

MERCK KGAA,	}	IPC No. 14-2009-00044
<i>Opposer,</i>	}	Case Filed: 05 February 2009
	}	
	}	Opposition to:
	}	
	}	App. Ser. No. 4-2008-000295
-versus-	}	Date Filed: 09 January 2008
	}	TM: "SILTALLIC"
	}	
ECKART GMBH	}	
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2009-108

DECISION

This is a VERIFIED NOTICE OF OPPOSITION filed by opposer Merck KGaA to the application for registration of the mark "SILTALLIC" bearing Application Serial No. 4-2008-000295 filed on January 09, 2008 by respondent-applicant Eckart GmbH covering goods under Class 02, namely, "Metal pastes, particularly aluminum pastes and bronze pastes, metal pigments, metal pigment pastes particularly aluminum pigment pastes and bronze pigment pastes, metal powders, particularly aluminum powders and bronze powders, aluminum granules, paints, lacquers, inks, printing inks"; and goods under Class 06, namely, "Metal pastes, particularly aluminum pastes and bronze pastes, metal pigments, metal pigments pastes, particularly aluminum pigments pastes and bronze pigment pastes, metal powders, particularly aluminum powders and bronze powders, aluminum granules, for industrial purposes", which application was published in the IP Philippines e-gazette on October 10, 2008.

Opposer is a corporation organized and existing under the laws of Germany with business address at Frankfurter Strade 250, 64293 Darmstadt, Germany while Respondent-applicant is a corporation organized and existing under the laws of Germany with principal address at Kaiserstrasse 30, 90763 Fuerth, Germany.

The facts to be proven by opposer are as follows:

"1. OPPOSER is the registered owner of the mark "XIRALLIC" trademark registration certificate number 4-2004-002549 date April 14, 2005 and valid for ten years.

"2. RESPONDENT filed an application before this Office to register the mark "SILTALLIC" last January 09, 2008 in classes 2 and 6 and was given serial number 4-2008-00295.

"3. The Intellectual Property Office published the RESPONDENT'S trademark in the OCTOBER 10, 2008 issue of the E-Gazette.

"4. Prior to the lapse of the period to file a Notice of Opposition to the Application, the OPPOER seasonably filed extensions of time and paid the necessary fees.

The grounds for opposition are as follows:

"1. The mark "SILTALLIC" which RESPONDENT seeks to register so resembles OPPOSER'S registered trademark "XIRALLIC", which when applied to or used in connection with the goods covered by the application under opposition will likely cause confusion, mistake and deception on the part of the purchasing public.

"2. The registration of RESPONDENT'S trademark will violate OPPOSER'S rights and interests in the trademark and will cause dilution and loss of distinctiveness.

"3. The registration of RESPONDENT'S trademark will violate section 123.1 of Republic Act 8293 and contravenes the provisions of the Paris Convention on the Protection of Industrial Property.

"4. Opposer has adopted and continuously used the trademark "XIRALLIC" in actual trade and international commerce and had acquired goodwill and international recognition. It had registered the marks in several countries that are members of the Paris convention.

"5. OPPOSER has actual and continuous use of the trademark "XIRALLIC" in trade and commerce in the Philippines and had acquired business goodwill and recognition with the relevant sector of the Philippines that uses the goods.

"6. RESPONDENT'S application exploits and capitalizes on the popularity and the goodwill generated by the use of the OPPOSER'S trademark in the Philippines.

A NOTICE TO ANSWER was issued to and received by respondent-applicant on March 06, 2008. Respondent-applicant, however, failed to file its answer albeit within the reglementary period. Thus, it is deemed to have waived its right to file the same and the case shall be decided on the basis of the opposition, the affidavits of the witnesses and the documentary evidence submitted by the opposer in accordance with Section 5, Rule 2 of office Order No. 79 Series of 2005 in relation to Section 11 of the Regulations On *Inter Parties* Proceedings.

The issues to be resolved in this case are:

1. Whether or not there is confusing similarity between respondent-applicant's mark "SILTALLIC" and opposer's mark "XIRALLIC"; and

2. Whether respondent-applicant is entitled to the registration of the mark "SILTALLIC".

Respondent-applicant's mark is depicted below:

SILTALLIC

Meanwhile, opposer's mark is depicted below:

XIRALLIC

A circumspect perusal of both marks shows that they are confusingly similar: Except for the first three letters of opposer's mark- "X", "I", and "R"- and for the first four letters of respondent-applicant's mark- "S", "I", "L", and "T", the two marks are almost identical as to render them as confusingly similar. Both marks end with the syllables "ALLIC" and both are written in uppercase letters with almost similar fonts. Visually, they are confusingly similar. Aurally, both marks are still confusingly similar: The stress is on the first syllable which sound nearly the same in view of the "I" vowel, and the second and third syllables are pronounced exactly the same.

This Bureau holds that the similarities in the respective marks are such as to render them confusingly similar. The differences are minor. Similarity in size, form and color, while relevant, is not conclusive. Neither duplication/imitation, or the fact that the infringing label suggests an effort to emulate, is necessary. The competing marks need only contain the main, essential or dominant features of another; and that confusion and deception are likely (*Sterling Products International, Inc. v. Farbenfabriken Bayer Aktiengesellschaft*, G.R. No. L-19906, April 30, 1969; *Lim Hoa v. Director of Patents*, G.R. No. L-8072, October 31, 1956; *Co Tiong Sa v. Director of Patents, et al.*, G.R. No. L-5378, May 24, 1954).

The confusion in this case is rendered more likely by the fact that opposer's and respondent-applicant's goods belong to the same class, and are identical and/or related: Opposer's and respondent-applicant's respective goods are essentially pastes, pigments, dyes, paints, and/or colorants under Class 02.

Moreover, opposer has already a registration for its mark "XIRALLIC" that is Registration No. 4-2004-002549 issued on April 14, 2005.

In view thereof; and of the finding herein that opposer's and respondent-applicant's respective marks are confusingly similar, and further, that opposer's and respondent-

applicant's goods belong to the same class and are similar and/or related, Section 123.1 (d) of the IP Code is in point, to wit:

"A mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor . . . in respect:

- (i) The same goods . . .
 - (ii) Closely related goods . . .
 - (iii) If it nearly resembles such a mark as to be likely to deceive or to confusion . . ."
- (Underscoring supplied.)

WHEREFORE, the VERIFIED NOTICE OF OPPOSITION is, as it is, hereby SUSTAINED. Consequently, Application Serial No. 4-2008-000295 filed on January 09, 2008 by respondent-applicant Eckart GmbH covering goods under Class 02, namely, "Metal pastes, particularly aluminum pastes and bronze pastes, metal pigments, metal pigment pastes particularly aluminum pigment pastes and bronze pigment pastes, metal powders, particularly aluminum powders and bronze powders, aluminum granules, paints, lacquers, inks, printing inks"; and goods under Class 06, namely, "Metal pastes, particularly aluminum pastes and bronze pastes, metal pigments, metal pigments pastes, particularly aluminum pigments pastes and bronze pigment pastes, metal powders, particularly aluminum powders and bronze powders, aluminum granules, for industrial purposes", is, as it is hereby, REJECTED.

Let the file wrapper of this case be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, September 22, 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs