

BERNESE ALPS MILK CO.,
LTD.,

Opposer,

INTER PARTES CASE NO. 1016

OPPOSITION TO:

- versus -

REAL FRESH MILK, INC.,
Respondent-Applicant.

x-----x

Appln. Serial No. 29409
Filed : March 1, 1976
Applicant : Real Fresh Milk, Inc.
Trademark : REALFRESH
Used on : Canned milk products

- a n d -

NUTRITIONAL PRODUCTS,
INC.,

Opposer;

INTER PARTES CASE NO. 1017

OPPOSITION TO:

- versus -

REAL FREHS MILK, INC.,
Respondent-Applicant.

x-----x

Appln. Serial No. 29409
Filed : March 1, 1976
Trademark : REAL FRESH
Applicant : Real Fresh Milk, Inc.
Used on : Canned milk products

DECISION NO. 88-14 (TM)
March 1, 1988

DECISION

Bernese Alps Milk Co., Ltd. filed on October 21, 1976 a Petition for extension of time to file its opposition to an application for the registration of the trademark "REAL FRESH" for canned milk, chocolate flavored drink, egg nog mix, baby formula, whipping cream (30%) half and half, table cream (18%), milk shake mix and ice cream milk. Said application was filed on March 1, 1976 by the Real Fresh Milk, Inc., published in Volume 72, No. 34 of the Official Gazette dated August 23, 1976 and officially released for circulation on September 21, 1976.

Opposer is a foreign corporation duly organized and, existing under the laws of Switzerland, while Respondent-Applicant is likewise a foreign corporation organized and existing under the laws of the State of California, with principal office at 1211 East Noble Avenue, City of Visalia, California, United States of America.

Opposer filed its Verified Notice of Opposition on October 21, 1976 based on the following grounds:

"1. The Opposer is the owner of the 'Bear Brand' trademarks, which are registered with the Philippine Patent Office under Certificate of Registration Nos. 5379, 5380 and 15315;

2. That the Opposer manufactures milk products in cans bearing the 'Bear Brand' trademarks, which are in direct competition with the Respondent-Applicant's canned whole milk products;

3. The 'REAL FRESH' as applied to the canned milk products of the Respondent-Applicant is deceptively misdescriptive of them, as it gives the impression that the said milk products of the Respondent-Applicant are fresh cow's milk when, in fact, they are prepared milk;

4. That the registration of the mark 'REAL FRESH' will result in unfair competition, as the said mark is deceptively misdescriptive of the Respondent-Applicant's canned milk products, as aforesaid."

The Office sent to Respondent-Applicant on January 6, 1977 a Notice to Answer the Notice of Opposition within fifteen (15) days after receipt thereof. In its Answer, the Respondent denied the material allegations made therein and invoked the following special defenses:

"As First Special Defense

4. The trademark applied for registration by the Respondent-Applicant -- REAL FRESH -- is a part of its corporate name continuously used by it since its incorporation up to the present and continuously used by it in the manufacture and sale of the goods produced by it;
5. Being a part of its corporate name continuously used by it in its business and in the sale and disposition of its products, the trademark applied for cannot be said to be deceptively misdescriptive of the products and goods of the Respondent-Applicant;

As Second Special Defense

6. The trademark applied for by Respondent-Applicant, REAL FRESH, has been previously registered by it in the United States and in all other countries where its products are sold and distributed; hence, said trademark distinctly point out the origin and ownership of the goods manufactured under the said trademark;
7. The aforesaid trademark being applied for registration by the Respondent-Applicant is not an imitation of, colorable or otherwise, Opposer's trademark or any other trademark.

As Third Special Defense

8. Respondent-Applicant has every right and authority to use its name to identify its own products;
9. As a consequence of the foregoing Respondent-Applicant is entitled to register its aforementioned trademark, and Opposer has no right or cause to oppose the registration of Respondent- Applicant's trademark.

As Fourth Special Defense

10. As alleged in the Second special Defense, the Respondent-Applicant as owner of the trademark REAL FRESH not only had the same registered in the United States Patent Office (Registration Certificate No. 788,785 issued on April 27, 1965) but has extensively used the same on all the products sold and manufactured by it;
11. The trademark as previously registered in the United States and other countries worldwide in favor of the Respondent-Applicant has been continuously used by it, as aforesaid; hence, the same has gained tremendous goodwill to the Respondent-Applicant and has become clearly distinctive of the goods manufactured and sold by Respondent-Applicant;

12. As a consequence of the foregoing, Respondent-Applicant is entitled to have its trademark registered in its name in the Philippines.

As Fifth Special Defense

13. The usage by the Respondent-Applicant of its firm name to distinguish or identify its products satisfies the object of the mark which is to distinctly point out the origin and ownership of the goods to which the same is affixed; hence, on this basis, Respondent-Applicant is entitled to have its trademark registered in its name in the Philippines.

As Sixth Special Defense

14. If there is any deception or misdescription in the marks, the same can be imputed against the Opposer.

15. As a consequence of the foregoing, Opposer does not have, and the Opposition does not state, any cause of action against the Respondent-Applicant. Indeed, Opposer does not appear to be the real party in interest, it having previously authorized another to bring an opposition against Respondent-Applicant."

Issues having been joined, the pre-trial conference was set to March 22, 1977.

The records further show that hearings were frequently postponed, mostly upon agreement of the parties up to August 15, 1979. Thereafter, there was no showing of further hearings.

To speedily dispose its pending cases, a Notice was sent to the parties on May 8, 1982 setting the hearing of the case to May 20, 1982. The Notice sent to counsel for the Opposer at 4th Floor; Domestic Insurance Building, Anda Circle, Port Area, Manila was, however, returned to the Office "unclaimed".

The above-stated Notice was followed up by a letter dated June 28, 1982 sent at the same addresses on record requesting the parties, to "signify their interest to prosecute this case x x x for the continuation of the hearing" and if we do not hear from them within thirty (30) days from receipt thereof, "this Office will be constrained to render either Judgment, Resolution or Order based on whatever available evidence found in the records of the cause". Said letter was again returned "unclaimed" to this Office.

This development constrained the Office in its Decision No. 83-44 dated March 21, 1983 "to dismiss Inter Partes Case No. 1016 for Opposer's lack of interest to prosecute its case for an unreasonable length of time under Rule 17 of the New Rules of Court".

On March 30, 1983, Opposer filed a Motion for the reconsideration thereof and, finding the Motion meritorious, this Office granted the same through its Resolution No. 83-25 dated April 27, 1983.

Thus, the hearing on the merits resumed. During the hearing on June 15, 1983, July 29, 1983 and September 15, 1983, the parties were negotiating for the amicable settlement of the controversy through a Compromise Agreement.

On March 19, 1984, counsel for Respondent-Applicant filed a Motion to resolve a pending Motion to Dismiss filed way back January 12, 1980 in view of the following considerations:

"1. There is really nothing more to resolve in the instant proceeding because in Civil Case No. 10050 of the then Court of First Instance of Rizal, Branch XI entitled 'F. E.

Zuellig, Inc. vs. Marina Sales, Inc.' the question of whether Respondent-Applicant could continue to use its tradename 'REAL FRESH' has been resolved in favor of the Respondent-Applicant by the parties in the said Civil Case submitting a MOTION TO DISMISS with the effect that the Complaint against the use of the tradename has been withdrawn with prejudice. A copy of the JOINT MOTION TO DISMISS together with the ORDER relative thereto is hereto attached as Annex '1' and made a part hereof.

II. Since it is basic that what had already been the subject of a prior adjudication which had already become final can no longer be re-litigated, it is obvious that the Motion to Dismiss which is still pending resolution by this Honorable Office be now resolved."

In its Resolution No. 84-7 dated April 9, 1984, Respondent-Applicant's Motion to Dismiss was denied for the following reasons:

"1. x x x this Office finds nothing in the said Order /Judgment regarding the registrability or non-registrability of the trademark 'REAL FRESH' in the name of Respondent herein taking into consideration this Opposition. Moreover, the parties in that case are distinctly different from the parties in this present litigation, namely, 'BERNESE ALPS MILK CO., LTD., OPPOSER vs. REAL FRESH MILK, INC., RESPONDENT-APPLICANT".

2. "x x x as aptly pointed out by Opposer's counsel in his Opposition to the said Motion to Dismiss, the herein Opposer was never a party to that case in the Court of First instance of Rizal. For this reason, therefore, it would seem that to grant Respondent's Motion to Dismiss the subject case would not appear to be in order."

A motion for reconsideration of the foregoing resolution was filed by the Respondent-Applicant but was likewise denied in Resolution No. 85-07 dated May 21, 1985.

Unsatisfied with the foregoing rulings, Respondent-Applicant filed on June 20, 1985 with the then Intermediate Appellate Court a Petition for Certiorari for the review of Resolution No. 84-7 dated April 9, 1984 denying its Motion to Dismiss, as well as Resolution No. 85-07 dated May 21, 1985 denying also its Motion for the reconsideration of the same.

The Intermediate Appellate Court, in its Decision promulgated on July 10, 1985, denied the foregoing Petition for Certiorari and dismissed the case for lack of merit.

The Office, thereafter, continued with the hearing of the case on the merits. Pending for resolution was the Motion for the consolidation of Inter Partes Case No. 1017 and Inter Partes Case No. 1016. On the hearing of October 16, 1985, by agreement of the parties involved, the two cases (IPC Nos. 1016 and 1017) were declared consolidated, in open court, by the Hearing Officer. Opposer then started presenting its evidence (Exhs. "A", "A-1", "A-2", "A-3", "A-4", "B" and "C").

On January 24, 1986, Respondent-Applicant, duly assisted by its counsel, filed with this Office a communication withdrawing its Application Serial No. 29409 for the trademark "REAL FRESH", the text of which is hereby quoted hereunder:

"WITHDRAWAL OF APPLICATION"

TO THE DIRECTOR OF PATENTS:

In the matter of application for the registration of the above trademark which is opposed by the Opposer, we wish to inform you that the Applicant no longer is interested in the same inasmuch as for the last several years it has ceased to have its products sold and/or distributed in the country such that the said application is by these presents hereby withdrawn.

Makati, Metro Manila, January 16, 1986.

REAL FRESH MILK, INC.

By:

s/t ADRIAN FONG, SR.

Representative”

With such development, herein Opposition cases have become academic and are thereby terminated ipso facto without further hearing on the merits.

WHEREFORE, the request made by Respondent-Applicant to withdraw its Application Serial No. 29409 filed on March 1, 1976 for the registration of the trademark "REAL FRESH" is GRANTED. Accordingly, Inter Partes Cases Nos. 1016 and 1017 are hereby DISMISSED/TERMINATED for having become academic.

Let the records of the cases be forwarded to the Trademark Examining Division for appropriate action in accordance herewith.

SO ORDERED.

IGNACIO S. SAPALO
Director