

Title: *Masso Hermanos, S. A. v. Director of Patents*

Facts: *Masso Hermanos, S. A.*, a company engaged in the production of canned fish, was the registered owner of the trademark “*Cosmopolite*,” which had been originally registered on March 16, 1917, under Act No. 666 with the Philippine Library and Museum. The registration was valid for thirty years. Upon the expiration of the original registration term, *Masso Hermanos* sought and was granted a renewal on June 6, 1947, by the Director of the Bureau of Commerce, still under the provisions of Act No. 666. Subsequently, with the enactment of Republic Act No. 166, on June 14, 1948, *Masso Hermanos* applied for a new certificate of registration of the same trademark but was denied by a trademark examiner, who reasoned that the word “*Cosmopolite*” was descriptive of canned fish and did not qualify as a trademark under Act No. 666. Thus, it could not be re-registered under Section 41(a) of Republic Act No. 166. *Masso Hermanos* appealed, but the Director of Patents affirmed the examiner’s decision. *Masso Hermanos* then sought relief from the Supreme Court by filing a petition for certiorari.

Issues: The legal issues raised in the Supreme Court’s decision were:

1. Whether the word “*Cosmopolite*” is descriptive of canned fish and hence not eligible for registration as a trademark under Act No. 666.
2. Whether the registration of a trademark under Act No. 666 which was “null and void ab initio” can be subsisting and qualify for renewal under Section 41 of Republic Act No. 166.

Court’s Decision: The Supreme Court set aside the ruling of the Director of Patents, holding that the trademark “*Cosmopolite*” was not descriptive of the merchandise to which it was applied, namely canned fish. Therefore, the original registration of the trademark under Act No. 666 was valid, and it was still subsisting under the law. The Supreme Court ordered the Director of Patents to issue a new certificate of registration for the trademark in exchange for the old certificate No. 1881 that had been surrendered.

Doctrine: The Supreme Court reinforced the doctrine that a trademark is not registrable if it merely describes the name, quality, or description of the merchandise upon which it is to be used. However, general terms not directly describing the product may be acceptable for trademark registration. Furthermore, the Court indicated that overturning longstanding trademark registrations should not be done for “light and unsubstantial reasons.”

Historical Background: This case is set in the historical context of the transition from the trademark law under Act No. 666 to the newer provisions of Republic Act No. 166 in the

Philippines. It deals with the stability of trademark rights over time and the expectations of trademark owners regarding the renewal and continuity of their intellectual property rights under changing legal frameworks. The protection of established trademarks is an element of legal certainty critical for businesses operating within a fluid legislative landscape. The decision by the Philippine Supreme Court reflects the need to balance legal modernization with respect for established rights.