

Republic of the Philippines
SUPREME COURT
Manila

EN BANC

G.R. No. L-3952 December 29, 1953

MASSO HERMANOS, S.A., petitioner,

vs.

DIRECTOR OF PATENTS, respondent.

McClure, Salas and Gonzales for petitioner.

Assistant Solicitor General Guillermo E. Torres and Solicitor Meliton G. Soliman for respondent.

JUGO, J.:

Masso Hermanos, S.A., is the registered owner under Act No. 666 of the trademark composed of the word "Cosmopolite" used on canned fish. Said trademark was first registered and the certificate of registration No. 1881 issued therefor on March 16, 1917, by the Director of the Philippine library and museum for a period of thirty years, under the provisions of Act No. 666. A renewal of the certificate of registration was applied for and issued on June 6, 1947 by the Director of the Bureau of Commerce also under the provisions of said Act.

On June 14, 1948, the petitioner, Masso Hermanos, applied to the Director of Patents for a new certificate of registration of said trademark under the provisions of section 41 (a) of Republic Act No. 166.

A trademark examiner of the Patents Office denied the petition on the ground that the word "Cosmopolite", as a trademark for canned fish is descriptive of said goods and, therefore, could not have been legally registered as a trademark under the provisions of Act No. 666 and, consequently, is not entitled to registration under section 41 (a) of Republic Act No. 166. The petitioner appealed from said ruling to the Director of Patents on the ground that the examining officer was not authorized to re-examine certificates which were originally issued under Act No. 666 and surrendered for re-registration under section 41(a) of Republic Act No. 166. The Director of Patents affirmed the ruling of the trademark examiner; hence, the present petition for *certiorari* was filed in his court. Section 41 of Republic Act No. 166 reads as follows:

Reservation in favor of prior registration — Owners of marks or trade-names registered under the provisions of the laws in force prior hereto, the registrations of which are still subsisting under the said laws, are hereby granted the right;

(a) Within one year after the taking effect of this Act to surrender their certificates of registration and procure the issuance of new certificates in which event they shall be entitled to the benefits and subject to the provisions of this act; or

(b) Within one year before the expiration of the period for which the certificate of registration was issued or renewed the registrant may renew the registration upon filing an application therefore, as provided in section fifteen, Chapter III hereof. If said application is granted, a renewal certificate shall be issued by the Director in accordance with the provisions of This Act.

It is clear that the renewal of the registration under section 41 of Republic Act No. 166 is subject to the following requirements:

- (1) The trademark must have been registered under the old laws:
- (2) The registration must be subsisting under said laws; and *1awphil.net*
- (3) The certificate issued under the old laws must have been surrendered to the Patents Office within one year from the time Republic Act No. 166 went into effect, which was on June 20, 1947.

There is no question that the above requirements nos. (1) and (3) have been complied with by the petitioner. The question is whether the condition required under No (2) exists in favor of the petitioner.

]The respondent Director of Patents contends that the original registration of the trademark under Act No. 666 was "null and void *ab initio*" because the word "cosmopolite" is descriptive and, therefore, the registration thereunder is not subsisting.

Is the word "Cosmopolite" descriptive? Section 13 of Act No. 666 provides that — ". . . But no alleged trademark . . . shall be registered which is merely the name, quality or description of the merchandise upon which it is to be used . . . In an application for registration, the Director of the Bureau of Commerce shall decide the presumptive lawfulness of claim to the alleged trademark.'

The word "Cosmopolite" does not give the name, quality or description of the canned fish for which it is used. It does not even describe the place of origin, for it does not indicate the country or place where the canned fish was manufactured. It is a very general term which does not give the kind or quality of the goods. For example, a dealer in shoes cannot register a trademark "Leather Shoes" because that would be descriptive and it would be right to use the same words with reference to their merchandise.

The court is, therefore, of the opinion that the registration of the trademark "Cosmopolite" under Act No. 666 was valid and is subsisting. The Director of Patents should not for light and unsubstantial reasons reverse the ruling of the former officer in charge of trademark registration, which has been accepted and in force since 1917 up to the present.

In view of the foregoing, the ruling of the respondent Director of Patents is set aside and he is ordered to issue to the petitioner a new certificate of registration of the trademark in exchange for the old one No. 1881 surrendered to him on June 18, 1948. Without pronouncement as to costs.

So ordered.

Paras, C.J., Pablo, Bengzon, Padilla, Tuason, Reyes, Bautista Angelo and Labrador, JJ., concur.