

SYNGENTA LIMITED,	}	IPC No. 14-2005-00093
Opposer,	}	Opposition to:
	}	Serial No. 4-2004-000621
-versus-	}	Date Filed: 22 January 2004
	}	
PLANTERS PRODUCTS INC.,	}	Trademark: "ENFORCE"
Respondent-Applicant.	}	Decision No. 2007 – 16
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DECISION

This pertains to an Opposition Case filed on 07 November 2007 by herein opposer, SYNGENTA LIMITED, a corporation duly organized and existing under and by virtue of the laws of Switzerland, with address at Syngenta Crop Protection AG, Intellectual Property & Licensing, Schwarzwaldallee 215, CH-4058 Basel, Switzerland, against the application for registration of the trademark "ENFORCE" bearing Application Serial No. 4-2004-000621 filed on 22 January 2004 for goods falling under Class 5 of the Nice Classification of Goods, for pesticides, by PLANTERS PRODUCTS, INC., respondent-applicant, a domestic corporation with registered address at PPI Bldg., No. 109 Esteban St., Legaspi Village, Makati City.

The subject trademark application was published for opposition in the Intellectual Property Office Official Gazette which was officially released for circulation on 11 July 2005.

The following are the grounds for the opposition to the application for registration, to wit:

"1. The trademark ENFORCE being applied for by respondent-applicant is confusingly similar to opposer's trademark FORCE, as to be likely, when applied to or used in connection with the goods of respondent-applicant, to cause confusion, mistake and deception on the part of the purchasing public."

"2. The registration of the trademark ENFORCE in the name of Respondent-Applicant will violate Section 123.1, subparagraph (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines and Section 6bis and other provisions of the Paris Convention for the Protection of Industrial Property to which the Philippines and Switzerland are parties."

"3. The registration and use by respondent-applicant of the trademark ENFORCE will diminish the distinctiveness and dilute the goodwill of opposer's trademark FORCE."

"4. The registration of the trademark ENFORCE in the name of respondent-applicant is contrary to other provisions of the Intellectual Property Code of the Philippines."

In support of the above opposition, Opposer relied on the following facts and circumstances, to wit:

"1. Opposer is the owner of and/or registrant of and/or applicant in many trademark registrations of the trademark FORCE around the world under International Class 1, 5, more particularly for "chemicals used in agriculture, horticulture and forestry; preparations for the treatment of seeds, preparations for destroying vermin; fungicides, herbicides, insecticides, pesticides."

“2. In the Philippines, Opposer is the applicant of the trademark FORCE, under Application No. 4-2003-0010187, and filed on 06 November 2003 by registrant Syngenta Limited.”

“3. By virtue of opposer’s prior application of the trademark FORCE in the Philippines and its prior application and/or registration and ownership of this trademark around the world, said trademark has therefore become distinctive of opposer’s goods and business.”

“4. The registration and use of the trademark ENFORCE by respondent-applicant will deceive and/or confuse purchasers into believing that respondent-applicant’s goods and/or products bearing the trademark ENFORCE emanate from or are under the sponsorship of opposer Syngenta Limited, owner/registrant of the trademark FORCE. Respondent-applicant obviously intends to trade and is trading on opposer’s goodwill.”

“5. Likewise, there is also no doubt that an ordinary and/or casual purchaser buying under normal prevalent conditions in trade is not expected to exercise a careful scrutiny between two (2) products bearing confusingly similar trademarks as in opposer’s trademark FORCE vis-à-vis respondent-applicant’s trademark ENFORCE and will most likely be confused and deceived to buy one product for the other.”

“6. The registration and sue of the trademark ENFORCE by respondent-applicant will therefore diminish the distinctiveness and dilute the goodwill of opposer’s FORCE.”

“7. It is evident that the adoption of the trademark ENFORCE by respondent-applicant was not made in good faith but rather, there is apparently an intent by respondent-applicant to “ride-on” the goodwill established and “pas-off” respondent-applicant’s goods as those of opposer.”

“8. The allowance of Application Serial No. 4-2004-000621 in the name of respondent-applicant will be violative of the treaty obligations of the Philippines under the Paris Convention for the Protection of Industrial Property, to which the Philippines and Switzerland are member-states.”

A Notice to Answer was issued on 17 January 2006 by this Office requiring the respondent-applicant to file its Answer to the Verified Notice of Opposition within thirty (30) days from receipt of the said Notice. Subsequently, an Alias Notice to Answer was issued on 30 August 2006 and was duly received by the opposer and the respondent-applicant on 05 and 14 of September 2006, respectively which respondent-applicant failed to file an Answer.

For failure of the respondent-applicant to file an Answer within the reglementary period, this Office under Order No. 2007-08 dated 03 January 2007 waived respondent-applicant’s right to file Verified Answer. Opposer was thereafter directed to file its position paper, after admitting the following documentary evidence, to wit:

Exhibit	Description
“A”	Special Power of Attorney
“A-1”	Legalization of the Special Power of Attorney
“A-2”	Certificate of Authentication

“B”	Trademark Application Form, page 1
“B-1”	Trademark Application Form, page 2
“B-2”	Formal Drawing of the Mark

Opposer likewise submitted the following documentary evidence marked as annexes and attached to the Notice of Opposition:

Annexes	Description
“A”	The Companies Act 1985 bearing Company No. 2710846 certifying the change of company name to SYNGENTA LIMITED on November 21, 2000
“B”	Registration in Supplemental Register bearing Registration No. 9056 registered on December 19, 1994 for the mark FORCE
“C”	Trademark Application Form for the mark FORCE
“D” to “D-4”	Portfolio showing the registration of the mark FORCE in different countries
“E” to “E-1”	Certificate of Trademark Registration in Thailand bearing Registration No. Kor48180, with attached English translation
“E-2” to “E-5”	Certificate of Registration in Thailand bearing Case No. (A) 107524
“E-6” to “E-8”	Certificate of Trademark Registration bearing Registration No. 211232 registered on November 18, 1996
“E-9” to “E-11”	Certificate of Trademark Registration No. 86/01596 (B) registered on 23 April 1986 in Malaysia
“E-12” to “E-13”	Renewal Certificate for Trademark No.86/01596 (B) effective from 23 April 1993
“F” to “F-3”	Computer print out of International Registration Details for the mark FORCE consisting of four (4) pages
“G” to “G-2”	Computer print our of Detailed Trademark Information consisting of three (3) pages

“H”	Colored print out showing the mark Cruiser & Force
“H-1” to “H-2”	SeedQuest News Section advertising the mark FORCE
“H-3”	Media Release of Syngenta bearing date of 15 April 2004
“H-4”	Advertising material for the mark FORCE 3G
“H-5” to “H-18”	Promotional materials for the mark Force 3G
“H-14” to “H-47”	Another promotional materials

After an in-depth perusal of the evidence of herein opposer, this Bureau is presented with the issue to resolve, to wit:

WHETHER OR NTO RESPONDENT-APPLICANT’S MARK “ENFORCE” IS CONFUSINGLY SIMILAR TO OPPOSER’S TRADEMARK “FORCE”.

The subject trademark application in this instant opposition was filed on 22 January 2004 or during the effectivity of Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines. Thus, the applicable provision of law in resolving the issue involved is Sec. 123.1 (d) of R.A. 8293, which provides the criteria for the registration of a trademark, to wit:

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

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- (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;
 (Emphasis Ours)

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In a contest involving registration of trademark, the determinative factor is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would *likely* cause confusion or mistake on the part of the buying public.

It does not require that the competing trademarks must be so identical as to produce actual error or mistake. It is rather sufficient that the similarity between the two trademarks is such that there is a possibility or likelihood of the older brand mistaking the newer brand for it.

The existence of confusion of trademark or the possibility of deception to the public hinges on “*colorable imitation*”, which has been defined as “such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name in their overall presentation or in their essential and substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.” (Emerald Garment Mfg. Corp. vs. Court of Appeals, 251 SCRA 600)

In resolving the issue of confusing similarity, the law and jurisprudence has developed two kinds of tests – the *Dominancy Test* as applied in a litany of Supreme Court decisions including *Asia Brewery, Inc. vs Court of Appeals*, 224 SCRA 437; *Co Tiong vs Director of Patents*, 95 Phil. 1; *Lim Hoa vs Director of Patents*, 100 Phil. 214; *American Wire & Cable Co. vs Director of Patents*, 31 SCRA 544; *Philippine Nut Industry, Inc. vs Standard Brands, Inc.* 65 SCRA 575; *Converse Rubber Corp. vs Universal Rubber Products, Inc.*, 147 SCRA 154; and the *Holistic Test* developed in *Del Monte Corporation vs Court of Appeals*, 181 SCRA 410; *Mead Johnson & CO. vs N.V.J. Van Dorp, Ltd.*, 7 SCRA 771; *Fruit of the Loom, Inc. vs Court of Appeals*, 133 SCRA 405.

As its title implies, the Test of Dominancy focuses on the similarity of the prevalent features, or the main essential and dominant features of the competing trademarks which might cause confusion or deception.

On the other side of the spectrum, the Holistic Test requires that the entirety of the marks in question be considered in resolving confusion similarity. Comparison of words is not the only determining factor. In the case of *Mighty Corporation vs E & L Gallo Winery*, 434 SCRA 473, “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.

The Honorable Supreme Court has consistently relied on the *Dominancy Test* in determining questions of infringement of trademark. Thus, in the land mark case of *Mc Donald’s Corporation vs LC Big Mak*, 437 SCRA 10, it was ruled that:

“This Court, however, has relied on the dominancy test rather than the holistic test. The dominancy test considers the dominant features in the competing marks in determining whether they are confusingly similar. Under the dominancy test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the public mind, giving little weight to factors like prices, quality, sales outlets and market segments.”

As to what constitutes a dominant feature of a label, no set of rules can be deduced. Usually, these are signs, color, design, peculiar shape or name, or some special, easily remembered earmarks of the brand that easily attracts and catches the eye of the ordinary consumer.

Relying on the foregoing premise, this Bureau finds that the word “Force” is the dominant feature in the contending marks. It easily attracts and catches the eye of the ordinary purchaser. In fact, the only difference between the two marks is that respondent-applicant’s mark has a one-syllable prefixed “en” before the word “force”. Practically, the two words have the same meaning. Opposer’s mark “FORCE” means, strength or energy especially of an exceptional degree, while respondent-applicant’s mark “ENFORCE” means to give force to. What makes the two words different is that the former is a noun and the latter is its verb. (Webster’s Third New International Dictionary)

What is even worse is that the contending marks, when pronounced, sounds almost alike. Under the *idem sonans rule* as held in the case of *Sapolin Co. vs Balmaceda*, 67 Phil. 795, confusion is likely to arise between words which when pronounced sounds alike.

Moreover, the goods covered by the competing trademarks are related and similar. While opposer’s goods fall under Classes 1 and 5, namely chemicals used in agriculture, horticulture and forestry; preparations for the treatment of seeds; preparations for destroying vermin;

fungicides, herbicides, insecticides and pesticides, respondent-applicant's goods on the other hand, fall under Class 5 for pesticides. They serve the same purpose and flow through the same channel of trade, hence, they are competing and are considered as related or similar goods.

Finally, with respect to the goods which the contending marks respectively carry, there is also likely to arise confusion as to their source or origin. This exists when, "in view of the similarity or identicalness of the marks involved, one party's product or service, though different from that of another or on which the latter does not use his mark, is such as might reasonably be assumed to originate from the latter and as to likely deceive the public into the belief that there is some business association between the parties which, in fact, is absent," (Sterling Products International, Inc. vs Farbenfabriken Bayer Aktiengesellschaft, 27 SCRA 1214)

Applying the foregoing tenets and taking into account the factual circumstances and evidence, this Office finds confusing similarity between opposer's "FORCE" and respondent-applicant's "ENFORCE". It bears stressing that opposer's trademark "FORCE" was first registered on 19 December 1994 under Certificate of Registration No. 9056 for Zeneca Limited (now Syngenta Limited, as duly recorded in the Book of Records, this Office on 10 October 2001). Opposer then re-filed an application for the same mark covering additional goods on 06 November 2003, which constitute the re-filing thereof, an earlier filing or priority date vis-à-vis respondent-applicant's filing on 22 January 2004 for the subject mark. Thus, opposer Syngenta Limited has a better right over respondent-applicant's later filing for the subject mark.

WHEREFORE, the Notice of Opposition is hereby SUSTAINED. Consequently, application bearing Serial No. 4-2004-000621 filed by respondent-applicant Planters Products, Inc. on 22 January 2004 for the registration of the mark "ENFORCE" used for pesticide under Class 5 of the Nice Classification of Goods is, as it is, hereby REJECTED.

Let the file wrapper of ENFORCE, 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, 20 February 2007.

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