SOCIETE DES PRODUITS NESTLE S.A.,	)	INTER PARTES CASE NO. 3173
Opposer,	)	OPPOSITION TO:
	)	Application Serial No. 49388
	)	Filed : October 11, 1982
- versus -	)	Applicant : CFC Corporation
	)	Trademark : GOLD 45
	)	Used on : Instant coffee
	)	
	)	DECISION NO. 93-14 (TM)
	)	
CFC CORPORATION, Respondent-Applicant.	)	December 13, 1993

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DECISION

On July 14, 1988, Societe Des Produits Nestle S.A., a corporation duly organized under the laws of Switzerland, filed its Verified Notice of Opposition (Inter Partes Case No. 3173) to Application Serial No. 49388 for the trademark “GOLD 45” for instant coffee, filed by CFC Corporation of Pasig, Metro Manila, published on page 84, Volume 1, No.4, June 17, 1988 issue of the Bureau of Patents, Trademarks and Technology Transfer Official Gazette and officially released for circulation on June 17, 1988.

Opposer’s ground for Opposition is:

The registration of the mark GOLD 45 in the name of Respondent-Applicant is proscribed by Section 4(d) of Republic Act 166, as amended.

Opposer relied on the following facts to support its Opposition:

1. That the mark GOLD 45 as used on “instant coffee” is an infringement of the trademarks GOLD, GOLD BLEND and GOLD CUP of Opposer, which are registered in the Bureau of Patents, Trademarks and Technology Transfer under Certificate of Registration Nos. 33, 311, 31, 515 and 33, 315 issued on May 29, 1984 respectively.

2. That Opposer is the prior user in commerce in the Philippines of the trademark GOLD, GOLD BLEND and GOLD CUP used in respect of “coffee and coffee extracts and preparations for making coffee” since June 11, 1981.

3. That the trademark GOLD BLEND is an internationally known trademark as belonging to Opposer.

4. That the use by Respondent-Applicant of the mark GOLD 45 and its registrations thereof in its name would violate Sections 2-a and 4(d) of Republic Act No. 166, as amended, and would cause confusions in the trade or mistake or deceive purchaser.

5. That such use by Respondent-Applicant likewise falsely suggests to the purchasing business of the Opposer, or that the goods of Respondent-Applicant might be mistaken as having originated from the Opposer.

On November 4, 1988, Respondent-Applicant filed its Answer raising the following defenses:

1. That Respondent's trademark "GOLD 45" is clearly not identical or "confusingly similar" to any of Opposer's alleged trademarks "GOLD", "GOLD BLEND" and "GOLD CUP".

Except for the word GOLD (which cannot be exclusively appropriated as a trademark by any person, for being a generic name), the four marks are different in spelling, pronunciation and sound.

2. That being a generic name, the word "GOLD" cannot be exclusively appropriated as a trademark.

"No word or combination of words can be exclusively appropriated if it is merely descriptive of the particular business, or of the quality, style, character, grade or class of the goods, xxx (63 C.J., Section 43)."

"Even words which were not originally or of their own meaning descriptive terms, but which, by use, association and acceptations, have come to be the generic name for a particular kind of class of goods, and indicate that only, and not origin of ownership, are not valid trademarks (63 C.J. Section 66)."

"Application of the above fundamental rule were made by the Supreme Court in the cases of La Yebana Co. vs. Alhambra Cigar and (Cigarette Mfg., Co., 56 Phil. 106; Ong Ai Gui vs. Dir. Of Patents, L-6235, March 28, 1955; and East Pacific Merchandising Corporation vs. Dir. Of Patents, L-14377, December 29, 1960."

3. That the issuance of the Certificate of Registration No. 33311 for the mark "GOLD" and Certificate of Registration No. 33315 for the mark "GOLD CUP" appears to have been issued in the name of Opposer in this case, hence, the latter cannot invoke the same.

4. That the issuance of said Certificate of Registration No. 33311 for the word "GOLD" is obviously in violation of Section 4(e) of R.A. No. 166, as amended, and thus, its Cancellation under Section 17(c) of the same law, for being null and void, is warranted.

5. That the likelihood of causing confusion mistaking one for the other, or deceiving purchasers is not possible, contrary to the claim of Opposer.

"Confusion is likely between trademarks only of their overall presentations in any of the particulars of sound, appearance or meaning are such as would lead the purchasing public into believing that the products to which the marks are applied emanated from the same products, L-20635, March 31, 1966, 16 SCRA 495)."

6. That the trademark applied for registration by Respondent does not infringe the alleged trademarks of Opposer under the criteria set by Section 22 of the R.A. No. 166, as amended.

7. That for reasons mentioned above, the registration of the trademark "GOLD 45" in the name of Respondent is not prescribed by Section 4(d) of Republic Act No. 166, as amended contrary to Opposer's claim.

The issues to be resolved in this case are as follows:

1. Whether or not the mark GOLD is a generic name and therefore cannot be appropriated as a trademark.

2. Whether or not the issuance of Certificate of Registration No. 33311 for the word GOLD is in violation of Section 4(e) of R.A. No. 166.

3. Whether or not the mark GOLD 45 is not identical or confusingly similar to the marks GOLD, GOLD BLEND and GOLD CUP.

4. Whether or not, Societe Des Produits Nestle, S.A., being the assignee of the marks GOLD and GOLD CUP has the legal personality to bring an action for Opposition against CFC.

As to the first issue, the test of descriptiveness has been aid down in the Ex-Parte Eagle Pencil, B.C. Serial No. 1729, 45 O.G. 1955 when it was held that if the mark directs the mind of the public to the quality or characteristics of the goods with which it is used, it is clearly descriptive and not registrable; but on the other hand, if it has no other function but to direct the mind of the public to the author or owner of the goods with which it is used, it constitutes a valid trademark and is registrable.

The Respondent-Applicant in this case never presented evidence to show why the mark "GOLD" is descriptive of coffee and coffee by products. Nor could this Office find it reasonable to accept respondent's argument that "GOLD" is descriptive of coffee products which is a complete reversal of its former position that Gold is distinctive in relation to coffee hence, registrable.

In CFC Corporation, Court of Appeals et.al., G.R. No. 108590, July 9, 1993, the Supreme Court was presented with exactly the same issue. The Court in this case affirmed the decision of the Court of Appeals and the Director of Patents denying CFC's petition for cancellation of the registration for GOLD as used with coffee products. The Court ruled:

"The word "gold" which by itself originally refers to a particular valuable metal, is clearly non-descriptive, in its application to and use in respondent's coffee products."

Pursuant to the principle of stare decisis, we are bound to apply this ruling to the case at bar.

The classic examples of descriptive marks are the following:

1. STARBRITE – applied to metal polish (In Re Chas. R. Long 280 F 975)

2. SAFE T. SEAL – applied to envelopes (In Re Alva Bushnell 261 F 1013)

The mark "GOLD" in connection with coffee products is hereby reiterated to be a valid and registrable trademark.

Regarding the second issue, Section 4(e) of the Rules of Practice in Trademark Cases provides that:

"xxx. The owner of a trademark, tradename or service mark used to distinguish his goods, business or services from the goods, business or service of others shall have the right to register the same on the principal register, unless it;

(e) Consist of a mark or trade name which, when applied to or used in connection with the goods, business or services of the applicant is merely descriptive or descriptively misdescriptive of them, or when applied or used in connection with the goods, business or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, or is primarily merely a surname;

We reiterate the arguments stated above relating to the first issue where the conclusion was drawn that GOLD is not descriptive or deceptively misdescriptive of coffee.

As to the third issue, this Office finds that there is confusing similarity between the marks GOLD, GOLD BLEND and GOLD CUP and the mark GOLD 45. The question of infringement is determined by the "test of dominancy" rather than by differences of variations in the details of one trademark and of another. The rule was formulated in Co Tiong Sa vs. Director of Patents, 95 Phil. 1, 4 (1954); reiterated in Lim Hoa vs. Director of Patents, 100 Phil. 214, 216 – 217 (1956), thus:

> It has been consistently held that the question of infringement is to be determined by the test of dominancy. Similarity in size, form and color, while relevant is not conclusive. If the competing trademark contains the main or essential or dominant feature of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitations is not necessary, nor is it necessary that the infringing label should suggest on effort to imitate. [C. Neilman Brewing Co. vs. Independent Brewing Co., 191F, 489, 495, citing Eagle White Lead Co. vs. Pfleigh (cc) 180 Fed. 579]. The question at issue in cases of infringement of trademarks is whether the use of the marks involved would be likely to cause confusion or mistakes in the mind of the public or deceive purchasers (Auburn Rubber Corp. vs. Honover Rubber Co., 107 F. 2d 588; xxx.)"

The dominant feature of the competing trademarks before this Office is the word GOLD. The ordinary customer does not scrutinize the details of the label; he forgets or overlooks these, but retains a general impression, or a central figure, or a dominant characteristic, hence, notwithstanding the fact that the accessories or background of the competing marks are dissimilar, the word GOLD alone used by different manufacturers/merchants creates confusion or deception on the minds of the ordinary purchaser.

As regards the final issue, this Office finds that in view of the assignment made by Nestle Food Products, in favor of Societe Des Produits Nestle, S.A. the latter being the assignee has now the legal personality to bring an action for Opposition against CFC.

WHEREFORE, the Notice of Opposition is hereby GRANTED and accordingly, Application Serial No. 49388 filed on 11 October 1982 by CFC Corporation for the trademark "GOLD 45" is hereby REJECTED.

Let the filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision. Likewise, let a copy of this Decision be furnished the Trademark Examining Division for information and to update its records.

SO ORDERED.

IGNACIO S. SAPALO
Director