

SOCIETE DES PRODUITS NESTLE S.A.	}	IPC No. 14-2002-00056
Opposer,	}	Opposition to:
	}	Serial No. 103377
-versus-	}	Date Filed: 13 October 1995
	}	Trademark: "NESFOODS
DOLORES D. RAMOS,	}	AND BIRD DESIGN HAVING
Respondent-Applicant.	}	TWO STRAIGHT LINES"

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Decision No. 2005 – 16

DECISION

This is an opposition to the application for registration of the trademark "NESFOODS AND BIRD DESIGN HAVING TWO STRAIGHT LINES" bearing Serial No. 103377 filed on 13 October 1995 by the Respondent-Applicant, Dolores D. Ramos for Repacked Sugar.

The Opposer, Soceite Des Produits Nestle S.A., is a foreign corporation organized under the laws of Switzerland while the Respondent-Applicant, Dolores D. Ramos is a resident of No. 6 Susano Rd., Novaliches Proper, Novaliches, Quezon City.

On October 13, 1995, Respondent-Applicant filed an application for registration of its trademark "NESFOODS AND BIRD DESIGN HAVING TWO STRAIGHT LINES" with the then Bureau of Patent, Trademarks and Technology Transfer (not Intellectual Property Office), which trademark application was assigned Serial No. 103377, for repacked sugar.

After examination and allowance of publication, it was published for opposition on page 40 of IPO Official Gazette, Volume V, Number 4 which was officially released for circulation on August 5, 2002. Believing that it will be damaged and prejudiced by the registration of "NESFOODS AND BIRD DESIGN HAVING TWO STRAIGHT LINES", Opposer filed its verified Notice of Opposition based on the following grounds:

- "1. The Opposer is the first to adopt, use and register the trademarks "NESTLE", "NESTLE BELOW NEST DEVICE" AND "NESTLE BELOW NEST DEVICE IN FRAME" for a whole range of products falling under international classes 5, 29, 30 and 32 in the Philippines and therefore enjoys under Section 147 of Republic Act (R.A.) No.8293 the right to exclude others from registering or using an identical or confusingly similar mark such as Respondent-Applicant's trademark "NESFOODS AND BIRD DESIGN" for repacked sugar.
- "2. There is a likelihood of confusing similarity between Opposer's trademarks, "NESTLE", "NESTLE BELOW NEST DEVICE" AND "NESTLE BELOW NEST DEVICE IN FRAME" for goods falling under classes 5, 29, 30 and 32 and Respondent-applicant's trademark "NESFOODS AND BIRD DESIGN" for repacked sugar because it nearly resembles Opposer's trademarks in sound, spelling and appearance. Opposer's trademarks and Respondent-Applicant's trademark cover products which are related (Section 123 [d], R.A. No. 8293) and/or falling under the same class.
- "3. The Opposer's trademarks "NESTLE", "NESTLE BELOW NEST DEVICE" AND "NESTLE BELOW NEST DEVICE IN FRAME" 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 trademarks owned by the Opposer, hence, even assuming for the sake of argument that the products of Respondent-Applicant and Opposer are not

related or similar, the Respondent-Applicant's trademark "NESFOODS AND BIRD DESIGN" cannot be registered in the Philippines pursuant to the express provision of Section 147.2 of R.A. No. 8293. There is no doubt that the use of Respondent-Applicant's trademark "NESFOODS AND BIRD DESIGN" for repacked sugar would indicate a connection between such good and the Opposer. Likewise, the interests of the Opposer are likely to be damaged by Respondent-Applicant's use of the trademark "NESFOODS AND BIRD DESIGN" for repacked sugar.

- "4 The Respondent-Applicant, by using "NESFOODS AND BIRD DESIGN" as her trademark for repacked sugar, has given Respondent-Applicant's sugar product the general appearance of the Opposer's products, which would be likely to influence purchasers to believe that the 'NESFOODS AND BIRD DESIGN' repacked sugar product is that of the Opposer of its thereby deceiving the public and defrauding the Opposer of its legitimate trade hence, she is guilty of unfair competition as provided in Section 168.3 of R.A. No. 8293."

On March 23, 2003, upon motion of the Opposer the Respondent-Applicant was declared for failure to file the required answer within the reglementary period. Hence, Opposer was allowed to present its evidence ex-parte.

On June 30, 2003, Opposer presented its witness, Mr. Dennis Barot, manager for Corporate Affairs for Nestle Philippines, local license of Opposer, personally testified in support of the Opposer.

On August 29, 2003, Opposer filed its written Formal Offer of Evidence consisting of Exhibits "A" to "Q-5".

The Issues

Record shows that Respondent-Applicant's filed its application on October 13, 1995 and remained pending when Republic Act No. 8293 took effect on January 1, 1998. Record also reveals that the application was prosecuted under Republic Act No. 166, the law governing this instant controversy pursuant to Sec. 235.2 of Republic Act No. 8293, to wit:

"235.2. All applications for registration of marks or trade names pending in the Bureau of Patents, Trademarks and Technology Transfer at the effective date of this Act may be amended, if practicable to bring them under the provisions of this Act. The prosecution of such applications so amended and the grant of registrations thereon shall be proceeded with in accordance with the provisions of this Act. If such amendments are not made, the prosecutions of said applications shall be proceeded with and registrations thereon granted in accordance with the Acts under which said application were filed, and said Acts hereby continued in force to this extent for this purpose only, notwithstanding the foregoing general repeal thereof." (underscoring supplied)

And under Section 4 of Republic Act No. 166, or the Trademark law as amended, it states that:

"Sec. 4. *Registration of trademark, trade names and service marks on the principal register.* – There is hereby established a register of trademarks, trade names and service

marks which shall be known as the principal register. The owner of the trademark, trade name and service mark used to distinguish his goods, business or services from the goods, business and services of others shall have the right to register the same on the principal register unless it:

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(d) Consist or comprises a mark or trade name which so resembles 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 service of the applicant, to cause confusion or mistake or deceive purchasers.”

The foregoing provision of law prescribes a stringent standard that a mark should be refused registration not only if it will actually cause confusion but also if it is likely to cause confusion or mistake or deceive purchasers.

Hence, the question in this case is whether is a likelihood that the “NESFOODS AND BIRD DESIGN” may cause confusion or mistake or may deceive purchasers as to the origin or source of the product on which the mark is used. In other words the issue is whether the trademark “NESFOODS AND BIRD DESIGN HAVING TWO STRAIGHT LINES” is confusingly similar to the trademarks “NESTLE”, “NESTLE BELOW NEST DEVICE” AND “NESTLE BELOW NEST DEVICE IN FRAME”.

The issue of likelihood of confusion or confusing similarity typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services on which the mark is use. Others factors may be considered only if relevant evidence is contained in the record.

There is no point into a long analysis regarding the identical or confusing similarity of the two marks. A visual graphic representation of the competing marks is the best argument for one or the other and the best evidence as to whether there is a confusing similarity in the contesting trademarks. (Phil. Nut Industry, Inc. vs. Standard Brands Inc., 65 SCRA 575) hence, for comparison we are reproducing below Opposer’s registered marks, introduced in evidence as Exhibit “D to D-4” and “G to G-2” and Respondent-Applicant mark filed with the then Bureau of Patents, Trademarks and Technology Transfer (BPTTT);



Opposer’s mark introduce as Exhibit “G to G-3”



Opposer’s mark introduce as Exhibit “D to D-4”



Respondent-Applicant's mark as filed
with the then BPTTT

The contesting trademarks when compared in their entireties in terms of appearance, sound, connotation and commercial impressions have a number of similarities. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. (*Sealed Air Corp., vs. Scott Paper Co.*, 190 USPQ 106) Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. (*In re National Date Corp.*, 224 USPQ 749)

Opposer's marks are "NESTLE BELOW NEST DEVICE" AND "NESTLE BELOW NEST DEVICE IN FRAME", a designation which, on this record appears to be wholly arbitrary as applied to the relevant goods on which the mark is use. This Office finds that Opposer's and Respondent-Applicant's mark are composite marks consisting of the prefix "NES" and "BIRD" device. We find that the likelihood of confusion is inevitable even if there is difference in suffixes.

The suffix "FOODS" in Respondent-Applicant's mark will not avoid confusion because the word are less likely to be remembered as they merely described Respondent-Applicant's product. The illustration of a "Bird" in Respondent-Applicant's mark reinforces the dominance of the arbitrary designation "NESTLE" which is the prior user and owner of the bird device. Therefore, because Respondent-Applicant's mark shares with Opposer's mark that element responsible for creating its over-all commercial impression, the marks are confusingly similar.

In *MARVEX COMMERCIAL CO. VS. PETRA HAW PIA (18 SCRA 1178)*, the Supreme Court held that "LIONPAS" and "SALONPAS" for medicated plaster were confusingly similar both words having the same suffix "PAS". Also, in *OPERATORS, INC. VS. THE DIRECTOR OF PATENTS (15 SCRA 47)*, the Court affirmed the similarities in appearance and sound between the marks "AMBISCO" and "NABISCO" for bakery goods, in the same way it held that the marks "LUSOLIN" and "SAPOLIN" were considered confusingly similar in sound when applied to paint products on merchandise of the same descriptive properties, in the case of *SAPOLIN VS. BALMACEDA (67 PHIL. 705)*.

Moreover, as testified to by Opposer's sole witness, Atty. Dennis Barot, sugar and specific products of which sugar is a necessary ingredient and/or complement, such as milk, infant cereal, tea and tea extracts, cream, ice cream and the like, have been imported, manufactured and distributed in the Philippines bearing the trademarks "NESTLE", "NESTLE BELOW NEST DEVICE" AND "NESTLE BELOW NEST DEVICE IN FRAME" since the early 1900sxxx", hence Respondent-Applicant's mark is considered confusingly similar especially when applied to sugar which is a necessary ingredient and/or complement of Opposer's products.

In sum, this Office finds that Respondent-Applicant's mark and Opposer's marks, when viewed in their entirety, are quite similar in terms of appearance, sound and connotation, and that they create essentially identical overall commercial impressions.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Application bearing Serial No. 103377 for the trademark "NESFOODS AND BIRD DESIGN HAVING TWO STRAIGHT LINES" for REPACKED SUGAR filed by DOLORES D. RAMOS is as it is hereby, REJECTED.

Let the filewrapper of "NESFOODS AND BIRD DESIGN HAVING TWO STRAIGHT LINES" subject matter of this case be forwarded to the Administrative, Financial and Human Resources Development Services Bureau for appropriate action in accordance with this Decision with a copy thereof to be furnished the Bureau of Trademarks for information and to update their records.

SO ORDERED.

Makati City, September 05, 2005.

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