

## FIRST DIVISION

**McDONALDS CORPORATION,**  
**Petitioner,**

**G.R. No. 166115**

Present:

PUNO, C.J., *Chairperson,*  
SANDOVAL-GUTIERREZ,  
CORONA,  
AZCUNA,  
GARCIA, JJ.  
Promulgated:

- versus -

**February 2, 2007**

**MACJOY FASTFOOD CORPORATION,**  
**Respondent.**

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## DECISION

**GARCIA, J.:**

In this petition for review on certiorari under Rule 45 of the Rules of Court, herein petitioner McDonalds Corporation seeks the reversal and setting aside of the following issuances of the Court of Appeals (CA) in *CA-G.R. SP No. 57247*, to wit:

1. **Decision dated 29 July 2004**<sup>[1]</sup> reversing an earlier decision of the Intellectual Property Office (IPO) which rejected herein respondent MacJoy FastFood Corporations application for registration of the trademark MACJOY & DEVICE; and
2. **Resolution dated 12 November 2004**<sup>[2]</sup> denying the petitioners motion for reconsideration.

As culled from the record, the facts are as follows:

On 14 March 1991, respondent MacJoy Fastfood Corporation, a domestic corporation engaged in the sale of fast food products in Cebu City, filed with the then Bureau of Patents, Trademarks and Technology Transfer (BPTT), now the Intellectual Property Office (IPO), an application, thereat identified as Application Serial No. 75274, for the registration of the trademark MACJOY & DEVICE for fried chicken, chicken barbeque, burgers, fries, spaghetti, palabok, tacos, sandwiches, halo-halo and steaks under classes 29 and 30 of the International Classification of Goods.

Petitioner McDonalds Corporation, a corporation duly organized and existing under the laws of the State of Delaware, USA, filed a verified *Notice of Opposition*<sup>[3]</sup> against the respondents application claiming that the trademark MACJOY & DEVICE so resembles its corporate logo, otherwise known as the Golden Arches or M

design, and its marks McDonalds, McChicken, MacFries, BigMac, McDo, McSpaghetti, McSnack, and Mc, (hereinafter collectively known as the MCDONALDS marks) such that when used on identical or related goods, the trademark applied for would confuse or deceive purchasers into believing that the goods originate from the same source or origin. Likewise, the petitioner alleged that the respondents use and adoption in bad faith of the MACJOY & DEVICE mark would falsely tend to suggest a connection or affiliation with petitioners restaurant services and food products, thus, constituting a fraud upon the general public and further cause the dilution of the distinctiveness of petitioners registered and internationally recognized MCDONALDS marks to its prejudice and irreparable damage. The application and the opposition thereto was docketed as *Inter Partes Case No. 3861*.

Respondent denied the aforementioned allegations of the petitioner and averred that it has used the mark MACJOY for the past many years in good faith and has spent considerable sums of money for said marks extensive promotion in tri-media, especially in Cebu City where it has been doing business long before the petitioner opened its outlet thereat sometime in 1992; and that its use of said mark would not confuse affiliation with the petitioners restaurant services and food products because of the differences in the design and detail of the two (2) marks.

In a decision <sup>[4]</sup> dated December 28, 1998, the IPO, ratiocinating that the predominance of the letter M, and the prefixes Mac/Mc in both the MACJOY and the MCDONALDS marks lead to the conclusion that there is confusing similarity between them especially since both are 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, sustained the petitioners opposition and rejected the respondents application, *viz*:

**WHEREFORE**, the Opposition to the registration of the mark **MACJOY & DEVICE** for use in fried chicken and chicken barbecue, burgers, fries, spaghetti, palabok, tacos, sandwiches, halo-halo, and steaks is, as it is hereby, **SUSTAINED**. Accordingly, Application Serial No. 75274 of the herein Respondent-Applicant is **REJECTED**.

Let the filewrapper of MACJOY subject matter of this case be sent to the Administrative, Financial and Human Resources Development Bureau for appropriate action in accordance with this Decision, with a copy to be furnished the Bureau of Trademarks for information and to update its record.

SO ORDERED.

In time, the respondent moved for a reconsideration but the IPO denied the motion in its Order <sup>[5]</sup> of January 14, 2000.

Therefrom, the respondent went to the CA *via* a Petition for Review with prayer for Preliminary Injunction <sup>[6]</sup> under Rule 43 of the Rules of Court, whereat its appellate recourse was docketed as *CA-G.R. SP No. 57247*.

Finding no confusing similarity between the marks MACJOY and MCDONALDS, the CA, in its herein assailed Decision <sup>[7]</sup> dated July 29, 2004, reversed and set aside the appealed IPO decision and order, thus:

WHEREFORE, in view of the foregoing, judgment is hereby rendered by us REVERSING and SETTING ASIDE the Decision of the IPO dated 28 December 1998 and its Order dated 14 January 2000 and ORDERING the IPO to give due course to petitioners Application Serial No. 75274.

SO ORDERED.

Explains the CA in its decision:

xxx, it is clear that the IPO brushed aside and rendered useless the glaring and drastic differences and variations in style of the two trademarks and even decreed that these pronounced differences are miniscule and considered them to have been overshadowed by the appearance of the predominant features such as M, Mc, and Mac appearing in both MCDONALDS and MACJOY marks. Instead of taking into account these differences, the IPO unreasonably shrugged off these differences in the device, letters and marks in the trademark sought to be registered. The IPO brushed aside and ignored the following irrefutable facts and circumstances showing differences between the marks of MACJOY and MCDONALDS. They are, as averred by the petitioner [now respondent]:

1. The word MacJoy is written in round script while the word McDonalds is written in single stroke gothic;
2. The word MacJoy comes with the picture of a chicken head with cap and bowtie and wings sprouting on both sides, while the word McDonalds comes with an arches M in gold colors, and absolutely without any picture of a chicken;
3. The word MacJoy is set in deep pink and white color scheme while McDonalds is written in red, yellow and black color combination;
4. The faade of the respective stores of the parties are entirely different. Exhibits 1 and 1-A, show that [respondents] restaurant is set also in the same bold, brilliant and noticeable color scheme as that of its wrappers, containers, cups, etc., while [petitioners] restaurant is in yellow and red colors, and with the mascot of Ronald McDonald being prominently displayed therein. (Words in brackets supplied.)

Petitioner promptly filed a motion for reconsideration. However, in its similarly challenged **Resolution [\[8\]](#)** of November 12, 2004, the CA denied the motion, as it further held:

Whether a mark or label of a competitor resembles another is to be determined by an inspection of the points of difference and resemblance as a whole, and not merely the points of resemblance. The articles and trademarks employed and used by the [respondent] Macjoy Fastfood Corporation are so different and distinct as to preclude any probability or likelihood of confusion or deception on the part of the public to the injury of the trade or business of the [petitioner] McDonalds Corporation. The Macjoy & Device mark is dissimilar in color, design, spelling, size, concept and appearance to the McDonalds marks. (Words in brackets supplied.)

Hence, the petitioners present recourse on the following grounds:

I.

THE COURT OF APPEALS ERRED IN RULING THAT RESPONDENTS MACJOY & DEVICE MARK IS NOT CONFUSINGLY SIMILAR TO PETITIONERS McDONALDS MARKS. IT FAILED TO CORRECTLY APPLY THE DOMINANCY TEST WHICH HAS BEEN CONSISTENTLY APPLIED BY THIS HONORABLE COURT IN DETERMINING THE EXISTENCE OF CONFUSING SIMILARITY BETWEEN COMPETING MARKS.

- A. The McDonalds Marks belong to a well-known and established family of marks distinguished by the use of the prefix Mc and/or Mac and the corporate M logo design.
- B. The prefix Mc and/or Mac is the dominant portion of both Petitioners McDonalds Marks and the Respondents Macjoy & Device mark. As such, the marks are confusingly similar under the Dominancy Test.
- C. Petitioners McDonalds Marks are well-known and world-famous marks which must be protected under the Paris Convention.

## II.

THE COURT OF APPEALS ERRED IN RULING THAT THE DECISION OF THE IPO DATED 28 DECEMBER 1998 AND ITS ORDER DATED 14 JANUARY 2000 WERE NOT BASED ON SUBSTANTIAL EVIDENCE.

In its Comment,<sup>[9]</sup> the respondent asserts that the petition should be dismissed outright for being procedurally defective: first, because the person who signed the certification against forum shopping in behalf of the petitioner was not specifically authorized to do so, and second, because the petition does not present a reviewable issue as what it challenges are the factual findings of the CA. In any event, the respondent insists that the CA committed no reversible error in finding no confusing similarity between the trademarks in question.

The petition is impressed with merit.

Contrary to respondents claim, the petitioners Managing Counsel, Sheila Lehr, was specifically authorized to sign on behalf of the petitioner the Verification and Certification<sup>[10]</sup> attached to the petition. As can be gleaned from the petitioners Board of Directors Resolution dated December 5, 2002, as embodied in the Certificate of the Assistant Secretary dated December 21, 2004,<sup>[11]</sup> Sheila Lehr was one of those authorized and empowered *to execute and deliver for and on behalf of [the petitioner] all documents as may be required in connection with x x x the protection and maintenance of any foreign patents, trademarks, trade-names, and copyrights owned now or hereafter by [the petitioner], including, but not limited to, x x x documents required to institute opposition or cancellation proceedings against conflicting trademarks, and to do such other acts and things and to execute such other documents as may be necessary and appropriate to effect and carry out the intent of this resolution.* Indeed, the afore-stated authority given to Lehr necessarily includes the authority to execute and sign the mandatorily required certification of non-forum shopping to support the instant petition for review which stemmed from the *opposition proceedings* lodged by the petitioner before the IPO. Considering that the person who executed and signed the certification against forum shopping has the authority to do so, the petition, therefore, is not procedurally defective.

As regards the respondents argument that the petition raises only questions of fact which are not proper in a petition for review, suffice it to say that the contradictory findings of the IPO and the CA constrain us to give due course to the petition, this being one of the recognized exceptions to Section 1, Rule 45 of the Rules of Court. True, this Court is not the proper venue to consider factual issues as it is not a trier of facts.<sup>[12]</sup> Nevertheless, when the factual findings of the appellate court are mistaken, absurd, speculative, conjectural,

conflicting, tainted with grave abuse of discretion, or contrary to the findings culled by the court of origin,<sup>[13]</sup> as here, this Court will review them.

The old Trademark Law, Republic Act (R.A.) No. 166, as amended, defines a trademark as any distinctive word, name, symbol, emblem, sign, or device, or any combination thereof adopted and used by a manufacturer or merchant on his goods to identify and distinguish them from those manufactured, sold, or dealt in by others.<sup>[14]</sup>

Under the same law, the registration of a trademark is subject to the provisions of Section 4 thereof, paragraph (d) of which is pertinent to this case. The provision reads:

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

xxx xxx xxx

(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name 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;

xxx xxx xxx

Essentially, the issue here is whether there is a confusing similarity between the MCDONALDS marks of the petitioner and the respondents MACJOY & DEVICE trademark when applied to Classes 29 and 30 of the International Classification of Goods, i.e., food and ingredients of food.

In determining similarity and likelihood of confusion, jurisprudence has developed two tests, the *dominancy test* and the *holistic test*.<sup>[15]</sup> The dominancy test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion or deception.<sup>[16]</sup> In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity.<sup>[17]</sup> Under the latter test, a comparison of the words is not the only determinant factor.<sup>[18]</sup>

Here, the IPO used the dominancy test in concluding that there was confusing similarity between the two (2) trademarks in question as it took note of the appearance of the predominant features M, Mc and/or Mac in both the marks. In reversing the conclusion reached by the IPO, the CA, while seemingly applying the dominancy test, in fact actually applied the holistic test. The appellate court ruled in this wise:

Applying the Dominancy test to the present case, the IPO should have taken into consideration the entirety of the two marks instead of simply fixing its gaze on the single letter M or on the combinations Mc or Mac. A mere cursory

look of the subject marks will reveal that, save for the letters M and c, no other similarity exists in the subject marks.

We agree with the [respondent] that it is entirely unwarranted for the IPO to consider the prefix Mac as the predominant feature and the rest of the designs in [respondents] mark as details. Taking into account such paramount factors as color, designs, spelling, sound, concept, sizes and audio and visual effects, the prefix Mc will appear to be the only similarity in the two completely different marks; and it is the prefix Mc that would thus appear as the miniscule detail. When pitted against each other, the two marks reflect a distinct and disparate visual impression that negates any possible confusing similarity in the mind of the buying public. (Words in brackets supplied.)

Petitioner now vigorously points out that the dominance test should be the one applied in this case.

We agree.

In trademark cases, particularly in ascertaining whether one trademark is confusingly similar to another, no set rules can be deduced because each case must be decided on its merits.<sup>[19]</sup> In such cases, even more than in any other litigation, precedent must be studied in the light of the facts of the particular case.<sup>[20]</sup> That is the reason why in trademark cases, jurisprudential precedents should be applied only to a case if they are specifically in point.<sup>[21]</sup>

While we agree with the CAs detailed enumeration of differences between the two (2) competing trademarks herein involved, we believe that the holistic test is not the one applicable in this case, the dominance test being the one more suitable. In recent cases with a similar factual milieu as here, the Court has consistently used and applied the dominance test in determining confusing similarity or likelihood of confusion between competing trademarks.<sup>[22]</sup>

Notably, in *McDonalds Corp. v. LC Big Mak Burger, Inc.*,<sup>[23]</sup> a case where the trademark Big Mak was found to be confusingly similar with the Big Mac mark of the herein the petitioner, the Court explicitly held:

This Court, xxx, has relied on the dominance test rather than the holistic test. The dominance test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominance test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments.

Moreover, in *Societe Des Produits Nestle, S.A. v. CA*<sup>[24]</sup> the Court, applying the dominance test, concluded that the use by the respondent therein of the word MASTER for its coffee product FLAVOR MASTER was likely to cause confusion with therein petitioners coffee products MASTER ROAST and MASTER BLEND and further ruled:

xxx, the totality or holistic test is contrary to the elementary postulate of the law on trademarks and unfair competition that confusing similarity is to be determined on the basis of visual, aural, connotative comparisons and

overall impressions engendered by the marks in controversy as they are encountered in the marketplace. The totality or holistic test only relies on visual comparisons between two trademarks whereas the dominance test relies not only on the visual but also on the aural and connotative comparisons and overall impressions between the two trademarks.

Applying the dominance test to the instant case, the Court finds that herein petitioners MCDONALDS and respondents MACJOY marks are confusingly similar with each other such that an ordinary purchaser can conclude an association or relation between the marks.

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.<sup>[25]</sup>

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 MCDONALDS marks which all use the prefixes Mc and/or Mac.

Besides and most importantly, both trademarks are used in the sale of fastfood products. Indisputably, the respondents 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 petitioners trademark registration for the MCDONALDS marks in the Philippines covers goods which are similar if not identical to those covered by the respondents application.

Thus, we concur with the IPOs findings that:

In the case at bar, the predominant features such as the M, Mc, and Mac appearing in both McDonalds 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 McDonalds 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 Donalds 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.

With the existence of confusing similarity between the subject trademarks, the resulting issue to be resolved is who, as between the parties, has the rightful claim of ownership over the said marks.

We rule for the petitioner.

A mark is valid if it is distinctive and hence not barred from registration under the Trademark Law. However, once registered, not only the marks validity but also the registrants ownership thereof is *prima facie* presumed.<sup>[26]</sup>

Pursuant to Section 37<sup>[27]</sup> of R.A. No. 166, as amended, as well as the provision regarding the protection of industrial property of foreign nationals in this country as embodied in the Paris Convention<sup>[28]</sup> under which the Philippines and the petitioners domicile, the United States, are adherent-members, the petitioner was able to register its MCDONALDS marks successively, i.e., McDonalds in 04 October, 1971<sup>[29]</sup>; the corporate logo which is the M or the golden arches design and the McDonalds with the M or golden arches design both in 30 June 1977<sup>[30]</sup>; and so on and so forth.<sup>[31]</sup>

On the other hand, it is not disputed that the respondents application for registration of its trademark MACJOY & DEVICE was filed only on March 14, 1991 albeit the date of first use in the Philippines was December 7, 1987.<sup>[32]</sup>

Hence, from the evidence on record, it is clear that the petitioner has duly established its ownership of the mark/s.

Respondents contention that it was the first user of the mark in the Philippines having used MACJOY & DEVICE on its restaurant business and food products since December, 1987 at Cebu City while the first McDonalds outlet of the petitioner thereat was opened only in 1992, is downright unmeritorious. For the requirement of actual use in commerce x x x in the Philippines before one may register a trademark, trade-name and service mark under the Trademark Law<sup>[33]</sup> pertains to the territorial jurisdiction of the Philippines and is not only confined to a certain region, province, city or barangay.

Likewise wanting in merit is the respondents claim that the petitioner cannot acquire ownership of the word Mac because it is a personal name which may not be monopolized as a trademark as against others of the same name or surname. As stated earlier, once a trademark has been registered, the validity of the mark is *prima facie* presumed. In this case, the respondent failed to overcome such presumption. We agree with the observations of the petitioner regarding the respondents explanation that the word MACJOY is based on the name of its presidents niece, Scarlett Yu Carcell. In the words of the petitioner:

First of all, Respondent failed to present evidence to support the foregoing claim which, at best, is a mere self-serving assertion. Secondly, it cannot be denied that there is absolutely no connection between the name Scarlett Yu Carcel and MacJoy to merit the coinage of the latter word. Even assuming that the word MacJoy was chosen as a term of endearment, fondness and affection for a certain Scarlett Yu Carcel, allegedly the niece of Respondents president, as well as to supposedly bring good luck to Respondents business, one cannot help but wonder why out of all the possible letters or combinations of letters available to Respondent, its president had to choose and adopt a mark with the prefix Mac as the dominant feature thereof. A more plausible explanation perhaps is that the niece of Respondents president was fond of the food products and services of the Respondent, but that is beside the point.<sup>[34]</sup>

By reason of the respondents implausible and insufficient explanation as to how and why out of the many choices of words it could have used for its trade-name and/or trademark, it chose the word MACJOY, the only logical conclusion deducible therefrom is that the respondent would want to ride high on the established reputation and goodwill of the MCDONALDs marks, which, as applied to petitioners restaurant business and food products, is undoubtedly beyond question.

Thus, the IPO was correct in rejecting and denying the respondents application for registration of the trademark MACJOY & DEVICE. As this Court ruled in *Faberge Inc. v. IAC*,<sup>[35]</sup> citing *Chuanchow Soy & Canning Co. v. Dir. of Patents and Villapanta*:<sup>[36]</sup>

When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill.

**WHEREFORE**, the instant petition is **GRANTED**. Accordingly, the assailed Decision and Resolution of the Court of Appeals in *CA-G.R. SP NO. 57247*, are **REVERSED** and **SET ASIDE** and the Decision of the Intellectual Property Office in *Inter Partes Case No. 3861* is **REINSTATED**.

No pronouncement as to costs.

**SO ORDERED.**

**CANCIO C. GARCIA**  
Associate Justice

WE CONCUR:

**REYNATO S. PUNO**  
Chief Justice  
Chairperson

**ANGELINA SANDOVAL-GUTIERREZ**  
Associate Justice

**RENATO C. CORONA**  
Associate Justice

**ADOLFO S. AZCUNA**  
Associate Justice

#### **C E R T I F I C A T I O N**

Pursuant to Article VIII, Section 13 of the Constitution, it is hereby certified that the conclusions in the above decision had been reached in consultation before the case was assigned to the writer of the opinion of the Courts Division.

**REYNATO S. PUNO**  
Chief Justice

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- [1] Penned by Associate Justice Isaias P. Dicdican and concurred in by Associate Justices Elvi John S. Asuncion and Ramon Bato, Jr.; Rollo, pp. 209-219.
- [2] Id. at 256-257.
- [3] Id. at 77-81.
- [4] Id. at 114-122.
- [5] Id. at 139-142.
- [6] Id. at 144-159.
- [7] Supra note 1.
- [8] Supra note 2.
- [9] Rollo, pp. 291-306.
- [10] Id. at 72.
- [11] Id. at 74 & 76
- [12] *Moomba Mining Exploration Co. v. CA*, G.R. No. 108846, October 26, 99, 317 SCRA 38, 397.
- [13] *Smith Kline Beckman Corporation v. CA*, G.R. No. 126627, August 14, 2003, 409 SCRA 33, 39.
- [14] Section 38, R.A. 166, as amended
- [15] *Mighty Corporation v. E & J Gallo Winery*, G.R. No. 154342, July 14, 2004, 434 SCRA 473, 506.
- [16] *McDonalds Corporation v. L.C. Big Mak Burger, Inc.*, supra
- [17] Id.
- [18] *Emerald Garment Manufacturing Corporation v. Court of Appeals*, G.R. No. 100098, December 29, 1995, 251 SCRA 600, 615-616.
- [19] *Societe Des Produits Nestle, S.A. v. CA*, GR No. 112012, April 4, 2001, 356 SCRA 207, 217.
- [20] Id.
- [21] Id. at p. 218.
- [22] Applied in *McDonalds Corp. v. L.C. Big Mak Burger, Inc.*, supra; *Societe Des Produits Nestle, S.A. v. CA*, supra; *Asia Brewery, Inc. v. CA*, G.R. No. 103543, July 5, 1993, 224 SCRA 437; *Converse Rubber Corp. v. Universal Rubber Products, Inc.*, G.R. No. L-27906, January 8, 1987, 147 SCRA 154; *Phil. Nut Industry Inc. v. Standard Brands, Inc.*, G.R. No. L-23035, July 31, 1975, 65 SCRA 575.
- [23] Supra note 14, at 32.
- [24] Supra note 23.
- [25] MacJoy mark, Rollo p. 297 and MCDONALDS marks, Rollo, pp. 86, 89 & 91.
- [26] *McDonalds Corporation v L.C. Big Mak Burger Inc.*, supra note 14; SEC. 20. *Certificate of registration prima facie evidence of validity.* - A certificate of registration of a mark or trade name shall be prima facie evidence of the validity of the registration, the registrants ownership of the mark or trade name, and of the registrants exclusive right to use the same in connection with the goods, business or services specified in the certificate, subject to any conditions and limitations stated therein.
- [27] Sec. 37. Rights of Foreign Registrants—Persons who are nationals of, domiciled in, or have a bona fide or effective business or commercial establishment in any foreign country, which is a party to an international convention or treaty relating to marks or tradenames on the repression of unfair competition to which the Philippines may be a party, shall be entitled to the benefits and subject to the provisions of this Act . . . x x x  
*Tradenames of persons described in the first paragraph of this section shall be protected without the obligation of filing or registration whether or not they form parts of marks.*
- [28] The Paris Convention is essentially a compact among the various member countries to accord in their own countries to citizens of the other contracting parties trademarks and other rights comparable to those accorded their own citizens by their domestic laws. The underlying principle is that foreign nationals should be given the same treatment in each of the member countries as that country makes available to its own citizens. In addition, the Convention sought to create uniformity in certain respects by obligating each nation to assure to nationals of countries of the Union an effective protection against unfair competition. Article 2 of the Paris Convention provides that: ART. 2. Nationals of each of the countries of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals, without prejudice to the rights specially provided by the present Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the conditions and formalities imposed upon nationals.
- [29] Rollo, p. 86

[30] Id. at 89 & 91

[31] Registration No. 31966, dated June 24, 1983 for the mark McChicken, Id. at 93; Registration No. 34065, dated March 06, 1985, for the mark McDonalds with corporate logoarches design, Id. at 94; Registration No. 34065, dated July 18, 1985 for the mark Big Mac, Id. at 97; Registration No. 39988, dated July 14, 1988 for the mark MacFries, Id. at 99; Registration No. 45583, dated July 14, 1988, for the mark McSpaghetti, Id. at 101; Registration No. 50987, dated July 24, 1991, for the servicemark McDo , Id. at 100; Registration No. 32009, dated June 24, 1983 for the trademark Big Mac and Circle Design Rollo, p. 106; Registration No. 48491, dated June 25, 1990 for the service mark McSnack Id. at 105; Registration No. 51789, dated December 02, 1991, for the trademark Mc (Id. at 107).

[32] IPO Decision; Rollo, pp. 120-121.

[33] Section 2 of R.A. 166, as amended, provides: Sec. 2. *What are registrable.* Trademarks, tradenames and service marks owned by persons, corporations, partnerships or associations domiciled in the Philippines and by persons, corporations, partnerships or associations domiciled in any foreign country may be registered in accordance with the provisions of this Act; *Provided, That said trademarks, tradenames, or service marks are actually in use in commerce* and services not less than two months *in the Philippines* before the time the applications for registration are filed; And provided, further, That the country of which the applicant for registration is a citizen grants by law substantially similar privileges to citizens of the Philippines, and such fact is officially certified, with a certified true copy of the foreign law translated into the English language, by the government of the foreign country to the Government of the Republic of the Philippines. (As amended by R.A. No. 865).

[34] Rollo, pp. 55-56.

[35] G.R. No. 71189, November 4, 1992.

[36] G.R. No. L-13947, 108 Phil. 833, 836.