SOCIETE DES PRODUITS NESTLE S.A.,	}	**IPC No. 14-2012-00357**
Opposer,	}	Opposition to:
	}	Appln. Serial No. 4-2011-004118
	}	Date Filed: 08 April 2011
-versus-	}	TM: **"MAS CAFÉ"**
	}	
	}	
	}	
UNITED HARVEST CORPORATION,	}	
Respondent-Applicant.	}	

x----------x

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 206 dated September 28, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 28, 2015.

For the Director:

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

SOCIETE DES PRODUITS NESTLE S.A.,
Opposer,

versus-

UNITED HARVEST CORPORATION,
Respondent-Applicant.
x ---------- x

IPC No. 14-2012-00357
Opposition to:
Appln. Serial No. 4-2011-004118
Date Filed: 08 April 2011
Trademark: **"MAS CAFÉ"**

Decision No. 2015- 206

DECISION

Societe Des Produits Nestle, S.A.[1] ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-004118. The contested application filed on 08 April 2011 by United Harvest Corporation[2] ("Respondent-Applicant") covers the mark "MAS CAFE" for use on *"coffee; coffee extracts and coffee-based preparations, coffee substitutes; tea; tea extracts and tea-based preparations"* and *"beers, non-alcoholic beverages; fruit juices; lemonades, preparations for making liquors* (sic)*; mineral water and preparations for making the same; and vegetable juices"* under Classes 30 and 32, respectively, of the International Classification of Goods.[3]

The Opposer alleges, among others, that it is the first to adopt, use and register the mark "NESCAFE" in the Philippines for use on coffee and coffee-based beverages/café, snack bar and canteen service. According to the Opposer, the Respondent-Applicant's mark "MAS CAFÉ" is confusingly similar in spelling, sound and connotation to "NESCAFE", which it claims to be well-known. It contends that the Respondent-Applicant's packaging has similar color-scheme and layout with its own goods. It also oppose the registration of "MAS CAFÉ" on the ground that the same is generic to the goods the mark seeks to identify. It explains that the term "MAS" is defined as "more" and therefore, the applied mark merely describes a coffee beverage that has more coffee in it.

In support of its opposition, the Opposer submitted the following:[4]

1. affidavit of Dennis Jose R. Barot, with annexes;
2. certified true copy of Decision No. 2012-162 issued by this Bureau;
3. actual labels of its "NESCAFE STRONG N' RICH" and "NESCAFE BROWN N' CREAMY" and of the Respondent-Applicant's "MASKAPE STRONG AND RICH" and "MASKAPE BROWN AND CREAMY"; and

[1] A corporation duly formed under the laws of Switzerland with business address at Vevey, Switzerland.
[2] With address at 9F Liberty Center Building, 104 H.V. Dela Costa Street, Makati City, Philippines.
[3] The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.
[4] Marked as Exhibits "1" to "4", inclusive.

3. actual labels of its "NESCAFE STRONG N' RICH" and "NESCAFE BROWN N' CREAMY" and of the Respondent-Applicant's "MASKAPE STRONG AND RICH" and "MASKAPE BROWN AND CREAMY"; and
4. compact disc containing its evidence of actual use of "NESCAFE" products worldwide.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 20 February 2013. The latter, however, did not file an Answer. Consequently, the Hearing Officer issued Order No. 2013-732 on 14 May 2013 declaring the Respondent-Applicant in default and the case submitted for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "MAS CAFE" should be allowed registration.

Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it:

> ***"(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:***
>
> ***(i) The same goods or services, or***
> ***(ii) Closely related goods or services, or***
> ***(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion; x x x"***

Records reveal that at the time Respondent-Applicant filed its application for registration of the contested mark on 08 April 2011, the Opposer already has a valid and existing registration of its mark "NESCAFE" issued as early as 28 February 1974 under Certificate of Registration No. 21490.

For comparison, the competing marks are reproduced below:

NESCAFÉ	Mas Café
Opposer's mark	*Respondent-Applicant's mark*

Both marks end with the word "CAFE". A trademark which appropriates the "CAFÉ" and is used on this line of products is a suggestive mark. The mark or brand

coffee products of which the word "CAFÉ" is a part of is the very concept or idea of the goods. Thus, what will set apart or distinguish such mark from another which also includes the word "CAFÉ" are the letters that come after it.

In this regard, the Opposer's mark uses the prefix "NES" as against the Respondent-Applicant's "MAS". "NES" and "MAS" resemble each other as they similarly end with the letter "S" and are composed of three letters. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.[5]

Succinctly, not only do "NES" and "MAS" look similar, they likewise sound similar. When pronounced, "MAS CAFÉ" can barely be distinguished from "NESCAFE". Aptly, in **Marvex Commercial Co. vs. Peter Hawpia**[6], the Supreme Court held that:

> ***"The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that 'SALONPAS' and 'LIONPAS' are confusingly similar in sound: 'Gold Dust' and 'Gold Drop'; 'Jantzen' and 'Jazz-Sea'; 'Silver Flash' and 'Supper-Flash'; 'Cascarete' and 'Celborite'; 'Celluloid' and 'Cellonite'; 'Chartreuse' and 'Charseurs'; 'Cutex' and 'Cuticlean'; 'Hebe' and 'Meje'; 'Kotex' and 'Femetex'; 'Zuso' and 'Hoo Hoo'. Leon Amdur, in his book 'TradeMark Law and Practice', pp. 419-421, cites, as coming within the purview of the idem sonans rule, 'Yusea' and 'U-C-A', 'Steinway Pianos' and 'Steinberg Pianos', and 'Seven-Up' and 'Lemon-Up. In Co Tiong vs. Director of Patents, this Court unequivocally said that 'Celdura' and 'Cordura' are confusingly similar in sound; this Court held in Sapolin Co. vs. Balmaceda, 67 Phil. 795 that the name 'Lusolin' is an infringement of the trademark 'Sapolin', as the sound of the two names is almost the same.***
>
> ***In the case at bar, 'SALONPAS' and 'LIONPAS', when spoken, sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (see Celanese Corporation of America vs. E. I. Du Pont, 154 F. 2d. 146, 148)."***

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief

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[5] Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.
[6] G.R. No. L-19297, 22 December 1966.

that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."[7]

Finally, 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 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.[8] The Respondent-Applicant's mark failed to meet this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2011-004118 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 September 2015.

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

[7] Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.
[8] Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.