



**DEL MONTE FRESH PRODUCE
INTERNATIONAL INC.,**

Opposer,

-versus-

DEWEY LIMITED,

Respondent-Applicant.

X-----X

IPC No. 14-2009-00146

Opposition to:

Appln. Serial No. 4-2008-006733

Date Filed: June 06, 2008

TM: "DEL MONTE FRESCO"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2013 - 164 dated August 08, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 08, 2013.

For the Director:


Atty. EDWIN DANILO A. DATING

Director III

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DEL MONTE FRESH PRODUCE
INTERNATIONAL INC.,

Opposer,

- versus -

DEWEY LIMITED,
Respondent-Applicant.

IPC NO. 14 – 2009- 000146

Case Filed on: 04 June 2009

Opposition to:

Appln Serial No. 42008006733

Date filed: 06 June 2008

TM: “DEL MONTE FRESCO”

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DECISION NO. 2013 - 164

DECISION

DEL MONTE FRESH PRODUCE INTERNATIONAL INC. (Opposer)¹, filed an opposition to Trademark Application No. 4-2008-006733 on 04 June 2009. The application filed by DEWEY LIMITED (Respondent-Applicant)², covers the mark “DEL MONTE FRESCO” for “non-alcoholic fruit juice / beverages” under Class 32 of the International Classification of Goods.³

The Opposer’s pertinent allegations in its Opposition are quoted as follows:

- “1. Del Monte Fresh Produce International Inc. is a marketer and distributor of high quality fresh fruit, vegetable and produce products produced and/or sourced by affiliated companies under common ownership and control. Del Monte Fresh Produce International Inc., together with its affiliated companies under common ownership and control, distributes and markets its fresh products worldwide under the DEL MONTE brand.
- “2. Del Monte Corporation is the original owner and licensor of the DEL MONTE trademarks (the “Marks”), including the most prominent and ubiquitous Marks consisting of the brand name DEL MONTE and the brand logo



¹ A corporation organized under the laws of Liberia with registered office at Canon’s Court, 22 Victoria Street, P.O. Box HM 1179, Hamilton HM EX, Bermuda.

² A corporation organized and existing under the laws of the Bermuda with address at Clarendon House No. 2, Church Street, Hamilton, Bermuda, HMCX.

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

as well as all permutations thereof such as DEL MONTE FRESCO, DEL MONTE GOLD, DEL MONTE DOLCE, DEL MONTE ROSE and DEL MONTE HONEY GOLD, and retains that status throughout most of the world.

- "3. On December 5, 1989, Del Monte Corporation licensed to Wafer Ltd., an affiliated company of Del Monte Fresh Produce International Inc. under common ownership and control, the perpetual, exclusive, royalty-free rights to use the Marks in connection with all fresh fruit, fresh vegetable and fresh produce products (the "Fresh Products") all over the world under that certain agreement hereinafter referred to as Wafer License Agreement, a true copy of which is attached hereto and incorporated herein by reference as ANNEX 1 to the attached Affidavit of the Corporate Secretary of Del Monte Fresh Produce International Inc. This occurred in connection with Del Monte Corporation's then sale of its fresh produce business, assets and operations to the Del Monte Fresh Produce organization of which Wafer Ltd. and Del Monte Fresh Produce International Inc. are both part. Wafer Ltd. has since assigned its right under the Wafer License Agreement, the rights of Del Monte Fresh Produce International Inc. to all the Marks in relation to Fresh Products are superior to the rights of Del Monte Corporation itself, its assignees and all others.
- "4. Since the execution of Wafer License Agreement, Del Monte Fresh Produce International Inc. has used from time to time in commerce in the Philippines the Marks DEL MONTE, DEL MONTE GOLD and as



trademarks and the Marks DEL MONTE FRESH PRODUCE and DEL MONTE FRESH FRUIT as tradenames in connection with Fresh Products to the exclusion of all other unaffiliated parties. Under Article 8 of the Paris Convention, a trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

- "5. On January 24, 1991, Del Monte Corporation assigned its rights to the Marks in the Philippines to Dewey Limited, subject to the rights of Del Monte Fresh Produce International Inc., as assignee, under the Wafer License Agreement, in accordance with that certain agreement hereinafter referred to as the Dewey Assignment Agreement explicitly acknowledged and agreed that its right under the Dewey Assignment Agreement are subordinate to the rights of Del Monte Fresh Produce International Inc., as assignee, under the Wafer License Agreement pursuant to that certain agreement dated January 24, 1991 between Del Monte Corporation and Dewey Limited hereinafter referred to as the

Dewey Assumption of Obligations Agreement, a true copy of which is attached hereto and incorporated herein by reference as Annex 2 to the attached Affidavit of the Corporate Secretary of Del Monte Fresh Produce International Inc. By virtue of the Wafer License Agreement and its priority over the Dewey Assignment Agreement pursuant to the Dewey Assumption of Obligations Agreement, the rights of Del Monte Fresh Produce International Inc. to the Marks in relation to Fresh Products are superior to the rights of Dewey Limited.

- “6. On April 3, 2008, Del Monte Fresh Produce International Inc. and Dewey Limited entered into that certain agreement hereinafter referred to as the Recordal Agreement, a true copy of which is attached hereto and incorporated herein by reference as ANNEX 3, for the purpose of formally documenting in the Philippines the perpetual, exclusive, royalty-free rights of Del Monte Fresh Produce International Inc. to the Marks in connection with Fresh Products under the Wafer License Agreement. Following the execution of the Recordal Agreement, the Marks DEL MONTE DOLCE, DEL MONTE HONEY GOLD and DEL MONTE ROSE, which are permutations of the principal Mark DEL MONTE, were registered (or in the case of DEL MONTE ROSE pending registration) in the Philippines in Class 31 on behalf and for exclusive benefit of Del Monte Fresh Produce International Inc. under Registration Nos. 4-2005-09996 and 4-2006-010715 and Application No. 4-2009-003708, respectively.
- “7. On or about February 23, 2009, Del Monte Fresh Produce International Inc. learned that Dewey Limited had filed on June 6, 2008 an application to register DEL MONTE FRESCO together with the brand logo for DEL MONTE depicted above for fruit juices and beverages (the “Application”), which Application was published for opposition on or about February 6, 2009.
- “8. On or about February 27, 2009, Dewey Limited was requested on behalf of Del Monte Fresh Produce International Inc. to withdraw the Application on the grounds that: (a.) “fresco” is the Spanish Word for “fresh” in the context of food and is used specifically to indicate that a particular food items is fresh and not altered by processing; (b.) Dewey Limited’s use of “DEL MONTE FRESCO” to market and promote fruit juices and beverages, which are often sold as “fresh”, is tantamount to marketing and promoting fresh fruit products; and (c.) Dewey Limited is prohibited, by virtue of the Wafer License Agreement and the Dewey Assumption of Obligations Agreement, from marketing and promoting any fruit, vegetable and/or produce products as “fresh” Dewey limited is fully aware that the use of DEL MONTE FRESCO on non-alcoholic fruit juices/beverages will create confusion among consumers, who are likely to be misled into believing that such products are fresh fruit products if such products are, in fact, not fresh fruit products and that, either way, such products are being marketed and distributed by the company with legal rights to use the Marks in connection with Fresh Products.
- “9. Based on foregoing, Dewey Limited should not be permitted to repudiate and breach its own agreement by adopting and attempting to

use the mark DEL MONTE FRESCO on non-alcoholic fruits juices/beverages.

The Opposer provides the following grounds to support its Opposition:

- “1. The registration of the trademark DEL MONTE FRESCO in the name of the Applicant will violate Section 37 of Republic Act No. 166, Section 123.1 (e) of the Intellectual Property Code, Article 6b of the Paris Convention for the Protection of Industrial Property and Article 16 of the Agreement on Trade Related Aspect of Intellectual Property Rights. Applicant’s appropriation of DEL MONTE FRESCO as a mark is also an infringement of Opposer’s trade names DEL MONTE FRESH PRODUCE and DEL MONTE FRESH FRUIT, which are protected against appropriation by others under Section 165 of the Intellectual Property Code and Article 8 the Paris Convention which states that “a tradename shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.” By reason of applicant’s exclusive rights over the marks for all Fresh Products, Applicant is prohibited from using of the word “fresh” (or its equivalent in other languages) when used in conjunction with DEL MONTE for the promotion and sale of fruit, vegetable and produce products.
- “2. The registration and use by Applicant of the trademark DEL MONTE FRESCO will diminish the distinctiveness and dilute the goodwill of the Marks DEL MONTE GOLD, DEL MONTE DOLCE, DEL MONTE ROSE and DEL MONTE HONEY GOLD, DEL MONTE FRESH PRODUCE and DEL MONTE FRESH FRUIT, which are well-known trademarks for pineapples, bananas and other fresh fruit products associated by Filipino consumers with Opposer. In appropriating the marks DEL MONTE FRESCO, Applicant seeks to ride on the popularity and goodwill earned by Opposer’s mark among Filipino consumers.
- “3. Applicant’s unlawful and unauthorized appropriation of the mark DEL MONTE FRESCO is a clear breach of its obligation under the Dewey Assumption of Obligations Agreement and the Recordal Agreement.
- “4. Applicant adopted the trademark DEL MONTE FRESCO on identical or related goods with the obvious intention of misleading the public into believing that its goods bearing the trademark originate from, or are licensed or sponsored by Opposer, which has been identified in the trade and by consumers as the source of goods bearing the trademarks and trade names DEL MONTE GOLD, DEL MONTE ROSE and DEL MONTE HONEY GOLD, DEL MONTE FRESH PRODUCE and DEL MONTE FRESH FRUIT. Applicant’s unlicensed appropriation of the mark DEL MONTE FRESCO (FRESCO being the equivalent of FRESH) is calculated to cause confusion and mistake on the part of consumers and to create the misleading and false representation among them that products bearing the mark DEL MONTE FRESCO are the same as those originating from and commercially sold by Opposer.
- “5. The approval of Applicant’s trademark DEL MONTE FRESCO is based on Applicant’s misrepresentation that it is the true owner and first user of the trademark, when in fact the Applicant has only copied it from

Opposer's own trademarks and trade names DEL MONTE FRESH FRUIT, which have acquired international renown in numerous countries around the world where bananas, pineapples and other fresh fruit products are commercially sold.

- "6. The registration of the trademark DEL MONTE FRESCO in the name of the Applicant is contrary to other provisions of the Intellectual Property Code and the Civil Code in that Applicant's registration of the mark DEL MONTE FRESCO is an actionable breach of its contractual commitment under the Dewey Assumption of Obligations Agreement and the Recordal Agreement. Given the fact that Del Monte Fresh Produce International Inc. has exclusive rights in perpetuity from December 5, 1989 in all areas of the world, including the Philippines to promote and sell fresh fruit, fresh vegetable and fresh produce products, its terms must be fully respected since under Article 36 of the Civil Code, "the contracting parties may establish such stipulations, clauses, terms and conditions as they may deem convenient, provided they are not contrary to law, morals, good customs, public order, or public policy.

This Bureau issued a Notice to Answer and received by the Respondent-Applicant on 25 June 2009. Respondent-Applicant filed its answer on 23 October 2009.

The pertinent allegations in the Respondent-Applicant's Answer are as follows:

- "19. Based on documents, Del Monte Corporation ("DMC") was the predecessor-in-title of Respondent-Applicant Dewey Limited. DMC was the owner of all right, title and interest throughout the world of the DEL MONTE trademarks for products that are in the processed and fresh foods fields. The processed field includes non-alcoholic fruit juice drinks / beverages in class 32. The non-processed foods or fresh foods field specifically refers to fresh fruit, fresh vegetables, and fresh produce in class 31.
- "20. It is apparent from the agreement stated hereunder that Opposer was only licensed to use the DEL MONTE trademarks of Respondent-applicant for goods in class 31 for "fresh fruit, fresh vegetables, and fresh produce." Respondent-applicant, as licensor of Opposer, was expressly granted the right to license the Del Monte trademarks to third parties to cover goods other than those belonging to class 31, such as the goods covered by the opposed mark DEL MONTE FRESCO AND DEVICE in class 32 for "non-alcoholic fruit juices/beverages." As licensor, Respondent-applicant retains the ownership of the Del Monte trademarks.
- "21. Under an Agreement dated December 05, 1989 entered into DMC and Wafer Limited, (hereinafter referred to as "Wafer License"), DMC granted Wafer Limited the perpetual, exclusive, royalty-free right and license to use the trademarks DEL MONTE and the DEL MONTE SHIELD DESIGN as depicted in the registrations and applications listed in Exhibit A of the Wafer License, for fresh fruit, fresh vegetables and fresh produce (THE PRODUCTS) in class 31, excluding those products that are excluded in the said Agreement. In specified countries and

territories worldwide, with the exception of Bophuthatswana, South Africa, Namibia (South West Africa), Transkei, and Venda.

21.1 Articles I and II of the Wafer License provide:

x x x

ARTICLE I DEFINITIONS

- 1.1 "LICENSED TRADEMARKS" as used herein means the trademark "DEL MONTE" plus any design or logotype, in any and all forms, as well as any and all of the trademarks, applications for registration of trademarks, and trademark registrations listed in Exhibit A attached hereto.
- 1.2 "THE PRODUCTS" as used herein means the products identified in Exhibit B.
- 1.3 "LICENSED GOODS" as used herein means THE PRODUCTS sold under the LICENSED TRADEMARKS.

x x x

ARTICLE II. GRANTS TO LICENSEE AND RELATED MATTERS

2.1 Subject only to the NAJ Agreement, LICENSOR hereby grants the LICENSEE a perpetual, exclusive, royalty-free right and license to use the LICENSED TRADEMARKS (a) on or in connection with the production, manufacture, sale, and distribution of THE PRODUCTS in the LICENSED TERRITORY, and (b) as part of the tradenames or corporate names identified in Exhibit D to be used by entities located and operating only in the territories indicated in Exhibit D solely in connection with all aspects of the business relating to THE PRODUCTS, and not other products or services.

x x x

21.2 Under Article II, Section 2.2 of the Wafer License, it is expressly stated that the LICENSED TRADEMARKS are the sole and exclusive property of the Licensor. More importantly, the Licensor Del Monte Corporation expressly retained all rights to license third parties to use its licensed Trademarks in connection with the production, manufacture, sale and distribution of goods other than fresh fruits, fresh vegetables, and fresh produce in Class 31, to wit.

x x x

ARTICLE II. GRANTS TO LICENSEE AND RELATED MATTERS.

x x x

2.2 The parties acknowledge and agree that the LICENSED TRADEMARK are the sole and exclusive property of LICENSOR except as otherwise provided herein and subject to the terms and conditions stated in this Agreement. Subject to any security interest in the LICENSED TRADEMARKS that

LICENSOR may grant to LICENSEE, **LICENSEE shall not challenge LICENSOR's ownership of the LICENSED TRADEMARKS. LICENSOR expressly retains all rights to license third parties to use the LICENSED TRADEMARKS in connection with the production, manufacture, sale and distribution of goods other than THE PRODUCTS.**

x x x

(underscoring and emphasis supplied)

21.3 Finally, Exhibit B of the same agreement, which defines what THE PRODUCTS are, provides:

EXHIBIT B

THE PRODUCTS are **fresh fruit, fresh vegetables, and fresh produce**, and shall include, but not be limited to, any products which are currently being sold by the Business **but shall exclude any products which have been heat treated or sterilized for the purpose of rendering such products shelf-stable. THE PRODUCTS shall also exclude frozen vegetables, frozen produce and frozen fruit**, except to the extent permitted below. **THE PRODUCTS shall also include (a) refrigerated fresh vegetables and refrigerated fresh produce, (b) cut non-refrigerated fresh fruit, cut fresh vegetables (whether or not refrigerated) and cut fresh produce (whether or not refrigerated) and (c) any combination of items described in (a) and (b).**

In addition, THE PRODUCT shall also include:

- (a) on a non-exclusive basis, (1) pineapple concentrates and purees and (2) fruit concentrates and purees, so long as in the case of clause (2) only, such concentrates and purees are produced from surplus fruit (as defined below), provided that, in the case of clauses (1) and (2), such concentrates and purees shall be sold as bulk commodities and not as retail products;
- (b) on an exclusive basis, refrigerated pineapple products (including but not limited to peeled, cored, cut or diced pineapple) and refrigerated Non-Utilized Fruit (as defined below) (including fruit salad) so long as, in the case of such Non-utilized Fruit only, it is or is produced from such surplus fruit; and
- (c) on an exclusive basis, frozen pineapple products (including but not limited to peeled, cored, cut or diced pineapple) for sale only to industrial or food service institutional accounts, and frozen Non-Utilized Fruit, so long as such pineapple products and Non-Utilized Fruit are or are produced from surplus fruit;

xxx

provided further that the packaging and labeling of (A) any containers holding such concentrates, purees, pineapple products (whether refrigerated or frozen) or Non-Utilized Fruit (whether refrigerated or frozen) when sold in each case, as bulk commodity (but not when sold as other than a bulk commodity) and any related documents and materials and (B) any individual containers holding such frozen pineapple products (but not the cartons holding such containers) may not in any way use any of the LICENSED TRADEMARKS or the "Del Monte" name, except that the "Del Monte" name may be used in the form permitted under Exhibit D as part of the corporate name of the seller thereof and then only if (X) an affiliate of Polly Peck International plc. (including but not limited to Subsidiaries (as defined in the Stock Purchase Agreement)) is the manufacturer of such concentrates, purees, pineapple products, or Non-Utilized Fruit, (Y) such affiliate of Polly Peck International plc. is identified as manufacturer and (Z) no part of the corporate name is given greater prominence than any other part of the corporate name.

As used in the Exhibit, "surplus fruit" means fruit that was either (a) grown on a plantation that is owned managed or controlled by the Licensee or its affiliate or (b) contracted for purchase by the Licensee or its affiliate, in each case for sale as fresh fruit, but which has not been sold as fresh fruit.

xxx

(emphasis supplied)

"22. On January 24, 1991, Del Monte Corporation ("DMC") granted, conveyed, and assigned to Respondent-applicant Dewey Limited ("DL") all its rights to the licensed Trademarks. Section 2 (a) of the Assumption of Obligations Agreement provides:

x x x

2. Effective upon the execution and delivery of the Intellectual Property Transfer Agreement,

(a) DMC hereby grants, convey and assigns top DL all of DMC's rights under the License Agreement with respect to the Intellectual Property x x x

"23. Under the Trademark Assignment dated January 24, 1991 between Assignor DMC and Assignee Respondent-Applicant, DMC granted conveyed and assigned to Respondent-Applicant all its rights to the Assigned Trademarks.

x x x

NOW THEREFORE, for good and valuable consideration receipt of which is hereby acknowledged ASSIGNOR does hereby assign unto ASSIGNEE, subject to the security agreement set forth on Schedule 1 hereto, subject to the deeds of assumption of obligations and charge by way of security set forth on Schedule 2 hereto x x x, and subject to the assumption

agreements set forth on Schedule 3 hereto x x x, all right, title and interest in the Philippines and to the Assigned Trademarks, together with the goodwill of the business symbolized by the marks and the applications for registration and registrations thereof. ASSIGNOR hereby accepts assignment of the Assigned Trademarks.

x x x

(emphasis supplied)

“24. On March 18, 2008, Respondent Applicant entered into a Trademark License Agreement, with Opposer Del Monte Fresh Produce International Inc. Under the Trademark License Agreement, Respondent applicant granted Opposer the license to use Respondent applicant’s trademark DEL MONTE DOLCE, DEL MONTE ROSE, DEL MONTE HONEY GOLD, DEL MONTE GOLD, DEL MONTE and DEL MONTE DESIGN in class 31 for “fresh fruit, fresh vegetables, and fresh produce” in the Philippines.

x x x

“26. The present Opposition is clearly without factual or legal bases. As discussed above, the Del Monte Trademarks subject of the Wafer License executed between Del Monte Corporation and Wafer Limited (Opposer’s predecessor-in-title) as well as the Trademark License Agreement executed between Respondent-applicant and Opposer do not include DEL MONTE FRESCO. More importantly, these agreements refer only to “fresh fruit, fresh vegetables, and fresh produce” in class 31. They do not cover processed foods under class 32, namely: “non-alcoholic fruit juices/beverages”, the goods covered by the opposed trademark DEL MONTE FRESCO AND DEVICE.

“27. Contrary to Opposer’s contention, Respondent-applicant’s mark DEL MONTE FRESCO AND DEVICE in class 32 for “non-alcoholic fruit juices/beverages” is not misleading as to the nature, quality, characteristics or geographical origin of the goods it seeks to cover since FRESCO is susceptible to a variety of meanings.

27.1 When one delves into the definition of the word FRESCO, one would find the following meanings:

Fresco (fres’kō) x x x 1 The art of painting on a surface of plaster, esp. while the plaster is still moist. 2. A picture so painted. x x x

27.2 Even the Spanish to English translation of the word FRESCO shows that FRESCO has different translations, such as: cool; fresh; refreshing; wet; cheeky; forward; loose; coolness; art; and soft drink.

27.3 Although the English translation of the word FRESCO may include “fresh”, the following are the meanings of the word “fresh”:

Fresh (fresh) xxx 1 Newly made, obtained, received, etc.: fresh coffee; fresh footprints. 2. Additional; further: fresh supplies. 3.

Not salted, pickled, smoked, etc. 4. Not spoiled, stale, musty, etc.
5. Not faded, worn, etc.: fresh colors. 6. Not salt: fresh water. 7.
Pure; refreshing: fresh air, 8. Appearing healthy or youthful. 9.
Not fatigued; active. 10. Inexperienced; unsophisticated. 11
Meteorol. Moderately rapid and strong: a fresh breeze. 12 Having
renewed supply of milk: said of a cow that has recently calved. x
x x

(underscoring supplied)

27. 4 Given that Respondent-applicant's mark DEL MONTE FRESCO AND DEVICE covers non-alcoholic fruit juice drinks / beverages, which are cool, refreshing, new and not spoiled or stale, then it is not likely to mislead the public as to the nature, quality and characteristics of its goods " non-alcoholic fruit juices/beverages."

27.5 Moreso, because all license of the DEL MONTE trademarks have the strict obligation to meet the quality standards and specifications of the products bearing the DEL MONTE marks as provided hereunder, the products in class 32 will certainly be new and not spoiled or stale beverages. Article 4.1 (a) on Quality Control states, to wit:

ARTICLE IV. QUALITY CONTROL

4.1 (a) LICENSEE will not sell THE PRODUCTS under any of the LICENSED TRADEMARKS pursuant to the grant of Paragraph 2.1 a) that shall fail to comply with (i) quality standards and specifications, including labeling specifications, employed by Licensor in commerce prior to the EFFECTIVE DATE, or where no such standards and specifications exist, a level of quality comparable to the quality standards generally accepted for other leading competitive brands of the same product in the same markets from time to time; or (ii) a level of quality comparable to that which may be adopted by LICENSOR for its or its other licensees' products. Prior to or contemporaneously with LICENSEE's first commercial sale of LICENSED GOODS which were not sold by LICENSOR prior to the EFFECTIVE DATE, LICENSEE shall provide with written notice of its introduction of such LICENSED GOODS and the markets in which LICENSED GOODS will be sold.

x x x

"28. Besides, even if one of the meaning of the word FRESCO is "fresh" as stated above, the word "fresh" is not even capable of exclusive appropriation as a trademark or a trade name as it is a descriptive word. Section 123.1 (j) of R.A. 8293, states:

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

x x x

- (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;

“29. Respondent-applicant did not violate Section 37 of Republic Act No. 166, Section 165 of the Intellectual Property Code, and Article 8 of the Paris Convention on trade names.

29.1 The words “fresh produce” and “fresh fruit” which are part of Opposer’s trade names, are generic, Section 123.1 (h) of R.A. 8293, states:

Section 123.1. A mark cannot be registered if it:

x x x

(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify:

x x x

29.2 Hence, even if the words “fresh”, fresh produce, or “fresh fruit” are present in Opposer’s trade names, the words “fresh”, “fresh produce”, or “fresh fruit” are not capable of exclusive appropriation by Opposer.

“30. Respondent-applicant did not also violate Section 123.1 (e) of the Intellectual Property Code, Article 6Bis of the Paris Convention for the Protection of Industrial Property, and Article 16 of the Agreement on Trade Related Aspects of Intellectual Property Rights.

30.1 Opposer failed to prove that its trade names DEL MONTE FRESH PRODUCE and DEL MONTE FRESH FRUIT are well-known trademarks or trade names in the Philippines and internationally, in accordance with Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames and Marked or Stamped Containers, which enumerates the criteria that should be taken into account in determining whether a marks is a well-known mark, thus:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of the use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the right in the mark;
- (k) the outcome of litigation dealing with the issue of whether the mark; and
- (l) the presence or absence of identical or similar trademark validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his trademark is a well-known trademark.

30.2 If at all, the only part of Opposer's names or mark DEL MONTE FRESH PRODUCE and DEL MONTE FRESH FRUIT that may be considered well-known is the distinctive mark and name DEL MONTE. The word Fresh Produce and Fresh Fruit are merely generic and/or descriptive.

"31. The registration and use by the Respondent-applicant of the trademark DEL MONTE FRESCO will not diminish the distinctiveness and dilute the goodwill of the Marks DEL MONTE DOLCE, DEL MONTE ROSE, DEL MONTE HONEY GOLD, DEL MONTE GOLD, DEL MONTE and DEL MONTE DESIGN, and it is definitely not an attempt by Respondent-applicant to ride on the alleged popularity goodwill earned by "Opposer's" Marks among Filipino consumers. By its own admission, Opposer only uses the Licensed Marks in the Philippines from time to time. If anyone has established, built and developed goodwill over the DEL MONTE trademarks in the Philippines, it is Respondent-applicant, through its licensee DEL MONTE PHILIPPINES, INC., which has been continuously using the DEL MONTE marks for products in classes 29, 30, and 32 in the Philippines, and has successfully garnered leading and substantial market share for its products bearing the DEL MONTE trademarks.

On 6 November 2009, the Opposer filed its Reply. Subsequently, the Respondent-Applicant filed its Rejoinder on 21 November 2009. After the termination of preliminary conference, the parties submitted their respective position papers.

The Opposer 's submitted the evidence consist of the following:

1. Verified and duly authenticated Notice of Opposition of the trademark application (Annex "A");
2. Notarized and duly authenticated Affidavit of Mr. Luis Gomez (Annex "B");
3. Wafer License Agreement (Annex "B-1");
4. Assumption of Obligation Agreement (Annex "B-2");
5. Recordal Agreement / Trademark License Agreement (Annex "B-3");
6. Notarized and duly authenticated Special Power of Attorney in favor of its counsel, (Annex "C").

The Respondent-Applicant submitted the following documentary evidence:

1. IPO database print-out of DEL MONTE DOLCE with Trademark Application No. 4-2005-009996 (Exhibit 1)
2. IPO database print-out of DEL MONTE ROSE with Trademark Registration No. 4-2005-010732 (Exhibit 2)
3. IPO database print-out of DEL MONTE HONEY GOLD with Trademark Application No. 4-2006-010715 (Exhibit 3)
4. IPO database print-out of DEL MONTE GOLD with Trademark Application No. 4-1998-006405 (Exhibit 4)
5. Wafer License Agreement dated December 5, 1989 between Del Monte Corporation and Wafer Limited (Exhibit 5)

6. Assumption of Obligation Agreement dated January 24, 1991 between Del Monte Corporation and Respondent-Applicant Dewey Limited (Exhibit 6)
7. Trademark Assignment dated January 24, 1991 between Assignor Del Monte Corporation (DMC) and Assignee Respondent-Applicant Dewey Limited. (Exhibit 7)
8. Trademark License Agreement dated March 18, 2008 between Respondent-Applicant Dewey Limited and Opposer Del Monte Fresh Produce International Inc. (Exhibit 8)
9. Opposer's letter of February 25, 2009, requesting Respondent-Applicant Dewey Limited to withdraw its trademark application for DEL MONTE FRESCO with Trademark Application No. 4-2008-006733 (Exhibit 9)
10. Label of Respondent-Applicant's DEL MONTE and SHIELD DEVICE mark evidencing use of the mark in the Philippines for fruit cocktail in class 29 (Exhibit 10)
11. Label of Respondent-Applicant's DEL MONTE and SHIELD DEVICE mark evidencing use of the mark in the Philippines for pineapple chunks in class 29 (Exhibit 10-1)
12. Label of Respondent-Applicant's DEL MONTE and SHIELD DEVICE mark evidencing use of the mark in the Philippines for crushed pineapple in class 29 (Exhibit 10-2)
13. Label of Respondent-Applicant's DEL MONTE and SHIELD DEVICE mark evidencing use of the mark in the Philippines for pineapple tidbits in class 29 (Exhibit 10-3)
14. Label of Respondent-Applicant's DEL MONTE and SHIELD DEVICE mark evidencing use of the mark in the Philippines for pineapple slices in class 29 (Exhibit 10-4)
15. Label of Respondent-Applicant's DEL MONTE and SHIELD DEVICE mark evidencing use of the mark in the Philippines for spaghetti sauce in class 30 (Exhibit 11)
16. Label of Respondent-Applicant's DEL MONTE and SHIELD DEVICE mark evidencing use of the mark in the Philippines for tomato sauce in class 30 (Exhibit 11-1)
17. Label of Respondent-Applicant's DEL MONTE and SHIELD DEVICE mark evidencing use of the mark in the Philippines for pasta in class 30 (Exhibit 11-2)
18. Label of Respondent-Applicant's DEL MONTE and SHIELD DEVICE mark evidencing use of the mark in the Philippines for pineapple juice in class 32 (Exhibit 12)
19. Label of Respondent-Applicant's DEL MONTE and SHIELD DEVICE mark evidencing use of the mark in the Philippines for fruit juice drink in class 32 (Exhibit 12-1)
20. Certification of the Managing Director of the Nielsen Company (Philippines), Inc. of the Market Share in the Philippines of Del Monte Philippines, Inc. for Canned Fruits in class 29 for the period of September 2008 – August 2009 (Exhibit 13)
21. Certification of the Managing Director of the Nielsen Company (Philippines), Inc. of the Market Share in the Philippines of Del Monte Philippines, Inc. for Ready-to-Drink Canned Juice in class 32 for the period of September 2008 – August 2009 (Exhibit 13-1)
22. Certification of the Managing Director of the Nielsen Company (Philippines), Inc. of the Market Share in the Philippines of Del Monte Philippines, Inc. for Spaghetti Sauce in class 30 for the period September 2008 – August 2009 (Exhibit 13-2)

23. Certification of the Managing Director of the Nielsen Company (Philippines), Inc. of the Market Share in the Philippines of Del Monte Philippines, Inc. for Tomato Sauce in class 30 for the period September 2008 – August 2009 (Exhibit 13-3)
24. Affidavit Executed by Atty. Antonio Eugenio S. Ungson (Exhibit 14)

The issue to be resolve in the instant case is whether the trademark “DEL MONTE FRESCO” should not be registered based on the following grounds:

- 1.) The registration of the subject trademark will violate the rights of the Opposer under Wafer License Agreement dated 5 December 1989 with the amendment no.1, Assumption of Obligation Agreement dated 24 January 1991, and Trademark License Agreement dated 18 March 2008.
- 2.) The registration of the subject trademark will infringe the trade name of the Opposer which is protected under Article 8 of the Paris Convention and Section 165 of the Intellectual Property Code.
- 3.) The subject trademark is confusingly similar with the Opposer’s marks and its trade names and may deceive consumers into associating Respondent-Applicant’s product with that of the Opposer’s.

On the first ground, a review of the terms of contracts executed by the parties and their predecessors-in-interest is imperative.

From a careful perusal of the Wafer License Agreement, it is explicit that the right of the Opposer, as successor of Wafer Limited is restricted only to the use of the “Licensed Trademark,” which is defined by the Wafer License Agreement as the trademarks “DEL MONTE” and “DEL MONTE” plus any design or logotype in any and all forms, as well as any and all of the trademarks, applications for registrations of trademarks and those enumerated in exhibit A. In addition, the agreement under the Trademark License Agreement dated 18 March 2008 between Respondent-Applicant and the Opposer, covers only the use of the trademarks: DEL MONTE DOLCE, DEL MONTE ROSE, DEL MONTE HONEY GOLD, DEL MONTE GOLD, DEL MONTE and DEL MONTE DESIGN.

Also, records show that the Opposer is not contesting the ownership of the Respondent-Applicant over the “DEL MONTE” Trademarks and its permutations. The only contention of the Opposer is that its right as the successor in interest of the Wafer Limited under the terms of the Wafer License Agreement should be treated superior over the ownership transfer of the Del Monte Trademarks to Respondent-Applicant.

However, this office does not agree with the Opposer. There is nothing in the submitted documents that would suggest that Opposer’s perpetual, exclusive, royalty-free rights to use the Del Monte’s Trademarks include the right to

prohibit the Respondent-Applicant from registering the Del Monte Trademark or any permutations thereof under its name or its successor in interest.⁴ In fact, even the registered Philippine trademarks subject of the previous license agreements of the herein parties or their predecessor of interest are registered under the name of the Respondent-Applicant or its predecessor in interest.⁵ Moreover, the Wafer License Agreement itself, expressly retains to the Licensor all the rights to license third parties to use the License Trademarks on other products.⁶

The Supreme Court has consistently emphasized that the essence of trademark registration is to give protection to the owners of trademarks.⁷ Consequently, in the absence of express stipulations transferring the ownership of the subject trademark or transferring the right to register it or its permutations to the Opposer, the Respondent-Applicant, as owner, can register its trademark as a matter of course. However, whether the said act of registration or the use of the said mark will violate the contractual agreement between the parties are issues that are beyond the jurisdiction of the instant inter partes proceeding.

As to the second issue, the Opposer contends that registration of the trademark "DEL MONTE FRESCO" should not be allowed as it violates the Opposer's right over its trade name as protected under Article 8 of the Paris Convention and Section 165 of the Intellectual Property Code.

The above-cited provisions are quoted as follows:

"Article 8. Trade Names. A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it form part of a trademark."

"Section 165. Trade Names or Business Names. x x x

165.2. (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

The above provisions protect trade names from unlawful act of a third party. However, the Respondent-Applicant being the owner and licensor is not the "third party" being contemplated under the Section 165.2 (a) of the IP Code. Corollarily, the Respondent-Applicant's Trademark application and use of the

⁴ Annex B-1, B-2, B-3 for the Opposer and Exhibit 5, 6, 7, 8 for the Respondent-Applicant

⁵ Exhibit 1, 2, 3, 4

⁶ Annex B-1 and Exhibit 5 p. 4

⁷ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999, citing Etepha v. Dir. of Patents, supra, Gabriel v. Perez, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. 91, of

mark applied for registration cannot be considered unlawful. Records will show that the use of the "Del Monte Fresh Produce" and "Del Monte Fresh Fruit" by the Opposer as trade name is only by virtue of the permission granted to it by the original licensor under the Wafer License Agreement and the Amendment No.1.⁸ Also, the use of the Respondent-Applicant of the subject trademark will not fall as "subsequent use" under Section 165.2 (b) of the IP Code as the trade names "DEL MONTE FRESH PRODUCE" and "DEL MONTE FRESH FRUIT" itself originated from the Respondent-Applicant's predecessor in interest. Therefore, since the right of the Opposer to use the said trade names emanates from the predecessor-in-interest of the Respondent-Applicant, the registration by Respondent-Applicant of the said trade name as a trademark in the absence of express prohibition cannot be considered as unlawful act committed by a third party under Section 165.2 (a) and (b) of the Intellectual Property Code.

Succinctly, the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; to secure to him who has been instrumental in bringing into the market a superior article of merchandise; the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁹ This Bureau finds the Respondent-Applicant's "DEL MONTE FRESCO" mark consistent with this function.

WHEREFORE, premises considered, the instant opposition to Trademark Application Serial No. 42008006733 is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 42008006733 be returned together with a copy of this DECISION to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 8 August 2013


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁸ Annex B-I and Exhibit 5

⁹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, November 19, 1999