



SOCIETE DES PRODUITS NESTLE S.A.,
Opposer,

-versus-

UNIVERSAL ROBINA CORPORATION,
Respondent-Applicant.

}
} **IPC No. 14-2008-00313**
} Opposition to:
} Application No. 4-2008-000578
} Date filed: 17 January 2008
} TM: "GREAT TASTE GOLD"

X-----X

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 43 dated March 16, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 16, 2015.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



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IPC No. 14-2008-00313
Opposition to:

Appln. No. 4-2008-000578
Date Filed: 17 January 2008
Trademark : **"GREAT TASTE GOLD"**
Decision No. 2015 - 43

DECISION

SOCIETE DES PRODUITS NESTLE S.A., ("Opposer")¹ filed a verified opposition to Trademark Application Serial No. 4-2008-000578. The application, filed by UNIVERSAL ROBINA CORPORATION ("Respondent-Applicant")², covers the mark "GREAT TASTE GOLD" for use on goods under class 30³ namely: "coffee."

The Opposer alleges the following grounds for opposition:

"1. Opposer is the first to adopt, use and register worldwide including the Philippines, the 'GOLD', 'GOLD BLEND' and 'NESTLE GOLD' trademarks and their derivatives (hereinafter referred to as 'GOLD' trademarks) for coffee and coffee extracts falling under International Class 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 'GREAT TASTE GOLD' for goods falling under international class 30.

"2. The Opposer's 'GOLD' trademarks 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 trademarks owned by the Opposer.

"3. There is a likelihood of confusion among Opposer's 'GOLD' trademarks and Respondent-Applicant's trademark 'GREAT TASTE GOLD' because the latter entirely contains Opposer's 'GOLD' trademark. As such, when applied to or used in connection with the goods of Respondent-Applicant, Respondent-Applicant's mark will 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 'GREAT TASTE GOLD' trademark cannot be registered in the Philippines pursuant to the express provision of 123 (e) of R.A. No. 8293.

"4. Respondent-Applicant, in adopting 'GREAT TASTE GOLD' 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 origin, sponsorship, or approval of its goods and services by the

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

² A corporation duly organized and existing under and by virtue of Philippine laws, with business address at the CFC Building, Bagong Ilog, Pasig City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

Opposer, for which it is liable for false designation of origin, false description or representation under Section 169 of R.A. No. 8293."

The Opposer's evidence consists of the following exhibits and annexes:

1. Exhibit "A" - Registration No. 033311 for the trademark GOLD;
2. Exhibit "B" - Registration No. 031515 for the trademark GOLD BLEND;
3. Exhibit "C" - Registration No. 41994094221 for the trademark NESTLE GOLD;
4. Exhibit "D"- "D-3"- Protection List showing worldwide registrations and applications for the marks GOLD and NESTLE GOLD;
5. Exhibit "E" - Affidavit of Gregorio T. Tongko Jr.;
6. Annex "A" - Employees Identification Card;
7. Annex "B" - 2004 Edition of Philippines 5000 (Top 5000 Corporations); ("B-1" 2005 Edition; "B-2" 2006 Edition; "B-3" 2007 Edition)
8. Annex "C" - Registration No. 033311 for the trademark GOLD;
9. Annex "D" - Registration No. 031515 for the trademark GOLD BLEND;
10. Annex "E" - Registration No. 41994094221 for the trademark NESTLE GOLD;
11. Annex "F"- "I"- Protection List
12. Annex "J" - Affidavit of Use for the Fifth Anniversary for the trademark GOLD BLEND;
13. Annex "K" - Affidavit of Use for the Fifth Anniversary for the trademark NESTLE GOLD;
14. Annex "L"- "L34"- Copies of product specifications bearing the marks GOLD, GOLD BLEND, NESTLE GOLD and NESCAFE GOLD;
15. Annex "M"- "M4"- Promotion and Advertising materials with GOLD marks;
16. Annex "N"- "N4"- Print outs of pictures of actual GOLD products in several countries;
17. Annex "O"- "O2"- Decision of Trademark Office of the State Administration for Industry and Commerce;
18. Annex "P" - Print out copy of the E-Gazette publication of the IPO Philippines.

On 27 March 2009, Respondent-Applicant filed its Answer, stating the following Affirmative Defenses:

"A. The Subject Mark is not confusingly similar with the Cited Marks for which reason the Trademark Application for the former should be granted.

"21. In its Verified Notice of Opposition, Opposer alleged that the trademark application for the Subject mark should be denied on the ground that the same is 'confusingly similar to Opposer's GOLD trademarks in sound, spelling and meaning as to likely cause confusion' and, considering that the products designated by the Subject Mark are allegedly identical to the products covered by the Cited Marks, 'the use of Respondent-Applicant's trademark 'GREAT TASTE GOLD' 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 Opposer.

x x x

A cursory examination of the foregoing will readily show that:

- (a) The pictorial presentation of Subject Mark and the Cited Marks are entirely different.
- (b) The presentation of the word "Gold" in the Subject Mark and the Cited Marks and the colors used therein are entirely different.
- (c) The printed matters on the Subject Mark and the Cited Marks are also at

variance with each other.

- (d) The identities of the manufacturers in the respective marks are clearly identified in the labels.

x x x

"B. The word 'GOLD' is generic or descriptive and may therefore be used by URC for its products.

"40. In its verified Notice of Opposition, Opposer alleged that as the registered owner of the Cited Marks, 'it enjoys the right to exclude others from registering or using identical or confusingly similar marks such as Respondent-Applicant's trademark 'GREAT TASTE GOLD' for goods falling under international class 30'.

It is Respondent-Applicant's humble opinion that the flaw in the foregoing claim of Opposer lies in its failure to take into consideration the fact that the word 'GOLD' falls under the category of generic or descriptive words which under the Intellectual Property Code is not susceptible of exclusive appropriation by any person, judicial or otherwise. As earlier mentioned, the word 'GOLD' cannot be anything but one which is generic in character and merely descriptive of the coffee products of Respondent-Applicant. As such, no exclusivity of its use can rightfully be asserted even by Respondent-Applicant who categorically disclaimed the same in its trademark application.

x x x

"c. The Registration of the subject mark will not constitute Unfair Competition.

The Respondent-Applicant's evidence consists of the following exhibits and annexes:

1. Annex "1" - Trademark Application of CFC Corporation for the trademark GREAT TASTE;
2. Annex "2" - Notice of Publication for the trademark GREAT TASTE;
3. Annex "3" - Notice of Issuance for the trademark GREAT TASTE;
4. Annex "4" - Certificate of Registration No. 32347 for the trademark GREAT TASTE;
5. Annex "5" - Affidavit of Use of the trademark GREAT TASTE;
6. Annex "6" - Affidavit of Use for the Tenth Anniversary of the trademark GREAT TASTE;
7. Annex "7" - Secretary's Certificate integrating the food manufacturing operations of CRC Corporation with URC;
8. Annex "8" - Secretary's Certificate transferring food production activities to URC;
9. Annex "9" - Trademark Application of URC for the trademark GREAT TASTE;
10. Annex "10" - Certificate of Registration No. 42005005413 for the trademark GREAT TASTE;
11. Annex "11" - Notice of Allowance;
14. Annex "14" - Actual packaging of contending marks;
15. Annex "15" - Actual packaging of contending marks;
16. Annex "16" - Sample product package of GREAT TASTE GOLD;
17. Annex "17" - Supreme Court 3rd Division Resolution dated 15 November 2000;
18. Annex "18" - Supreme Court 3rd Division Entry of Judgment; and,
19. Annex "19" - Photos of products showing composite marks with the word GOLD;

On 22 June 2009, Opposer filed its Reply, stating among others that although the words GREAT TASTE were allegedly added to GOLD, this addition does not rule out the similarity between the subject trademarks, especially since Opposer's GOLD trademarks have several derivative marks also registered

under the same class and covering the same goods (coffee) as Respondent-Applicant's goods. It further alleged that confusion is made certain since the parties' respective trademarks are used for one and the same type of products - coffee. The following are attached to the Reply:

1. Exhibit "E" - Supreme Court Decision in G.R. No. 108590 dated 09 July 1993 entitled, CFC Corporation vs. Court of Appeals;
2. Exhibit "F" - Bureau of Legal Affairs Decision No. 2007-136 dated 27 September 2007; and,
3. Exhibit "G" - Bureau of Patents, Trademarks and Technology Transfer Decision No. 94-32 dated 28 June 1994.

On the other hand, Respondent-Applicant filed its Rejoinder on 09 July 2009 stating that what it is registering is not the mark GOLD appended with the words GREAT TASTE, but GREAT TASTE GOLD which is a special variety of its coffee products under the registered mark GREAT TASTE, the word GOLD merely functioning as an adjective which is generic to denote and emphasize quality and class of the product. The following are attached to the Rejoinder:

1. Annex "1" - Supreme Court Resolution dated 15 November 2001 in G.R. No. 144744-46, entitled Societe Des Produits Nestle, S.A. vs. CFC Corporation; and,
2. Annex "2" - Court of Appeals Decision dated 20 March 2000

Thereafter, the Opposer filed its Position Paper on 15 September 2009; whereas Respondent-Applicant was declared to have waived its right to submit the same⁴ because it failed to attend the preliminary conference set on 02 July 2009.⁵ Hence, this case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark GREAT TASTE GOLD?

It is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing out into the market a superior 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.⁶

The competing marks are reproduced below for comparison:

GOLD

GOLD BLEND

NESTLE GOLD

Opposer's Trademarks

⁴ Order No. 2009-1328 dated 27 August 2009.

⁵ Section 14.3 of Office Order No. 79.

⁶ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).



Respondent-Applicant's Trademark

In Respondent-Applicant's composite mark GREAT TASTE GOLD, the brand GREAT TASTE is recognizable or discernible, which differentiates it from that of the Opposer's. It is likewise shown that the word GOLD in GREAT TASTE GOLD adopts a dissimilar font in handwriting, as compared to the font used by the Opposer's GOLD marks. Thus, the total presentation of the contending products bearing their respective marks⁷ demonstrates diverse individualities and creates divergent impression to the public, unlikely to cause confusion, mistake or deception to the ordinary purchasers.

Also, this Bureau takes judicial notice of the Resolution of the Supreme Court which has become final and executory.⁸ In that, the Supreme Court affirmed the right of CFC Corporation to use the word GOLD, which was declared as generic or descriptive word, as part of the composite mark BLEND 45 GOLD for its coffee products. Pertinent portions of the Court of Appeals Decision dated 20 March 2000⁹ reads, as follows:

"We have examined the respective labels of the products of both NESTLE and CFC and saw therein no similarity whatsoever that may tend to confuse the consumers. For sure, if there is any similarity at all between CFC's 'BLEND 45 GOLD' and those products of NESTLE bearing the word 'GOLD', such similarity ends there. The rests betray an array of prominent dissimilarities. Thus, in the 'BLEND 45 GOLD' line of CFC, it is the name 'BLEND 45' which prominently stand out because of the relatively bigger size of its text (see Records, Civil Case No. 56657, pp. 38, 149-150, 373). Although the word 'GOLD' is indeed found in the label of said product, it is much smaller than the brand name 'BLEND 45'.

What this Court is trying to drive at is that in the 'BLEND 45 GOLD' line, the brand name of the product, which is still 'BLEND 45', is easily, if not most immediately recognizable or discernible even by a cursory visual inspection of the said CFC product since it is far easier to see 'BLEND 45' than the word 'GOLD' itself. Hence, there clearly appears no effort whatsoever on the part of CFC to pass it off as the product of another company. Neither can 'BLEND 45 GOLD' be mistaken as forming part of the 'GOLD' series of coffee products of NESTLE. For this reason alone, the charge of infringement would already fail.

Then, too, the over-all color scheme of the 'BLEND 45 GOLD' product is also substantially dissimilar to the registered coffee products of NESTLE. For one, although all the products of NESTLE and the 'BLEND 45 GOLD' line of CFC appear to have use the color red in some parts of their products, the color red color used by CFC, as a background for the phrase 'BLEND 45', in the 'BLEND 45 GOLD' line clearly appears to be of a brighter hue which by itself, already gives the said CFC product an overall appearance distinct from the other NESTLE coffee products (see Records, Civil Case No. 56657, p. 373).

⁷ Exhibits "14, "15" and "16" of Respondent-Applicant.

⁸ Annex "18" of Respondent-Applicant.

⁹ Annex "2" of Respondent-Applicant.

We do not even have to mention the evident variance in the type and size of the text used for the printed words, including the arrangement or positioning thereof, as appearing in the products being compared herein.

We thus agree with the Cebu trial court when it held that word 'GOLD' is 'generic' or 'descriptive' in character and therefore no person has the right to the exclusive appropriation thereof even if NESTLE had registered some of its products under several trademarks with the work 'GOLD' in them. In fact, judicial notice may be taken of the fact that the word 'GOLD' is so commonly used nowadays in the market simply to denote a superior specie of a product line or goods. In a very real sense, then, the term 'GOLD' can be equated with the words 'supreme' or 'superior', as contra distinguished from the words 'regular' or 'ordinary'. It is unquestionable that the words 'supreme' or 'superior' are merely 'generic' if not 'descriptive' in character."

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2008-000578 is hereby **DISMISSED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 March 2015.


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