

SOCIETE DES PRODUITS NESTLE S.A.
Opposer,
- versus -

IPC 14-2007-00061

Opposition to:
TM Application No. 4-2000-007717
(Filing Date: 12 September 2000)

PT ARNOTTS INDONESIA,
Respondent-Applicant.
x-----x

TM: "GOLD'N CHEESE DESIGN"
Decision No. 2007 – 136

DECISION

This is an opposition to the registration of the mark "GOLD'N CHEESE DESIGN" bearing Application No. 4-2000-007717 filed on September 12, 2000 covering the goods falling under class 30 of the International Classification of goods which application was published in the Intellectual Property Philippines (IPP) E-Gazette and officially released on November 10, 2006.

The Opposer in the instant opposition is "SOCIETE DES PRODUITS NESTLE S.A.", a corporation organized and existing under the laws of Switzerland with business address at Vevey, Switzerland.

The Respondent-Applicant on the other hand is "PT ARNOTTS INDONESIA", with address at J.I.H. Wahab Affan No. 8 Km. 28, Raya Bekasi 17132 Jawa Barat, Indonesia.

The grounds for the opposition are as follows:

- "1. Opposer is the first to adopt, use and register worldwide including the Philippines, the "GOLD", "GOLD BLEND" and "NESTLE GOLD" trademarks and their derivatives (hereinafter referred to as "GOLD" trademarks) for coffee, coffee extracts falling under Class 30 and therefore, enjoys under from registering or using identical or confusingly similar mark such as Respondent-Applicant's trademark "GOLD'N CHEESE" for goods falling under International Class 30.
- "2. There is a likelihood of confusion between Opposer's "GOLD" trademarks and Respondent-Applicant's "GOLD'N CHEESE" because Respondent-Applicant's trademark "GOLD'N CHEESE" entirely contains the dominant portion of Opposer's "GOLD" trademarks, which is the word "GOLD" as such, when applied to or used in connection with the goods of Respondent-Applicant, cause confusion or mistake and deception on the part of the purchasing public as being a trademark owned by the Opposer, hence, the Respondent-Applicant's "GOL'N CHEESE" trademark cannot be registered in the Philippines pursuant to the express provision of Section 147.2 and 123 (e) of Republic Act No. 8293. No doubt, the use of Respondent-Applicant's "GOLD'N CHEESE" trademark for its products will indicate a connection between its products and those of Opposer's.
- "3. The Opposer's "GOLD" trademarks for goods falling under International Class 30 are well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being a trademark owned by the Opposer.
- "4. Respondent-Applicant, in adopting "GOLD'N CHEESE" for its goods, is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association with the Opposer, or as to origin, sponsorship, or approval of its goods and services by the Opposer, for which it is liable for false designation of origin, false description for representation under Section 169 of Republic Act No. 8293.

“5. Respondent-Applicant’s appropriation and use of the trademark “GOLD’N CHEESE” infringes upon the Opposer’s exclusive right to use, as registered owner its “GOLD” trademarks, which is protected under Republic Act No. 8293 particularly Section 147 thereof.

Opposer relied on the following facts to support its opposition:

“1. Opposer is the first to adopt, use and register the “GOLD” trademarks.

Opposer is the first to adopt, use and register the “GOLD” trademarks in the Philippines and worldwide. The trademark “GOLD” registered for coffee and coffee extract under Registration No. 0333111 issued on May 29, 1984. The trademark “GOLD BLEND” is registered in the Philippines under Registration No. 031515 issued on January 24, 1983 for preparation for making coffee, while the trademark “NESTLE GOLD” is registered for, among others, coffee and coffee extracts, chocolate, confectionary, sweets, sugar, bakery products pastry and foodstuffs having a base of rice, flour or of cereals under Registration No. 4-1994-094221 issued on January 14, 2000. These registrations are still valid and in force in the Philippines.

Copies of the above-mentioned Certificates of Registration are hereto attached as Exhibits “A”, “B” and “C”, respectively.

The “GOLD” trademarks are likewise registered and protected in, to name a few, the following countries:

African Union	Brunei	China	Congo
Greece	Indonesia	Italy	Nigeria
Peru	Philippines	Taiwan	Thailand
Malaysia	Australia	Argentina	Brazil
Chile	Hong Kong	Japan	Korea

A Protection List showing worldwide registrations and applications of the mark “GOLD” and “NESTLE GOLD” is attached as Exhibits “D” to “D-17”.

“2. There is a likelihood of confusing similarity between Opposer’s “GOLD” trademarks and Respondent-Applicant’s trademark “GOLD’N CHEESE.”

Respondent-Applicant’s trademark “GOLD’N CHEESE” is confusingly similar to Opposer’s “GOLD” trademarks in sound, spelling and meaning as to likely to cause confusion.

Respondent-Applicant is similar in sound and spelling since Respondent-Applicant entirely reproduced and adopted Opposer’s “GOLD” trademarks in its “GOLD’N CHEESE” trademark. In meaning, the mark, the marks “GOLD”, “GOLD BLEND” and “NESTLE GOLD” connote superior or excellent quality. Although the letter “N” and the word “cheese” are added to Respondent-Applicant’s mark, this does not rule out the similarities between the subject marks especially since Opposer’s “GOLD” trademarks has several derivatives such as “GOLD BLEND”, “GOLD ESPRESSO”, “GOLD FINESSE”, “GOLD AMBIANCE” and “GOLD INTENSO”, hence, the mark “GOLD CHOICE” can be very well be mistaken as a variant of Opposer’s “GOLD” trademarks. Confusion is even made more certain since the subject marks are used for identical goods under class 30.

“3. The Opposer’s “GOLD” trademarks are internationally well-known.

The "GOLD" trademarks which Opposer herein originated and adopted for coffee are internationally well-known.

The Opposer's "GOLD" trademarks have been used, promoted and advertised for a considerable duration of time and over wide geographical areas having been in use in several countries and all over the Philippines. In 1965, Opposer launched its freeze-dried coffee range bearing the "GOLD" trademark. Since its first use, several products of the "GOLD" brand denomination have been launched. These include "GOLD WITHOUT CAFFEINE", "GOLD EXPRESSO", "GOLD FINESSE", "GOLD AMBIANCE" and "GOLD INTENSO". In the Philippines, coffee bearing the mark "GOLD" was first sold in the early 1980's. The Nestle cereals bearing the trademark "NESTLE GOLD" was first sold in the Philippines in 1998. Since its first use in the Philippines, Opposer has invested significant amount of resources in the promotion of its "GOLD" trademarks worldwide and in the Philippines.

Attached as Exhibits 'E' and 'F' to 'F-12' are actual labels and pictures of actual products bearing the trademark 'NESTL GOLD', "GOLD" and "GOLD BLEND" sold in several countries worldwide, respectively. Also attached as Exhibit "G" with sub-markings are promotional materials such as banners, clips of television commercials and newspaper and magazine advertisements used in the Promotion of the "GOLD" trademarks. Also attached as Exhibit "H" is the affidavit of Mr. Gregorio Tongko Jr., Brand Manager of Nestle Philippines, Inc., to show the use and promotion of Opposer's well-known products bearing the "GOLD" trademark.

- "4. The use of Respondent-Applicant's trademark "GOLD'N CHEESE" would indicate a connection with the goods and services covered in Opposer's "GOLD" marks, hence, the interests of the Opposer are likely to be damaged.

Respondent-Applicant's products are clearly identical to Opposer's products covered by its "GOLD" trademarks. Undoubtedly, the use of Respondent-Applicant's trademark "GOLD'N CHEESE" definitely misleads the public into believing that its goods originate from, or are licensed or sponsored by Opposer or that Respondent-Applicant is associated with or affiliate of the Opposer.

Respondent- Applicant has appropriated the trademark "GLD'N CHEESE" for the obvious purpose of capitalizing upon or riding on the valuable goodwill and popularity of the "GOLD" trademarks which Opposer gained through tremendous effort and expense over a long period of time. This clearly constitutes an invasion of Opposer's intellectual property rights.

The use by Respondent-Applicant of "GOLD'N CHEES" will dilute the distinctiveness of Opposer's "GOLD" trademarks.

The use, sale and distribution by the Respondent-Applicant of goods bearing the "GOLD'N CHEESE" trademark is inflicting considerable damage to the interest of the Opposer. To allow Respondent-Applicant to register "GOLD'N CHEESE" will constitute a mockery of our laws protecting intellectual property rights; it will legitimize its unfair and unlawful business practice.

The Opposer submitted the following as its evidence in support of its opposition:

Exhibit	Description
Exhibit "A"	Certificate of Registration No. 4-1994-094221 issued On January 14, 2000 for the mark "NESTLE GOLD."
Exhibit "B"	Certificate of Registration No. 31515 issued

	On January 24, 1983 for the mark "GOLD BLEND."
Exhibit "C"	Certificate of Registration No. 33311 issued On May 29, 2004 for the mark "GOLD"
Exhibit "D" to "D-17"	Protection List showing registrations and applications Of the marks "GOLD" and "NESTLE GOLD".
Exhibit "G"	Promotional materials with sub-markings.
Exhibit "H"	Affidavit of Mr. Gregorio Tongko Jr.

On the other hand, Respondent-Applicant did not submit any evidence in support of its trademark application subject of the instant opposition. In fact, it failed to file its verified Answer to the Notice of Opposition.

Records will show that the Bureau of Legal Affairs issued Order No. 2007-694 dated 27 April 2007 pursuant to the Motion for Time filed by Respondent-Applicant through counsel, given thirty (30) days or until May 22, 2007 within which to file its verified Answer to the Notice of Opposition. This Order was sent on May 9, 2007 to the Respondent-Applicant's counsel.

Despite receipt of the Order, Respondent-Applicant did not file the required Answer, together with the affidavit of its witness and other documents in support of its application, hence, the same is considered WAIVED.

Section 11 the Summary Rules (Office Order No. 79, Series of 2005) provides:

Section 11. Effect of failure to file an Answer. – In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

The only issue to be resolved in the instant opposition is:

WHETHER OR NOT THE RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK "GOLD'N CHEESE DESIGN".

The Applicable provisions of law is, Section 123 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, which provides:

"Sec. 123. Registrability. – 123.1 A mark cannot be registered if it:

X X X

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

The trademarks of the parties are reproduced below for comparison and for better appreciation.

Visual appreciation of the Opposer's marks as shown in the certificate of registrations submitted, clearly noticeable is the presence of the word 'GOLD.'

On the other hand, the Respondent-Applicant's mark consists of the word "GOLD'N CHEESE".

It is worthy to emphasize that the word "CHEESE" was disclaimed and that there was no design contained therein, hence, what is actually sought to be registered is the word "GOLD'N".

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. (87 C.J.S., pp. 288-291) Some factors as "sound, appearance; form, style shape, size or format; color, ideas connoted by the marks; the meaning, spelling and pronunciation of the words appear "may be considered (87 C.J.S., pp. 291-292) For indeed, trademark infringement is a form of unfair competition. (Clarke vs. Manila Candy Co., 36 Phil. 100, 106; Co Tiong Sa vs. Director of Patents, 95 Phil. 1, 4)

Confusion is likely between trademarks only if their over-all presentation 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 source.

In the present case, the competing trademarks are almost the same or identical. The word "GOLD" is present on both marks. Their distinction lies with the presence of the letter "N" at the end portion of Respondent-Applicant's mark. Another distinction is the manner of display of the Respondent-Applicant's mark. However, these minor dissimilarities are not significant as there is still confusing similarity between the competing marks.

One vital point to be taken into consideration is the fact that Opposer's marks are registered with the Intellectual Property Philippines (IPP) bearing Registration No. 4-1994-094221 issued on January 14, 2000 (Exhibit "A"), Registration No. 31515 issued on January 24, 1983 (Exhibit "B") and Registration No. 33311 issued on My 29, 2004 (Exhibit "C", and that the goods or products covered by the competing mark fall under the same class 30 of the International Classification of goods.

Being confusingly similar, the consuming public, particularly the unwary consumers will be deceived, confused and mistaken into believing that the goods of the Respondent-Applicant come from or are authorized by the Opposer.

It is truly difficult to understand why, of the million of terms and combination of letters and designs available, the Respondent-Applicant had to choose exactly the Opposer's mark and "GOLD" adding only the letter "N" at the end portion, if there was no intent to take advantage of the goodwill of the Opposer's marks.

In connection with the use of confusingly similar or identical marks, both foreign authority and our Supreme Court on several occasions ruled that:

"Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty on the English language or paucity of signs, symbols, numerals etc., as to justify one who really wishes to distinguish his products from those of all others entering the twilight zone of a field already appropriated by another."
(Weco Products Co., vs. Milton Ray Co., F, 2d, 985, 32 C.C.P.A. Patents 1214)

As previously stated, Opposer registered the trademarks "NESTLE GOLD", "GOLD BLEND" and "GOLD" for goods falling under class 30 of the International Classification of goods and prior actual commercial use thereof had been established (Exhibit "H") affidavit of Mr. Gregorio T. Tongko Jr., paragraph 6, the Brand Manager of Nestle Philippines, Inc., and Exhibit "G", promotional materials, magazines and advertisements.

In *Chuanchow Soy & Canning Co., vs. The Director of Patents and Rosario Villapanat* (G.R. No. L-13947, June 30, 1960) the Supreme Court ruled:

“When two competing labels are placed together for inspection and still they may confuse an ordinary person, specially cooks and maids, who as a rule are the ones in charge of buying such household article as soy sauce, there would be more confusion and doubt when the two labels are not placed together for comparison and prospective purchaser is guided only by his memory or collection that the soy sauce he or she is planning to buy has its label the drawing of a fish with letters and Chinese characters, within in a certain style of lettering and color. When one applies for the registration of a trademark or label which is almost the same or very 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 is 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. There should be no halfway measures, as when an examiner of the office of the Director of Patents directs an applicant to amend or modify the label or trademark he sought to register by eliminating some portions thereof.”

WHEREFORE, with all the foregoing, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, application bearing Serial No. 4-2000-007717 for the mark “GOLD’N CHEESE DESIGN” filed on September 12, 2000 by “PT ARNOTTS INDONESIA” is hereby REJECTED.

Let the filewrapper of “GOLD’N CHEESE DESIGN” subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 27 September 2007.

ESTRELITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office