

PHILIPPINE GLOBAL
COMMUNICATIONS, INC.,
Opposer,

- versus -

EASTERN TELECOMMUNICATIONS
PHILS., INC.,
Respondent-Applicant.

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) INTER PARTES CASE NO. 3475

) OPPOSITION TO:

) Application Serial No. 60529

) Filed : December 8, 1986

) Applicant : Eastern Tele-
communications
Phils., Inc.

) Trademark : TELEX WORLD LETTER

) Used on : Special service
in the transmission
messages, local or
international in
scope

) DECISION NO. 94-15 (TM)

) January 18, 1994

DECISION

This is an Opposition to the registration of the trademark TELEX WORLD LETTER under Application Serial No. 60579 filed by Eastern Telecommunications Inc., a corporation duly organized and existing under the laws of Philippines with address at Makati, Metro Manila. Said application was published for opposition in Official Gazette of this Bureau which was released on 31 July 1989. Opposer, Philippine Global Communications, Inc., a corporation with postal address at 8755 Paseo de Roxas, Makati, Metro Manila believing that if it will be damaged by the said registration filed this Opposition on the following ground:

1. The Opposer, like respondent-applicant, is a corporation engaged in the transmission of international messages, through various electronic means and devices which include, but not limited to, the use of telex and fax machines.
2. The mark sought to be registered by respondent-applicant under application No. 60529 is merely descriptive of the message transmission service it is offering to the public. The words TELEX WORLD LETTER are generic in nature and therefore, their registration as a trademark is proscribed by the Trademark Act, particularly Section 4(e) thereof.
3. Respondent-Applicant's applied trademark, if registered, will definitely cause confusion to the consuming public as opposer herein is likewise offering to the public the same kind of service with the same description, TELEX WORLD LETTER.
4. The approval of respondent-applicant's trademark application will clearly cause damage to opposer since it will exclude opposer and other telecommunications companies from using the same words in identifying or describing the modified service that the words TELEX WORLD LETTER entail.
5. In the course of the proceedings, opposer will prove facts in support of the preceding allegations, with the reservation to present evidence to prove other facts as may be necessary, depending upon the evidence that may be introduced by respondent-applicant.

The Respondent-Applicant filed its Answer denying all the material allegations of the Opposition and alleged that the trademark in question is registrable.

After the issues were joined, a pre-trial conference was scheduled on 27 February 1990. The parties agreed to submit the case for decision on the legal question of whether the trademark "TELEX WORLD LETTER" is generic/descriptive.

A mark is considered "descriptive" if it describes the intended purpose, function or use of the goods (*W.E. Bassett Co. vs. Revlon, Inc.* 168 USPQ 1); the size of the goods (*Bada vs. Ward & Co.*, 164 USPQ 513); the desirable characteristic of the goods, (*Deercon Corp is the Woodhill Chemical Sales Corp.*, 172 USPQ 417 or of the end effect upon the user (*Jean Patol vs. Cochran Inc.*, 133 USPQ 242; Generic terms on the other hand is the "ultimate" in descriptiveness (*Imported Auto Parts Corp., vs. R.B. Shaller*, 202 45 PQ 235).

In determining whether a mark is generic/descriptive, the majority of the decisions of the courts in the United States, confront this question: What do buyers understand by the word for whose use the parties are contending? (*Bayer Co. vs. United Drug Co.* 272 F 505. And as the customs of Patent Appeals stated in the matter of the application of Automatic Radio Manufacturing Co. CCPA 817: "We are dealing here with the common use of languages."

Under the foregoing discussion, the following terms were declared descriptive:

1. MIRRORLIKE – for furniture, floor and automobile polish (*Mirrorlike Mfg. vs. Devce & Reynolds*, 3 Fed 2d 847)
2. NEXT TO BEER – for a malt beverage (*In RE: Central Consumer Co.*, 32 App. DC 523)
3. EASYLOAD – for tape recorders (*In Re: Sony Corp.* 176 USPQ 6)

Likewise, the following marks were held generic.

1. CONSUMER ELECTRONICS MONTHLY – a title of a magazine on electronics published monthly. (*CEZ Publishing Co. vs. St. Regis Publicators* 188 USPQ 612)
2. MULTISTATE BAR EXAMINATION – for examinations given in several states (*National Conference of Bar Examiners vs. Multistate Legal Studies Inc.* 216 USPQ 27)
3. IMPORTED AUTO PARTS – for a firm selling imported automobile parts (*Imported Auto Parts vs. Shaller and Sons*, 202 USPQ 235)

Going back to the trademark in question, it would be apparent that the mark TELEX WORLD LETTER is a generic term. It actually connotes or describes the type of service which it intends to give to the public.

In a brochure forming part of the application, the Respondent-Applicant claimed that TELEX WORLD LETTER combines the ease of TELEX, the impact of priority mail, the flexibility of cablegram at low rates. The brochure further states:

"Now, Telex World Letter allows you to send high quality letters to anyone, anywhere in the world right from your teleprint or at any Eastern Telecoms Branch."

In simple and common language, it is a service of sending letters to any part of the world through the use of TELEX machines. The mark sought to be registered as clearly generic term in so far as this particular line of service is concerned.

Generic terms are regarded by law as free for all to use. Sharing in the goodwill of an article unprotected or incapable of protection by trademarks, is the exercise of a right possessed by all, the free exercise of which by the consuming public is deeply rooted.

To grant an exclusive right to use a term generic of a service would be equivalent to creating a monopoly in that particular service, something that the trademark laws were never intended to accomplish.

WHEREFORE, premises considered, the herein Opposition is hereby SUSTAINED. Application Serial No. 60529 is hereby REJECTED, the subject matter thereof being generic of the service.

Let the filewrapper of this case be forwarded to the Trademark Examining Division for proper action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director