

SOCIETE DES PRODUITS NESTLE S.A.,
Opposer,

-versus-

NATURE'S HARVEST CORPORATION,
Respondent- Applicant.

X-----X

}
} **IPC No. 14-2012-00502**
} Opposition to:
} Appln. Serial No. 4-2012-008486
} Date Filed: 12 July 2012
} **TM: "MAGIC"**
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 409 dated November 16, 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 Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, November 16, 2016.

Marilyn F. Retutal
MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

SOCIETE DES PRODUITS NESTLE S.A.,
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NATURE'S HARVEST CORPORATION,
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IPC No. 14-2012-00502

Opposition to Trademark
Application No. 4-2012-008486
Date Filed: 12 JULY 2012
Trademark: **"MAGIC"**

Decision No. 2016- 409

DECISION

Societe Des Produits Nestle S.A.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-008486. The contested application, filed by Nature's Harvest Corporation² ("Respondent-Applicant"), covers the mark "MAGIC" for use on "*cooking oil*" under Class 29 of the International Classification of Goods³.

The Opposer alleges, among others, that it is the exclusive owner of the "MAGGI" trademark and the various Maggi "MAGIC" marks, which it adopted all over the world. The mark "MAGGI" was first used in the Philippines since the 1930s for several goods. As shown in the Petition for Renewal of Certificate of Registration No. 12332-BC filed on 17 August 1966 for R-1053, its "MAGGI" mark was first registered in the country on 28 November 1936. It was also issued trademark registrations for the marks "MAGGI", "MAGGI (YELLOW) WITH BUBBLE DEV. (RED)", "MAGGI CUP SARAP", "MAGGI NOODLE EXPRESS", "MAGIC SARAP" and "MAGIC SINIGANG". In addition, its applications for registrations for the marks "MAGIC RICE", "MAGIC SABAW", "MAGIC MEALS" and "MAGIC MEALS SL IN 'RICE COOKER' DV (COL)" were allowed publication. Outside the country, it has obtained registrations and/or filed applications for the said marks in one hundred fifty-six (156) countries around the world.

The Opposer contends that there is confusing similarity between its "MAGGI" mark and various Maggi "MAGIC" extension marks and the Respondent-Applicant's applied mark "MAGIC". According to the Opposer, the latter's "MAGIC" mark significantly and obviously contains all the letters "M", "A", "G" and "I" found in its "MAGGI" mark. Also, it asserts that the applied mark is identical or confusingly similar to its Maggi "MAGIC" trademarks. It points out that it was issued registration for "MAGIC SARAP" and "MAGIC SINIGANG" under Registration Nos. 4-2004-007824

¹A corporation organized and existing under the laws of Switzerland, with business address at Vevey, Switzerland.

²With address at Rm. 504, Kim Siu Ching Building, 473 Sto. Cristo corner Jaboneros Streets, Binondo, Manila.

³The 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.

and 4-2009-500291, respectively, and that these marks were derived and used in conjunction with the "MAGGI" mark. It believes that to allow the Respondent-Applicant's "MAGIC" trademark will create confusion among purchasers since the competing marks similarly use the word "MAGIC" as a dominant feature and are applied to similar goods.

In support of its Opposition, the Opposer submitted the following:⁴

1. copy of Petition for Renewal of Certificate of Registration No. 12332-BC;
2. copy of Renewal Certificate of Registration No. 12332-BC;
3. copies of its certificates of registrations;
4. copies of its trademark applications;
5. certification showing Respondent-Applicant's failure to file 3rd Anniversary Declaration of Actual Use ("DAU") for Application No. 4-2008-001657;
6. list of its registrations and pending applications for the mark "MAGGI";
7. affidavit of Atty. Dennis R. Barot, with annexes;
8. printout copies of advertising and promotional materials of "MAGGI" and Maggi "MAGIC" marks;
9. compact disc containing various commercials;
10. copies of its foreign registrations of "MAGGI"; and
11. actual labels of its marks.

The Respondent-Applicant filed its Answer on 08 May 2013 averring that the Opposer is deliberately forum-shopping since the issues involved in the present opposition has already been decided in its favor by this Bureau in IPC No. 4-2008-001657, which appeal is pending with the Office of the Director General.

The Respondent-Applicant alleges, among others, that its company has been duly organized and existing since 1988. It has been marketing, advertising, distributing and selling cooking oil in the Philippines since 1989 under the "MAGIC FRY" trademark, which was registered with the then Bureau of Patents, Trademarks and Technology Transfer ("BPTTT") on 13 May 1991. Sometime in 2008, it discovered that the said mark was cancelled, prompting it to re-file a trademark application, which was granted on 22 September 2008. It discovered that the Opposer filed an application for the mark "MAGIC RICE", which it opposed. Without answering the opposition, the Opposer withdrew its application and manifested its withdrawal for the dismissal of the opposition. On 24 March 2011, the Bureau issued Order No. 2011-14(D) dismissing the said opposition. On 09 February 2011, the Opposer also filed an application for "MAGIC SABAW", which it likewise opposed.

According to the Respondent-Applicant, its registration certificate for "MAGIC FRY" expressly disclaims the word "FRY". It is thus its intention that the word

⁴ Marked as Exhibits "C" to "V", inclusive.

"MAGIC" is the principal subject of the said registration, which is exactly the same word subject of the contested application. It asserts that the Opposer never opposed the registration of "MAGIC FRY" and now cannot claim damage or confusing similarity from its use of the mark "MAGIC". It claims that the Opposer's withdrawal of the application for the mark "MAGIC RICE" is recognition of its right over the "MAGIC" trademark. It also disputes the Opposer's claim that the latter's marks are well-known. The Respondent's evidence consists of the affidavit of Rebbie L. Chua, with annexes.⁵

Pursuant to Office Order No. 154, s. 2010, the case was referred to mediation. The parties, however, refused to mediate. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 13 August 2014. Thereafter, the parties submitted their respective position papers. After which, the case is deemed submitted for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "MAGIC" should be allowed registration.

On the procedural issue, the Respondent-Applicant raises the issue of forum shopping in view of IPC Case No. 14-2008-00362 wherein the Opposer herein also opposed the Respondent-Applicant's application of the mark "MAGIC". The Supreme Court in the case of Hernando Borra vs. Court of Appeals held that:⁶

"Forum-shopping can be committed in three ways: (1) by filing multiple cases based on the same cause of action and with the same prayer, the previous case not having been resolved yet (where the ground for dismissal is litis pendentia); (2) by filing multiple cases based on the same cause of action and with the same prayer, the previous case having been finally resolved (where the ground for dismissal is res judicata); and (3) by filing multiple cases based on the same cause of action but with different prayers (splitting of causes of action, where the ground for dismissal is also either litis pendentia or res judicata).

More particularly, the elements of forum-shopping are: (a) identity of parties or at least such parties that represent the same interests in both actions; (b) identity of rights asserted and reliefs prayed for, the relief being founded on the same facts; (c) identity of the two preceding particulars, such that any judgment rendered in the other action will, regardless of which party is successful, amount to res judicata in the action under consideration."

The subject matter in IPC Case No. 14-2008-00362 is Trademark Application No. 4-2008-001657 while in the instant case, the subject matter is Trademark Application No. 4-2012-008486. Although both seek to register the mark "MAGIC",

⁵ Marked as Exhibits "1" to "34", inclusive.

⁶ G.R. No. 167484, 09 September 2013.

separate oppositions should be filed in order to contest their registration. Also, in IPC Case No. 14-2008-00362, the issue to be resolved is whether the marks "MAGGI" and "MAGIC" are confusingly similar. In the instant case, the Opposer also cites its marks "MAGIC SARAP" and "MAGIC SINIGANG" in opposing to the Respondent-Applicant's applied mark. Therefore, there is no forum shopping.

Proceeding to the substantive issue, Section 123.1. (d) of R.A. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it:

"xxx

(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; x x x"

Records reveal that the Opposer was issued registration for the mark "MAGGI" as early as 28 November 1986 under Certificate of Registration No. 000343. It also has valid and existing registrations for the marks "MAGIC SARAP" and "MAGIC SINIGANG" under Certificate of Registration Nos. 4-2004-007824 and 4-2009-500291 issued on 21 January 2006 and 01 January 2010, respectively. On the other hand, the Respondent-Applicant filed the contested application only on 12 July 2012.

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

Opposer's marks:

MAGGI



MAGIC SARAP

MAGIC SINIGANG

Respondent-Applicant's mark



The Opposer's marks consist of the word "MAGGI" or "MAGIC" combined with a Tagalog word. Whether the marks "MAGGI" and "MAGIC" are confusingly similar has already been ruled upon by the Bureau of Legal Affairs ("BLA") in "Societe des Produits Nestle, S.A. vs. Nature's Harvest Corporation" docketed IPC Case No. 14-2008-00362 wherein it was ruled that:⁷

"The visual and aural differences between the marks negate the likelihood of confusion or deception. The configuration of a double 'G' followed by 'I' in MAGGI is in stark contrast with the 'GIC' in 'MAGIC'. The eyes and ears can easily distinguish between MAGGI and MAGIC. While MAGGI is pronounced as spelled (mag-gi), MAGIC is pronounced as 'ma-jic'. The word 'magic', in the first place is a common English word, and a popular one for that matter, such that it is very remote for one to confuse it with the word MAGGI. Moreover, the way the marks are presented also diminishes the chances of committing mistake or confusion. The letters in the Opposer's mark are all capital letters and in upright, perpendicular and static positions. This, while the letters in the Respondent-Applicant's mark are stylized, in distinctive script, with letters in lower case except the letter 'M', and in diagonal position connoting dynamism or action."

The Adjudication Officer sees no cogent reason to deviate from the above-findings. Noteworthy, the Office of the Director General affirmed the decision in the above case thus:⁸

⁷ Decision No. 2012-27, 15 February 2012.

⁸ Appeal No. 14-2012-0008, 20 December 2013.

"On its face, the distinctive features of the contending marks are sufficient to warn the purchasing public on which are the Appellant's products, as distinguished from the Appellee's products. As can be gleaned from the above illustrations, the Appellee's mark is composed of a stylized word 'MAGIC' while the Appellant's mark is the word 'MAGGI'. The difference in presentation of the two marks belies any claim of visual similarity. Also, despite the common letters 'M', 'A', 'G' and 'I', the Appellee's mark cannot be broken down into letters and must be construed as the whole word 'MAGIC'. Obviously, the Appellee's mark denotes a separate term and concept from the Appellee's mark, 'MAGGI'. Moreover, there is no phonetic or aural similarity between the two marks, as even their pronunciations are different. The Appellant's mark is pronounced ordinarily as 'mah-gee' while the Appellee's mark is ordinarily pronounced as 'mah-jeek'."

Anent the Respondent-Applicant's mark "MAGIC" vis-à-vis the Opposer's marks "MAGIC SARAP" and "MAGIC SINIGANG", the Adjudication Officer finds that they are not confusingly similar. The Opposer's marks comprises of the word "MAGIC" followed by a Tagalog word while that of the Respondent-Applicant's is the word "MAGIC" alone. In presentation, the Opposer's word marks are easily distinguishable from the Respondent-Applicant's stylized and/or script presentation of its mark "MAGIC". More importantly, the word "MAGIC" is a common English word. In fact, the Trademark Registry of this Office has registered various marks for Class 29 appropriating the word "MAGIC" such as "MILK MAGIC" under Certificate of Registration No. 4-2000-05808 issued on 23 April 2007, "SOY MAGIC AND DEVICE" under Certificate of Registration No. 4-2008-011428 issued on 07 April 2011 and "MAGIC WHIRL" under Certificate of Registration No. 4-2015-0001397 issued on 11 June 2015. Therefore, the mere use of "MAGIC" is insufficient to conclude that there is likelihood of confusion. The said word has been appropriated as a trademark by many other different proprietors for goods under the same class as that used or intended to be used by the Opposer and the Respondent-Applicant.

Finding no confusing similarity between the contending marks, there is no need for a determination whether the Opposer's marks are well-known.

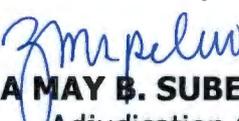
Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market 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.⁹ Based on the above discussion, Respondent-Applicant's trademark sufficiently met this function.

⁹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-008486 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **16 NOV 2016**


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs