



OFFICE OF THE DIRECTOR GENERAL

CADBURY UK LIMITED,
Applicant-Appellant,

Appeal No. 4-2011-0017

-versus-

Application No. 4-2006-008133

Date Filed: 26 July 2006

**DIRECTOR OF THE BUREAU
OF TRADEMARKS,**
Respondent-Appellee.

Trademark: CADBURY DAIRY MILK

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DECISION

Cadbury UK Limited (“Appellant”) appeals the decision¹ of the Director of the Bureau of Trademarks (“Director”) sustaining the final rejection of the Appellant’s application to register the mark “CADBURY DAIRY MILK”.

Records show that the Appellant filed on 26 July 2006 Trademark Application No. 4-2006-008133 seeking to register CADBURY DAIRY MILK for use on chocolates, non-medicated confectionery, biscuits, cakes, wafers, ice cream, chilled and frozen confections. Subsequently, the Examiner-in-Charge (“Examiner”) issued Paper No. 02² stating that the words “DAIRY” and “MILK” cannot be registered and should be disclaimed for being descriptive of the kind and other characteristics of the goods.

The Appellant filed a response³ claiming that its mark is distinctive. The Appellant averred that even if its mark is considered to be descriptive, CADBURY DAIRY MILK has acquired a secondary meaning. The Appellant maintained that it was given a certificate of registration for this mark in 1989. However, according to the Appellant, it was unable to maintain the registration for failing to locate its file on this mark.

The Examiner reiterated her objection that “MILK” and “DAIRY” cannot be registered and ruled that this mark is likely to mislead the public as the Appellant’s mark gives the impression that the goods covered is “MILK” when in truth it is “CHOCOLATE”.⁴ The Appellant, however, argued that CADBURY DAIRY MILK is a composite mark and that the prospective purchaser of its products would be aware

¹Dated 01 July 2011.

²Mailing date of 05 March 2007.

³Letter dated May 04, 2007

⁴Paper Nos. 04, 06, 08, 10, 11, 14, 16, 18, 21.

that this mark which has been around since 1905 refers to a chocolate bar. The Appellant maintained that its mark has acquired a secondary meaning.⁵

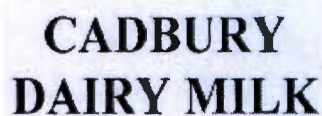
On 04 January 2010, the Examiner issued a “FINAL REJECTION”⁶ of the Appellant’s trademark application which the Appellant appealed to the Director on 05 March 2010. On 01 July 2011, the Director rendered the decision affirming the final rejection of the Appellant’s application to register CADBURY DAIRY MILK.

The Appellant filed on 03 August 2011 an “APPEAL MEMORANDUM” citing its arguments in the Bureau of Trademarks that this Office in 1989 had issued a certificate of registration for CADBURY DAIRY MILK. The Appellant asserts that its mark is not misleading or deceptive, but is a composite mark that has already acquired a secondary meaning.

The Director submitted a “COMMENT” on 26 August 2011 contending that the descriptive words “Dairy” and “Milk” cannot be registered as trademarks and that the Appellant failed to show evidence and sufficient proof to support the claim that its mark has acquired a secondary meaning.

The issue in this appeal is whether the Director was correct in sustaining the final rejection of the Appellant’s application to register CADBURY DAIRY MILK.

Below is an illustration of the Appellant’s mark:



The image shows the text "CADBURY DAIRY MILK" in a bold, serif font, centered within a light blue rectangular background.

The mark is composed of three words namely, “CADBURY” which is derived from the Appellant’s name, “DAIRY” which refers to an establishment or a place where milk or cream is made or kept, and “MILK” which pertains to an opaque white or bluish-white liquid secreted by the mammary glands of female mammals, serving for the nourishment of their young or any liquid resembling this.⁷

Sec. 121.1 of Rep. Act No. 8293 known as the Intellectual Property Code of the Philippines (“IP Code”) provides that a mark is any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods. CADBURY DAIRY MILK is, therefore, a visible sign that can be considered a mark under the provision of Sec.

⁵ Filewrapper for Trademark Application No. 4-2006-008133.

⁶ Paper No. 23 mailed on 08 January 2010.

⁷ Ibid.

121.1 of the IP Code. The Examiner, however, was correct in issuing Paper No. 02 and requiring the Appellant to disclaim the words "DAIRY" and "MILK" in the trademark application.

Sec. 126 of the IP Code states that:

SEC. 126. Disclaimers.- The Office may allow or require the applicant to disclaim an unregistrable component of an otherwise registrable mark but such disclaimer shall not prejudice or affect the applicant's or owner's rights then existing or thereafter arising in the disclaimed matter, nor such shall disclaimer prejudice or affect the applicant's or owner's right on another application of later date if the disclaimed matter became distinctive of the applicant's or owner's goods, business or services.

In this case, the Appellant is seeking the registration of CADBURY DAIRY MILK which would entitle it to the exclusive right to use this mark on the goods covered by its trademark application. However, the words "DAIRY" and "MILK" are generic terms which cannot be registered. The words "DAIRY" and "MILK" constitute the common descriptive name of an article or substance. These terms comprise the genus of the particular specie of a product or are commonly used as the name or description of a kind of goods. They imply reference to every member of a genus and the exclusion of individuating characters. Therefore, these terms are not legally protectable.⁸

The reason for this is because generic words are considered to be in the public domain and free for all to use. To allow an individual or an entity to register a generic term would give the registrant the exclusive right to use this term to the prejudice of others who are engaged in the production or manufacture of a similar class of products and who are using the same generic words in similar trade or services.

In the related case of *Ong Ai Gui alias Tan Ai Gui vs. The Director of The Philippines Patent Office*,⁹ the Supreme Court of the Philippines held that:

The import of the decision is that the trade name may be registered, but applicant-appellant may not be entitled to the exclusive use of the terms "shirts factory" and "nylon" as against any other who may subsequently use the said terms, for the latter are merely descriptive or general terms, *juris publici*, incapable of appropriation by any single individual to the exclusion of others. This is supported by reason and authority.

⁸See *Societe Des Produits Nestle, S.A. and Nestle Philippines, Inc. vs. Court of Appeals and CFC Corporation*, G.R. No. 112012, 04 April 2001.

⁹G. R. No. L-6235, 28 March 1955.

The Examiner issued an official action for the Appellant to disclaim the generic words "dairy" and "milk". However, the Appellant did not disclaim these words and instead maintained that its mark has acquired a secondary meaning.

The Appellant's position is not tenable. The doctrine of secondary meaning allows the registration of a descriptive mark which has become distinctive as provided for in Sec. 123.2 of the IP Code.¹⁰ However, "DAIRY" and "MILK" are generic terms and, therefore, the doctrine of secondary meaning is not applicable.

This Office is vested with the function to examine applications for registration of marks.¹¹ The Appellant submitted to this Office its trademark application for CADBURY DAIRY MILK. The function to determine whether this trademark application can be registered includes the authority of this Office to order the applicant to disclaim matters which this Office deems to be generic and which are not subject to exclusive appropriation.


WHEREFORE, premises considered, the appeal is hereby DISMISSED. The Appellant is hereby ordered to disclaim the words "DAIRY" and "MILK" in Trademark Application No. 4-2006-008133.

Let a copy of this Decision as well as the trademark application and records be furnished and returned to the Director of the Bureau of Trademarks. Let a copy of this Decision be furnished also the library of the Documentation, Information and Technology Transfer Bureau for its information and records purposes.

SO ORDERED.

AUG 10 2012

Taguig City


RICARDO R. BLANCAFLOR
Director General

¹⁰ Sec. 123.2 of the IP Code provides that:

123.2. As regards signs or devices mentioned in paragraphs (j), (k), and (l), nothing shall prevent the registration of any such sign or device which has become distinctive in relation to the goods for which registration is requested as a result of the use that have been made of it in commerce in the Philippines. The Office may accept as prima facie evidence that the mark has become distinctive, as used in connection with the applicant's goods or services in commerce, proof of substantially exclusive and continuous use thereof by the applicant in commerce in the Philippines for five (5) years before the date on which the claim of distinctiveness is made.

¹¹ Sec.5.1(b) of the IP Code.