

MARS, INCORPORATED)	INTER PARTES CASE NO. 3669
Opposer,)	
)	OPPOSITION TO:
)	
)	Serial No. 70109
)	Filed : November 21, 1989
- versus -)	Applicant : CFC Corporation
)	Trademark : TRIX
)	Used on : Chocolate caramel
)	candies
)	
)	DECISION NO. 94-27 (TM)
CFC CORPORATION)	
Respondent-Applicant.))	March 10, 1994
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DECISION

This pertains to an opposition filed by MARS, INCORPORATED, a corporation of the State of Delaware, U.S.A., with office at 6885 Elm Street, McLeacn, Virginia, 112101, U.S.A., against the application for the registration of the mark "TRIX", bearing Serial No. 70109, filed on November 21, 1989 by CFC Corporation of Pasig, Metro Manila, for chocolate caramel candies which application was published in Vol. IV, No. 1, page 32 of the Bureau of Patents Trademarks and Technology Transfer (BPTTT), Official Gazette and was officially released for circulation on March 21, 1991.

The grounds for the opposition are as follows:

"1. The registration of the captioned trademark is contrary to the provisions of Sec. 4(d), Chapter II of Republic Act No. 166, as amended, which prohibits the registration of:

". . . A mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers".

2. Opposer is the owner of the tradename "TWIX" for use on candies duly registered with the BPTTT under certificate of Registration No. 39139 issued on June 1, 1988. A copy of the said certificate of registration is hereto attached as Annex "A" and made an integral part hereof.

3. Opposer's "TWIX" trademark is a well known or world famous mark and the registration of Respondent-Applicant's "TRIX" trademark will constitute a violation of Article 6bis of the Convention of Paris for the Protection of Industrial Property in conjunction with the memoranda of the then Minister of Trade dated November 20, 1980 and October 25, 1983.

4. The registration of the captioned mark is likely to cause confusion, mistake or deceive purchasers in view of the fact that Respondent-Applicant's "TRIX" trademark is similar to Opposer's "TWIX" trademark used on similar goods".

Opposer relies on the following facts to support its opposition:

a) Long before the alleged date of first use of the mark "TRIX" by Respondent-Applicant on September 1, 1989, herein Opposer has adopted, used and registered the trademark "TWIX" in the United States on March 22, 1983. The said mark was thereafter used and registered in other countries of the world including the Philippines. A copy of United States Patent and Trademark Office Certificate of Registration No. 1,232,085 is hereto attached as Annex "B" and made and integral part hereof.

b) Opposer's trademark "TWIX" is widely promoted and by virtue of its long and extensive use and various registrations in several countries has gained international fame and acceptance.

c) By virtue of the use by Opposer of its "TWIX" trademark in international commerce, the sale of its products depicting its mark on an international scale. Opposer's products identified by its mark have acquired immense popularity and goodwill and placed the said mark in the rank of internationally famous marks.

d) The registration of Respondent-Applicant's trademark "TRIX" which is obviously a colorable imitation of Opposer's well-known "TWIX" mark will be violative of the memoranda of the then Minister of Trade dated November 20, 1980 and October 25, 1983, which prohibits the registration of world famous marks by applicants other than their true owners.

e) Moreover, the business reputation established and acquired by Opposer through the years of continuous and exclusive use of its "TWIX" trademark, is likely to be seriously jeopardized and impaired. Consequently, Opposer will continuously suffer damages due to the dilution of the value of its mark and loss of prestige.

f) Further, Respondent-Applicant's adoption and use of its trademark "TRIX" is not a mere coincidence but is a result of a deliberate and well calculated scheme to take advantage of the popularity and goodwill of Opposer's trademark "TWIX".

g) Finally, the trademark "TRIX" of Respondent-Applicant is visually and phonetically similar to the trademark "TWIX" of the Opposer such that it will likely influence purchasers to believe that the goods of Respondent-Applicant are those of Opposer or sponsored by Opposer thereby defrauding and damaging the public in general and Opposer, Mars, Incorporated, in particular.

On June 17, 1991, respondent-applicant filed its Answer to the Notice of Opposition denying all the material allegations therein and further alleged that:

1. Respondent-applicant's trademark "TRIX" is clearly not confusingly similar (or identical) while opposer's alleged trademark "TWIX";
2. The trademark "TRIX" is clearly not confusingly similar with the mark "TWIX" when viewed in their entirety or overall presentation as they appear in the respective labels or wrappers they are used.
3. The trademarks "TRIX" and "TWIX" are patently different from each other. The likelihood of causing confusion mistaking one for the other, or deceiving purchasers is not possible.

4. For all the reasons mentioned above, the registration of the trademark "TRIX" in the name of respondent-applicant is not proscribed by Sec. 4 (d) of R.A. No. 166 as amended, contrary to the opposer's claim.

5. Opposer is now estoppel from alleging confusing similarity between the trademarks "TRIX" and "TWIX" and requesting for the denial of the former's registration in respondent-applicant's name because it is guilty of laches.

The parties were not able to come out with an amicable settlement for which trial on the merit was conducted.

The main issue to be resolved in this particular case is whether or not Respondent-Applicant's trademark "TRIX" is confusingly similar to opposer's trademark "TWIX".

Our Trademark Law, particularly Section 4(d) thereof, provides as follows:

"Sec. 4. Registration of trademarks, tradenames and service marks on the principal register. There is hereby established a register of trademarks, tradenames and service marks which shall be known as the principal register. the owner of a trademark, tradename or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register unless it:

xxx

(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers".

Well settled is the rule that the determinative factor in a contest involving registration of trademarks is not whether the challenged mark would actually cause confusion or deception on the purchasers but whether the use of such mark would likely to cause confusion or mistake on the part of the buying public. To constitute infringement, the law does not require that the competing trademarks be so identical as to produce actual error or mistake. It would be sufficient for that 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 (American Wire & Cable Co. vs. Director of Patents 31 SCRA 544).

In the case at bar and as shown by the evidence presented the respondent-applicant's trademark "TRIX" is confusingly similar to opposers registered and not abandoned trademark "TWIX".

It must be noted that the two competing trademarks consist only of one (1) syllable and four (4) letters. The only distinction they have is that the opposer's mark "TWIX" has the latter "W" and as the other hand respondent-applicant's mark "TRIX" has the letter "R". However, when the two marks are pronounced, they are almost the same if not identical, hence, there is no doubt that the similarity between the competing marks is apparent.

Attention must be given to the observations of the Supreme Court in the American Wire and Cable Co. vs. Director of Patents 31 SCRA 544 that:

"xxx The similarity between the competing trademarks, DURAFLEX and DYNAFLEX is apparent. Not only are the initial letters and the last half of the appellations identical but the difference exists in only two out of the eight literal elements of the designations. Coupled with the fact that both marks cover

insulated Flexible wires under class 20 xxx no difficulty is experienced in reaching the conclusion that there is a deceptive similarity that would lead the purchaser to confuse one product with another.

In holding BONAMINE to be phonetically similar to DRAMAMINE the Seventh Circuit Court said:

“DRAMAMINE and BONAMINE contain the same number of syllables; they have the same stress pattern, with primary accent on the first syllable and secondary accent on the third; and the last two syllables of DRAMAMINE and BONAMINE are identical. The initial sounds of DRAMAMINE and BONAMINE [‘d’ and ‘b’] are both what are known as voiced plosives’ and are acoustically similar, the consonants “m” and “n” are nasal sounds and are acoustically similar. The only dissimilar sound in the two trademarks is the “R” in DRAMAMINE. Slight difference in the sound of similar trademarks will not protect the infringer”. (G.S. Searle & Co. v. Chas. Pfizer & Co. [1959, CA 7 111] 265 F 2d 386, 121 USPQ 74)

In another case, the Supreme Court uniformly ruled that the trademark “LIONPAS” for medicated plaster cannot be registered because it is confusingly similar to “SALONPAS”, a registered mark also for medicated plaster. The Honorable Supreme Court stated:

“Although two letters of “SALONPAS” are missing in “LIONPAS”, nevertheless, when the two words are pronounced, the sound effects are confusingly similar. When goods are advertised over the radio, similarity in 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 (Marvex Commercial Co. Inc. v. Petro Hawpia & Co., L-19297, Dece. 22, 1966 18 SCRA 1178)”.

In *Co Tiong Sa vs. Director of Patents* (L-5378, May 24, 1954, 95 Philippines) the application for the trademark “FREEDOM” was rejected over the existing registration of the trademark “FREEMAN” for the same class of goods.

Moreover, the merchandise or goods being sold by the parties herein are ordinary commodities purchased by average persons who are at times ignorant and unlettered. These are the persons who will not, as a rule, examine the printed small letters on the container but will simply be guided by the striking dominant mark SUPER on the label. Differences there will always be, but what-ever they are, these play into insignificance in the face off an evident similarity of the dominant feature (the word super) and overall appearance of the labels (*Phil. Nut Industry Inc. vs. Standard Brand Inc.* 65 SCRA 575)

Those who desire to distinguish their goods from the goods of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals, etc., as to justify one who really wishes to distinguish his product from those of all others in entering the twilight zone of the field already appropriated by another (*Weco Products Co. vs. Milton Ray Co.*, 143 F. 2d 985, 31 C.C.P.A. Patents 1214).

“Why of the million of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another’s trademark if there was no intent to take advantage of the goodwill generated by the other mark (*American Wire and Cable Co., vs. Director of Patents*, 31 SCRA 544)

“xxx Why with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from, the defendant company

(Manila Candy Co.) elected two roosters as its trademark, although its directors and managers must have been well aware of the long continued use of a rooster by the plaintiff with the sale and achievement of its goods? xxx a cat, a dog, a carabao, a shark, or an eagle stamped upon the container in which candies are sold would serve as well as a rooster for purposes of identification as the product of defendant's factory. Why did defendant select two roosters as its trademark? (Clarke vs. Manila Candy Co., 36 Phil. 100)

In another case, "Operators, Inc. vs. Director of Patents, 15 SCRA 149, THE Supreme Court ruled:

"Considering the similarities in appearance and sound between the marks "AMBISCO and NABISCO", the nature and similarity of the products of the parties, confusion of purchasers is likely".

It cannot be gain said in the case at bar, the mark "TRIX" of respondent-applicant and "TWIX" of opposer are phonetically similar. The similarity of the trademarks in question as to sound is so clear and beyond further examination and hearing aid to determine the same is no longer necessary.

WHEREFORE, the Notice of Oppositions hereby SUSTAINED. Accordingly, Application Serial No. 70109 for the trademark "TRIX" filed by CFC Corporation is hereby REJECTED.

Let the filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision and furnished the Trademark Examining Division to update its records.

SO ORDERED.

IGNACIO S. SAPALO
Director