

SYNGENTA LIMITED,
Opposer,

-versus-

TECHNOPIA SDN BHD,
Respondent-Applicant.

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IPC No. 14-2005-00038
Opposition to:

Serial No.: 4-2004-001908
Filed : 27 February 2004
Trademark: "F-FORCE"

Decision No. 06-134

DECISION

Before this Bureau is an Opposition filed by Syngenta Limited, a corporation duly organized and existing under and by virtue of the laws of the United Kingdom, with business address at European Regional Centre, Priestly Road, Surrey Research Park, Guildford, Surrey GU2 7YH, England, against the application for registration of the trademark "F-FORCE" for bleaching preparations and other substances for laundry use, cleaning, polishing scouring and abrasive preparations; soaps; perfumery; essential oils; detergents; dish wash liquid under insecticides, pesticides, germicides, fumigating pastilles, sticks and coil, insect repellents, insect catching adhesives, insect catching papers and mats, insecticidal aerosol and liquid under Class 5, with Application Serial No. 4-2004-001908 and filed on 27 February 2004 in the name of Respondent-Applicant, Technopia SDN BHD with business address Level 16, Menara PSCI, 39 Jalan Sultan Ahmad Shah, 10050 Penang, Malaysia.

The grounds for the opposition to the application for registration of the trademark F-FORCE are as follows:

- "1. The trademark F-FORCE 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 F-FORCE 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 United Kingdom are parties.
- "3. The registration and use by Respondent-Applicant of the trademark F-FORCE will diminish the distinctiveness and dilute the goodwill of Opposer's trademark FORCE.
- "4. The registration of the trademark F-FORCE in the name of Respondent-Applicant is contrary to other provisions of the Intellectual Property Code of the Philippines.

Opposer relied on the following facts to support its contentions in this Opposition:

- "1. Opposer Syngenta Limited was incorporated under the Companies Act 1985 of England as a limited company on April 29, 1992. Opposer was originally called Hackremco Limited but changed its name to ICI Bioscience Limited on September 25, 1992. A few months later or on November 18, 1992, Opposer again changed its name to Zeneca Limited. Finally on November 21, 2000, Zeneca Limited changed its name to its present name, Syngenta Limited.

“2. Opposer Syngenta Limited is an affiliate of Syngenta International AG, a world-leader in agribusiness specifically in crop protection and high-value commercial seeds. Syngenta International AG is one of the top companies in the world engaged in the crop protection business with a global market share of over 20% and ranks third in high-value commercial seeds market. Its major products include insecticides, fungicides, herbicides, field crops, vegetables and flowers. It markets, develops and sells these products through a global organization with use-programs and solutions tailored to customers’ growing needs.

“3. In 2004, Syngenta International AG achieved gross sales of USD 7.269 billion, out of which USD 1.049 billion in sales was achieved for insecticides and a net income to shareholders of USD 762 million. In 2000, it invested around USD 745 million in research and development and cooperates with over 400 external research partners and universities.

“4. Furthermore, Syngenta International AG employs around 19,000 employees in ninety (90) different countries worldwide. On the worldwide web, the company maintains sixty-four (64) business as well as country and regional websites in order to provide product information as well as to advertise and/or market its business and its products or services in other countries.

“5. Opposer Syngenta Limited 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 01, 05, more particularly for “Chemicals used in agriculture, horticulture and forestry; preparations for the treatment of seeds. Preparations for destroying vermin; fungicides, herbicides, insecticides, pesticides”.

“6. In the Philippines, Opposer is the Applicant of the trademark FORCE, as follows:

Trademark	: FORCE
Appln. No.	: 4-2003-010187
Date Filed	: November 6, 2003
Applicant	: Syngenta Limited

“7. Furthermore, the trademark FORCE was first registered on December 19, 1994 in the name of Zeneca Limited, the former name of Opposer Syngenta Limited. The particulars of this registration are as follows:

Trademark	: FORCE
Registrant	: Zeneca Limited
Certificate of	
Regn. No.	: 9056
Date Issued	: December 19, 1994

“8. The trademark FORCE is owned and has been used by Opposer Syngenta Limited for many years, long before Respondent-Applicant Technopia SDN BHD filed its application for the mark F-FORCE in the Philippines on February 27, 2004 for “disinfectants, preparations for destroying vermin; fungicides, insecticides, pesticides, germicides, fumigating pastilles, sticks and coil, insect repellents, insect catching adhesives, insect catching papers and mats, insecticidal aerosol and liquid, et. al”. Although the trademark FORCE was first launched in 1988 in the United States, it was in fact registered by Imperial Chemical Industries PLC, the predecessor-in-interest of my company Syngenta Limited, in Great Britain and Northern Ireland as early as January 10, 1981 for “insecticides, fungicides and herbicides”.

“9. Opposer Syngenta Limited is the registered owner and/or Applicant for registration of the trademark FORCE in many countries around the world, among which are Algeria, Argentina, Australia, Austria, Benelux, Bolivia, Bulgaria, Canada, Chile, China, Costa Rica, Croatia, Cyprus, Denmark, Ecuador, Egypt, El Salvador, European Community, France, Germany, Greece, Guatemala, Honduras, Hungary, India, Indonesia, Iran, Iraq, Ireland, Italy, Japan, Jordan, Kenya, Macedonia, Malawi, Malaysia, Morocco, Nicaragua, Norway, Panama, Portugal, Peru, Romania, Slovenia, South Africa, South Korea, Syria, Switzerland, Taiwan, Tanganyika, Thailand, U.S.A., United Kingdom, Uruguay, Venezuela, Vietnam, Yugoslavia, Zambia, Zanzibar and Zimbabwe.

“10. Notably, Opposer Syngenta Limited also registered the trademark FORCE in the World Intellectual Property Organization (WIPO) as well as in the Office for Harmonization in the Internal Market (OHIM).

“11. Opposer Syngenta Limited has sold and marketed “pesticides” bearing the mark FORCE worldwide, including but not limited to U.S.A., Germany, Canada, United Kingdom, Italy, Spain, Japan, Hungary, South Korea, Greece, Chile, Portugal and Serbia Montenegro. Indeed, Opposer caused the worldwide promotion, advertising, sale and marketing of “insecticides, fungicides and herbicides, et. al.” bearing the trademark FORCE in major cities and countries all over the world, including the Philippines.

“12. By virtue of Opposer’s prior application and/or registration 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.

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

“14. 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 F-FORCE and will most likely be confused and deceived to buy one product for the other.

“15. The registration and use of the trademark F-FORCE by Respondent-Applicant will therefore diminish the distinctiveness and dilute the goodwill of Opposer’s trademark FORCE.

“16. It is evident that the adoption of the trademark F-FORCE was not made in good faith but rather, there is apparently an intent by Respondent-Applicant to “ride on” the goodwill established and “pass off” Respondent-Applicant’s goods as those of Opposer.

“17. The allowance of Application Serial No. 4-2004-001908 in the name of Respondent-Applicant will be in violation of the treaty obligations of the Philippines under the Paris Convention for the Protection of Industrial Property, to which the Philippines and United Kingdom are member-states.

The Notice to Answer dated 28 March 2006 was sent to Respondent through their Counsel, Ortega Del Castillo Bacorro Odulio Calma & Carbonell directing it to file their Verified Answer within a prescribed period from receipt. For failure of Respondent to file the required Answer within four (4) months from receipt of the notice, the Bureau in Order No. 2006-1515 declared Respondent to have waived its right to file the Verified Answer and resolved to submit the case for decision.

Considering that the case was mandatorily covered by the Summary Rules under Office Order No. 79, this bureau directed Opposer to file all evidence in original and duplicate copies, and in compliance with said Order, Opposer through Counsel filed its evidence on February 16, 2006.

In support of its prayer for the rejection of Application Serial No. 4-2004-001908 for the mark F-FORCE, Opposer's evidence consisted, among others, of the Affidavit-Testimony of the Trademark Counsel of Syngenta Limited, Joachim Hofmann (Exhibits "A-1 to A-7"); Certificate of registration in Great Britain and Northern Ireland (Exhibits "C-C-2"); Certificate of Registration of the mark FORCE at the Bureau of Patents, Trademarks & Technology Transfer (Exhibit "D"); Trademark Application No. 4-2003-010187 of the mark FORCE at the Intellectual Property Office of the Philippines (Exhibit "E-E-2"); Printouts of the webpage of WIPO showing registration of the mark FORCE (Exhibit "H-H-3"); Printouts of the webpage of OHIM showing registration of the mark FORCE (Exhibit "I-I-2"), and copy of other trademark registrations obtained abroad.

Tersely, the issue for this Office disposition is the propriety of Application Serial No. 4-2004-001908; whether or not Respondent-Applicant is entitled to register the trademark F-FORCE covering goods in Classes 3 and 5.

After close scrutiny and careful evaluation of the records and evidence presented, this bureau finds substantiation on the grounds relied upon to sustain this instant Opposition.

A cursory reading of paragraph (d) of R.A. 8293 with emphasis on prior registration and/or application of the same mark involving same or similar goods states that:

"Section 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 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 such a mark as to be likely to deceive or cause confusion;"*

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The preceding section provides that it is the owner of a registered mark or an owner of a mark with an earlier filing date or priority date that can oppose an application for registration of another mark involving the same or related products. The purpose of the Trademark Law is to provide protection not only to the owner of the trademark or proprietor of a mark with an earlier filing or priority date in exact adherence to the First-to-First Rule as one important factor of registrability under R.A. 8293, likewise, and more importantly, to the unwary public that they may not be confused, mistaken or deceived by goods they buy.

The right to register, trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano v. Director of Patents, et.al.*, G.R. No. L-20170, August 10, 1965). And where a trademark application is opposed, the Respondent-Applicant has the burden of proving ownership (*Marvex Commercial Co., Inc. v.*

Peter Hawpia and Co., 18 SCRA 1178). In the instant case, from an array of evidence submitted by Respondent-Applicant to prove its entitlement for registration of the mark F-FORCE for use on goods under Classes 3 and 5, no single proof equivocably showed priority either in registration or application in the Philippines or abroad. Opposer Syngenta Limited, on 6 November 2003 filed with the Intellectual Property Philippines (IPP) an application for the registration of the mark FORCE for chemical products for use in agriculture, horticulture, forestry and preparations for the treatment of seeds under Class 1 and preparations for destroying vermin, fungicides, herbicides, insecticides, pesticides under Class 5. Respondent-Applicant, on its part, filed their application for registration of the mark F-FORCE on 27 February 2004 for bleaching preparations, cleaning and polishing substances, detergents, disinfectants and insecticides under classes 3 and 5. As it now stands, we may safely deduce that it is the Opposer, not the Respondent-Applicant, which can claim priority of an earlier filing pursuant to Section 123 of R.A. 8293.

Moreover, it may well be worthy to note that as early as January 1981, Opposer obtained registrations of the trademark FORCE on products in classes 1 and 5 abroad, more particularly in Great Britain and Northern Ireland. These registrations are subsisting and have not been abandoned. Hence, Respondent-Applicant, by any parity of reasoning, cannot be considered an originator, prior registrant nor a prior applicant of the subject or questioned trademark.

The mark of Respondent-Applicant consisted of a mark F-FORCE for use on chemical products under Classes 3 and 5. Anyone is likely to be misled by its close resemblance or identity with Opposer's trademark FORCE used and not abandoned by Opposer and applied on the same chemical products such as insecticides, pesticides, fungicides et. al. The subject mark applied for, F-FORCE and Opposer's FORCE trademark as they appear on the goods of the contending parties readily manifest the glaring similarities. The marks are phonetically the same, of identical sounds with similar consonant and vowel content. To create some variations which is not significantly distinctive, Respondent-Applicant's mark inserted a prefix or letter F with a hyphen. However, the inserted letter F is not glaring and striking to the eye since all the six (6) letters remained written in the same style and print, in close resemblance to the one used by Opposer, as can be gleaned from the formal drawing and facsimiles submitted by the Applicant. The court observed in *Philippine Refining Co., Inc., vs. Dir. Of Patents and Sparklets Corp. vs. Walter Kidde Sales Co.*, 104 F. 2d 396, that "a trademark is designed to identify the user. But it should be so distinctive and sufficiently original as to enable those who come into contact with it to recognize instantly the identity of the user. It must be affirmative and definite, significant and distinctive, capable to indicate the origin." Likewise, our trademark law does not require identity, confusion is likely if the resemblance is so close between two trademarks. Bolstering this observation is the pronouncement by the court in the case of *Forbes, Munn & Co. (Ltd.) vs. Ang San To*, 40 Phil. 272, 275) where it stated that *the test was similarity or "resemblance between the two (trademarks) such as would be likely to cause the one mark to be mistaken for the other. . . . [But] this is not such similitude as amounts to identity."*

The word or term FORCE remains the dominant, prominent and distinctive feature in the new mark, the prefix or inserted letter F is insignificant as to yield a distinct appearance not only because it is printed with the style used by the Opposer but the word FORCE standing alone has continued to create confusion between the competing marks. This Bureau quote with approval the pronouncement of the Court in the case of *Emerald Garment Mfg. Corp. vs. Court of Appeals*, 251 SCRA 600, which states:

"while it is true that there are other words such as "STYLISTIC", printed in the appellant's label, such word is printed in such small letters over the word "LEE" that it is not conspicuous enough to draw the attention of ordinary buyers whereas the word "LEE" is printed across the label in big, bold letters and of the same color, style, type and size of lettering as that of the trademark of the appellee. The alleged difference is too insubstantial to be noticeable."

Clearly etched in *Converse Rubber Corp. vs. Universal Rubber Products, Inc.* is the concept of likelihood of confusion where it said "The similarity in the general appearance of

respondent's trademark and that of petitioner would evidently create a likelihood of confusion among the purchasing public. xxx The risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the public could reasonably assume that the goods of the parties originated from the same source. "The law does not require actual confusion, it suffices that confusion is likely to occur in the sale of the goods and adoption of both marks (Philips Export B.V., et. al. vs. Court of Appeals, et. al. G.R. No. 96161, February 21, 1992). Hence, the likelihood that prospective buyers may perceive that Respondent's goods are manufactured by or is associated or connected with Opposer is probable.

Having thoroughly discussed and resolved issued on confusion and priority in use and application, we shall now be delving on the goods involved.

Confusion is likely and/or inevitably when identical or similar marks are applied on similar goods. there is no need to lengthily discuss when the goods involved are those mentioned under Class 5 as both parties sell the same chemical products as disinfectants, pesticides, fungicides, insecticides et. al. Anent those goods of Respondent-Applicant under Class 3 specifically bleaching preparations, detergents, cleaning and polishing substances, while specifically different to those goods enumerated under Class 5, nonetheless they are chemicals intended for use at home. It is likely that may be sold commercially in the same market altogether and have common purchasers. Under these circumstances, the goods are related. By their being basically chemical products, they can be marketed similarly. The goods involved may flow through the same channels of trade. The Supreme court in ESSO Standard Eastern, Inc. vs. Court of Appeals, et. al, 201 Phil 803, defined what are essentially related goods under the trademark law as:

"Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. Thus, biscuits were held related to milk because they are both food products."

Applying this principle clearly etched in the above-cited cases, this Bureau has been an iota of connection between herein Opposer's goods and those of Respondent or to a large extent that would apropos place the goods in the same category or fall within the normal or zone of potential business expansion of Opposer. It is highly probable that Opposer may one day venture in the sale of detergents, cleaning and polishing substances, bleaching and abrasive preparations since its line of merchandise are wholly chemical products.

Opposer is the registered owner, originator, prior applicant and user of the trademark FORCE used on pesticides, insecticides, fungicides, et. al. The use and adoption by Applicant of the mark as subsequent user can only mean that Applicant wishes to reap on the goodwill, benefit from the advertising value and reputation of Opposer's FORCE trademark.

In the case of American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544, it was observed that:

"Why of the million and combination of letters and designs available the appellee had to choose a mark so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark"

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, application bearing Serial No. 4-2004-001908 filed by Technopia SDN BHD on 27 February 2004 for the registration of the mark "F-FORCE" for use on goods falling under classes 3 and 5 is, as it is hereby REJECTED.

Let the filewrapper of F-FORCE, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, November 30, 2006.

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