

PROCTER & GAMBLE PHILIPPINES, INC.,

Opposer,

INTER PARTES CASE NO. 3318

OPPOSITION TO:

- versus -

Application Serial No. 62567
Filed: September 1, 1987
Applicant: Henkel Kommanditgesellschaft auf Aktien
Trademark: PERLANA
Used on: Washing and cleaning agents, starch for laundry use and textile

HENKEL KOMMANDITGESELLSCHAFT AUF AKTIEN

Respondent-Applicant.

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DECISION NO. 90-33 (TM)
August 29, 1990

DECISION

This is an opposition filed by Procter & Gamble Philippines, Inc. to the registration of the trademark "PERLANA" under Application Serial No. 62567 used on washing and cleansing agents, starch for laundry use on textile, filed on September 1, 1987 by Henkel Kommanditgesellschaft auf Aktien, and which was published on December 20, 1988 issue of the BPTTT's Official Gazette.

Opposer is a corporation duly organized and existing under the laws of the Philippines with principal office located at 777 Solid Bank Building, Paseo de Roxas, Makati, Metro Manila, while Respondent is a corporation organized under the laws of Federal Republic of Germany with business address at Henkelstr 67, D-4000 Dusseldorf-Holfhausen, Federal Republic of Germany.

The grounds for opposition are as follows:

"1. The opposer is the owner of the trademark PERLA for soap in Class 4 which was originally registered under Philippine Certificate of Registration No. 402 which was last renewed on November 12, 1969 under Certificate of Renewal No. 676-R and the application for renewal of the latter is now pending under Application Serial No. R-5289 filed on March 15, 1988. The mark was initially used in the Philippines on May 14, 1925 and show commercial use in the same year.

The trademark PERLA sought to be registered by respondent-applicant so resembles and is in fact confusingly similar with the unabandoned mark of the opposer such that the use of subject mark will very likely cause confusion or mistake in the minds of the public, or will deceive purchasers thereof into believing that the respondent-applicant's mark are those of opposer or sponsored by opposer or originated from or related with the opposer herein.

2. The trademark PERLA is, and ever since its adoption has been continuously applied to products of opposer, to the package and containers of said products and the labels affixed to said packages and containers. The trademark PERLA has come to be and is now popularly known throughout the Philippines such that opposer's product bearing the mark PERLA has become identified as coming from opposer herein. Hence, the tremendous goodwill established by the mark PERLA, nurtured through its long use,

the superior quality of its products and public acceptance of the product's reliability is an invaluable asset of the opposer which must be protected from trade-poachers like respondent-applicant herein.

3. The opposer herein believes that the registration of the mark PERLANA in the name of the respondent-applicant will cause great and irreparable injury and damage to herein opposer pursuant to Section 8 of Republic Act 166, as amended."

For failure to file its Answer to the Notice of Opposition within the reglementary period despite due notice thereof, and upon motion of the Opposer, Respondent-Applicant was declared in default under Order No. 89-303 dated May 5, 1989. Accordingly, Opposer was allowed to present its evidence ex parte.

Admitted as Opposer's evidence were Exhibits "A" to inclusive of submarkings.

The issue to be resolved is whether or not Respondent's trademark "PERLANA" is confusingly similar to Opposer's trademark "PERLA".

This Bureau resolves in the affirmative.

Opposer is the registered owner and proprietor of the trademark "PERLA" for laundry soap as evidenced by Original Certificate of Registration issued on June 14, 1948 (Exh. "A") and the Renewal Certificate of Registration No. R-676 issued on November 12, 1969 (Exh. "B") and its renewal application filed on March 15, 1988 (Exh. "C")

Also, Opposer is the first user of the trademark "PERLA", having first used the same in the Philippines since May 14, 1925 (Exh. "A-2"), and has used the mark extensively and continuously up to the present time.

Comparing the two (2) marks "PERLANA" it is interesting to note that except for the last syllable "NA" both marks are identical to each other both in appearance and in sound.

Under the "test of dominancy", if one trademark contains the main essential or dominant features of another by reason of which confusion and deception are likely to result, then infringement takes place. Duplication or imitation is not necessary, a similarity in the dominant features of the trademarks would be sufficient (Philippine Nut Industries Inc. vs. Standard Brands, Inc., 65 SCRA 575; emphasis supplied). Here, the dominant feature is the word "PERLA".

It is, therefore, not necessary that the matter sought to be protected be literally copied. Difference or variations or similarity in the details of one device or article of those of another are not the legally accepted tests whether an action based on confusing similarity exists. It is sufficient that the substantial and distinctive part of the main or essential or dominant features of one mark is copied or imitated in another (Co Tiong Sa vs. Director of Patents, 95 Phil. 1; emphasis supplied).

Moreover, both marks are used on closely related goods. Opposer's mark "PERLA" is used on soap while Respondent's mark "PERLANA" is used on washing and cleaning agents, starch for laundry use and textiles.

Lastly, Respondent-Applicant's failure to file its Answer is a clear manifestation of lack of interest to pursue further its application for registration. Hence, it is deemed to have abandoned its application for registration.

WHEREFORE, this Opposition is SUSTAINED. Consequently, Application Serial No. 62567 for the trademark "PERLANA" is hereby REJECTED.

Let the records of this case be transmitted to the Application, Issuance and publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director