Republic of the Philippines
SUPREME COURT
Manila

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G.R. No. L-17501 April 27, 1963

MEAD JOHNSON and COMPANY, petitioner,

vs.

N. V. J. VAN DORP, LTD., ET AL., respondents.

Ross Selph and Carrascoso for petitioner.
Manuel Y. Macias for respondent N. V. J. Van Dorp. Ltd.
Office of the Solicitor General for respondent Director of the Patent Office.

BAUTISTA ANGELO, *J.:*

On June 2, 1956, N. V. J. Van Dorp, Ltd. a corporation organized under the laws of Netherlands, located and doing business at Gouda, Netherlands, filed an application for the registration of the trademark "ALASKA and pictorial representation of a Boy's Head within a rectangular design (ALASKA disclaimed)." The trademark was published in an issue of the Official Gazette which was officially released on June 5, 1956.

Mead Johnson & Company, a corporation organized under the laws of Indiana, U.S.A., being the owner of the trademark "ALACTA" used for powdered half-skim milk, which was registered with the Patent Office on June 12, 1951, filed an opposition on the ground that it will be damaged by the said registration as the trademark "ALASKA" and pictorial representation of a Boy's Head within a rectangular design (ALASKA disclaimed), used for milk, milk products, dairy products and infant's foods, is confusingly similar to its trademark "ALACTA".

In answer to the opposition the applicant alleged that its trademark and product "ALASKA" are entirely different from oppositor's trademark and product "ALACTA", since applicant's product covers milk, milk products, dairy products and infant's foods which fall under Class 47 Foods and Ingredients of Foods, while oppositor's products cover pharmaceutical preparations for nutritional needs which fall under Class 6, which refers to Medicines and Pharmaceutical Preparations.

Wherefore, the parties respectfully pray that the foregoing stipulation of facts be admitted and approved by this Honorable Court, without prejudice to the parties adducing other evidence to prove their case not covered by this stipulation of facts.

After issues were joined, and after due hearing, the Director of the Patent Office, on August 26, 1960, rendered decision dismissing the opposition and holding that the trademark sought to be registered does not sufficiently resemble oppositor's mark "as to be likely when applied to the goods of the parties to cause confusion or mistake or to deceive purchasers" even if oppositor's goods, half-skim powdered and powdered whole milk and those of applicant's condensed and evaporated milk are similar as they have the same descriptive properties, both goods being milk products.

Hence, oppositor filed the present petition for review.

Petitioner contends that the Director of the Patent Office erred (1) in holding that the mark which respondent seeks to register does not resemble petitioner's mark as to be likely when applied to the goods to cause confusion or mistake or to deceive purchasers, and (2) in holding that the trademark sought to be registered has become distinctive based on its extensive sales.

Anent the first point, petitioner seems to dispute the finding of the Director of the Patent Office by emphasizing the striking similarities existing between the trademark "ALASKA" which is sought to be registered and that of "ALACTA" which petitioner has long registered for the protection of its products. Thus, it is argued, in appearance and sound the trademarks "ALASKA" and "ALACTA" are sufficiently close. The three vowels are the same in both and the public would pronounce them short accenting on the second syllable. Both marks have the same number of letters and the vowels are placed on the same position. The general form and sound of the words are of marked similarity so as to suggest the likelihood of confusion. While "ALACTA" and "ALASKA" differ entirely in meaning, they are confusingly similar in appearance. The three letter prefixes of both marks are identical. Both marks end with the same letter "A". The only difference lies in the letters "CT" in "ALACTA" and "SK" in "ALASKA". And in support of its contention, petitioner cites the case of Esso Standard Oil Company v. Sun Oil Company, et al., 46 TMR 444, wherein it was held that SUNVIS and UNIVIS are quite different in sound and meaning but in their entireties they are confusingly similar in appearance. Said the Court:

> As already noted, it found on the basis of the evidence before it that the two marks are quite different in sound and meaning but that in their entireties the marks are confusingly similar in appearance, because of their having identical suffixes and three letter prefixes with the same two letters UN in the same order.

On the other hand, respondent contends that it is not correct to say that in passing on the question as to whether the two marks are similar only the words "ALASKA" and "ALACTA" should be taken into account since this would be a most arbitrary way of ascertaining whether similarity exists between two marks. Rather, respondent contends, the two marks in their entirety and the goods they cover should be considered and carefully compared to determine whether petitioner's opposition to the registration is capricious or well-taken. In this connection, respondent invokes the following rules of interpretation: (1) appellant's mark is to be compared with all of the oppositor's marks in determining the point of confusion;[1] (2) the likelihood of confusion may be determined by a comparison of the marks involved and a consideration of the goods to which they are attached;[2] and (3) the court will view the marks with respect to the goods to which they are applied, and from its own observation arrive at a conclusion as to the likelihood of confusion.[3]

It is true that between petitioner's trademark "ALACTA" and respondent's "ALASKA" there are similarities in spelling, appearance and sound for both are composed of six letters of three syllables each and each syllable has the same vowel, but in determining if they are confusingly similar a comparison of said words is not the only determinant factor. The trademarks in their entirety as they appear in the respective labels must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other. Having this view in mind, we believe that while there are similarities in the two marks there are also differences or dissimilarities which are glaring and striking to the eye as the former. Thus we find the following dissimilarities in the two marks:

(a) The sizes of the containers of the goods of petitioner differ from those of respondent. The goods of petitioner come in one-pound container while those of respondent come in three sizes, to wit: 14-ounce tin of full condensed full cream milk; 14-1/2-ounce tin of evaporated milk; and 6-ounce tin of evaporated milk.

(b) The colors too differ. One of petitioner's containers has one single background color, to wit: light blue; the other has two background colors, pink and white. The containers of respondent's goods have two color bands, yellowish white and red.

(c) Petitioner's mark "ALACTA" has only the first letter capitalized and is written in black. Respondent's mark "ALASKA" has all the letters capitalized written in white except that of the condensed full cream milk which is in red.

Again, coming to the goods covered by the trademarks in question, we also notice the following dissimilarities:

In the petitioner's certificate of registration, it appears that the same covers "Pharmaceutical Preparations which Supply Nutritional Needs" which fall under Class 6 of the official classification as Medicines and Pharmaceutical Preparations", thus indicating that petitioner's products are not foods or ingredients of foods but rather medicinal and pharmaceutical preparations that are to be used as prescribed by physicians. On the other hand, respondent's goods cover "milk, milk products, dairy products and infant's foods" as set forth in its application for registration which fall under an entirely different class, or under Class 47 which refers to "Foods and Ingredients of Foods", and for use of these products there is no need or requirement of a medical prescription.

In view of the above dissimilarities, the Director of the Patent Office overruled petitioner's opposition in the following wise:

> Considering the substantial difference in the marks as displayed on the respective labels of the parties and considering the distinctiveness of the mark of applicant, acquired from its extensive sales, it is concluded that the applicant's mark does not resemble opposer's mark as to be likely when applied to the goods of the parties to cause confusion or mistake or to deceive purchasers.

We have examined the two trademarks as they appear in the labels attached to the containers which both petitioner and respondent display for distribution and sale and we are impressed more by the dissimilarities than by the similarities appearing therein in the same manner as the Director of the Patent Office, and because of this impression we are persuaded that said Director was justified in overruling petitioner's opposition. Hence, we are not prepared to say that said Director has erred in overruling said opposition.

WHEREFORE, the decision appealed from is affirmed, with costs against petitioner.

Bengzon, C.J., Padilla, Labrador, Concepcion, Reyes, J.B.L., Barrera, Paredes, Dizon, Regala, and Makalintal JJ., concur.

Footnotes:
[1]Architectural Catalog Co. v. F.W. Dodge Corp., 136 F. 2d 1008, 30 C.P.A., Patents, 1215.
[2]Kroger Grocery & Banking Co. v. Blue Earth Canning Co., Cust & Pat. Appl. 88 F. 2d 725.
[3]37 C.J.S. 476.