

SOCIETE DES PRODUITS NESTLE S.A.,
Opposer,

-versus-

**ROBINSONS TRUE SERVE HARDWARE
PHILIPPINES INC.,**
Respondent- Applicant.

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IPC No. 14-2014-00439
Opposition to:
Appln. Serial No. 4-2013-014626
Date Filed: 06 December 2013
TM: "SUPER CHOW"

X-----X

NOTICE OF DECISION

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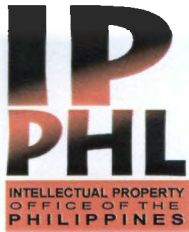
GREETINGS:

Please be informed that Decision No. 2016 - 109 dated April 07, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 07, 2016.

For the Director:

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



SOCIETE DES PRODUITS NESTLE S.A.,

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**ROBINSONS TRUE SERVE HARDWARE
PHILIPPINES INC.,**

Respondent-Applicant.

X ----- X

IPC No. 14-2014-00439

Opposition to Trademark

Application No. 4-2013-014626

Date Filed: 06 December 2013

Trademark: **"SUPER CHOW"**

Decision No. 2016- 109

DECISION

Societe Des Produits Nestle S.A.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-014626. The contested application, filed by Robinsons True Serve Hardware Philippines Inc.² ("Respondent-Applicant"), covers the mark "SUPER CHOW" for use on "dog food" under Class 31 of the International Classification of Goods³.

According to the Opposer, the term "CHOW" was first used in United States of America (USA) by William H. Danfort, founder of Ralston Purina, in 1914 for animal products. On 23 February 1915, Danfort was issued Registration No. 0102843 for the mark "CHOW". Over the last three years, 225 million CHF was spent worldwide for marketing expenditures of the mark. In the Philippines, the "CHOW" mark was first used in 11 September 1941 as indicated in its Certificate of Registration No. 2451 (formerly Registration No. 8554). It also registered its "CHOW" products with the Bureau of Animal Industry, which also granted it importation permit. These registrations and permits were allegedly in the then distributors of Purina Pet Food, namely, Eveready Battery, Inc. and subsequently Energizer Philippines, Inc. prior to its acquisition of Ralston Purina. In addition, it claims that its company and its predecessor have gained international goodwill over its "CHOW" line of animal food through aggressive marketing efforts.

The Opposer maintains that it registered in many countries the marks "DOG CHOW", "PUPPY CHOW", "CAT CHOW", "KITTEN CHOW" and "CHOW" trademarks and their derivatives for, among others, dog food, animal feeds for rats, mice, dogs, cats, monkeys, hamsters, poultry and cattle, foodstuffs for animals falling Class 31. In the Philippines it registered the marks "CHOW", "PURINA DOG CHOW" and "PUPPY CHOW". Recently, this Bureau upheld the its opposition for the mark

¹ A corporation duly formed under the laws of Switzerland with business address at Vevey, Switzerland.
² A domestic corporation with office address at 110 E. Rodriguez Jr. Avenue, Bagumbayan, Quezon City, Metro Manila.
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.

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"BUDDY'S CHOW" in the case of "Societe des Produits Nestle, S.A. vs. Ampro Pet Nutrition, Inc." docketed as IPC No. 14-2011-00026. It thus contends that "SUPERCHOW" should not be registered as the same is confusingly similar with its "CHOW" trademarks. In support of its Opposition, the Opposer submitted the printout of the E-Gazette publication of "SUPER CHOW" and affidavit of Jose r. Barot, with annexes.⁴

The Respondent-Applicant filed its Answer on 30 March 2015 alleging, among others, that what it seeks to register is the phrase "SUPER" and "CHOW" used together and not individually as it disclaimed both words. It asserts that it does not in any way seek to appropriate the word "CHOW" alone and that its application readily shows that apart from "SUPER CHOW", a substantial part of its trademark a caped dog and two paw prints. It thus insists that the competing marks are distinct and will not result to confusion. The Respondent-Applicant's evidence consists of its 01 June 2014 addressed to the Director of Trademarks and a copy of Certificate of Registration No. 4-2008-007234.⁵

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. This Bureau's Alternative Dispute Resolution Services, however, submitted a report that the parties refused to mediate. Accordingly, a Preliminary Conference was initially conducted on 24 September 2015. Upon termination thereof on 07 January 2016, the Hearing Officer directed the parties to submit their respective position papers. Both parties filed their position papers and the case is then deemed submitted for resolution.

The issue to be resolved in this case is whether the mark "SUPER CHOW" should be allowed.

Records reveal that on 01 December 1980, the Opposer was able to register the same mark in its name under Certificate of Registration No. 002451. On the other hand, Respondent-Applicant filed the application for the mark "SUPER CHOW" on 06 December 2013.

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the competing marks are reproduced hereafter for comparison:

⁴ Marked as Exhibits "B" to "V", inclusive.

⁵ Marked as Exhibits "3" and "4".

Opposer's Marks

CHOW

PUPPY CHOW

**Purina
DOG
CHOW**

Respondent-Applicant's Mark



Looking at the Opposer's marks, it can be observed that their common denominator is the word "CHOW". This is the prevailing feature of its marks whether the said word is used alone or adjunct to other words. The term "CHOW", however, is generic and/or descriptive of food products as it connotes the noun "food" and/or the verb "eat." Generally, generic and/or descriptive words cannot be registered as trademarks except when the word has acquired secondary meaning. In the case of **Philippine Nut Industry, Inc. vs. Standard Brands Incorporated**⁶, the Supreme Court explained this doctrine as follows:

"The doctrine of secondary meaning is found in Sec. 4 (f), Chapter II-A of the Trade-Mark Law, viz:

Except as expressly excluded in paragraphs (a), (b), (c) and (d) of this section, nothing herein shall prevent the registration of a mark or trade-name used by the applicant which has become distinctive of the applicant's goods, business or services. The Director may accept as prima facie evidence that the mark or trade-name has become distinctive, as applied to or used in

⁶ G.R. No. L-23035, 31 July 1975.

connection with the applicant's goods, business or services, proof of substantially exclusive and continuous use thereof as a mark or trade-name by the applicant in connection with the sale of goods, business or services for the five years next preceding the date of the filing of the application for its registration. (As amended by Sec. 3, Rep. Act No. 638.)

This Court held that the doctrine is to the effect that a word or phrase originally incapable of exclusive appropriation with reference to an article on the market, because geographically or otherwise descriptive, might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase has come to mean that the article was his product.

By way of illustration, is the word 'Selecta' which according to this Court is a common ordinary term in the sense that it may be used or employed by any one in promoting his business or enterprise, but which once adopted or coined in connection with one's business as an emblem, sign or device to characterize its products, or as a badge of authenticity, may acquire a secondary meaning as to be exclusively associated with its products and business, so that its use by another may lead to confusion in trade and cause damage to its business.'

Succinctly, the provisions of Section 4(f) of the Trademark Law are adopted in Section 123.2 of the IP Code, to wit:

"Section 123.2. As regards signs or devices mentioned in paragraphs (j), (k), and (l), nothing shall prevent the registration of any such sign or device which has become distinctive in relation to the goods for which registration is requested as a result of the use that have been made of it in commerce in the Philippines. The Office may accept as prima facie evidence that the mark has become distinctive, as used in connection with the applicant's goods or services in commerce, proof of substantially exclusive and continuous use thereof by the applicant in commerce in the Philippines for five (5) years before the date on which the claim of distinctiveness is made."

In the instant case, the Opposer has registered the mark "CHOW" in its name way back 01 December 1980. Its predecessor-in-interest registered the said mark even earlier on 01 December 1960 under Certificate of Registration No. 8554, with a statement that the "CHOW" mark was first used in the Philippines on 11 September 1941. Besides its registrations, the Opposer proved that it has been in continuous use of its marks as evidenced by the sample advertisements, import permits and approved applications by the Bureau of Animal Industry. Thus the doctrine of secondary meaning applies as it is sufficiently supported by documentary evidence showing that the word "CHOW" has been used by and closely associated with the Opposer for animal food since 1941 in this country.

Hence, if some other party, such as Respondent-Applicant in this case, will appropriate the word "CHOW" for its marks covering animal food products, it is highly likely that the consumers will be misled to believe that the goods came from the same source. 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 purchasers as to cause him to purchase the one supposing it to be the other.⁷

This is especially so since the Respondent-Applicant will also use or uses the mark "SUPER CHOW" to goods likewise covered by the Opposer's registrations. After all, the determinative factor in a contest involving registration of trade mark is not whether the challenged mark would *actually* cause confusion or deception of the purchasers but whether the use of such mark would *likely* cause confusion or mistake on the part of the buying public.⁸ The Respondent-Applicant, therefore, cannot simply disclaim the word "CHOW" in its application as the same will not eradicate the likelihood of confusion.

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 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."⁹

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.¹⁰ Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function.

⁷ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁸ American Wire & Cable Company vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

⁹ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

¹⁰ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), which provides that:

"123.1. 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; xxx."

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-014626 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 April 2016.


ATTY. NATHANIEL S. AREVALO

Director IV

Bureau of Legal Affairs