

NALLOVALE LTD.	}	INTER PARTES CASE NO. 14-2000-00014
Opposer,	}	Opposition to:
	}	
	}	Application Serial No. : 109288
-versus-	}	Date Filed : 6-24-96
	}	Trademark : "LA MOLISANA & DEVICE"
	}	
LA MOLISANA INDUSTRIE	}	
ALIMENTARI S.P.A.,	}	
Respondent-Applicant.	}	Decision No. 2002-35
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DECISION

Before us is an Opposition to the registration of the trademark "LA MOLISANA & DEVICE" filed by Opposer, Nallovale Ltd., a company organized and existing under the laws of Spain. Respondent-Applicant, La Molisana Industrie Alimentari, S.P.A. is an Italian company located at ontrada Colle Delle Api, 100/A, Campobasso, Italy.

On March 30, 2000, Volume II, No. 5 of the Intellectual Property Office Gazette was officially released containing the application for registration of trademark Respondent-Applicant. On 28 April 2000, opposer filed a Motion for Extension to File Opposition. The Motion for Extension of Time to File Opposition was granted through Office Order No. 2000-214 thereby giving opposer until 30 May 2000 to file its verified opposition. Thereafter, on 30 May 2000, opposer filed the instant opposition and on 27 June 2000 submitted the legalized verification of said opposition. Opposer contends that:

- "1. Opposer Nallovale's ownership of its duly registered trademark means that no other entity may use or infringe Nallovale's trademark or use similar marks without the consent of Nallovale (Sec. 22, R.A. 166 [Trademark Law]); Sec. 139 Intellectual Property Code [IP Code], R.A. 8293).
- "2. Confusingly similar marks cannot be registered, whether under the Trademark Law or IP Code which provide:

Trademark Law:

"Sec. 4 Registration of Trade-marks, trade-names and service-marks on the principal register – There is hereby established a register of trade-marks, trade-names and service-marks which shall be shown as the principal register. the owner of trade-mark, trade-name 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.

x x x

"(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name 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 mistakes or to deceive purchasers.”

IP Code:

“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 a 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 a mark as to be likely to deceive or cause confusion;

x        x        x

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;”

- “3. The respondent-applicant’s mark may not be registered, whether under the Trademark Law or the Intellectual Property Code. The subject mark is identical with or confusingly similar with the registered trademark of the Opposer Nallovale.
- “4. The respondent-applicant’s mark covers the same or closely similar goods under the same class. Especially considering the closeness of the said goods, phonetic similarity of the marks, respondent-applicant’s mark resembles the trademark of Nallovale as to be likely to receive or cause confusion among the purchasing public. The mark of respondent-applicant is likely to mislead the public as to nature, quality, source, characteristics or geographical origin of goods.
- “5. Respondent-Applicant’s mark would likely deceive the public to believe that respondent-applicant is capitalizing on the goodwill generated by Nallovale’s continued use of the mark.”

The Notice to Answer, dated 2 August 2000 was received by respondent-applicant’s counsel on 8 August 2000. On 23 August 2000, this office received an Urgent Motion for Extension of Thirty Days to File an Answer which was granted through Order No. 2000-391. For failure of Respondent-Applicant to answer Order No. 2000-537 dated November 13, 2000 was issued declaring it in default and allowing the Opposer to present its evidence ex-parte.

Opposer’s evidence consists of the following:

- (i) Notarized and legalized affidavit of Ma. Rosario Perez Lloret dated 10 April 2001;

- (ii) Certified true copy of the official English translation o the Certificate of Incorporation of Nallovale;
- (iii) Certified true copy of the Certificate of Incorporation of Nallovale;
- (iv) Certified true copy of the Nallovale's Trademark Registration No. 1.692.650 in Spain for trademark "MOLINERA & DEVICE" under Class 29 dated 5 May 1993;
- (v) Certified true copy of Nallovale's Trademark Registration No. 410.036 in Mexico for trademark "MOLINERA & Device" under Class 29 dated 31 March 1992;
- (vi) Certified true copy of Nallovale's Trademark Registration No. 1.292.050 in United Kingdom for trademark "MOLINERA & Device" under Class 29 dated 25 January 1989;
- (vii) Certified true copy of Nallovale's Trademark Registration No. 3.165.150 in Japan for the mark "MOLINERA & DEVICE" under Class 29 dated 28 June 1996;
- (viii) Notarized and legalized affidavit of Ma. Rosario Perez Lloret dated 28 August 2001;
- (ix) Invoice dated 16 March 1988 for the purchase of "MOLINERA" products by Espa-Fil Import and Export Corporation in the Philippines, in the total amount of US\$10,102.75;
- (x) Bill of Lading for the "MOLINERA" products exported by Nallovale's predecessor to Espa-Fil Import and Export Corporation in the Philippines;
- (xi) Description of the "MOLINERA" products exported by Nallovale's predecessor to the Philippines in 1988;
- (xii) Freight Bill No. 14779 dated 25 April 1988 issued by Don Tim Shipping Corporation to Espa-Fil Import and Export Corporation for the shipment of "Molinera" products to the Philippines;
- (xiii) Irrevocable Documentary Credit No. 88-0780 applied for by Espa-Fil Import and Export Corporation with Solid bank, with Nallovale's predecessor as beneficiary, for the amount of US\$10,102.75;
- (xiv) Central bank of the Philippines Release Certificate of the amount of US\$10,102.75 as applied for by Espa-Fil Import and Export Corporation by way of payment for the "MOLINERA" products it purchased from Nallovale's predecessor;
- (xv) Import Entry Declaration of "Moliners" products issued by the Bureau of Customs in Manila;
- (xvi) Invoice No. 10.002 dated 23 June 1997 by Molinera, S.A. for the exportation of "MOLINERA" products to Espa-Fil Import and Export Corporation in the Philippines;
- (xvii) Bill of Lading (in Spanish) for the "MOLINERA" products exported to the Philippines through Espa-Fil Import and Export Corporation;
- (xviii) Invoice No. 10.003 dated 3 July 1997 issued for the exportation from Spain of "MOLINERA" products to Espa-Fil Import and Export Corporation in the Philippines;

- (xix) Bill of Lading for the “MOLINERA” products exported to the Philippines through Espa-Fil Import and Export Corporation in 1997;
- (xx) Bill of Lading (in Spanish) for the “MOLINERA” products exported to the Philippines through Espa-Fil Import and Export Corporation;
- (xxi) Invoice No. 10.009 dated 27 February 1998 issued for the exportation from Spain of “MOLINERA” products to Espa-Fil Import and Export Corporation in the Philippines;
- (xxii) Bill of Lading for the “MOLINERA” products exported to the Philippines through Espa-Fil Import and Export Corporation in February 1998;
- (xxiii) Bill of Lading (in Spanish) for the “MOLINERA” products exported to the Philippines through Espa-Fil Import and Export Corporation in Spanish in February 1998;
- (xxiv) Invoice No. 10.010 dated 11 March 1998 issued for the exportation from Spain of “MOLINERA” products to Espa-Fil Import and Export Corporation in the Philippines;
- (xxv) Bill of Lading for the “MOLINERA” products exported to the Philippines through Espa-Fil Import and Export Corporation in March 1998; and
- (xxvi) Bill of Lading (in Spanish) for the “MOLINERA” products exported to the Philippines through Espa-Fil Import and Export Corporation in Spanish in March 1998.

The issue to be resolved in this particular case is:

Whether the mark “LA MOLISANA” applied for by the Respondent-Applicant is confusingly similar to the Opposer’s registered mark “MOLINERA”?

In consideration of the fact that the application for registration of mark “La Molisana & Device” subject of this instant opposition proceedings was filed under Republic Act 166 (old Trademark Law), this case shall be decided on the basis of the provisions of the old law.

The applicable provision is Section 4(d) of Republic Act No. 166 as amended which provides as follows:

“Sec.4. Registration of trademarks, trade names and service marks on the principal register. There is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. the owner of a trademark, trade name 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:

x        x        x

(d)        Consist of or comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark or trade name 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;”

In analyzing the spelling, sound and pronunciation of the words “MOLINERA” and “MOLISANA”, we observe that both marks have the same prefix, “MOLI” and similar sounding suffix, “A”. In short, the initial letters and the last letter of the two words are identical. When pronounced, the sound produced is very similar, especially so because the both words also consist of four syllables. Moreover, the trademark of the respondent-applicant is intended to be used for goods under Class 29, the same category under which Opposer’s trademark is being used.

In Marvex Commercial Co., Inc. vs. Petra Hawpia & Co. (L-19297, December 22, 1966), the Supreme Court held:

The following random list of confusingly similar sounds in the matter of trademarks, culled from NIMS, Unfair Competition and Trademarks, 1947, vol. 1, will reinforce our view that “SALONPAS” and “LIONPAS” are confusingly similar in sound: “Gold Dust” and “Gold Drop”; “Jantzen” and “Jazz-Sea”; “Silver Flash” and “Supper-Flash”; “Cascarete” and “Celborite”; “Celluloid” and “Cellonite”; “Chartreuse” and “Charseurs”; “Cutez” and “Cuticlean”; “Hebe” and “Meje”; “Kotex” and “Femetex”; “Zuso” and “Hoo Hoo”. Leon Amdur, in his book “Trademark Law and Practice”, pp. 419-421, cites as coming within the purview of the *idem sonans* rule, “Yusea” and “U-C-A-”; “Steinway Pianos” and “Steinberg Pianos” and “Seven-Up” and “Lemon-Up”. In *Co Tiong vs. Director of Patents*, this Court unequivocally said that “Celdura” and “Condura” are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name “Lusolin” is an infringement of the trademark “Sapolin”, as the sound of the two names is almost the same.

In the case at bar, “SALONPAS” and “LIONPAS” when spoken sound very much alike. Similarity of sound is sufficient ground for this Court to rule that the two are confusingly similar when applied to merchandise with the same descriptive properties (see *Celanese Corporation of America vs. E. I. Du pont*, 154 F. 2d. 146, 148).

In the case of *American Wire & Cable Co. vs. Director of Patents* (L-26557, February 18, 1970), the Supreme Court reiterated the same doctrine and stated:

“In fact, even the similarity in sound is taken into consideration, where the marks refer to merchandise of the same descriptive properties, for the reasons that trade *idem sonans* constitutes a violation of trademark patents. Thus in the case of *Marvex Commercial Co. vs. Hawpia & Co.*, the registration of the trademark “Lionpas” for medicated plaster was denied for being confusingly similar in sound with “Salonpas”, a registered mark also for medicated plaster, x x x

The present case is governed by the principles laid down in the preceding cases. 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 only in two out of the eight literal elements of the designations. Coupled with the fact that both marks cover insulated flexible wires under class 20; x x x“

Considering the general appearance of each mark, Opposer’s mark designed in such a way that the word “MOLINERA” is enclosed inside an oblong shape, with a dark background and

3 outer borders, protruding in the top middle of the oblong shape, above the word "MOLINERA" is a drawing of what appears to be a windmill. On the other hand, the words "LA MOLISANA" are enclosed in an oblong shape. The word "LA" is in smaller sized letters and is placed above the letter "O" in the word "MOLISANA". Inside an elliptical frame, a drawing of two ears of corn are below the word, "LA MOLISANA" and an emblem is also on top of the word at the middle portion. Although there are differences in the over-all appearance of both marks, the dominant portion of the Respondent-Applicant's trade mark is the word "Molisana", such that when it is compared to the dominant feature of Opposer's registered mark, confusion is likely to result.

The High Court in *American Wire & Cable Co. vs. Director of Patents* (L.-26557, February 18, 1970) held:

The question is, when is a trademark likely to confuse or cause the public to mistake one for the another? Earlier rulings of the Court seem to indicate its reliance on the *dominancy* test or the assessment of the essential dominant features in the competing labels to determine whether they are confusingly similar. (*Parke Davis & Co. vs. Kui Foo & Co, Ltd.* 60 Phil. 928; *Sapolin Co., Inc. vs. Balmaceda*, 67 Phil 705). On this matter, the Court said:

"It has been consistently held that the question of infringement of a trademark is to be determined by the *test of dominancy*. Similarity in size, form, and color, while relevant, is not conclusive. If the competing trademark contains the main or essential *dominant* features of another of another, and confusion and deception are likely to result, infringement takes place. Duplication or imitation is not necessary, nor is it necessary that the infringing label should suggest an effort to imitate. (*C. Nellman Brewing Co. vs. Independent Brewing Co.*, 191 F. 489,495, citing *Eagle White Lead Co. vs. Pflugh* [CC] 180 Fed. 579). The question at issue in cases of infringement of trademarks is whether the use of the marks involved would be likely to cause confusion or mistakes in the mind of the public or deceive purchasers." (*Go Tiong vs. Director of patents*, 95 Phil. 1, cited *Lim Hoa vs. Director of Patents*, 100 Phil. 214).

To be taken into consideration is the fact that the goods for which the registration is sought are food items under Class 29. This is the exact type of goods which Opposer has dealt with since 1988 using its trademark "MOLINERA". These food items will be sold in groceries or some kind of food outlet and their intended customers will be the same set of consumers. Therefore, likelihood of confusion to the buying public cannot be ignored.

A careful scrutiny of the records reveal that the Opposer, Nallovale, Ltd. has used the mark commercially in the Philippines since 1988. Evidence of volume importation by Philippine companies of food products have been shown in 1988(Exhibit "I" and submarkings); 1997 (Exhibits "J" and submarkings) and 1997 (Exhibit "L" and submarkings). The records also show that the Opposer has obtained registration of the mark in other countries such as Spain (Exhibit "D") Mexico (Exhibit "E") United Kingdom (Exhibit "F") an Japan (Exhibit "G"). Notably, in Spain, one of the two registrations that exist, the trademark is "LA MOLINERA".

WHEREFORE, premises considered the instant Opposition is hereby SUSTAINED. Accordingly, Application Serial No. 109288 filed by Molisana Industrie, Alimentari, S.P.A. on June 24, 1996 under class 29 is hereby REJECTED.

Let the file wrapper subject of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau for appropriate action in accordance with this DECISION. Likewise, let a copy of this DECISION be furnished the Bureau of Trademarks for information and update of its records.

SO ORDERED.

Makati City, 17 December 2002.

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