

WARNER LAMBERT COMPANY, <i>Opposer,</i>	}	IPC NO. 4043
	}	Opposition to:
	}	
	}	Application Serial. No. 85071
-versus-	}	Date Filed: 13 April 1993
	}	Trademark: "CHLORALIT"
	}	Goods: For coffee, tea, cocoa
	}	sugar, rice, tapioca, sago,
	}	coffee substitutes, flour
	}	and preparations made
	}	from cereals (except
	}	fodder); bread, biscuits,
	}	cakes, pastry and confectionery,
	}	ices, honey; treacle, yeast,
	}	baking-powder; salt, mustard,
	}	pepper, vinegar, sauces;
	}	spices; ice, chewing gum.
	}	
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	}	
PERFETTI S.P.A.	}	
<i>Respondent-Applicant.</i>	}	Decision No. 2004-11
x-----x		

DECISION

This pertains to the opposition filed on September 6, 1994 by the herein Opposer, WARNER LAMBERT COMPANY, a foreign corporation with principal place of business at 201 Tabor Rd., Morris Plains, New Jersey, 07950, United States of America, against the application for the registration of the trademark "CHLORALIT" filed on April 13, 1993 bearing Serial No. 85071 used for coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes, flour and preparations made from cereals (except fodder); bread, biscuits, cakes, pastry and confectionery, ices, honey; treacle, yeast, baking powder; salt, mustard, pepper, vinegar, sauces, spices; ice, chewing gum under class 30 of the International classification of goods, which application was published on page 68 of the Bureau of patents, Trademarks and Technology Transfer Official Gazette which was officially released for circulation on May 12, 1994.

The Respondent-Applicant in the instant opposition is PERFETTI, S.P.A., likewise a foreign corporation with address at VIA XXV APRILE, 7-LAINATE, MILANO, ITALY.

The grounds of the opposition are as follows:

- "1. Opposer is the owner-registrant of the trademark "CLORETS" in the Philippines under Original Certificate of Registration No. 34452 issued on May 29, 1985;
- "2. The trademark CLORETS was first used on July 24, 1979 in the United States of America and the Philippines;
- "3. The ownership of the trademark CLORETS is registered in favor of the Opposer and its CLORETS products are sold worldwide. Due to the high quality of Opposer's goods, people all over the world have associated said trademark and the goods on which it is used with the Opposer. As such, trademark CLORETS enjoys tremendous goodwill all over the world;

- “4. Opposer’s trademark CLORETS is a world famous mark associated with its products and deserves protection as such pursuant to the Convention of Paris for the Protection of Industrial Property to which the Philippine became a signatory in 1968. It is likewise duly registered as a trademark with numerous Paris Convention member countries;
- “5. The trademark CLORETS is used on class 30 goods, specifically breathe purifying gum. The registration sought by the Respondent-Applicant is in violation of or contrary to the provision of Section 4 of Republic Act No. 166, as amended, as Respondent-Applicant’s CHLORALIT is confusingly similar to Opposer’s registered trademark CLORETS and is likely to cause confusion or mistake or will likely deceive purchasers who may be led to believe that the goods of the Respondent-Applicant on which the subject mark is used are those of the Opposer, and vice-versa for the following reasons:
- (i) The first five letters of the Opposer’s trademark and Respondent-Applicant’s mark are exactly the same;
 - (ii) The mark of Respondent-Applicant is used on the same class of goods as Opposer;
- “6. In the Philippines, Opposer’s goods bearing the trademark CHLORET has been sold in the market at least since 1979;
- “7. For reasons above-stated, Opposer will be damaged by the registration of the trademark CHLORALIT in the name of Respondent-Applicant and Opposer’s business reputation and goodwill suffer great and irreparable injury.

A Notice to Answer dated 12 September 1994 was issued by this Office requiring the Respondent-Applicant to file its Answer within fifteen (15) days from receipt.

On October 7, 1994, Respondent-Applicant filed its Answer denying all the material allegations of the opposition and further alleged the following as its special and affirmative defenses:

- “1. Respondent-Applicant is the owner and the first user of the mark CHLORALIT, which is registered in its name in the Trademark Registry of Italy and in various other industrial property offices worldwide. As such, it is entitled to the registration of the said mark in the Philippines in accordance with the provisions of Republic Act No. 166 (the “Trademark Law”), specifically Section 37 thereof, and the Provision of the Paris Convention for the Protection of Industrial Property of which the Philippines and Italy are signatories;
- “2. The registration of the Respondent-Applicant’s mark CHLORALIT will not violate Section 4 of the Trademark Law as it is not confusingly similar to the mark CLORETS or any other trademark registered with the Bureau of Patents Trademarks and Technology Transfer (BPTTT);

- “3. The Respondent-Applicant’s mark CHLORALIT is wholly dissimilar in appearance, spelling, pronunciation, syllabication, and meaning from the mark CLORETS. Thus, while the Respondent-Applicant’s mark is composed of nine (9) letters and three (3) syllables, the mark CLORETS is composed only of six (6) letters and two (2) syllables. Also, while the initial syllable “CLOR” of the Opposer’s mark “CHLOR” of the Respondent-Applicant’s mark might sound in a quite similar way, both said syllables cannot, by themselves alone, be considered as particularly distinctive, taking into account that they make reference to the content of chlorophyll of the goods distinguished by the marks. Hence, the Opposer cannot claim exclusive use of the “CLOR” component of its mark. Consequently, there can be no confusing similarity between “CHLORALIT” and “CLORETS” since the respective appropriable components of the marks, i.e. “RALIT” and “RETS”, are wholly dissimilar in spelling, sound and appearance;
- “4. The grounds of opposition relied upon by the Opposer, taken together, do not state a cause of action against the Respondent-Applicant.

During the pre-trial conference, the conference, the parties to reach an amicable settlement for which trial on the merits was conducted whereby both parties presented their respective evidence in support of their claims.

Opposer submitted as its evidence Exhibits “A” to “X” inclusive of sub-markings which was admitted for whatever they are worth under ORDER NO. 99-24 dated 12 January 1999.

On the other hand, Respondent-Applicant submitted as its evidence consisting of Exhibits “1” to “20” inclusive of sub-markings likewise admitted in evidence under ORDER No. 2003-248 dated 25 June 2003.

The main issue to be resolved in this particular case is:

WHETHER OR NOT RESPONDENT-APPLICANT’S MARK “CHLORALIT” IS CONFUSINGLY SIMILAR TO OPPSER’S MARK “CLORETS”.

HEREIN Opposer advance the view that Respondent-Applicant’s trademark “CHLORALIT” is confusingly similar to their trademark “CLORETS” as the two competing marks almost sounds alike especially in its first syllable which is “CLO” FOR Opposer’s “CLORETS” while “CHLO” for Respondent-Applicant’s “CHLORALIT”. Opposer further contends that its trademark and that of the Respondent-Applicant would likely cause confusion to the buying public considering the mark “CLORETS” has allegedly gained goodwill and reputation for being well-known throughout the world. With regard to the container packaging, Opposer argued that the Respondent-Applicant’s packaging denoted similarity with their packaging since the same represent colors green and white in its respective labels. Lastly, Opposer interpose that the reason behind this instant opposition case against Respondent-Applicant is that the latter’s mark covers the same product with the Opposer, i.e. chewing gum under Class 30 of the International Classification of goods.

Respondent-Applicant counters that the instant case should be resolved in their favor under the principle of “Res Ipsa Loquitor” (the fact speaks for itself). Accordingly, the visual as well as phonetic examinations for said competing marks would reveal several distinctions. Through verbal analogy, Opposer’s mark consist only two (2) syllables, viz., “CLO-RETZ”, while Respondent-Applicant, *“the only phonetic similarity is the first syllable for both marks, i.e. “CLOR” and “CHLOR”.*”

Furthermore, Respondent-Applicant added that the second and last syllable of Opposer's mark, viz., "-ETS" by any thought or consideration cannot be declared similar to that of Respondent-Applicant's "-A-LIT". To insist that "ETS" and "ALIT" are phonetically similar, is, therefore, to perpetuate an obvious lie.

It should be noted that the trademark application subject of the instant opposition was filed on April 13, 1993, *thus*, the governing law on Intellectual Property Rights particularly on trademarks is Republic Act No. 166, as amended.

Accordingly, the applicable provision is Section 4(d) of Republic Act No. 166, as amended which provides, to wit:

"Section 4. Registration of trademark, 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 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 of the applicant, to cause confusion or mistake or to deceive purchasers."*

In the case of *Etepha vs. Director of Patents* (16 SCRA 502), the Supreme Court stated that:

"The essential element of infringement is colorable imitation. This term has been defined as "such a close or ingenious imitation as to be calculated to deceive ordinary purchasers, or such resemblance of the infringing mark to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one, supposing it to be the other."

In cases of this nature, there can be no better evidence as to whether there is confusing similarity in the contesting trademarks than the labels themselves. In the case of *Mead Johnson & CO. vs. N.V.L. Van Dorp, Ltd.* (7 SCRA 768), the Supreme Court held:

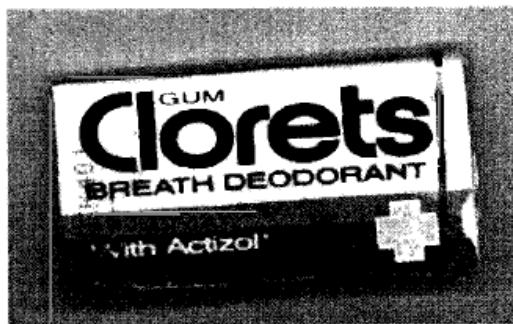
"In determining whether two (2) trademarks are confusingly similar, the two marks in their entirety as they appear in the respective labels must be considered in relation to the goods to which they are attached; the discerning eye of the observer must focus not only on the predominant words but also on the other features appearing on both labels."

Applying the abovementioned guidelines to the instant case and considering the trademarks involved as a whole, it is clear that there is no confusing similarity between the trademark "CLORETS" and "CHLORALIT". The trademark "CLORETS" of Opposer consists

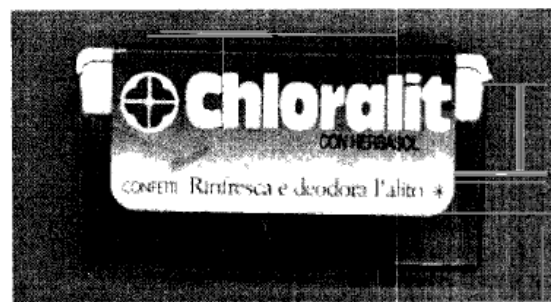
merely of the two syllables while the trademark “CHLORALIT” of herein Respondent-Applicant consists of three syllables. The two trademarks are also pronounced differently. The only similarity between the two (2) trademarks are the first four (4) letters of CLORETS (CLOR) and first five letters of CHLORALIT (CHLOR) which refer to the chlorophyll content of the goods. The dissimilarity between the two trademarks is striking and glaring to the eye that confusion is improbable.

The foregoing doctrines would show that after the comparative analysis between the two marks as well as the containers where their respective labels are attached, were found to be entirely different. This can be deduced from Exhibits “M”, “N”, “O”, “P” and Exhibits “R”, “S”, “U”, “V” and “W”.

For a better appreciation of the contending marks, Opposer’s “CLORETS” as well as Respondent-Applicant’s CHLORALIT are reproduced hereunder:



Opposer’s CLORETS
(Exhibit “O”)



Respondent-Applicant’s CHLORALIT
(Exhibit “U”)

As shown by the marks, Opposer’s “CLORETS” contained a cross design below and the word CLORETS is written in green color while Respondent-Applicant mark “CHLORALIT” is written in white with green background.

Furthermore, Respondent-Applicant is correct in saying that the aforementioned marks are different in appearance, sound, spelling, pronunciation and in their respective packaging or containers. While the Respondent-Applicant’s CHLORALIT mark is composed of nine (9) letters and three (3) syllables, the mark “CLORETS” is composed only of seven (7) letters and two (2) syllables. In addition, their respective appropriable components of the marks, i.e. “RALIT” for Respondent-Applicant’s “CHLORALIT” and “RETS” for Opposer’s “CLORETS”, are wholly dissimilar in sound, spelling and appearance.

Moreover, when *pronounced* either on television or radio, the ordinary listeners or the public could *easily distinguish* one mark from the other as their *sounds* are very different. At this point, Respondent-Applicant is correct when it raises the latin maxim “Res Ipsa Loquitur”. When an ordinary purchaser pronounces the competing marks, they are entirely different. Ordinary purchaser is defined by our Supreme Court in the case of “DY BUNCIO vs. TANTIAO BOK (42 Phil. 192) as one “*accustomed to buy, and therefore to some extent familiar with the goods in question.*”

Lastly, it cannot be denied that the contending marks are used on the same product, under class 30 of the International Classification of goods. These goods are ordinary items and can be found in the same shelves of the supermarket or stores. They belong to the basic commodities like food or any other ordinary commodities without great care. Be that as it may, still, there can be no instance where the purchaser or the buying public would take the goods bearing “CHLORALIT” believing that it is also the same as “CLORETS” as the labels are obviously different considering the visual attributes as well as the very clear distinction in its

pronunciation vis-à-vis spelling of both competing marks. Hence, it cannot be said that confusion is present and is therefore, unlikely to occur.

IN VIEW THEREOF, this Office holds that there is no confusing similarity between the trademarks "CLORETS" and "CHLORALIT" involved in the instant opposition proceedings.

WHEREOF, the opposition is, as it is hereby, DENIED. Consequently, trademark application bearing Serial No. 85071 for the mark "CHLORALIT" filed on April 13, 1993 by PERFETTI S.P.A. is, as it is hereby, GIVEN DUE COURSE.

Let the file wrapper of "CHLORALIT" subject matter of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau (AFHRDSB) for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks (BOT) for information and to update its record.

SO ORDERED.

Makati City, 31 May 2004.

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