on page 29, Vol. IV, No. 6 of the Bureau of Patents, Trademarks and Technology Transfer Official Gazette and officially released for circulation on December 31, 1991.

McDonald's Corporation, the herein Opposer is a Corporation duly organized and existing under the laws of the State of Delaware, United States of America, with offices at McDonald's Plaza, Oak Brook, Illinois, 60521, U.S.A.

Respondent-Applicant on the other hand is GOLDEN DRAGON FOODS SERVICES COMPANY, a company duly organized and existing under the laws of the Philippines and with office address at No. 227 Wilson Street, Greenhills, San Juan, Metro Manila.

On April 15, 1991, the herein Opposer commenced this Opposition proceedings claiming that it is the original and lawful owner of the mark "MICKEY D's" and believing that it would be damaged by the registration of the mark 'MICKY D's' in the name of the herein Respondent-Applicant.

Opposer McDonald's and McGeorge rely on the following facts to support its Opposition:

1. McDonald's is the owner and rightful proprietor of the internationally known McDonald's Trade Name, Trademark and Service Marks, including the mark "MICKEY D'S" which are used in connection with Opposer McDonald's restaurant services and food products. The McDonald's Marks, especially the mark "MICKEY D'S", are also used on posters, advertisements and promotional goods such as t-shirts, caps, toys games and the like.
2. Being the owner and the rightful proprietor of the mark "MICKEY D'S" McDonalds effected the registration of the mark "MICKEY D'S" in the United States of America and in many countries. In the United States, the mark "MICKEYS D'S" has been registered as a service mark with the Principal Register of the United States Patent and Trademark Office since 28 August 1984 under Registration No. 1, 292,557. The mark "MICKEYS D'S" which has been described to be a "fanciful name and is not the name of any living individual", has been in use in the United States since 15 November 1981. Opposer's respectfully submit herewith (2) specimens of the mark "MICKEYS D'S" registered in the name of McDonald's.
3. In the Philippines, the United States home registration has been made the basis of the application for registration of the mark "MICKEY D'S" in Class 42 under Application Serial No. 72650 filed on July 19, 1990 in the name of McDonald's. Since the application is based on home registration, the date of first use is reckoned

from the date of its first use as appearing in the Certificate of Home Registration, which is 15 November 1981.

4. By reason of the prior and continuous use of the mark "MICKEY D'S" by McDonald's long before the alleged first use by Respondent-Applicant of the mark "MICKY D'S", the mark "MICKEY D'S" has acquired a meaning exclusively identified with the Opposer's goods such as to solely indicate that goods bearing the internationally known mark "MICKEY D'S" are quality McDonald's products. In the United States, the name 'MICKEY D'S' is closely associated with, and has in fact, been popularly coined as a slang word for McDonald's restaurants. This became the very basis for the need to register the mark in the name of McDonald's.
5. To promote Opposer's goods and services in the Philippines and to ensure the quality thereof, Opposers have embarked on the extensive campaign through all forms of media.
6. On 26 January 1990, Respondent-Applicant intentionally adopted, and fraudulently applied for registration of the mark "MICKEY D'S" for restaurant and catering services, undoubtedly to take advantage of the popularity and goodwill connected with the mark "MICKEY D'S". There are limitless names and devices available to Respondent-Applicant, yet it has ventured to adopt the mark "MICKY D'S" which is a near perfect exact reproduction of Opposer's mark "MICKEY D'S", indubitably to confuse, mislead or deceive purchasers into believing that the goods of Respondent-Applicant are those of Opposers or sponsored by the Opposers.
7. The use and adoption in bad faith by Respondent-Applicant of the mark "MICKY D'S" would falsely tend to suggest a connection or affiliation with Opposer's and, therefore, would constitute a fraud on the general public, and further cause the dilution of the distinctiveness of the registered and internationally recognized McDonald's Marks, in particular the mark "MICKEY D'S" to the prejudice and irreparable damage on the part of the Opposers.
8. The use and adoption Respondent-Applicant of the mark "MICKY D'S", which is a near perfect reproduction of the McDonald's mark "MICKEY D'S" constitute an unlawful appropriation of marks previously used in the Philippines and not abandoned. Accordingly, Application Serial No. 70674 filed by Respondent-Applicant of the mark "MICKY D'S" as a trademark is in violation of Section 4(d) of Republic Act No. 166, as amended.
9. Consequently, Respondent-Applicant the application of Respondent-Applicant must be rejected pursuant to the Paris Convention for the Protection of Industrial Property and in consonance with the Memorandum dated 20 November 1980, issued by the then office of the Minister of Trade directing the latter "to reject all pending applications for the Philippine registration of signature and other world famous trademarks by applicants other than its original owners and user's" (La Chemise Lacoste, S.A vs. Fernandez, 129 SCRA 373, 390)

The issue to be resolved in this particular case is WHO between the two parties is the PRIOR ADOPTER and USER of the trademark "MICKEY D'S" and deserves protection Under our Trademark Law.

The trademark "MICKEY D'S" has been registered by the herein Opposer in its home country, the United States of America bearing Registration No, 1, 292, 557 dated August 25, 1984 for restaurant services in Class 42 of the International Classification of goods marked as Exhibit "A". As stated in the said Certificate of Registration, McDonald's Corporation first use of MICKEY D'S is November 15, 1981.

Further, Opposer has likewise filed said trademark "MICKEY D'S" in other foreign countries for its registration, namely:

Japan	Application No. 321666 Application No. 321667 Application No. 321668 Application No. 321669 Application No. 321670
Bermuda	Exhibit "K"
Philippines	Application bearing Serial No. 72650 dated July 17, 1990

The trademark "MICKEY D'S" has been advertised and being used on various promotional items by the herein Opposer in and outside United States of America (Exhibits "C" to "C-1" up to "C-8").

From the evidence presented, Opposer has shown that it possesses the exclusive title and interest to the trademark "MICKEY D'S" and has used the same in its home country and some other foreign countries of the world.

It must be noted that Opposer filed the registration of the mark "MICKEYS D'S" with the BPTTT under Section 37 of Republic Act No. 166, as amended based on its home registration which was issued on August 04, 1984 which claim of date of first use of November 15, 1981 (Exhibit "A"). On the other hand, Respondent-Applicant filed its own trademark application on January 26, 1990 with the BPTTT and claiming first use as November 15, 1989.

Comparing the date of issuance of the Certificate of Registration issued in the name of the herein Opposer, August 04, 1984 in the United States of America and the date of filing of the Respondent-Applicant January 26, 1990, and Opposer's claim of first use of November 15, 1981 as against Respondent's claim of first use November 15, 1989, there is no doubt that the herein Opposer is the PRIOR ADOPTER and USER of the trademark in controversy and is therefore the rightful owner thereof in accordance with Section 2-A of R.A. No. 166, as amended.

Therefore, the registration of the trademark "MICKY D's" in favor of Respondent-Applicant is contrary to Section 4(d) of R.A. No. 166, as amended, which provides:

"Section 4. Registration of trademark, tradenames and service marks on the principal register. There has been established a register of trademarks, tradenames and service marks which shall be known as the principal register. The owner of a trademarks, tradenames or service marks use to distinguish his goods, business or services from the goods, business or services from others shall have the right to register the same on the principal register, unless it:

xxx

(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers."

The rule is well settled that to constitute an infringement of a registered trademark, not abandoned, and to warrant a denial of an application for registration of a new mark, the new mark need not be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law that the similarity between the two marks is such that there is a mere

possibility or likelihood of confusion or mistake in the mind of the public or of deceiving purchasers (Co Tiong Sa vs. Director of Patents, 95 Phil. 1).

It is thus clear that Respondent-Applicant merely adopted its trademark from Opposer. One conclusion which should be emphasized is that Respondent-Applicant is merely riding on the reputation of Opposer's mark, for, in the unlimited field of choice, what could have been Respondent-Applicant's purpose in selecting "MICKEY D'S" if not for its fame.

"Why of the million of terms and combinations of letters and designs available, the appellee had to choose those closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark (American Wire and Cable Co. vs. Director of Patents, 31 SCRA 544 x x x)

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently application bearing Serial No. 70674 for the trademark "*MICKY D'S*" used on restaurant and catering service, filed by Golden Dragon Foods Services Company is hereby REJECTED.

Let the filewrapper subject matter of this case be forwarded to the Application Issuance and Publication Division for appropriate action in accordance with this Decision with a copy thereof to be furnished the Trademark Examining Division for information and to update its record.

SO ORDERED.

Makati City, November 27, 1997.

EMMA C. FRANCISCO
Director