

DOW AGROSCIENCES L.L.C.,	}	Inter Partes Case No. 14-2008-00194
Opposer,	}	Case Filed: 28 August 2008
	}	Opposition to:
	}	
-vs-	}	Appl'n. Serial No. : 4-2007-012186
	}	Date Filed: 05 November 2007
	}	Trademark: "EMTHANE"
SABERO ORGANICS PHILIPPINES,	}	
ASIA, INC.,	}	
Respondent-Applicant.	}	
x-----x	}	Decision No. 2009-50

DECISION

This is an opposition to the registration of the mark "EMTHANE" bearing Application Serial No. 4-2007-012186 filed on 05 November 2007 covering the goods "*fungicides*" falling under Class 5 of the International Classification of goods which trademark application was published for opposition on the Intellectual Property Philippines (IPP) Electronic Gazette (E-Gazette), officially released for circulation on 02 May 2008.

The Opposer in the opposition is "DOW AGROSCIENCES LLC", a limited company duly organized and existing under and by virtue of the laws of the State of Delaware, United States of America with principal office address located at No. 9330 Zionsville Road, Indiana 46268, United States of America.

On the other hand, the Respondent-Applicant is "SABERO ORGANICS PHILIPPINES ASIA, INC.", a domestic corporation with principal office address at Unit 2005-13 West Tower, Philippine Stock Exchange Center, Exchange Road, Ortigas Center, Pasig City.

The grounds of the opposition are as follows:

- "1. Opposer "DOW AGROSCIENCES LLC" is the registered owner of the mark "DITHANE" for Insecticides, Fungicides or Disinfectants in Class 5 (U.S Class 6) under U.S. Certificate of Registration No. 409,848 issued as early as October 24, 1944 and the mark "DITHANE M-45" for Fungicides for agricultural use in Class 5 under U.S Certificate of Registration No. 1,351,283 issued on July 30, 1985.
- "2. Opposer and Opposer's predecessors in interest have likewise registered the trademark "DITHANE" for Broad Spectrum protectant fungicides in Class 5 in the Philippines under Philippine Certificated of Registration No. 1433 issued on October 11, 1954; and more recently under Philippine Certificate of Registration No. 4-1998-005168 issued on July 01, 2005 and the trademark "DITHANE M-45" for fungicides for use in agricultural, horticulture, forestry, turf and ornamental application in Class 5 under Philippine Certificate of Registration No. 4-1998-005167 issued on December 16, 1985.
- "3. Opposer has registered the trademarks "DITHANE" and "DITHANE M-45" in 120 countries of the world. Additionally, Opposer has sold over two billion U.S. Dollars worth of DITHANE ® branded goods over the years. Applicant Sabero lists EMTHANE M-45 fungicide on their website as a mancozeb based fungicide, which is an imitation knock-off product of Opposer's "DITHANE M-45" fungicide.
- "4. Opposer has widely used the marks "DITHANE" and "DITHANE M-45" and distributed its products using the marks "DITHANE" and "DITHANE M-45" throughout the world and the same are widely known around the world to be

exclusively owned by the Opposer. Hence, registration of the similar mark “EMTHANE” in the name of Respondent-Applicant is contrary to the clear provisions of Article 6bis of the Paris Convention for the Protection of Industrial Property (Lisbon Revision) and the pertinent provisions of the GATT-TRIPS Agreement both of which the Philippines is a signatory, and which are being enforced in this jurisdiction by virtue of Section 123 (d), (e) and (f) of the Intellectual Property Code (R.A. No. 8293), which provide that:

Section 123. *Registrability.* – A mark cannot be registered if it:

- | | | |
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| x | x | x |
|---|---|---|
- (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;
 - (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, that in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;
 - (f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, that use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, that the interests of the owner of the registered mark are likely to be damaged by such use;”

“5. The Respondent-Applicant’s mark “EMTHANE” is used on nearly “identical” goods is confusingly similar to the marks “DITHANE” and “DITHANE M-45” first registered in the Philippines in 1954 with over 50 years of use by Opposer as to be likely, when applied to or used in connection with Respondent-Applicant’s goods, to cause confusion or mistake and deceive the public or the public may be led to believe that the goods of Respondent-Applicant is owned by Opposer or originated from or sponsored by the Opposer. Thus, the application for registration of the mark “EMTHANE” in the name of Respondent-Applicant’s Application No. 4-2007-012186 has already been proscribed by Opposer’s prior registration for similar marks under Section 123.1 (d) but also because Opposer’s mark “DITHANE” and “DITHANE M-45” are world famous marks which are protected by Section 123.1 (e) and (f) of the Intellectual Property Code.

“6. The registration of the mark “EMTHANE” in the name of Respondent-Applicant will cause grave and irreparable injury and damage to the Opposer within the meaning of Section 134 of Republic Act No. 8293.

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

- “a. Opposer, DOW AGROSCIENCES LLC is the registered owner and proprietor of the world renowned trademarks “DITHANE” and “DITHANE M-45” registered in 1954 in the Philippines under Registration No. 1433.
- “b. Opposer is the registered owner of the mark “DITHANE” for Insecticides, Fungicides or Disinfectants in Class 5 (U.S. Class 6) under U.S. Certificate of Registration No. 409.848 issued as early as October 24, 1944 and the mark “DITHANEM-45” for Fungicides for agricultural use in Class 5 under U.S. Certificate of Registration No. 1,351, 283 issued on July 30, 1985 and registration granted in 1954, in the Philippines under Registration No. 1433.
- “c. Opposer has likewise registered the trademark “DITHANE” for Broad Spectrum protectant fungicides in Class 5 in the Philippines under Philippine Certificate of Registration No. 4-1998-005168 issued on July 01, 2005 and the trademark “DITHANE M-45” for Fungicides for use in agricultural, horticulture, forestry, turf and ornamental applications in Class 5 under Philippine Certificate of Registration No. 4-1998-005167 issued on December 16, 1985.
- “d. Opposer has registered the trademarks “DITHANE” and “DITHANE M-45” in many other countries of the world.
- “e. The mark “DITHANE” was first used and adopted by Opposer as early as April 28, 1944, while the mark “DITHANE M-45” was first used and adopted by Opposer on July 18, 1984.
- “f. Opposer has used the marks “DITHANE” and “DITHANE M-45” for its products throughout the world making the marks “DITHANE” and “DITHANE M-45” well-known around the world, including the Philippines.
- “g. The Respondent-Applicant’s mark “EMTHANE” is confusingly similar to Opposer’s marks “DITHANE” and “DITHANE M-45” because Respondent-Applicant conveniently copied and the essential elements of DOW AGROSCIENCES LLC marks, i.e. The letter “T”, “H”, “A”, “N”, “E” of the marks “DITHANE” and “DITHANE M-45” made them the dominant elements of its “EMTHANE” mark. In addition, on applicant’s website, www.sabero.com, applicant calls the product “EMTHANE M-45” copying the M-45 of Opposer’s registrations.
- “h. Moreover, Respondent-Applicant’s mark “EMTHANE” is used on goods similar or closely related to the goods covered by the Opposer’s marks “DITHANE” and “DITHANE M-45”.
- “i. The uncanny similarity in the marks and the use of Respondent-Applicant’s mark make it very obvious that the Respondent-Applicant is riding on the international popularity of Opposer’s marks “DITHANE” and “DITHANE M-45” and is passing off its goods as those of the Opposer.
- “j. Opposer has spent large sums of money for advertising and popularizing its products using the marks “DITHANE” and “DITHANE M-45”, which coupled with Opposer’s long use and unblemished and esteemed public reputation as manufacturer and distributor of superior and high quality pharmaceutical products

and other chemicals, has generated and established an immense and valuable goodwill for its marks "DITHANE" and "DITHANE M-45" the world over.

- "k. Moreover, the use and registration of the mark "EMTHANE" by Respondent-Applicant will likely cause the dilution of the advertising value of the Opposer's marks "DITHANE" and "DITHANE M-45" and the excellent image of the marks "DITHANE" and "DITHANE M-45" and will surely weaken their power of attraction.
- "i. Under the circumstances, the use and registration of the mark "EMTHANE" by Respondent-Applicant will amount to a violation of Opposer's propriety rights over the mark "DITHANE" and "DITHANE M-45", will cause great and irreparable injury to Opposer and will likely prejudice the public who might mistakenly believe that Respondent-Applicant's goods are those of the Opposer's or sponsored by Opposer, or originated from or are to Opposer herein.

Opposer submitted the following as its exhibits in support of its opposition.

Exhibit	Description
Annex "A" and "B"	Certified true copies of U.S. Registration No. 409,848 and 1,351,283
Annex "C" and "D"	Certified true copies of Philippine Certificate of Registration No. 4-1999-005167 issues on December 16, 1985 and Registration granted in 1954 and Registration No. 4-1998-005168.
Annex "E"	List of registration of "DITHANE" around the world.
Annex "F" and "G"	Sample product packaging labels of the marks "DITHANE" and "DITHANE M-45"

The Respondent-Applicant failed to file its Verified Answer despite receipt of the Notice to Answer on September 30, 2008, issued by the Bureau of Legal Affairs dated 12 September 2008.

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 THE RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK "EMTHANE".

The applicable provision of the law is Section 123.1 (g) and (h) of Republic Act No. 8293, which provides:

Sec. 123. *Registrability*—123.1. A mark cannot be registered if it:

x

x

x

"(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.

DITHANE	EMTHANE
Opposer's mark	Respondent-Applicant's mark

The contending trademarks are composed of seven (7) letters each and two (2) syllables. The last syllable is the word "THANE" which is exactly the same in spelling and pronunciation as well as composition of letters. The two trademarks differ only in their first syllable, however, this slight distinction does not in anyway negate the existence of confusingly similarity the overall impression remains the same.

The determinative factor in a contest involving registration of trademark 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 purpose 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. (American Wire & Cable Company vs. Director of Patents et. al., [31 SCRA 544] [G.R. No. L-26557, February 18, 1970]).

It cannot be denied that the essential elements of the competing trademarks is the word or letters "T", "H", "A", "N", "E", which is exactly the same spelling and pronunciation. As such confusing similarity exists between the two marks.

As shown in the records, the Opposer's trademark "DITHANE" has been registered with the Intellectual Property Office bearing Registration No. 4-1998-005168, date of registration July 01, 2005 for "*broad spectrum protectant fungicides*", in Class 5 of the International Classification of goods (Exhibit "C") and Registration No. 4-1998-005167 for "*fungicides for use in agriculture, horticulture, forestry, turf and ornamental applications*" also in Class 5 (Exhibit "D").

Opposer's mark is likewise registered in the United States Patent and Trademark Office, bearing Registration No. 1,351,283 issued on July 30, 1985 (Exhibit "B").

Another document showed that the mark of the Opposer has been registered in the United States Patent and Trademark Office on October 24, 1944, more than sixty (60) years ago. (Exhibit "A")

Considering therefore that the Respondent-Applicant's mark is confusingly similar to the Opposer's registered trademark, the approval of the application in question is contrary to Section 123.1 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines. Likelihood of confusion on the part of the consuming public is bound to occur, as well as confusion of source or origin. Compounding the likelihood of confusion and deception is the fact that the goods upon which Respondent-Applicant's trademark are to be used on almost identical or closely related goods of the Opposer and are falling under Class 5 of the International Classification of goods, more particularly "*fungicides*".

WHEREFORE, in view of all the foregoing, the opposition is, as it is hereby SUSTAINED. Consequently, Trademark Application No. 4-2007-012186 for the mark "EMTHANE" filed on November 5, 2007 by SABERO ORGANICS PHILIPPINES ASIA, INC., is, as it is hereby REJECTED.

Let the filewrapper of the trademark "EMTHANE" 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 April 2009.

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