

NESTLE PHILIPPINES, INC  
3202  
And SOCIETE DES PRODUITS  
NESTLE S.A.

Opposer,

- versus -

CFC CORPORATION  
Respondent-Applicant  
x-----x

INTER PARTES CASE NOS. 3200 and

OPPOSITION TO:

Application Serial No.52994

Filed : January 18, 1984

Applicant : CFC Corporation

Trademark : FLAVOR MASTER

Used on : Instant Coffee

DECISION NO. 90-47 (TM)  
December 27, 1990

### DECISION

On January 18, 1984, CFC Corporation of Pasig, Metro Manila filed under Serial No. 52994 an application for the registration of the trademark FLAVOR MASTER for "instant coffee". Having been allowed, the trademark FLAVOR MASTER was subsequently published for opposition on Page 45, Vol. 1, No. 5, of the July 18, 1988 issue of the BPTTT's Official Gazette, which was officially released for circulation to the public on the same date.

On August 15, 1988 Societe Des Produits Nestle S.A., a company organized under the laws of Swiss, domiciled in Switzerland, and having its registered head office in Vevey Canton of Vaud, Switzerland, filed an Unverified Notice of Opposition with IPC No- 3202 claiming that the aforementioned trademark is confusingly similar to its trademarks for coffee and coffee extracts, to wit: MASTER ROAST, registered under Cert. of Regn. No. 34521, issued on June 24, 1985; and MASTER BLEND, registered under Cert of Regn. No. 36027, issued on Oct. 9, 1986, both for a term of 20 years from their respective dates of issuance. On September 27, 1988 the Verified Notice of Opposition was filed.

Likewise, on the same date of August 15, 1988 Nestle Philippines, Inc., a corporation organized and existing under the laws of the Philippines with registered office in 335 Sen. Gil J. Puyat Avenue, Makati, Metro Manila, in its capacity as licensee of Societe Des Produits Nestle S.A. (see Exh. "C" of Opposer Nestle Phil., Inc.), filed a Verified Notice of Opposition docketed as IPC No. 3200 against the same Application for Regn. of the trademark FLAVOR MASTER.

After three (3) consecutive motions for extension of time to file an answer, all of which having been granted by this Office, the respondent-applicant filed its answer on October 28, 1988 wherein it claimed that the trademark FLAVOR MASTER is not confusingly similar with either trademarks MASTER ROAST or MASTER BLEND for the reason that "except for the word MASTER (which cannot be exclusively appropriated by any person for being a descriptive or generic name), the other words that are used respectively with said word in the three trademarks are very different from each other - in meaning, spelling; pronunciation, and sound." Further, with respect to Nestle Phil. Inc. it is argued that "for not being the registrant of the alleged trademarks MASTER ROAST and MASTER BLEND but is merely a licensee of Societe Des Produits Nestle S.A. in the Philippines (as alleged by opposer in its opposition), opposer has no legal personality to file the opposition".

There being an identity in the subject matter and issue involved, the Office conducted on Dec. 12, 1988 a joint pre-trial conference of IPC Nos. 3200 & 3202. The parties failed to amicably settle the dispute, thus a joint hearing on the merits ensued. After all the oral and documentary

evidences of the parties were submitted and admitted in evidence, the cases were deemed submitted for decision. The parties were then requested to file their respective memoranda.

On March 26, 1990 Nestle Philippines, Inc. and Societe Des Produits, through their common counsel, filed their joint memorandum where they reiterated their prayer for the denial of respondent-applicants application for registration of its trademark FLAVOR MASTER for the following reasons:

- 1) that the “use, if any, by respondent-applicant of the trademark FLAVOR MASTER and the registration thereof in its name would likely cause confusion in the trade, or deceive purchasers and would falsely suggest to the purchasing public a connection in the business of opposers as the dominant word present in the three (3) trademarks is “MASTER”, or that the goods of respondent-applicant might be mistaken as having originated from opposers”; and
- 2) that “respondent-applicant failed to establish and/or prove prior use in commerce of the trademark “FLAVOR MASTER” since it” ...merely marked and offered in evidence certain documents but failed to introduce any testimonial evidence in support thereof”.

Respondent-Applicant, on the other hand, filed its memorandum on May 4, 1990 reiterating the arguments and defenses it raised in its answer to the opposers' verified notices of opposition, to wit:

- “1) except for the word MASTER (which of course cannot be exclusively appropriated by any person for being a descriptive or generic name), the other words that are used respectively with said word in the three trademarks are clearly very different from each other in sound, spelling, pronunciation & meaning;
- 2) Respondent-Applicant-s trademark FLAVOR MASTER is clearly very different from any of opposer's alleged trademarks MASTER ROAST & MASTER BLEND especially when the marks are viewed in their entirety, by considering their pictorial representations, color schemes and the letters of their respective labels;
- 3) Opposers certainly cannot claim exclusivity of use to the word MASTER, the same being a descriptive or generic name;
- 4) the opposition in IPC No. 3200 should immediately be denied or dismissed, and said case dismissed for the reason that the opposer Nestle Philippines, Inc. does not have the legal personality or right to file the opposition”.

It is provided under Sec. 4(d), R.A. 166 that “the owner of a trademark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register, unless it consists of or comprises 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”.

Based on the records of the case it is clearly shown that the trademarks MASTER ROAST & MASTER BLEND are both registered marks in the Phil. in the name of Societe Des Produits Nestle S.A. But does the trademark FLAVOR MASTER so resemble the aforementioned trademarks as to be likely when, applied or used in connection with the goods of respondent-applicant CFC Corp., to cause confusion or mistake or to deceive purchasers? This Office believes it, does.

From the evidences at hand, it is sufficiently established that the word MASTER is the dominant feature of opposer's mark. The word MASTER is printed across the middle portion of the label in bold letters almost twice the size' of the printed word ROAST. Further, the word MASTER has always been given emphasis in the TV and radio commercials and other advertisements made in promoting the product. This can be gleaned from the fact that Robert Jaworski and Atty. Ric Puno, Jr., the personalities engaged to promote the product, are given the titles Master of the Game and Master of the Talk Show, respectively. In due time, because of these advertising schemes the mind of the buying public had come to learn to associate the word MASTER with the opposer's goods.

As if anticipating the above ruling of the Office, Respondent-Applicant maintains there exists glaring differences in the pictorial representations, color schemes, & letters of the contesting marks as would be sufficient to remove the trademark FLAVOR MASTER from the ambit of the prohibition provided for in Sec. 4 (d), R.A. 166. But then again, this Office believes otherwise. It is the observation of this Office that much of the dominance which the word MASTER has acquired through Opposer's advertising schemes is carried over when the same is incorporated into respondent-applicant's trademark FLAVOR MASTER. Thus, when one looks at the label bearing the trademark FLAVOR MASTER (Exh.4) one's attention is easily attracted to the word MASTER, rather than to the dissimilarities that exist. Therefore, the possibility of confusion as to the goods which bear the competing marks or as to the origins thereof is not farfetched. In the case of *Co Tiong Sa vs. Director of Patents* (95 Phil 1), it was held that "dissimilarity in size, form & color of the label and place where it is applied are not conclusive against infringement. The resemblance may so far dominate the differences as to be likely to deceive ordinary purchaser". "Where a trademark contains a dominating or distinguishing word, and purchasing public has come to know and designate the article by such dominating word, the use of such word by another in marking similar goods may constitute infringement though the marks aside from such dominating word may be dissimilar". (*Queen Mfg. Co. v. Isaac Ginsberg & Bros.*, C.C.A. Mon 25 F. 2d. 284,287)

As explained in the case of *Operators Inc. vs. Dir. of Patents* (15 SCRA 147), "The average person usually will not and often cannot take in, at a casual glance, all or even a large part of the details of what he looks at. What part or parts of two trademarks which are alleged to be similar does the average ordinary buyer see when he looks at them? What features of them are remembered by the average buyer? We do not really hear all that is spoken in our hearing. Far from all we see or hear casually is retained sufficiently clear or in sufficient detail for us to get a lasting impression of it which we can remember when we encounter the mark again. The importance of this rule (the test of dominancy) is emphasized by the increase of radio advertising in which we are deprived of the help of our eyes and must rely entirely on the ear".

Respondent also claimed that Opposer cannot appropriate exclusive use of the word MASTER because it is a descriptive or generic name. However, looking at the word MASTER in relation to the goods with which it is used, one observes that the word serves no other function than direct the mind of the public to the author or owner of the goods. It does not describe an ingredient, quality, characteristics, function, feature, purpose, use etc. of the goods to which it is applied. The question of whether or not a mark is merely descriptive must be determined not in the abstract but rather in relation to the goods or services for which registration is sought. Hence, it can constitute a valid trademark and is registrable. (in *re Bright Crest, Ltd.*, 204 USPQ 591; In *re Abcor Dev. corp.*, 200 USPQ 215; *Ex Parte Minnesota Valley Canning Co.*, 4 USPQ 48). It may be well to note that respondent-applicant, through its counsel, stated in its reply (dated March 19, 1985) to the findings/action of the Examiner-in-Charge re its application that "subject mark (FLAVOR MASTER) cannot be considered descriptive when used in connection with the particular good wherein the said mark is used. Said mark can be used with any other goods aside from coffee where it is being applied. In fact said trademark can be used on any other goods, particularly, food".

With regard to IPC No. 3200 the respondent-applicant further puts forth the argument that opposer Nestle Philippines, Inc. being a mere licensee, does not have the legal personality

or right to file the opposition. Again this argument is without merit, for it is clearly provided in Sec. 8, RA 166 that "any person who believes that he would be damaged by the registration of a mark or tradename may, upon payment of the required fee and within 30 days after the publication under the first paragraph of section seven hereof, file with the Director an opposition to the application ... "It is clear then that Ownership of trade-mark is not essential to enable user thereof to maintain opposition to registration of another trade-mark (Molave vs. Proctor & Gamble Co., 65 F2d 154). The right to oppose registration is not limited to one who possesses registered mark (Trustees for Arch Preserver Shoe Patents vs. James Mc Creevy & Co., 49 F. 2d 1068).

In view of all the foregoing, this Office finds Respondent-Applicant's trade-mark to be likely, when applied to or used in connection with the goods of Opposer, to cause confusion or mistake or to deceive purchasers. Refusal, therefore, of Respondent-Applicant's application for registration of its trademark "FLAVOR MASTER" appears to be in order.

WHEREFORE, premises considered, it is ordered that Respondent's Application. Serial No. 52994 for the registration of the trade-mark FLAVOR MASTER for use on instant coffee be, as it is, hereby refused.

Let the records of these cases be transmitted to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director