

THE COCA-COLA COMPANY,  
*Opposer,*

IPC No. 14-2007-00080  
Case Filed: 26 March 2007  
Opposition to:  
Serial No: 4-2005-011934  
Filed : 6 Dec 2005  
Trademark: "MISMO"

-versus-

DELFIN G. WALDO, Jr.  
*Respondent-Applicant.*

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Dec. No. 08-186

## DECISION

Before this Office is an Opposition filed by The Coca-Cola Company, a corporation duly organized and existing under and by virtue of the laws of the State of Delaware, with business address at P.O. Box 1734, Atlanta, Georgia 30301, U.S.A., against the application for registration of the trademark "MISMO" for *cleaning chemicals, powder detergent, dishwashing soap, handwash, toilet bowl cleaner, cleaning solution, disinfectant spray & wipe, laundry bar, bath soap* under Class 03, with Application Serial No. 4-2005-011934 and filed on 06 December 2005 in the name of Respondent-Applicant, Delfin G. Waldo, Jr. with stated address at 896 T. Sora St., Diliman, Quezon City, Philippines.

The grounds upon which the opposition to the registration of the trademark MISMO were anchored are as follows:

- "1. The trademark MISMO being applied for by Respondent-Applicant is confusingly similar to Opposer's trademark "MISMO!", 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 MISMO in the name of Respondent-Applicant will violate 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 the United States of America are parties.
- "3. The registration and use by Respondent-Applicant of the trademark MISMO will diminish the distinctiveness and dilute the goodwill of Opposer's "MISMO!" trademark. It will also forestall the normal potential expansion of Opposer's business.
- "4. The registration of the trademark MISMO 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:

- "5. Opposer has long been a worldwide business. It is the largest beverage company with the most extensive distribution system in the world. Its product variety spans the globe and it has about 400 marks and brands in over 200 countries. In the Philippines, Opposer first adopted and used the mark "MISMO!" for the goods, beverages, drinking waters, flavored mineral and aerated waters and other non-alcoholic beverages, namely, soft drinks, energy drinks and sport drinks; fruit drinks and juices, syrups, concentrates and powders for making beverages, namely, flavored waters, mineral and aerated waters, energy drinks, sport drinks and juices in class 32.

"6. Opposer is the owner of the "MISMO!" trademark which has been applied and registered in the name of Opposer under Registration No. 4-2003-000188, prior to the filing date of the opposed application. By virtue of Opposer's use and registration of the "MISMO!" trademark, this trademark has become distinctive of Opposer's goods and business.

"7. Opposer's "MISMO!" trademark has been in commercial use in the Philippines since January 2003, way prior to the December 6, 2005 filing date of the opposed application.

"8. Opposer's trademark "MISMO!" and Respondent-Applicant's trademark MISMO are practically identical marks in sound and appearance that they leave the same commercial impression upon the public.

"9. The application for registration of the trademark MISMO by the Respondent-Applicant, also covering commonly purchased goods moving in the same trade channel as that of Opposer's, will deceive and/or confuse purchasers into believing that Respondent-Applicant's goods and/or products bearing the trademark MISMO emanate from or are under the sponsorship of Opposer.

"10. The trademark MISMO of Respondent-Applicant is so confusingly similar to Opposer's "MISMO!" trademark such that it may have been adopted and used by Respondent-Applicant with the intention of riding on the established goodwill of the "MISMO!" mark and "pass off" Respondent-Applicant's goods as those of Opposer.

"11. The strong and distinctive goodwill of the "MISMO!" mark will be diluted, whittled away, diminished, if not tarnished, by the MISMO mark of Respondent-Applicant.

"12. The allowance of Application Serial No. 4-2005-011934 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, of which the Philippines and the U.S.A. are member-states.

"13. Opposer encloses labels showing its trademark "MISMO!" and the filing fee of Php 12,322.00.

The Notice to Answer dated 17 April 2007 directed Respondent-Applicant to file its Verified Answer. For failure of Respondent to file the required Answer within the 30-day period, this Bureau 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 Verified Notice of Opposition on 26 March 2005.

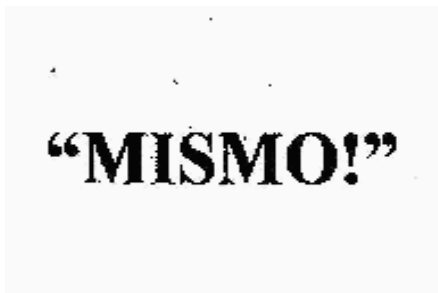
Filed as evidence for the Opposer, based on the records, are the following:

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|--|---|--------------------------|
| 1. Affidavit of the Legal Manager/<br>Operations Attorney of The Coca-<br>Cola Company | - | <i>Exhibit "A"</i>       |
| 2. Declaration of Actual Use   | - | <i>Exhibit "B"</i>       |
| 3. Various advertisements carrying<br>the "MISMO!" mark                                | - | <i>Exhibit "C" – "E"</i> |
| 4. Registration No. 4-2003-000188  | - | <i>Exhibit "F"</i>       |

For consideration in particular is the propriety of Application Serial No. 4-2005-011934. Resolution by this Office is called for on the following issues:

1. whether or not there is confusing similarity between Opposer's "MISMO!" trademark for use on goods particularly of beverages under class 32 vis-à-vis Respondent-Applicant's mark, MISMO, for *cleaning chemicals, powder detergent, dishwashing soap, handwash, toilet bowl cleaner, cleaning solution, disinfectant spray & wipe, laundry bar, bath soap* under class 03;
2. whether or not Respondent-Applicant's trademark application for the mark MISMO should be granted registration;

The above issue requires a careful comparison and scrutiny of the marks involved; to determine the points where these labels as they appear on the goods to which they are attached are similar, in spelling, sound and manner of presentation or general appearance. There can be no doubt that the competing marks are similar in their adoption of the word MISMO. Below is a side-by-side comparison of the competing marks:



Opposer's MISMO mark  
Registration No. 42003000188



Respondent-Applicant's MISMO mark  
Application No. 4200511934

Although the word MISMO appears in both labels of the contending parties, Opposer's MISMO trademark has an exclamation point at the end to complete the same. This is missing in Respondent-Applicant's MISMO mark. Most importantly, MISMO is a generic word, no one has exclusive right thereto, depending on how this one-word mark is used, interpreted and presented to the public, its appropriation by anyone does not preclude another from using the same, having shown the marks of both parties, we now delve on the matter of confusion of goods which certainly has decisive effects in the adjudication of the case.

Opposer's goods are mainly beverages, nowhere in Opposer's family of COCA-COLA trademarks appeared or showed that it has an intention to include goods under Class 03 specifically for cleaning chemicals and/or materials. Respondent-Applicant limited its goods to these cleaning materials namely *cleaning chemicals, powder detergent, dishwashing soap, handwash, toilet bowl cleaner, cleaning solution, disinfectant spray & wipe; laundry bar, Bath soap*. Hence, no confusing similarity exists between the subject trademarks as well as in the general appearance, presentation and packaging of their goods. The facts of the instant suit so closely resemble the circumstances obtaining in the case of *Faberge, Incorporated vs. Intermediate Appellate Court, et al*, G.R. No. 71189, November 04, 1992, that the application of the ruling in said case to the one at bar becomes unavoidable and compelling. The Supreme Court ruled, thus:

*"In short, paraphrasing Section 20 of the Trademark Law as applied to the documentary evidence adduced by petitioner, the certificate of registration issued by the Director of Patents can confer upon petitioner the exclusive right to use its own symbol only to those goods specified in the certificate, subject to ant conditions and limitations stated therein."*

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The case likewise of Philippine Refining Co., Inc. vs. Ng Sam, 201 Phil 61, is one case relevant to and decisive of this particular point when the court ruled:

*“The trademark “CAMIA” is used by petitioner on a wide range of products: lard, butter, cooking oil, abrasive detergents, polishing materials and soap of all kinds. Respondent desires to use the same on his product, hem. While ham and some of the products of petitioner are classified under Class 47 (Foods and Ingredients of Food), this alone cannot serve as the decisive factor in the resolution of whether or not they are related goods. Emphasis should be on the similarity of the products involved and not on the arbitrary classification or general description of their properties or characteristics.”*

All told, confusion or deception to the purchasing public or the apprehension, if at all, that the public may be misled into believing that there is some connection or association between Opposer’s goods using its MISMO! Trademark and Applicant’s word mark MISMO, the likelihood that these goods may be mistaken as coming from the same origin, is far-fetched.

Based on the foregoing and despite allegation by Opposer that the marks involved are practically identical, this Bureau resolves to grant protection to Respondent-Applicant’s mark MISMO, the two marks not being confusingly similar.

WHEREFORE, based on the foregoing facts and the evidence, the Notice of Opposition filed by herein Opposer is, as it is hereby, DENIED. Accordingly, application bearing Serial No. 4-2005-011934 for the mark “MISMO” filed on 06 December 2005 for use on *cleaning chemicals, powder detergent, dishwashing soap, handwash, toilet bowl cleaner, cleaning solution, disinfectant spray & wipe, laundry bar, bath soap* under Class 03 is hereby GIVEN DUE COURSE.

Let the filewrapper of MISMO, 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, October 23, 2008.

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