

THE MENNE COMPANY	}	IPC NO. 3781
Opposer,	}	Opposition to:
	}	Application Serial No. 74271
	}	Date Filed: 12-05-90
-versus-	}	
	}	
LORNA YU TIU,	}	Trademark: "BABY MAGIC"
Respondent-Applicant.	}	Decision No. 2002-34
x-----x		

D E C I S I O N

This is an Opposition filed on June 26, 1992 for the registration of the mark "BABY MAGIC" filed on December 5, 1990 bearing Serial No. 74271 used on feeding bottles, pacifiers, teethers, nursing nipples, diaper pins, nursery bar set, rubber mats, piece mats, hangers, training cups, instruments for hair care, namely: combs, brushes, drinking cups and glasses, in classes 10, 17 and 21 which application was published on page 52, Vol. V, No. 1 of the Official Gazette issue for January-February 1992 and released for circulation on March 10, 1992.

The Opposer in the above-captioned case is "The Mennen Company organized and existing under the laws of the State of New Jersey of the United States of America, located and doing business at East Hanover Avenue, Morris Township, New Jersey, U.S.A..

The Respondent-Applicant on the other hand, is "LORNA YU TIU, a citizen of the Philippines, doing business under the style of BABY MAGIC GARMENT'S MFG. of 2244 Amatista St., San Andres, Manila.

The grounds for the opposition are as follows:

"1. The grant of registration of the aforesaid application for registration in the Principal Register of the mark "BABY MAGIC" in the name of Respondent-Applicant is a blatant violation of Section 4 (d) of Republic Act 166, as amended, because this mark is patently confusingly similar to the Opposer's registered trademark "BABY MAGIC" which is a world famous mark being continuously in use all over the world including in the Philippines up to the present, thus, the same has never been abandoned by the Opposer.

"2. The applicant has misrepresented in alleging first use of the mark on the goods and in the Philippines to be on February 1, 1986, thus, this subject application from its inception is tainted with fraud.

"3. The grant of registration of the mark "BABY MAGIC" in the name of the Respondent-Applicant will cause grave and irreparable injury and damages to the Opposer within the meaning of Section 8 of Republic Act 166, as amended.

Opposer relied on the following facts to support its opposition:

"1. The Opposer is the registered owner in the Philippines and worldwide, of the trademark "BABY MAGIC", having been issued by the Bureau of Patent, Trademarks & Technology Transfer (BPTTT) Trademark Certificate of Registration No. 31446 on December 17, 1982 for the goods "Body Powder and Body Lotion; Skin Cleansers" under Class 3. Photocopy of this Trademark Registration is made an integral part of this Opposition and is hereto attached as Annex "A".

"2. Opposer's goods, which are primarily goods catering to the needs of babies and children, bearing the trademark "BABY MAGIC" since more than forty-two (42) years ago as it was first used in January 1950, has been sold to people all over the world including the Philippines and is still continuously being sold and used worldwide and in the Philippines up to the present.

"3. Opposer has obtained registration of this trademark for various goods primarily catering to the needs of babies and children falling under different classes in its home country which is the United States of America and likewise in other countries of the world which have a system of trademark protection. Photocopies of some of the corresponding U.S. Trademark Registrations are made integral parts of this opposition and are hereto enclosed as Annexes "B", "C", "D", "E", "F", "G", and "H", respectively.

"4. The Opposer's goods covered by the trademark "BABY MAGIC", have been and continue to be the most widely used and sought after baby and child care products worldwide. It is therefore common knowledge that the Opposer, the Mennen Company, has since forty-two (42) years ago established a very valuable worldwide goodwill of its "BABY MAGIC" trademark which is internationally famous primarily due to the superior quality of its products as well as to the substantial amount of money, time and effort spent on worldwide advertisement to increase the people's awareness all over the world, from all walks of life especially those who have taken care of the needs of their children as well as those who did not have a chance to take care of children but who are literate enough to read their own national newspaper or tabloid or to understand what is shown in their national television programs and movies.

"5. A comparison of the Opposer's registered trademark with that of Respondent-Applicant's mark would show that the latter's mark is confusingly similar with the Opposer's said trademark, in clear violation of Section 4 (d) of Republic Act No. 166, as amended.

"6. The grant of registration of the Respondent-Applicant's mark "BABY MAGIC" will not only transgress on the rights and interest of herein Opposer over its registered trademark "BABY MAGIC" of long standing, but worse, it will tend to mislead the general consuming public into believing that Respondent-Applicant's products are the products of the Opposer or they originated from the latter to the damage and injury to both the interest of the Opposer and the consuming public at large, and on the other hand, to the undeserved or even fraudulent gain of herein Respondent-Applicant. This is obviously the case because the famous trademark "BABY MAGIC" is known all over the world to be owned by herein Opposer, The Mennen Company, thus goods and services which carries the mark "BABY MAGIC" would automatically be believed by the general consuming public to be emanating from the Opposer. In today's fast changing world, wherein we are witnessing the emergence of corporate conglomerate, which owns world famous Trademarks, producing goods and services which are very divergent from each other even belonging to different International Classification of Goods, the public at large, including those in the Philippines, is now very much aware of this, through widespread dissemination of information

made possible by modern mass media facilities worldwide and in the Philippines. This being the case the use of famous trademarks on goods which are related and unrelated would lead the public at large to believe that these goods are made or authorized to be made by said conglomerates which originated and owns various world famous trademarks. Thus, in this case on hand, the grant of registration of Respondent-Applicant's subject application would cause confusion to the Philippine consuming public wherein they would be mistakenly led to believe that the goods covered by the Respondent-Applicant's mark is manufactured by the Opposer or that the Respondent-Applicant is authorized by the Opposer to manufacture and market said goods.

"7. The Opposer likewise believes that the Respondent-Applicant has misrepresented in her filed application that the subject mark was first used on the covered goods, which are feeding bottles, pacifiers, teethers, nursing nipples, diaper pins, nursery bar set, rubber mats, piece mats, hangers, training cups, instruments for hair care, namely: combs, brushes, drinking cups and glass, on February 1, 1986. It is common knowledge that no such goods bearing said alleged mark of Respondent-Applicant was then being sold in the Philippines at that time. This misrepresentation in Respondent-Applicant's trademark application for subject mark which is under oath makes said application fraudulent which even for this reason alone should preclude the grant of registration of the same.

"8. The foregoing clearly shows that the Opposer will be greatly and irreparably damaged by the grant of registration of the questioned mark in the name of Respondent-Applicant, particularly the Opposer's business reputation and goodwill not only here in the Philippines but internationally as well. Furthermore, application which from its inception is tainted with fraud should not be granted registration.

On April 2, 1993, Respondent-Applicant through counsel filed the requires Answer denying all the material allegations alleged in the Notice of Opposition and further alleged the following as her affirmative and/or special defenses.

"1. That she incorporates by reference all the material, pertinent and relevant allegations contained in the preceding paragraphs;

"2. That the above Notice of Opposition was filed out of time;

"3. That Opposer has no valid legal ground to oppose the application in question. In fact, Opposer is now barred by the equitable principles of acquiescence, estoppel and laches from opposing the application in question.

The parties were not able to come out with an amicable settlement for which trial on the merit was conducted.

The main issue to be resolved in this particular case is:

WHETHER OR NOT RESPONDENT-APPLICANT IS ENTITLED TO REGISTER IN HER FAVOR THE TRADEMARK "BABY MAGIC" FOR USE IN GOODS FALLING UNDER CLASSES 10, 17 AND 21.

Our Trademark Law, particularly Section 4(d) of R.A. No. 166 as amended, provides:

“Section 4. Registration of trademark, tradenames and service marks on the Philippine register. There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. The owner of a trademark, tradename or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register unless it:

x x x

“(d) Consists of or comprise 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 service of the applicant, to cause confusion or mistake or to deceive purchasers.”

Records of the case will show that the instant opposition proceedings has been dismissed for Opposer’s failure to prosecute for an unreasonable length of time under the Rules of Court (ORDER No. 95-72 dated January 24, 1995). However, on February 2, 1995, Opposer through Counsel filed a Motion for Reconsideration praying that ORDER No. 95-72 dated January 25, 1995 be SET ASIDE which was GRANTED WITH WARNING THAT SHOULD OPPOSER STILL FAIL TO APPEAR AT THE NEXT-PRE-TRIAL CONFERENCE, THIS CASE SHALL MOTU PROPIO BE DISMISSED FOR FAILURE OF OPPOSER TO PROSECUTE. (ORDER No. 95-227) dated April 24, 1995.

For TEN YEARS (10) from June 26, 1992 when the above-Notice of Opposition was filed until May 3, 2002 when ORDER No. 2002-194 was issued, Opposer failed to complete the presentation of its evidence which prompted this Office to issue ORDER No. 2002-194 DECLARING Opposer to have waived its right to file its Formal Offer of Evidence.

SECTION 11 (a) of Rule 2 of the Regulations on Inter Partes Proceedings provides:

Section 11 (a) Dismissal for failure to prosecute if the xxx  
Opposer xxx failed to prosecute his case for an unreasonable length of time, xxx the Notice of Opposition shall be dismissal for failure to prosecute and judgment rendered in favor of the Respondent.

In view of all the foregoing, this case is hereby DISMISSED for Opposer’s failure to prosecute for an unreasonable length of time as provided in the aforecited Regulations on Inter Partes Proceedings. Consequently, Serial No. 74271 for the registration of the trademark “BABY MAGIC” used on feeding bottles, pacifiers, teethers, nursing nipples, diaper pins, nursery bar set, rubber mats, piece mats, hangers, training cups, instruments for hair care, namely: combs, brushes, drinking cups and glasses, in classes 10, 17 and 21 filed on 05 December 1990 by LORNA YU TIU is, as it is hereby GIVEN DUE COURSE.

Let the filewrapper of trademark BABY MAGIC be forwarded to the Administrative, Financial & Human Resources Development Services Bureau (AFHRDSB) for appropriate action in accordance with this order with a copy to be furnished the Bureau of Trademarks (BOT) for information and to update its record.

SO ORDERED.

Makati City, 12 December 2002.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office