

****Title:**** Societe des Produits Nestle, S.A. vs. Puregold Price Club, Inc.: A Trademark Dispute Over “COFFEE MATCH”

****Facts:**** Societe des Produits Nestle, S.A. (Nestle), a Swiss corporation engaged in marketing and selling various products including coffee, filed an opposition to the application for the registration of the trademark “COFFEE MATCH” by Puregold Price Club, Inc. (Puregold), a Philippine corporation. Nestle claimed exclusive ownership of the “COFFEE-MATE” trademark, arguing that Puregold’s “COFFEE MATCH” would likely mislead the public due to its similarity. The Bureau of Legal Affairs-Intellectual Property Office (BLA-IPO) dismissed Nestle’s opposition due to a procedural defect in the verification and certification against forum shopping. Nestle appealed to the Office of the Director General of the Intellectual Property Office (ODG-IPO), which dismissed the appeal on similar grounds and ruled that the marks were not confusingly similar. Nestle then filed a petition for review with the Court of Appeals (CA), which dismissed the petition on procedural grounds. Nestle filed a motion for reconsideration, which the CA also denied.

****Issues:****

1. Procedural issues regarding the timeliness and verification of Nestle’s filings.
2. Whether the trademarks “COFFEE MATCH” and “COFFEE-MATE” are confusingly similar.

****Court’s Decision:****

1. The Supreme Court found that Nestle timely filed its petition for review, correcting the CA’s mistaken dismissal on timing grounds. However, it agreed that Nestle failed to properly execute a certification against forum shopping, lacking a board resolution or secretary’s certificate proving the authority of their representative.
2. On the substantive issue, the Court sided with the findings of the BLA-IPO and ODG-IPO, holding that “COFFEE MATCH” can be registered as it is not confusingly similar to “COFFEE-MATE.” The Court applied tests for determining trademark similarity and emphasized that the word “COFFEE” could not be appropriated exclusively by either party as it is generic.

****Doctrine:**** The ruling reiterates the importance of following procedural requirements in judicial filings, particularly the requirement for a certification against forum shopping. It also emphasizes the principle that generic terms cannot be exclusively appropriated as trademarks and underscores the application of the dominance and holistic tests in determining trademark similarity.

****Class Notes:****

- ****Procedural Requirements:**** Certifications against forum shopping must be properly authorized and executed, including evidence of such authorization if the signatory is not a natural person.
- ****Trademark Similarity Tests:**** The dominance test focuses on dominant features of trademarks, while the holistic test considers the entirety of the marks, including labels and packaging.
- ****Generic Terms:**** Terms that are generic or descriptive of the goods or services offered cannot be exclusively appropriated as trademarks.

****Historical Background:**** This case highlights the challenges in trademark disputes, especially where common or generic terms are part of the trademarks. It also illustrates the rigorous procedural standards applied by Philippine courts in adjudicating cases to ensure that only duly authorized representations are considered, reflecting the courts' increasing emphasis on procedural detail and accuracy in legal representation.