



OFFICE OF THE DIRECTOR GENERAL

SOCIETE DES PRODUITS NESTLE,  
S.A.,

Appellant,

-versus-

DIRECTOR OF THE BUREAU OF  
TRADEMARKS,

Appellee.

X-----X

Appeal No. 04-2011-0013

Application No. 4-2008-012958

Date Filed: 21 October 2008

Trademark: ENERGIZES BODY  
& MIND

DECISION

SOCIETE DES PRODUITS NESTLE S.A. ("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 "ENERGIZES BODY & MIND".

Records show that the Appellant filed on 21 October 2008 Trademark Application No. 4-2008-012958 for ENERGIZES BODY & MIND for goods<sup>1</sup> falling under Classes 29, 30, and 32 of the Nice Classification.<sup>2</sup> The Examiner-in-Charge ("Examiner") issued a "REGISTRABILITY REPORT"<sup>3</sup> 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 intended purpose and other characteristics of the goods. According to the Examiner, the arrangement of words "ENERGIZES BODY & MIND" readily denotes the intended purpose and other characteristics of the goods covered

<sup>1</sup>Class 29 - Milk-based preparations and beverages; milk substitutes; milk-based and cream-based desserts; yoghurts

Class 30 - Coffee, coffee extracts, coffee-based preparations and beverages; iced coffee; coffee substitutes, extracts of coffee substitutes, preparations and beverages based on coffee substitutes; chicory; tea, tea extracts, tea-based preparations and beverages; iced tea; malt-based preparations; cocoa and cocoa-based preparations and beverages; breakfast cereals; cereal bars; ready-to-eat cereals; cereal preparations; chocolate, chocolate-based preparations and beverages; confectionery, candy, sweets, biscuits, cakes, cookies, wafers, ice cream, products for the preparation of ice cream

Class 32 - Non-alcoholic beverages and preparations for making non-alcoholic beverages (except essential oils); malt-based beverages; isotonic beverages

<sup>2</sup>The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

<sup>3</sup> Paper No. 03 with mailing date of 04 December 2008.

Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center, 28 Upper McKinley Road, McKinley Hill Town Center  
Fort Bonifacio, Taguig City 1634 Philippines

T: +632-2386300 • F: +632-5539480 • www.ipophil.gov.ph

by the mark, which lacks distinctiveness and is proscribed under Sec. 123.1 (j) of Republic Act No. 8293 ("IP Code").<sup>4</sup>

On 07 April 2009, the Appellant submitted a response that its mark does not denote the intended purpose and other characteristics of the goods covered by the mark and that the mark is merely suggestive when applied to or used in connection with the goods/services under Classes 29, 30, and 32. The Appellant averred that the Supreme Court has consistently ruled that suggestive marks are distinctive and can be registered.

Subsequently, the Examiner issued a "FINAL REJECTION"<sup>5</sup> stating that the Appellant's mark cannot be registered because this mark is incapable of functioning as trademark and Sec. 123.1(j) prohibits the registration of a mark which consists exclusively of signs or of indications that may serve in trade to designate the intended purpose and other characteristics of the goods.

On 19 August 2009, the Appellant appealed to the Director the final rejection of the trademark application. On 18 March 2011, the Director issued a decision denying the appeal and sustaining the final rejection of the Appellant's application to register ENERGIZES BODY & MIND.

Not satisfied, the Appellant appealed to this Office and sought the reversal and setting aside of the decision of the Director. The Appellant reiterates its claim that ENERGIZES BODY & MIND does not denote the intended purpose and other characteristics of the goods covered by this mark and that this mark is merely suggestive.

On 21 June 2011, the Director filed her "COMMENT" contending that:

"Even if re-examined, a cursory reading of the subject mark will show that the phrase "ENERGIZES BODY & MIND" immediately informs the purchasing public of a desirable characteristic of the goods it identifies: that it is intended to energize the body and mind. As the goods involved are food products, the use of the descriptive phrase "ENERGIZES BODY & MIND" constitutes as puffing or directly telling the public of a desirable characteristic of the food products the applicant-appellant is selling.

In this case, the descriptive nature of the subject mark is so direct that the public need not even exercise additional power of perception or imagination for them to figure out what the subject mark intended to convey. As such it is considered an indication of the intended purpose or a desirable characteristic of the product, hence, descriptive and unregistrable under trademark law."

---

<sup>4</sup> Paper No. 05 with mailing date of 02 March 2009.

<sup>5</sup> Paper No. 07 with mailing date of 09 June 2009.

The issue in this appeal is whether the Director was correct in sustaining the final rejection of the Appellant's application to register the mark ENERGIZES BODY & MIND.

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

(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 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.<sup>6</sup>

In this case, ENERGIZES BODY & MIND is a descriptive mark which indicates the characteristics of the Appellant's products like milk substitutes, coffee, coffee-based preparations and beverages, and non-alcoholic beverages. By using this mark, the Appellant conveys to the consuming public the nature and characteristics of these products. The consumers are readily informed that the product serves to energize the body and mind. There is no need for the purchasing public to imagine the products or services of the Appellant for the mark itself illustrates and gives the idea of the intended purpose of these products.

The Appellant cannot, therefore, register ENERGIZES BODY & MIND. Otherwise, the Appellant would have the exclusive right to use these descriptive terms on the goods covered by its trademark application. Other persons would be barred from using these descriptive terms on similar goods or related items which have the same characteristics. This is not the rationale for registering a trademark. A mark must be a visible sign that distinguishes a goods or services of an enterprise.<sup>7</sup> ENERGIZES BODY & MIND does not distinguish the Appellant's products but only describes them.

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*,<sup>8</sup> the Supreme Court of the Philippines held that:

---

<sup>6</sup> 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.

<sup>7</sup> See Sec. 121.1 of the IP Code.

<sup>8</sup> G.R. No. 112012. April 4, 2001.

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 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 ENERGIZES BODY & MIND would not require the purchasing public or the consumers to exercise their powers of perception or imagination to determine the Appellant's goods. Rather, this mark describes to the purchasing public the nature and characteristics of the Appellant's goods.

WHEREFORE, premises considered, the appeal is hereby DISMISSED. The Appellant's Trademark Application No. 4-2008-012958 for ENERGIZES BODY & MIND 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