

ADELFA M. NUESTRO,
Petitioner,

-versus-

BOTE CENTRAL, INC.,
Respondent- Registrant.

X-----X

} **IPC No. 14-2012-00442**
}
} Cancellation of:
} Reg. No. 4-2007-010201
} Date Issued: 16 February 2009
} **TM: "ALAMID"**
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NOTICE OF DECISION

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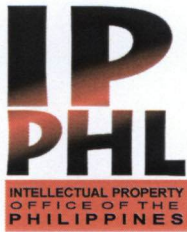
GREETINGS:

Please be informed that Decision No. 2016 - 58 dated February 24, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 24, 2016.

For the Director:

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



ADELFA M. NUESTRO,
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- versus -

BOTE CENTRAL, INC.,
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IPC No. 14-2012-00442

Cancellation of:

Reg. No. 4-2007-010201
Date Issued: 16 February 2009
Trademark: "ALAMID"

Decision No. 2016 - 58

DECISION

ADELFA M. NUESTRO ("Petitioner")¹ filed a petition for cancellation of Trademark Registration No. 4-2007-010201. The registration, issued to BOTE CENTRAL, INC. (Respondent-Registrant)², covers the mark "ALAMID" for use of goods under class 30 namely: *coffee, tea, cocoa, sago, rice, bread, cakes, sauces, spices.*³

The Petitioner alleges that on 14 September 2007, Respondent Bote Central sought for the registration of the mark 'Alamid' in an attempt to gain exclusive use of the same. On 16 February 2009, Respondent Bote Central was able to secure the registration of the mark in its favor under Registration No. 4-2007-010207 before this Honorable Office. It likewise secured the registration of the following trademarks: "Coffee Alamid Working to Clean and Save the Environment & Logo" and a representation of the face of a palm civet/alamid with Registration No. 4-2006-002806 dated 24 March 2008; and, "Arengga Coffee Alamid" and a representation of a civet/alamid with Registration No. 4-2008-000750 dated 11 February 2010. Accordingly, The Civet/Alamid coffee is known to be the most expensive and rarest coffee. The coffee is called as such because it is actually made from the coffee berries ingested and then excreted by the animal Asian Palm Civet, also known as 'Alamid' in Tagalog.

The Petitioner contends that herein Respondent does not have the exclusive right to the production and sale of Civet/Alamid coffee within and outside the Philippine jurisdiction because Respondent is not the lone producer and/or seller of the said coffee product. In fact, Delfa's Food Products, a duly registered sole proprietorship under the management of herein Petitioner is among the many producers and/or suppliers of the Civet/Alamid coffee. Petitioner was able to build and establish its own Civet/Alamid coffee which she sold under the brand name 'Upland Civet Cafe'.

It was further claimed that the registered mark 'Alamid' is the local name of the animal known as the Asian Palm Civet from the excretion of which the Civet/Alamid coffee is made. Thus, inevitably, producers and suppliers of such coffee, including herein Petitioner, to make use of the local term 'Alamid' to describe or indicate the source\origin of their coffee product. Thus, to grant the exclusive use of the term 'Alamid' to the Respondent with respect to its own Civet/Alamid coffee products will unjustly prejudice

¹ Sole proprietor of Delfa's Food Products with address at 156 Barangay Mangas I, Alfonso, Cavite.

² A corporation duly organized and existing under Philippine laws with business address at 21 Graceful corner Menchie Sts., BF Almanza, Las Pinas 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.

other persons and entities likewise engaged in the production and sale of the same coffee product, who have as much right as the Respondent to engage in the said business activity.

The Petitioner's evidence consists of the following:

1. Petitioner's DTI Certificate of Registration;
2. Certificate of Registration No. 4-2007-010201 for the trademark Alamid of Respondent-Registrant;
3. Certificate of Registration No. 4-2006-002806 for the trademark Alamid Working to Clean and Save the Environment & Logo of Respondent-Registrant;
4. Certificate of Registration No. 4-2008-000750 for the trademark Arengga Coffee Alamid of Respondent-Registrant;
5. Copies of Petitioner's Civet/Alamid coffee labels;
6. Screenshots of websites making reference to the animal "alamid" in the marketing of Civet/Alamid coffee;

On 15 February 2013, Respondent-Registrant filed its Answer, and by way of affirmative defense, states that it is the registered owner of the following marks: Alamid, Registration No. 4-2007-010201; Registration date: 16 February 2009; Coffee Alamid Working to Clean the Environment; Registration No. 4-2007-002806; Registration Date: 24 March 2008; Arengga Coffee Alamid; Registration No. 4-2008-000750; Registration Date: 11 February 2010. The registration of which is preceded by Respondent-Registrant's production and sale of coffee products from Alamid droppings since May 2004. In fact, its 'Coffee Alamid' won 1st Prize in the Trendy Award 2005, a project of the Center for International Trade Expositions and Missions (CITEM) in partnership with COOK Magazine. Respondent-Registrant's 'Coffee Alamid' was also featured in tri-media locally and internationally.

Respondent-Registrant refutes the allegation of the Petitioner that the subject mark is generic. It states that generic term constitutes the common descriptive term of an article or substance; it is commonly used as the name or description of the kind of goods; and it refers to the basic nature of the wares or services provided rather than to the more idiosyncratic (peculiar) characteristics of a particular product.

Accordingly, the term "alamid" does not convey the characteristics, qualities or ingredients of coffee; hence "alamid" is not a common descriptive name of coffee. "Alamid" is the local name of palm civet (genus *Paradoxurus*), a cat-sized mammal roaming our mountainous forests. Coffee, on the other hand and as used in its ordinary sense, is a beverage made by percolation, infusion, or decoction from the roasted and ground seeds of a coffee plant (genus *Coffea*). It also refers to seeds harvested from it, whether grounded or whole seeds. Further, the term "Alamid" is not commonly used as a name of coffee. It is not descriptive of coffee as they are worlds apart in terms of genus. It has gained some undertone only when respondent-Registrant continuously used it in 2004, and earned some suggestive (but not descriptive) connotation of coffee. Thus, it is not commonly used as the name or description of a kind of goods. Finally, the genus of palm civet and coffee greatly differ. Their basic nature also differs. Civets come from the animal kingdom while coffee from plant. Even the peculiar characteristics of coffee could not be associated with the mark "Alamid". Acidity and bitterness, including sweetness, depending on the variety, are the specific characteristics of coffee/coffee beans. No amount of imagination-stretching can be made to associate these idiosyncratic characteristics of coffee to the mark "Alamid".

The Respondent-Registrant's evidence consists of the following:

1. Certificate of Registration No. 4-2007-010201 for the trademark ALAMID;
2. Certificate of Registration No. 4-2006-002806 for the trademark Coffee Alamid Working to Clean & Save the Environment & Logo;

3. Certificate of Registration No. 4-2008-000750 for the trademark Arengga Coffee Alamid Philippine Civet Coffee and Device
4. Certification issued by the Department of Trade of Industry (Coffee Alamid 1st Prize in the Trendy Award 2006);
5. Letter dated 22 August 2012 Re: Alleged Trademark Infringement/Unfair Competition; and, Secretary's Certificate executed by Victor Paolo C. Reyes.

The Preliminary Conference was conducted and terminated on 23 September 2013 wherein parties were directed to submit their respective position papers.

Should Respondent-Registrant's trademark "ALAMID" be cancelled?

A trademark is any distinctive word, name symbol, emblem, sign or device, or any combination thereof, adopted and used by a manufacturer or merchant on his goods to identify and distinguish them from those manufactured, sold or dealt by others. Inarguably, it is an intellectual property deserving protection by law.⁴

As stated in the above definition, a trademark must, first and foremost, be capable of distinguishing one's goods apart from the other. It is the Opposer's contention that the Respondent-Registrant's mark "ALAMID" should not be allowed registration for being generic and/or descriptive. In this regard, Section 123.1 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:

"x x x

- (h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;
- (i) Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;
- (l) Consists exclusively of signs or 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;

x x x"

In **Societe des Produits Nestle vs. Court of Appeals**⁵, the Supreme Court held:

"Generic terms are those which constitute 'the common descriptive name of an article or substance,' or comprise the 'genus of which the particular product is a species' or are 'commonly used as the name or description of a kind of goods,' or 'imply reference to every member of a genus and the exclusion of individuating characters,' or 'refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product,' and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it 'forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is,' or 'if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods,' or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination."

The Respondent-Applicant's mark is the local/Tagalog name of palm civet, also known as Musang or Toddy Cat. This comes from the Genus of Paradoxurus; and from the Species of Hermaphroditus.⁶ It is

⁴ Dermaline Inc. vs. Myra Pharmaceuticals Inc., G.R. No. 190065, 16 August 2010.

⁵ G.R. No. 112012, 04 April 2001.

found from the Himalayas and southern China, Philippines, Malay Peninsula and the Indonesian Islands. It is a highly adaptive animal and can live in dense forests, agricultural areas, and even alongside humans.⁷ On the other hand, a coffee is from coffee beans which are the seeds of berries from the *Coffea* plant. Thus, the two goods differ from each other in nature, characteristics, functions, qualities, ingredients, and even in the Genus and Species it come from. Neither one describes or relates with another, and therefore, do not fall within the legal purview of a generic or descriptive mark. While it is a fact that this involves a coffee product which are excreted by the civets or "alamid", the connection or linkage of the products is not easily ascertained except through the use of perception or imagination. Instead, the said mark is considered suggestive as it connotes the intervention of the alamids in the production of the end-product as coffee beans, by feeding the alamids with berries and later on, excreting the same for roasting.


In the cited case, the Supreme Court explained that suggestive terms are those which, in the phraseology of one court, require "imagination, thought and perception to reach a conclusion as to the nature of the goods." Such terms, "which subtly connote something about the product," are eligible for protection. While suggestive marks are capable of shedding "some light" upon certain characteristics of the goods or services in dispute, they nevertheless involve "an element of incongruity," "figurativeness," or "imaginative effort on the part of the observer. To illustrate, the following marks have been held to be merely suggestive, and therefore, capable of registration: "BAC-A-BELT" for belt backing materials⁸; "SEVENTEEN" for teen-age magazines⁹; "FRUIT SUNDAE" for yogurt¹⁰; and "SUGAR & SPICE" for bake goods¹¹

Finally, it is emphasized that 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.¹² Based on the above discussion, Respondent-Applicant's trademark sufficiently met this function.

WHEREFORE, premises considered, the instant Petition for Cancellation of Trademark Registration No. 4-2007-010201 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, 24 February 2016.


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

⁶ Common Palm Civet, available at http://www.blueplanetbiomes.org/common_palm_civet.htm (last accessed 24 February 2016).

⁷ Id.

⁸ Ref.: See Supply Mfg. Co. vs. King Trimmings, Inc. (1963, DC NY) 220 F Supp 947.

⁹ Ref.: See Triangle Publications, Inc. vs. Rohrlich (1948, CA2) 234 F2d 538).

¹⁰ Ref.: See Johnston Foods, Inc. vs. Carnation Co. (1968, TMT & App Bd) 159 US Pat Quart 625.

¹¹ Mc Carthy on Trademarks and Unfair Competition, vol. 1., s11:20, pp.388-395 citing Watkins Products, Inc. vs. Subway Fruit Products, Inc., (1962, CA7) 311 F2d 496.

¹² 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).