



SOCIETE DES PRODUITS NESTLE S.A.,
Opposer,

-versus-

PUREGOLD PRICE CLUB, INC.,
Respondent-Applicant.

X-----X

} **IPC No. 14-2008-00333**
} Opposition to:
} Appln. Serial No. 4-2007-006134
} Date filed: 14 June 2007
} **TM: "COFFEE MATCH"**
}
}
}

NOTICE OF DECISION

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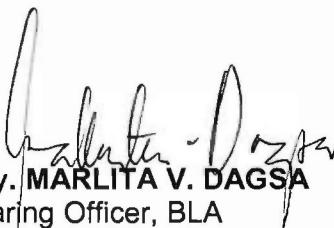
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GREETINGS:

Please be informed that Decision No. 2012 - 68 dated April 16, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 16, 2012.

For the Director:


Atty. MARLITA V. DAGOSA
Hearing Officer, BLA



SOCIETE DES PRODUITS NESTLE SA,
Opposer,

IPC NO. 14-2008-00333

- versus -

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Respondent-Applicant.

Opposition to:
Appln. Serial No. 4-2007-006134
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TM: "COFFEE MATCH"

x-----x

Decision No. 2012- 68

DECISION

NESTLE SOCIETE DES PRODUITS ("Opposer")¹ filed on 05 December 2008 an opposition to Trademark Application Serial No. 4-2007-006134.² The application, filed by PUREGOLD PRICE CLUB, INC. ("Respondent-Applicant")³, covers the mark "COFFEE MATCH" for use on "*coffee, tea, cocoa, sugar, artificial coffee; flour and flour preparations made from cereals, bread, pastry and confectionery and honey*" under Class 30 of the International Classification of Goods.⁴ The Opposer alleges, among other things, the following:

"1. Opposer is the first to adopt, use and register worldwide including the Philippines, the 'COFFEE-MATE' trademark for goods/products falling under International Class 29 and 30, and therefore, enjoys under Section 147 of Republic Act (R.A.) No. 8293 the right to exclude others from registering or using identical or confusingly similar marks such as Respondent-Applicant's trademark 'COFFEE MATCH' for goods falling under international class 30.

"2. There is a likelihood of confusion between Opposer's 'COFFEE-MATE' trademarks and Respondent-Applicant's trademark 'COFFEE-MATCH' because the latter trademark so resembles Opposer's 'COFFEE-MATE' trademark in terms of sound, sight, meaning and connotation as to likely, when applied to or used in connection with the goods of Respondent-Applicant, cause confusion, mistake and deception on the part of the purchasing public as being a trademark owned by the Opposer, hence, the Respondent-Applicant's 'COFFEE-MATCH' trademark cannot be registered in the Philippines pursuant to the express provision of Section 147.2 of R.A. No. 8293. No doubt, the use of Respondent-Applicant's 'COFFEE-MATCH' trademark for its products will indicate a connection between its products and those of the Opposer's.

"3. The Opposer 'COFFEE-MATE' trademark for goods falling under International Class 30 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 the trademark owned by the Opposer.

"4. Respondent-Applicant, in adopting 'COFFEE-MATCH' for its goods, is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association with the Opposer, or as to

¹ A corporation organized and under the laws of Switzerland with business address at Vevey, Switzerland

² The application was published in the Intellectual Property E-Gazette on 8 August 2008.

³ A domestic corporation with office address at 3rd Flr., Tabacalera Bldg., 900 D. Romualdez St., Ermita, Manila,

⁴ 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 Registration of Marks concluded in 1957.

origin, sponsorship, or approval of its goods and services by the Opposer, for which it is liable for false designation of origin, false description or representation under Section 169 of R.A. No. 8293.

"5. Respondent-Applicant's appropriation and use of the trademark 'COFFEE MATCH' infringes upon the Opposer's exclusive right to use as registered owner of its 'COFFEE-MATE' trademark, which is protected under R.A. 8293 particularly Section 147 thereof.

"Opposer relies on the following facts to support its opposition, reserving the right to present other evidence to prove these facts and others as may appear necessary or expedient in the course of the proceedings:

"1) Opposer is the exclusive owner of the 'COFFEE-MATE' trademark.

"Opposer is the exclusive owner of the 'COFFEE-MATE' trademark. It has adopted and used the 'COFFEE-MATE' trademark all over the world. The mark 'COFFEE-MATE' was first used in the Philippines on October 2, 1963. It was initially registered in the name of The Carnation Company, Los Angeles, U.S.A. The use and registration of the 'COFFEE-MATE' mark were properly assigned / transferred to herein Opposer on October 1, 1985. From then to present, Opposer has continuously used the 'COFFEE-MATE' mark through its licensees in the Philippines.

"Opposer was issued by the IPO the following certificates of trademark registration:

TRADEMARK	REG NO.	DATE ISSUED	CLASSES OF GOODS
COFFEE-MATE	011806	August 26, 1965	30
BOTTLE DEVICE (COFFEE-MATE)	4-2001-008228	January 6, 2006	29
3-D CONTAINER DEVICE (COFFEE- MATE)	4-2002-005367	March 26, 2007	29

The above-enumerated registrations are still valid and existing. xxx

"The 'COFFEE-MATE' trademark is also registered or applied for registration in over one hundred twenty (120) countries worldwide long before the appropriation and filing of the application by Respondent-Applicant for the registration of the trademark 'COFFEE MATCH' in the Philippines.

"2) There is confusing similarity between Opposer's 'COFFEE-MATE' trademark and Respondent-Applicant's trademark 'COFFEE MATCH'.

"Respondent-Applicant's trademark 'COFFEE-MATCH' is confusingly similar to Opposer's 'COFFEE-MATE' trademark in sound, spelling, meaning and connotation as to likely cause confusion.

"Specifically, the dominant word 'COFFEE' in Opposer's mark is glaringly a dominant part of Respondent-Applicant's mark. The second word 'MATCH' in Respondent-Applicant's mark means 'a pair, a mate, each one of which resembles or harmonizes'. Also, the word 'MATCH' is a synonym of the word 'MATE'. Taken together, Opposer's 'COFFEE-MATE' mark and Respondent-Applicant's 'COFFEE-MATCH' connotes a pair, mate or match for coffee. Hence, it is clear that Respondent-Applicant's 'COFFEE-MATCH' is confusingly similar to Opposer's 'COFFEE-MATE' mark.

"Moreover, the likelihood of confusion and deception are even greater since the goods of Opposer and Respondent-Applicant are the similar and/or related, and are made available to the same consuming public and in the same channels of distribution. Respondent-Applicant's 'COFFEE MATCH' trademark covers goods belonging to International Class 30 while Opposer's 'COFFEE-MATE' trademark is also registered for products falling under International Class 29 and 30.

Particularly, Respondent-Applicant's 'COFFEE MATCH' products include coffee, cocoa, sugar, flour, preparations made from cereals, confectionery, etc. While those of Opposer's products bearing its 'COFFEE-MATE' mark include non-dairy creamer, foods and ingredient of foods. Respondent-Applicant's goods are evidently similar and/or related to Opposer's goods. Therefore, confusion is very likely.

3) The Opposer's trademark 'COFFEE-MATE' is internationally well-known.

"The trademark 'COFFEE-MATE' which Opposer adopted and exclusively owned is internationally well-known. Opposer's 'COFFEE-MATE' mark has obtained trademark registrations and pending applications for trademark registration in more than one hundred twenty (120) countries around the world such as the Philippines, Malaysia, China, Taiwan, Thailand, United States of America, United Kingdom, South Africa, Saudi Arabia, Russian Federation, Switzerland, Germany, among many others.
xxx

"The Opposer's 'COFFEE-MATE' trademarks have been used, promoted and advertised for a considerable duration of time and over wide geographical areas having been in use in many countries around the globe. Opposer's 'COFFEE-MATE' trademark was first used in the early 1960's. In the Philippines, the 'COFFEE-MATE' trademark was first used on October 2, 1963. Since its first use, Opposer has invested significant amount of resources in the promotion of its trademark 'COFFEE-MATE' worldwide and in the Philippines.

"From 1991 to 2001, the sales volume of COFFEE-MATE in the Philippines grew more than 4000 from annual average of 270 metric tons in 1991 to nearly 8,000 metric tons in 1996 and steadily rising to 12,000 metric tons in 2001. It has a 95% share of the non-dairy coffee creamer segment. In 2002, COFFEE-MATE sales once more surged to hit 15,100 metric tons in volume and surpass the 2 billion peso mark in value.

"Furthermore, it must be pointed out that Opposer's 'COFFEE-MATE' trademark has been declared a well-known mark in Decision No. 1999/2265 issued by the Eleventh Civil Chamber of the Court of Appeals, Republic of Turkey. Copy of the said Decision No. 1999/2265 for Case No. 1998/10243 dated March 16, 1999 (with English translation) is hereto attached as Exhibit 'F' series

4) The use of Respondent-Applicant's trademark 'COFFEE MATCH' would indicate a connection with the goods covered in Opposer's 'COFFEE-MATE' mark hence, the interests of the Opposer are likely to be damaged.

"Respondent-Applicant's products are clearly similar and/or related to Opposer's products covered by its 'COFFEEMATCH' trademark. Undoubtedly, the use of Respondent-Applicant's trademark 'COFFEE-MATE' definitely misleads the public into believing that its goods originate from, or are licensed or sponsored by Opposer or that Respondent-Applicant is associated with or an affiliate of the Opposer.

"Respondent-Applicant has appropriated the trademark 'COFFEEMATCH' for the obvious purpose of capitalizing upon or riding on the valuable goodwill and popularity of the 'COFFEE-MATE' trademark which Opposer gained through tremendous effort and expense over a long period of time. This clearly constitutes an invasion of Opposer's intellectual property rights.

"The use by Respondent-Applicant of 'COFFEEMATCH' will dilute the distinctiveness of Opposer's 'COFFEE-MATE' trademark.

"The use, sale and distribution by the Respondent-Applicant of goods bearing the 'COFFEEMATCH' trademark are inflicting considerable damage to the interests of the Opposer. To allow Respondent-Applicant to register 'COFFEE MATCH' will constitute a mockery of our laws protecting intellectual property rights; it will legitimize its unfair and unlawful business practice.xxx"


The Opposer's evidence consists of the following:

1. Exh. "A" and "A-1": certified copy of the Cert. of Renewal of Reg. No. 11806 for the mark COFFEE-MATE;
2. Exh. "B": certified copy of the Cert. of Trademark Reg. No. 4-2001-008228 of the "BOTTLE DEVICE";
3. Exh. "C": certified copy of the Cert. of Trademark Reg. No. 4-2002-005367 of the "3-D CONTAINER MARK";
4. Exh. "D" to "D-29": list of the registrations and pending applications for registration of the mark COFFEE-MATE in various countries;
5. Exh. "E": copy of the article entitled "*Philippines: COFFEE-MATE Converts Milk Powder Users*";
6. Exh. "F" to "F-3": Decision No. 1999/2265 issued by the Eleventh Civil Chamber of the Court of Appeals, Republic of Turkey (with English translation);
7. Exh. "G" to "G-56": copies of the different COFFEE-MATE labels used in different countries; and
8. Exh. "H" to "H-3": actual labels of COFFEE-MATE used in the Philippines and a receipt issued by SM Supermarket, Makati where the coffee-mate was purchased.

The Respondent-Applicant filed its Answer on 05 June 2009 alleging, among other things, the following:

"III
AFFIRMATIVE ALLEGATIONS


X X X


"4.1. The trademark  was adopted by Respondent-Applicant in good faith and in accordance with law.

"4.2. Application Serial No. 4-2007-006134 was filed by Respondent-Applicant in good faith and in accordance with the provisions of the IP Code. xxx

"4.3. The examination, recommendation for allowance, and approval for publication of Application Serial No. 4-2007-006134 was done pursuant to, and in accordance with the provisions of the IP Code and the Implementing Rules on Trademark, etc. Initially, the Examiner stated that subject mark cannot be registered as it nearly resembles a mark with an earlier filing or priority date and the resemblance is likely to deceive or cause confusion (Sec. 123.1 [d] [ii]) citing in her Registrability Report five (5) existing registrations/ pending applications, including Opposer's registration for the mark 'Coffee-mate'.

After satisfactorily traversing the Examiner's objections, and there being no valid legal impediments to its approval, Application Serial No. 4-2007-006134 was allowed and its publication in the e-Gazette approved.

"4.4. As determined by the Bureau of Trademarks, Respondent-Applicant's trademark  is neither identical nor confusingly similar to Opposer's mark 'Coffee-mate'.

"4.5 The registration and use by Respondent-Applicant of the mark  will not cause confusion, mistake, and deception on the part of the consuming public, nor diminish the alleged distinctiveness and goodwill of Opposer over its "Coffee-mate" mark.

IV


AFFIRMATIVE AND/ OR SPECIAL DEFENSES

“5. Respondent-Applicant pleads the allegations in the foregoing paragraphs and in addition, respectfully states.

“5.1 The Verification and Certificate of Non Forum Shopping attached to the Notice of Opposition is fatally defective. The authority of the person who executed the Special Power of Authority has not been properly established or shown.


“5.2 The following exhibits submitted by Opposer together with the Notice of Opposition do not comply with Office Order No. 79 and are therefore, inadmissible, namely: Exhibits ‘D’ to ‘D-29’; ‘E’; ‘F’ to ‘F-3’; and ‘G’ to ‘G-56’.

Incidentally, there is no exhibit G-16 attached to the copy of the Notice of Opposition furnished Respondent-Applicant.

“5.3 There is neither legal nor factual basis for Opposer’s claim that it will be damaged by the registration of the trademark  in favor of Respondent-Applicant.

“5.4 Respondent-Applicant’s trademark  is neither identical nor confusingly similar to Opposer’s trademark ‘Coffee-mate’. xxx

“5.5 Opposer’s trademark ‘Coffee-mate’ is not well-known internationally and in the Philippines. Opposer failed to submit competent substantial evidence to show that its mark is indeed well-known internationally and in the Philippines.


“5.6 The registration and use by Respondent-Applicant of the trademark  will not cause confusion or mistake on the part of the consuming public, nor deceive them into believing that Respondent-Applicant is affiliated or connected with Opposer.

Subject application was filed in good faith and its examination and approval for publication was in accordance with the IP Code, as well as its Implementing Rules and Regulations.

“5.7 Respondent-Applicant adopted subject mark in good faith without any intention to ride on the popularity or goodwill of any mark. Respondent-Applicant did not violate any provision of the IP Code, including Sections 147 and 169 thereof.

“5.8 Respondent-Applicant is a responsible corporate entity duly organized and existing under the laws of the Philippines. Aside from being a lawful and law-abiding corporate citizen, Respondent-Applicant is well respected in the business community and is well-known for its fair and just undertaking of its corporate business.” xxx

The Respondent-Applicant’s evidence consists of the following:

1. Exh. “1” to “1-c”: photocopies of the Acknowledgment of Filing, Trademark Application Form, and Drawing of Application Serial No. 4-2007-006134 for the registration of the trademark  taken from the file wrapper of subject application;
2. Exh. “2” to “2-b”; “3” to “3-a”; and “4” to “4-a”: photocopies of the Registrability Report and the Response thereto, the Notice of Allowance as well as the publication in the e-Gazette, taken from the file wrapper of the subject application;
3. Exh. “5”: certified copy of the Respondent-Applicant’s Certificate of Incorporation and Articles of Incorporation; and
4. Exh. “6”: duly notarized Affidavit of Denise Maria D. Carolino.

The Opposer filed on 25 June 2009 a "Reply" together with the affidavit of Dennis Jose R. Barot, marked as Exh. "I"⁵ while the Respondent-Applicant filed its "Rejoinder" on 07 July 2009. On 28 May 2010, the Preliminary Conference was terminated. Then after, the Opposer filed its Position Paper on 28 June 2010 while Respondent-Applicant did so on 01 July 2010.

The Respondent-Applicant raised the issue that the instant opposition should be dismissed on the ground that the "Verification and Certificate of Non Forum Shopping" attached to the Notice of Opposition is fatally defective. According to the Respondent-Applicant, the authority of the person who executed the Special Power of Authority ("SPA") in favor of the one who signed the Verification and Certification of Non Forum Shopping has not been properly established or shown.

The records show that Dennis Jose R. Barot, purportedly, the Regional Intellectual Property Adviser of the Opposer, executed and signed an SPA constituting and appointing as its authorized representatives/signatories Attys. Ignacio S. Sapalo, Augusto R. Bundang, and Neptali L. Bulilan and /or SAPALO VELEZ BUNDANG & BULILAN LAW OFFICES. Atty. Bundang of the aforementioned law office signed the Verification and Certification of Non forum Shopping on the basis of the SPA executed by Mr. Barot. However, no document was submitted showing Mr. Barot's authority to sign the SPA in behalf of the Opposer. In this regard, Rule 2, Sec. 7.3 of the Rules and Regulations of Inter Partes Cases, as amended, provides:

7.3. If the petition or opposition is in the required form and complies with the requirements including the certification of non-forum shopping, the Bureau shall docket the same by assigning the Inter Partes Case Number. Otherwise, the case shall be dismissed outright without prejudice. A second dismissal of this nature shall be with prejudice.

The Opposer attached to its Reply the affidavit of Mr. Barot wherein he stated, among other things, that his duties include among others, "the filing and prosecution of trademark applications and the maintenance and defense of trademark registrations in the Philippines and other territories under my management". But bare allegations unaccompanied by proof or evidence are given little or no weight at all. The affidavit of Mr. Barot cannot stand in lieu of a Board Resolution or Secretary's Certificate showing that the Opposer Company has authorized him to act in its behalf.

The Supreme Court has ruled many times that "it is obligatory for the one signing the verification and certification against forum shopping on behalf of the principal party or the other petitioners that he/she has the authority to do the same."⁶ If the real party-in-interest is a corporate body, an officer of the corporation can sign the certification against forum shopping so long as he has been duly authorized by a resolution of its board of directors.⁷ If the certification against forum shopping signed by a person on behalf of a corporation, is unaccompanied by proof that said signatory is authorized to file a petition on behalf of the corporation, the same shall be sufficient ground to dismiss the case.⁸

⁵ With Annexes "A" to "K".

⁶ *Fuentebella v. Rolling Hills Memorial Park, Inc.*, G.R. No. 150865, 30 June 2006

⁷ *Supra*.

⁸ *Mediserv, Inc. v. Court of Appeals, et.al*, G.R. No. 161368, 05 April 2010

But even if this Bureau considers the aforementioned Verification and Non Forum Shopping valid, the instant opposition should still be dismissed.

Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time Respondent-Applicant filed its trademark application on 14 June 2007, the Opposer’s mark has an existing trademark registration for the mark “COFFEE MATE”. The Respondent-Applicant’s trademark application indicates goods that are similar to those covered by the Opposer’s registered mark. Be that as it may, this Bureau finds that confusion or deception is unlikely to occur in this instance.

The feature that is common to the competing marks, as shown below, is the word “Coffee”.

The logo for "Coffee-mate" features the word "Coffee" in a stylized, cursive font with a drop shadow, followed by a hyphen and the word "mate" in a simpler, sans-serif font.The logo for "Coffee Match" features the word "Coffee" in a stylized, cursive font with a drop shadow, followed by the word "Match" in a bold, sans-serif font with a drop shadow.

The word as a mark, or as a part of a trademark, which is used on coffee and similar or closely related goods is obviously not unique or highly distinctive. The word is generic or descriptive of the goods. If paired with another word, the mark as a whole may be registered but at any rate is suggestive, and therefore considered a weak mark.

Aptly, it is the word, or device, paired with the word “Coffee” that would determine whether such mark is distinctive by itself and in relation to other marks, and thus, possibly registrable. In the Trademark Registry, the contents of which the Bureau can take cognizance of via judicial notice, there are several trademarks consisting of the word “Coffee” or in pair with other word or device that are registered or applied for registration.

With respect to the Opposer’s mark, the word “Coffee” is combined with the word “Mate”. On the other hand, the Respondent-Applicant appended the word “Match” to the word “Coffee”. While both “Mate” and “Match” contain the first three letters, the last two in the Respondent-Applicant’s mark rendered it a visual and aural character that makes it easily distinguishable from the Opposer’s. Also, the letter “M” in the Respondent-Applicant’s mark is written in capital letter. The eyes and the ears of a consumer would not be confused or deceived. One cannot mistake the mark and the products of the Opposer as that of the Respondent-Applicant or *vice versa*.

It is emphasized that the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in

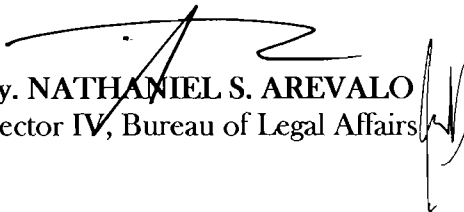
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bringing into a market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his products.⁹ This Bureau finds that the Respondent-Applicant's mark serves this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2007-006134 be returned, together with a copy of this **DECISION**, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 April 2012.


Atty. **NATHANIEL S. AREVALO**
Director IV, Bureau of Legal Affairs

⁹ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents*, 16 SCRA 495.