

ARYSTA LIFESCIENCE CORP.,	}	Inter Partes Case No. 14-2009-00017
<i>Opposer,</i>	}	Case Filed : 06 October 2008
	}	
	}	Opposition to:
-versus-	}	Appl'n. Serial No.: 4-2008-001809
	}	Date Issued : 14 February 2008
	}	Trademark : "LARISTA"
BAYER AKTIENGESELLSCHAFT,	}	
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2009-81

DECISION

This pertains to the opposition to the registration of the mark "LARISTA" bearing Application No. 4-2008-001809 filed on February 14, 1008 covering the goods "*killing weeds and destroying vermin, insecticides, herbicides, fungicides*" falling under class 5 of the International Classification of goods which application was published for opposition in the Intellectual Property Philippines (IPP) E-Gazette, officially released on June 06, 2008.

The Opposer in this instant case is "ARYSTA LIFESCIENCE CORPORATION" a corporation duly organized and existing under the laws of Japan, with principal office located at 8-1, Akashi-cho, Chuo-ko, Tokyo, Japan.

On the other hand, the Respondent-Applicant is "BAYER AKTIENGESELLSCHAFT" with principal office address at Bayer Aktiengesellschaft, Kaiser-Wilhelm-Allee 51373, Germany.

The grounds of the opposition are as follows:

- "1. The Opposer is the first to adopt and use the trade name "ARYSTA" and trademark "ARYSTA LIFESCIENCE (WORD PLUS DESIGN OF TWO LEAVES)" for products falling under International Classes 01 and 05 in the Philippines and therefore, enjoys under Section 147 of Republic Act No. 8293 the right to excludes others from registering or using an identical or confusingly similar mark such as Respondent-Applicant's trademark "LARISTA".

- "2. The Opposer was also first to file an application for the trademark "ARYSTA LIFESCIENCE (WORD PLUS DESIGN OF TWO LEAVES)" for products falling under International Classes 01 and 05 in the Philippines under Application No. 4-2005-004911 which strengthens its right to exclude others from registering or using and identical or confusingly similar mark such as Respondent-Applicant's trademark "LARISTA".

- "3. There is a likelihood of confusion between Opposer's "ARYSTA LIFESCIENCE (WORD PLUS DESIGN OF TWO LEAVES)" and Respondent-Applicant's "LARISTA" because Respondent-Applicant's mark "LARISTA" is closely similar in sound, appearance and spelling to Opposer's trade name "ARYSTA LIFESCIENCE (WORD PLUS DESIGN OF TWO LEAVES)" trademarks. Moreover, Respondent-Applicant's "LARISTA" trademark used for "*preparations for killing weeds and destroying vermin, insecticides, herbicides and fungicides*" in International Class 05 will dilute the distinctiveness and erode the goodwill of Opposer's trademark "ARYSTA LIFESCIENCE (WORD PLUS DESIGN OF TWO LEAVES)", which is an arbitrary trademark when applied to Opposer's identical products, which are fertilizers, chemicals for the

manufacture of pharmaceuticals in class 01 and herbicides, insecticides, pesticides and fungicides for use in agriculture in class 05.

- “4. The Opposer’s “ARYSTA LIFESCIENCE (WORD PLUS DESIGN OF TWO LEAVES)” trademark, as well as its trade name “ARYSTA”, are well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being trademark owned by the Opposer. Hence, the Respondent-Applicant’s trademark “LARISTA” cannot be registered in the Philippines pursuant to the express provision of Section 147.2 of Republic Act No. 8293. No doubt, the use of Respondent-Applicant’s trademark “LARISTA” for its products would indicate a connection between these goods and those of the Opposers. Likewise, the interests of the Opposer are likely to be damaged by Respondent-Applicant’s use of the trademark “LARISTA” for “*preparations for killing weeds and destroying vermin, insecticides, herbicides and fungicides*” in International Class 05.
- “5. The Respondent-Applicant, by using “LARISTA” as its trademark for its products, has given its products the general appearance of the Opposer’s products, which would be likely to influence purchasers to believe that the “LARISTA” products are those of Opposer’s thereby deceiving the public and defrauding the Opposer of its legitimate trade, hence, it is quality of unfair competition as provided in Section 168.3 of Republic Act No. 8293.
- “6. Respondent-Applicant, in adopting “LARISTA” for “*preparations for killing weeds and destroying vermin, insecticides, herbicides and fungicides*” in International Class 05, is likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection or association with the Opposer, or as to origin, sponsorship or approval of its goods by the Opposer, for which it is liable for false designation of origin, false description or representation under Section 169 of Republic Act No. 8293.

Opposer relied on the following facts in support of its opposition:

- “A. The Opposer is the first to adopt and use the trade name “ARYSTA”, as well as apply for registration of the “ARYSTA LIFESCIENCE (WORD PLUS DESIGN OF TWO LEAVES)” trademark in the Philippines.
- “B. There is a likelihood of confusion between Respondent-Applicant’s trademark “LARISTA” and Opposer’s “ARYSTA LIFESCIENCE (WORD PLUS DESIGN OF TWO LEAVES)” trademark.
- “C. The Opposer’s tradename “ARYSTA” and trademark “ARYSTA LIFESCIENCE (WORD PLUS DESIGN OF TWO LEAVES)” is well known internationally and in the Philippines.
- “D. The use of Respondent-Applicant’s trademark “LARISTA” for its products would indicate a connection to the goods covered in Opposer’s “ARYSTA LIFESCIENCE (WORD PLUS DESIGN OF TWO LEAVES)” trademark hence, the interests of the Opposer are likely to be damaged.

Opposer submitted the following in support of its opposition:

Exhibit	Description
Exhibit “A”	Affidavit of Nobumasa Ishia
Exhibit “B”	Copies of Registration certificate indicating registration of “ARYSTA LIFESCIENCE” in

	various countries.
Exhibit "C" and Series	Commercial Invoices
Exhibits "D" and Series	Actual labels.
Exhibits "E" and Series	Print-out copies of pages downloaded from the website of Opposer regarding the world-wide use and history of the "ARYSTA LIFESCIENCE".
Exhibits "F" and Series	Advertisements and promotional items in the Philippines
Exhibit "G"	Certified true copy with English translation of the favorable Decision rendered by the court of "Peru".

Respondent-Applicant failed to file its answer despite having received the Notice to Answer issued by the Bureau of Legal Affairs (BLA) on March 18, 2009.

Section 11 of the Summary Rules (Office Order No. 79, Series of 2005), provides:

Section 11. *Effect of failure to file an Answer.* – In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

The issue to be resolved in this particular case is:

WHETHER OR NOT RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK "LARISTA".

The applicable provision of law is Section 123.1 (d) of Republic Act No. 8293, which provides:

"Section 123.1. A mark cannot be registered if it:

- "(d) Is identical with a registered mark belonging to a different proprietor or 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;"

The contending trademarks are reproduced below for comparison and scrutiny.



Opposer's mark



Respondent-Applicant's mark

The Opposer's mark is a composite one, as it is composed of *many* components. They are the design of two leaves, the word "ARYSTA" and "LIFESCIENCE". On the other hand, the Respondent-Applicant's mark consists only of the word "LARISTA".

In ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, two kinds of tests have been developed. The *dominancy test* applied in *Asia Brewery, Inc., vs. Court of Appeals*, 224 SCRA 437; *Co Tiong Sa vs. Director of Patents*, 95 Phil. 1; *Lim Hoa vs. Director of Patents*, 100 Phil. 214; *American Wire & Cable Co., vs. Director of Patents*, 31 SCRA 544; *Philippine Nut Industry, Inc., vs. Standard Brands, Inc.*, 65 SCRA 575; *Converse Rubber Corp., vs. Universal Rubber Products, Inc.*, 147 SCRA 154 and the *holistic test* developed in *Del Monte Corp., vs. Court of Appeals*, 181 SCRA 410; *MEAD Johnson & Co., vs. N.V.J. Van Dorp, Ltd.*, 7 SCRA 771; and in *Bristol Myers Co., vs. Director of Patents*, 17 SCRA 128.

As it implies, the *test of dominancy* focuses on the similarity of the prevalent, essential or dominant features of the competing trademarks which might cause confusion or deception. On the other side of the spectrum, the *holistic test* mandates that the *entirety* of the mark in question must be considered in determining confusing similarity.

In the case at bar, the dominant feature of the Opposer's mark is the word "ARYSTA" which is almost identical with the Respondent-Applicant's mark "LARISTA" in terms of sound or pronunciation.

One vital point to be taken into consideration is the fact that the goods covered by the contending trademarks are exactly the same, class 05 of the International Classification of goods such as "*fungicides*". Where goods are advertised over the radio, similarity of sound is of special significance. Similarity of sound is a sufficient ground for holding that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.

It is interesting to note that the word "ARYSTA" as one of the components of Opposer's mark is almost the same with the Respondent-Applicant mark "LARISTA" in terms of sound or pronunciation.

If the Respondent-Applicant's trademark application be allowed and approved, the likelihood of confusion on the part of the consuming public, as well as confusion of source, affiliation or origin of the products or connection is bound to occur if Respondent-Applicant's mark be registered.

In "*American Wire & Cable Co., vs. Director of Patents et. al.*, 31 SCRA 544 [G.R. No. L-26557, February 18, 1970]," the Supreme Court ruled:

"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. In short, to constitute an infringement of an existing trademark patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it."

The Opposer's trademark have been filed for its registration with the Intellectual Property Philippines (IPP) bearing Application No. 4-2005-004911 on May 26, 2005 covering the goods falling under classes 1 and 5 of the International Classification of goods.

On the other hand, the Respondent-Applicant's trademark application for "LARISTA" was filed only on February 14, 2008 with the Intellectual Property Philippines (IPP) a period of more than *three (3) years later*, hence, Opposer's mark is a bar for the registration of the Respondent-Applicant's mark pursuant to Section 123 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines.

When one applies for the registration of a trademark or label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without any opposition on the part of the owner and user of a previously registered label or trademark, this not only to avoid confusion on the part of the public, but also to protect an already *used* and *registered* trademark and an established goodwill. (Chuanchow Soy & Canning Co., vs. The Director of Patents and Rosario Villapanta [G.R. No. L-13947, June 30, 1960])

WHEREFORE, in light of all the foregoing, the opposition is, as it is hereby SUSTAINED. Consequently, Application No. 4-2008-001809 filed on February 14, 2008 by Respondent-Applicant "BAYER AKTIENGESELLSCHAFT" for the mark "LARISTA" is, as it is hereby REJECTED.

Let the filewrapper of the trademark "LARISTA" subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 22 June 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office