

THE COCA-COLA COMPANY,
Opposer,

INTER PARTES CASE NO. 3114
Opposition to:

-versus-

SINALCO AKTIENGESELLSCHAFT,
Respondent-Applicant

x-----x

Serial No.: 56753
Filed : July 02, 1985
Trademark : "SINCO-COLA"
DECISION NO.: 98-28

DECISION

This pertains to an Opposition filed by THE COCA-COLA COMPANY (the Opposer), a corporation duly organized and existing under the laws of the United States of America, with office address at P.O. Drawer 1734, Atlanta, Georgia 30301, USA to the application for the registration of the trademark SINCO-COLA for non alcoholic beverages made from cola with Serial No. 56753, filed on July 02, 1985 by Sinalco Aktiengesellschaft (the Respondent-Applicant), a corporation duly organized and existing under the laws of Germany, with business address at BahnhofstraBe 3-4, 4930 Detmold, Germany which application was published on page 112, Volume I, No. 3, May 23, 1988 issue of the Bureau of Patents, Trademark and Technology Transfer (BPTTT) Official Gazette, officially released for circulation on March 23, 1988.

The grounds for opposition are the following:

- "1. The registration of the trademark 'SINCO-COLA' in the name of the respondent applicant will violate the rights and interest of opposer over its trademark 'COCA-COLA' and will therefore cause great and irreparable injury and damage to herein opposer, pursuant to Section 8 of Republic Act No. 166, as amended;
- "2. The registration of the trademark 'SINCO-COLA' in the name of respondent-applicant will mislead the purchasing public and make it convenient for respondent-applicant to pass off its goods of the oppose, to the injury of oppose and the purchasing public;
- "3. The trademark 'SINCO-COLA' is so confusingly similar to the trademark "COCA-COLA" owned and being used by oppose and the registration of the mark 'SINCO-COLA' of respondent-applicant therefore will violate and run counter to Section 4 (d) of Republic Act No. 166, as amended."

Opposer relied on the following factual circumstances to sustain its Opposition, among other things, that: a) oppose is the owner of the mark COCA-COLA on various goods prior to the date of alleged use by Respondent of the mark SINCO-COLA; b) oppose is using the mark COCA-COLA worldwide and the registration of the mark in the Philippines; c) the trademark SINCO-COLA is used on goods similar and/or closely related to the goods of oppose so that the public will be confused to assume that the goods of oppose are goods of respondent-applicant; d) opposer has spent large amount of money in popularizing its product; e) Opposer's mark COCA-COLA has been registered in many countries worldwide; and f) the trademark "SINCO-COLA" is a flagrant and veritable imitation of Opposer's mark "COCA-COLA".

On September 06, 1988, respondent-applicant filed its Answer denying the material allegations made in the verified Opposition.

Upon joinder of issues, pre-trial conference was set in which both parties stipulated on the existence of their juridical personalities, thereafter the pre-trial conference was terminated and trial on the merits followed.

Opposer offered in evidence Exhibits "A" to "H" -8, including the deposition of its witness, Mr. William J. Davies.

On the other hand, Respondent-Applicant was declared by this Office, under Order No. 97-539, dated October 21, 197, to have waived its right present evidence for failure to present the same when it is its time to do so. In the same Order, both parties were directed to submit their respective Memorandum.

On January 19, 1998, Opposer complied with the Order by submitting its Memorandum, whereas Respondent-Applicant did not file the same.

The lone issue to be resolved in this case is- WHETHER OR NOT THERE IS CONFUSING SIMILARITY BETWEEN THE OPPOSER'S TRADEMARK "COCA-COLA" AND THE RESPONDENT-APPLICANT'S MARK "SINCO-COLA" SO MUCH SO THAT DAMAGE OR PREJUDICE TO THE GOODWILL AND REPUTATION OF THE FORMER WOULD BE CAUSED IF THE TRADEMARK REGISTRATION OF THE LATTER WOULD BE GRANTED.

Notwithstanding the enactment of Republic Act No. 8293, known as the Intellectual Property Code of the Philippines, Republic Act No. 166, as amended, shall still be applied considering that Section 235.2 of R.A. 8293 allows prosecution of application and registration thereof granted in accordance with the law under which application for trademark registration was filed, unless said application was so amended in pursuance of R.A. 8293.

Considering that the application for the registration of the trademark "SINCO-COLA" was filed – July 02, 1985 – when R.A. 166, as amended, was in effect, and because of the impossibility of amending the subject application for trademark registration to conform with R.A. 8293, this case will thus be resolved under R.A. 166, as amended, more specifically, to wit:

"Section 4. Registration of trade-marks, trade-names and service-marks on the principal register. – there is hereby established a register trade-marks, trade-names and service-marks which shall be known 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:

XXX

(d) Consists of or comprises a mark or trade-names 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; or

XXX"

On analytical comparison of the Opposer's trademark "COCA-COLA" and Respondent's mark "SINCO-COLA", any unwary purchaser would observe the glaring dissimilarities in appearance, sound and spelling so that confusion or deception as to source or origin of the two trademarks is unlikely.

It should be observed that the dominant word in the composite mark "COCA-COLA" is the word COCA or COKE as most people commonly referred to, while the dominant word in the other trademark "SINCO-COLA" is the word mark SINCO.

These predominant words which draw a fine line of distinctions in the overall presentation of the two trademarks are stored in the minds of ordinary purchaser that the general impression of passing one product as similar to or under the sponsorship of the other is essentially remote.

The allegation in the affidavit of Opposer's witness Mr. William J. Davis (Exhibit "A") in regard to the similarities in trisyllabic sounds and vowels, and on the third-syllabic accent of the two trademarks is not worth considering in view of the common practice among purchasers to look into the general impression, or central figure, or dominant feature appearing in the label and not on the tiniest details thereof when choosing and buying the goods.

The Supreme Court in *Bristol Myers Co., vs. Director of Patents* (L-21587, May 19, 1966) and *Etepha vs. Director of Patents* (16 SCRA 494), reiterated the rule that the test of similarity is not necessarily with the words, or their spelling or pronunciation but the appearance of each mark in their respective labels in relation to the goods to which the mark is attached.

In the case at bar, the trademarks "COCA-COLA" and "SINCO-COLA" not only vary in their predominant words but also in their appearance particularly on their respective letters style such as the ornate and stylistic trademark of "COCA-COLA" in contrast to the straight and block style of the mark "SINCO-COLA".

Moreover, the averments of Mr. Davies that respondent-applicant's intention in using the mark "SINCO-COLA" from the marks it previously used such as "SINALCO-COLA", "SINALCO-KOLA", "SINALCO", and "SINALCOLA" is to associate its products with that of Opposer's are purely imaginative thinking without basis in fact and in law. Opposer should bear in mind that, as shown by the factual setting of this case, the mark "SINCO-COLA" was derived from respondent's corporate name SINALCO AKTIEGELLSHAFT. Respondent has all the right to adopt an abbreviated or shortened version of its corporate name as trademark in the same way that opposer is adopting and using the word COKE in brevity to the mark "COCA-COLA".

As to the word "cola", according to the Webster Third New International Dictionary, "cola" is "a carbonated softdrink flavored with extract from coca leaves, kola nut, sugar caramel, and acid and aromatic substance." Though found in both marks, the word "COLA" is a generic name which is incapable of exclusive appropriation by anyone.

From the foregoing discussion, it would appear that the marks COCA-COLA and SINCO COLA can stand by themselves in commerce after finding no confusing similarity existing between themselves as applied for non-alcoholic beverages made from cola.

WHEREFORE, the Opposition is, as it is hereby DENIED. Accordingly, Application Serial No. 56753 for the registration of the trademark SINCO COLA for non-alcoholic beverages made from cola is, as it is hereby GIVEN DUE COURSE.

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

SO ORDERED.

Makati City, December 21, 1998.

ESTRELLITA BELTRAN-ABELARDO
Caretaker/Officer-In-Charge

