



**SYNGENTA LIMITED,**  
Opposer,

**-versus-**

**FMC CORPORATION,**  
Respondent-Applicant.

} **IPC No. 14-2010-00032**  
} Opposition to:  
} Appln No. 4-2009-005025  
} Date Filed: 22 May 2009  
} **TM: "BISTAR"**

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**NOTICE OF DECISION**

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**GREETINGS:**

Please be informed that Decision No. 2015 - 82 dated May 11, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 11, 2015.

For the Director:

  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



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- versus -

**FMC CORPORATION,**  
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IPC No. 14-2010-00032  
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Date Filed: 22 May 2009  
Trademark : "BISTAR"

Decision No. 2015 - 82

## DECISION

SYNGENTA LIMITED ("Opposer"),<sup>1</sup> filed a verified opposition to Trademark Application Serial No. 4-2009-005025. The application, filed by FMC CORPORATION ("Respondent-Applicant"),<sup>2</sup> covers the mark "BISTAR" for use on "*pesticides*" under class 05 of the International Classification of Goods.<sup>3</sup>

The Opposer alleges the following grounds for the opposition:

"6. The trademark BISTAR being applied for by respondent-applicant is confusingly similar to opposer's trademark AMISTAR, 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.

"7. The registration of the trademark BISTAR in the name of respondent-applicant will violate Section 123.1 subparagraph (d) of Republic Act No. 9203, otherwise known as the Intellectual Property Code of the Philippines (IPCode).

"8. The registration and use by respondent-applicant of the trademark BISTAR will diminish the distinctiveness and dilute the goodwill of opposer's trademark AMISTAR.

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

The Opposer's evidence consists of the following:

1. Certificate of Registration No. 4-11996-112028 for AMISTAR;
2. Affidavit-Testimony of Jane Collins;
3. Certification from Register of Companies re: change in the name of Syngenta Limited;
4. Syngenta AG's Annual Report for 2008;
5. Certificates of Registration in various countries for AMISTAR;

<sup>1</sup> A corporation duly organized and existing under and by virtue of the laws of United Kingdom with business address at Syngenta European Regional Centre, Priestley Road, Surrey Research Park, Guildford, Surrey, GU2, 7YH, United Kingdom.

<sup>2</sup> A corporation organized and existing under and by virtue of the laws of the United States of America with office address at 1735 Market Street, Philadelphia, Pennsylvania 19103, U.S.A.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

6. Syngenta Limited's worldwide trademark portfolio for AMISTAR;
7. Advertising materials of AMISTAR in Philippines and in the world; and,
8. Purchase orders and invoices for products bearing the mark AMISTAR in the Philippines.

On 24 June 2010, Respondent-Applicant filed its Answer pleading the following special and affirmative defenses:

"9. Opposer has no valid cause of action against the respondent.

"10. Contrary to opposer's claim, the trademark BISTAR of the herein respondent is phonetically and visually dissimilar from the AMISTAR trademark of the opposer.

x x x

"11. As shown in the various certificates of registration that were presented by the opposer the trademark AMISTAR is registered for pesticides, herbicides, insecticides - all for use in agriculture and horticulture. On the other hand, respondent's BISTAR trademark is used for pesticides for household (non-agricultural pesticides) as shown in the attached product label of BISTAR for Philippine market hereto marked as Annex "1" and made integral part hereof. Though the goods of the contending parties belong to the same general classification of goods, i.e. Class 5, the contending trademarks of the parties do not cause confusion on the market for the goods covered by the respective trademark have different use and/or application.

"12. The trademark BISTAR was registered in the Philippines much earlier than the registration by the opposer of the AMISTAR trademark on July 19, 2000. The trademark BISTAR was first registered by the respondent in the Philippines on November 25, 1998 under Certificate of Registration No. 06661. Respondent has re-registered the same trademark on June 18, 2007 under Certificate of Registration No. 4-2005-010838.

"13. The registrability of the respondent's BISTAR trademark has long been determined and resolved by no less than the Intellectual Property Office (IPO) when the latter, through the Bureau of Trademarks, allowed the registration of the trademark BISTAR as early as 1998 despite th then pending trademark application of the trademark AMISTAR that was earlier filed by the opposer on July 10, 1996 as indicated in item No. 21 of the Notice of Opposition.

"14. The non-similarity or non-confusing similarity of respondent's BISTAR and opposer's AMISTAR trademark was further affirmed by this Honorable Office when the latter allowed the re-registration of the trademark AMISTAR. Respondent wishes to underscore the fact that opposer's AMISTAR trademark registration was never cited as a bar or reference by the Bureau of Trademarks during the substantive examinations of the present and previous BISTAR trademark application of the respondent.

"15. The trademarks BISTAR and AMISTAR are allowed to co-exist without any confusion in different countries of the world, particularly in Argentina, Australia, Benelux, China, Ecuador, France, Germany, Great Britain, Greece, Hungary, Italy, Japan, Mexico, New Zealand, Poland, The Russian Federation, and Vietnam."

The Respondent-Applicant's evidence consist of the following:

1. BISTAR product label for Philippines;
2. Philippine Registration No. 66601 for BISTAR;
3. Philippine Registration No. 4-2005-0010838 for BISTAR;
4. Renewal registration documents for BISTAR in Argentina, Australia, Italy, Mexico

5. Certificate of Registration of BISTAR in Benelux, Ecuador, Germany, Great Britain, Japan,
6. New Zealand, Poland, The Russian Federation, and Vietnam; and,
7. Certificate of Renewal Registration of BISTAR in China, France, Greece, Hungary.

On 05 July 2010, Opposer filed its Reply, reiterating the confusing similarity of the contending marks BISTAR and AMISTAR, and the similarity and relatedness of the goods covered to cause confusion in the minds of the purchasing public.

Thereafter, Preliminary Conference was conducted and terminated on 24 August 2010.<sup>4</sup> The Opposer and the Respondent-Applicant submitted their respective position papers on 27 and 30 September 2010. Hence, this instant case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark BISTAR?

The instant opposition is anchored on Section 123.1 paragraph (d) of R.A. No. 8293, otherwise known as the Intellectual Property Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services if it nearly resembles such mark as to be likely to deceive or cause confusion.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 22 May 2009<sup>5</sup>, the Opposer has already an existing trademark registration for the mark AMISTAR bearing Registration No. 4-1996-112028 issued on 19 July 2000<sup>6</sup> in the Philippines. It has also various registrations for AMISTAR in different countries in its name.<sup>7</sup> Unquestionably, the Opposer's application and registration preceded that of Respondent-Applicant's.

A comparison of the Opposer's mark with the Respondent-Applicant's is depicted below:

**AMISTAR**

Opposer's Trademark

**BISTAR**

Respondent-Applicant's Trademark

The foregoing marks contain the prominent middle and ending letters *I, S, T, A,* and *R* (ISTAR). They only differ in their beginning letters - *A* and *M* in Opposer's AMISTAR, as against *B* in Respondent-Applicant's BISTAR. Such that, if either of the marks are spoken, they create an apparent aural similarity creating the likelihood of confusion of one mark as against the other.

Further, a scrutiny of the goods covered by the mentioned marks show the similarity and relatedness of the pharmaceutical products covered by the marks in classification no. 5. Opposer's AMISTAR particularly covers pesticides, herbicides, insecticides, fungicides, preparations for destroying vermin, all for use in agriculture and horticulture. On the other hand Respondent-Applicant's BISTAR

<sup>4</sup> Order No. 2010-980 dated 02 September 2010.

<sup>5</sup> Filewrapper records.

<sup>6</sup> Exhibit "A" of Opposer.

<sup>7</sup> Exhibits "E" and "F" of Opposer.

covers pesticides. Obviously, they are intended for the same purpose and use, cater to the same group of purchasers, and available in the same channels of trade.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.<sup>8</sup> Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.<sup>9</sup>

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.<sup>10</sup> The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:<sup>11</sup>


Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase on product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2009-005025 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 May 2015.

  
Atty. **NATHANIEL S. AREVALO**  
Director IV, Bureau of Legal Affairs

<sup>8</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

<sup>9</sup> Emerald Garment Manufacturing Corp. v. Court of Appeals, G.R. No. 100098, 29 December 1995.

<sup>10</sup> American Wire and Cable Co. v. Director of Patents, et al., 31 SCRA 544, G.R. No. L-26557, 18 February 1970.

<sup>11</sup> Converse Rubber Corporations v. Universal Rubber Products, Inc. et al., G.R. No. L-27906, 08 January 1987.