



OFFICE OF THE DIRECTOR GENERAL

CALIFORNIA TABLE GRAPE
COMMISSION,

Appellant,

-versus-

DIRECTOR OF THE BUREAU OF
TRADEMARKS,

Appellee.

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Appeal No. 04-2011-0016

Application No. 4-2006-003217

Date Filed: 21 March 2006

Trademark: GRAPES FROM
CALIFORNIA &
DESIGN

DECISION

CALIFORNIA TABLE GRAPE COMMISSION ("Appellant") appeals the decision of the Director of the Bureau of Trademarks ("Director") sustaining the final rejection of the Appellant's application to register the mark "GRAPES FROM CALIFORNIA & DESIGN".

Records show that the Appellant filed on 21 March 2006, Trademark Application No. 4-2006-003217 for GRAPES FROM CALIFORNIA & DESIGN for use on grapes. The Examiner-in-Charge ("Examiner") issued a "REGISTRABILITY REPORT"¹ stating that the mark may not be registered because it consists exclusively of signs or of indications that may serve in trade to designate the kind and geographical origin of the goods.

The Appellant submitted on 19 February 2007 a "RESPONSIVE ACTION" stating that it is disclaiming the use of the words "GRAPES" and "CALIFORNIA" taken separately, apart from the mark as shown. The Appellant claimed that its grape design is not an accurate illustration of grapes but, an abstract, stylized, and fanciful design that is suggestive of grapes. The Appellant maintained that its mark consists of symmetrical, diamond-shaped design formed around one central circle. According to the Appellant, the registration of its mark is supported by numerous registrations for similar fruit designs in connection with fruit-related goods and services where the design was considered sufficiently abstract.

Subsequently, the Examiner issued a "FINAL REJECTION"² stating that the Appellant's mark cannot be registered because it consists exclusively of sign or of indications that may serve in trade to designate the kind and geographical origin of the goods. On 23 September 2008, the Appellant appealed to the Director the final

¹ Paper No. 3 with mailing date of 21 December 2006.

² Paper No. 5 with mailing date of 28 July 2008.

rejection of the trademark application. The Director denied the appeal and sustained the final rejection of the Appellant's trademark application.

Not satisfied, the Appellant appealed to this Office the final rejection of GRAPES FROM CALIFORNIA & DESIGN³ contending that its mark is distinctive. The Appellant maintains that its "GRAPE DESIGN" is not an accurate illustration of grapes but, an abstract, stylized, and fanciful design that is suggestive of grapes. The Appellant claims that its mark consists of a symmetrical, diamond-shaped design formed around one central circle. According to the Appellant, the suggestion of a stem or leaf appears at the top of the design and that the overall design does not accurately depict the way grapes actually look. The Appellant argues that the registrability of its mark is further supported by the existence of numerous registrations for similar fruit designs in connection with fruit-related goods and services where the design was considered sufficiently abstract. The Appellant further posits that a survey conducted in the Philippines in 2009 shows that 81% of the consumers of the goods have seen and are familiar with the Appellant's mark. The Appellant also contends that it has disclaimed the word "California" and that this Office has allowed the registration of marks containing the term "Grape" and the "GRAPE DESIGNS".

The Director filed her "COMMENT" on 15 August 2011 contending that the Appellant's mark cannot be registered because it is descriptive and indicates a geographical origin. According to the Director, although the terms "Grapes" and "California" were disclaimed by the Appellant, the grape design is still descriptive of the goods. Regarding the Appellant's arguments that there are registered marks in this Office containing the term "Grape" and the grape designs, the Director maintains that each case must stand on its own merits.

The issue in this case is whether the Director was correct in sustaining the final rejection of the Appellant's mark GRAPES FROM CALIFORNIA & DESIGN.

Below is an illustration of the Appellant's mark:



In this regard, Sec. 123.1 (j) of the Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it:

³ The Office received a copy of the "APPEAL MEMORANDUM" on 30 June 2011.

(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time, or production of the goods or rendering of the services, or other characteristics of the goods or services;

Accordingly, signs or indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods cannot be registered. All persons have an equal right to produce and vend similar articles and describe them properly and to use any appropriate language or words for that purpose. No person can appropriate exclusively any word or expression, properly descriptive of the article, its qualities, ingredients, or characteristics, and thus limit other persons in the use of language appropriate to the description of their manufactures, the right to the use of such language being common to all.⁴

In this case, GRAPES FROM CALIFORNIA & DESIGN is a descriptive mark which indicates the nature and geographical origin of Appellant's products. The Appellant's mark immediately conveys to the consuming public the characteristics of the products. The consumers are readily informed that the product refers to grapes from California. The Appellant's mark cannot, therefore, be registered because the registration would allow the Appellant to use exclusively and prevent other persons from using the terms "grapes from California"

As correctly pointed out by the Director:

A word or a combination of words which is merely descriptive of an article of trade, or of its composition, characteristics, or qualities, cannot be appropriated and protected as a trademark to the exclusion of its use by others inasmuch as all persons have an equal right to produce and vend similar articles, they also have the right to describe them properly and to use any appropriate language or words for that purpose, and no person can appropriate to himself exclusively any word or expression, properly descriptive of the article, its qualities, ingredients or characteristics, and thus limit other persons in the use of language appropriate to the description of their manufactures, the right to the use of such language being common to all. ([52 Am. Jur. 542-543] as cited in the case of *Asia Brewery Inc. vs. Court of Appeals and San Miguel Corporation*, G. R. 103543.⁵

The Appellant's contention that its mark is suggestive is not tenable. In the case of *Societe Des Produits Nestle, S.A. and Nestle Philippines, Inc. vs. Court of Appeals and CFC Corporation*,⁶ the Supreme Court of the Philippines held that:

Suggestive terms are those which, in the phraseology of one court, require "imagination, thought and perception to reach a conclusion as to the nature of the goods." Such terms, "which subtly connote something about the product," are eligible for protection in the absence of secondary meaning. While suggestive marks are capable of shedding "some light" upon certain characteristics of the goods or services

⁴ See *Ong Ai Gui Alias Tan Ai Gui v. Director of the Philippines Patent Office*, G. R. No. L-6235, 28 March 1955 citing 52 Am. Jur. 542-543.

⁵ COMMENT, dated 11 August 2011, pp. 5-6.

⁶ G.R. No. 112012. April 4, 2001.

in dispute, they nevertheless involve "an element of incongruity," "figurativeness," or "imaginative effort on the part of the observer."


In the present case, the Appellant's use of GRAPES FROM CALIFORNIA & DESIGN would not require the purchasing public or the consumers to exercise their powers of perception or imagination to determine the Appellant's goods. Rather, and in pain of redundancy, this mark describes to the purchasing public the nature, characteristics, and geographical origin of the Appellant's goods. Accordingly, this Office finds no need to address the other arguments raised by the Appellant.

WHEREFORE, premises considered, the appeal is hereby DISMISSED. The Appellant's Trademark Application No. 4-2006-003217 for GRAPES FROM CALIFORNIA & DESIGN is hereby rejected.

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.

OCT 15 2012 Taguig City


RICARDO R. BLANCAFLOR
Director General