

SYNGENTA PARTICIPATIONS AG,
Opposer,

-versus-

MITSUI CHEMICALS AGRO, INC.,
Respondent- Applicant.

x-----x

} IPC No. 14-2013-00492
}
} Opposition to:
} Appln. Serial No. 4-2013-002443
} Date Filed: 05 March 2013
} TM: "POLIDO"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 240 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 01, 2016.

For the Director:


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

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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SYNGENTA PARTICIPATIONS AG,
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IPC NO. 14 – 2013 - 00492

- versus -

Opposition to:

Appln Serial No. 42013002443

MITSUI CHEMICALS AGRO, INC.,
Respondent-Applicant.

TM: "POLIDO"

DECISION NO. 2016 - 240

X-----X

DECISION

SYNGENTA PARTICIPATIONS AG (Opposer)¹, filed an Opposition to Trademark Application Serial No. 4-2013-002443. The application filed, by MITSUI CHEMICALS AGRO, INC. (Respondent-Applicant)², covers the mark "POLIDO" for "*preparations for killing weeds and destroying vermin; insecticides; pesticides; vermicides; fungicides; herbicides; germicides*" under Class 5 of the International Classification of Goods.³

The Opposer alleges:

- "1. (sic) The mark POLIDO of respondent-applicant is confusingly similar with the trademark SOLITO of opposer Syngenta Participations AG since:
- (a) Four (4) out of six (6) letters in the published mark, i.e. O, L, I and O, are identical to and are arranged in the same exact order as SOLITO. The letters and syllables OLI-O in the mark POLIDO are present and may be considered as the dominant feature of opposer's trademark SOLITO. Under the Dominancy Test which focuses on the similarity of the prevalent features of the competing trademarks, if the competing mark contains the main or essential or dominant features of another, confusion and deception is likely to result.
 - (b) The syllables in the published mark PO-LI-DO are similar visually and phonetically to opposer's trademark SO-LI-TO. The first syllables PO vis-avis SO are nearly identical in spelling, appearance and pronunciation. The second syllable in each LI is the same. The third syllables DO vis-avis TO are also nearly identical in spelling, appearance and pronunciation. Hence, there is hardly any difference in their sound and pronunciation. Applying the test of "idem sonans", the said syllables in the published mark are similar aurally to

¹ A corporation organized under the laws of Switzerland with business address at Schwarzwaldallee 215, 4058 Basel, Switzerland.

² A corporation organized and existing under the laws of Japan with address at 5-2 Higashi-Shimbashi, 1-chome, Minato-ku, Tokyo, Japan.

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

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those of opposer's mark; hence the likelihood of confusion is greater. (Amigo Manufacturing, Inc. vs. Cluett Peabody, Co., Inc. G.R. No. 139300, 14 March 2001)

- (c) Because the letters, syllables and the sequence of the letters and syllables are practically the same, the marks "look" alike. Furthermore, both marks are in plain block lettering without any distinguishing design or device accompanying each mark. Hence, the marks are confusingly similar with each other in terms of over-all appearance.

"10. Indubitably, opposer's and respondent-applicant's mark are confusingly similar. The case of American Wire and Cable Co. vs. Director Patents (G.R. No. L-26557, February 18, 1970) where the Supreme Court found that DURAFLEX and DYNAFLEX are confusingly similar, finds application in the instant case x x x

"11. Moreover, it is settled jurisprudence that identity or similarity in the dominant features of two (2) competing marks will cause mistake or confusion in the minds of the purchasing public. x x x

"14. In the recent case of McDonald's Corporation, et. al. vs. L.C. Big Mak Burger, et al. (G.R. No. 143993, August 18, 2004), the Supreme Court likewise applied the test of dominancy in determining that the mark BIG MAC of McDonald's Corporation and the mark BIG MAK of L.C. Big Mak Burger are confusingly similar. x x x

"15. The reasoning in the McDonald's case (supra) applying the Dominancy Test is relevant in the instant case. The dominant feature in opposer's mark SOLITO is the mark itself, four (4) out of six (6) letters of which are identical to those of respondent-applicant's mark POLIDO and similar positioned. The difference in the first and fourth letters of opposer's and respondent-applicant's mark is inconsequential. This marginal distinction does not sufficiently distinguish the marks from each other as they are similar in pronunciation, syntax, sound and appearance. As such, the marks are, for all intents and purposes, practically identical and confusingly similar. The purchasing public will easily recognize and remember the common letters _O-L-I _O and hence, it is very easy to mistake respondent-applicant's products bearing the mark POLIDO for opposer's goods bearing the mark SOLITO.

x x x

"16. Opposer's mark and respondent-applicant's mark cover the same and competing goods.

Opposer's mark SOLITO covers:
"agricultural herbicides"

while respondent-applicant's mark POLIDO covers:

"preparations for killing weeds and destroying
vermin; insecticides; pesticides; vermicides;
fungicides; herbicides; germicides"

"17. Opposer's mark SOLITO and respondent-applicant's mark POLIDO cover very similar and closely-related goods such that confusion is more likely to arise as to the source of the goods bearing each mark. The set of goods are sold in the same channels of business and trade. They are all used in the agrochemical/agropharmaceutical industry. The targeted market, i.e., agricultural sector is the same. Hence, the confusion on the purchasing public is further enhanced. x x x

“19. In view of the similarity of the covered goods, the purchasing public in the belief that they are purchasing opposer’s goods. This will thus result to damage to the public and to opposer’s established business and goodwill, which should not be allowed.

x x x

“20. In the Philippines, opposer is the registrant of the trademark SOLITO, the particulars of which are, as follows:

Trademark	: SOLITO
Registrant	: Sygenta Participations AG
Certificate of	
Reg. No.:	4 - 2011- 008896
Date Issued	: 29 December 2011
Goods	: <i>agricultural herbicides</i>
Class	: 05

x x x

“22. Opposer applied for registration of the mark SOLITO in the Philippines as early as 28 July 2011. The mark was registered as early as 29 December 2011. On the other hand, respondent-applicant applied for registration of the mark POLIDO only on 05 March 2013, almost two (2) years after opposer for registration of its mark SOLITO in the Philippines and more than one (!) year after its registration. Hence, opposer has the right to use the mark SOLITO to the exclusion of others and has the right to prevent other persons from using similar marks, including respondent-applicant’s mark POLIDO, that are likely to deceive or cause confusion among the purchasing public.

“23. For reasons already stated above, respondent-applicant’s mark POLIDO is practically identical or nearly resembles opposer’s mark SOLITO and covers the same and competing goods which is likely to deceive or cause confusion among the consuming public. Hence, pursuant to the aforecited provision, respondent-applicant’s mark cannot be registered.

x x x

“24. By virtue of opposer’s prior registration of the trademark SOLITO in the Philippines and abroad, said trademark has become distinctive of opposer’s goods and business.

“25. A boundless choice of words, phrases and symbols is available to a person who wishes to have a trademark sufficient unto itself to distinguish its product from those of others. There is no reasonable explanation therefore for respondent-applicant to use the mark POLIDO for “herbicides” when the field for its selection is so broad. Respondent-applicant obviously intends to pass off its products as those of opposer.

x x x

“28. Indubitably, the registration and use of the trademark POLIDO by respondent-applicant will deceive and/or confuse the purchasers into believing that respondent-applicant’s goods and/or products bearing the trademark POLIDO emanate from or are under the sponsorship of opposer Syngenta Participations AG, the rightful owner of the trademark SOLITO in the Philippines and around the world.

“29. In view of the foregoing, opposer’s mark SOLITO which are legally protected under Philippine law bar the registration in the Philippines of the confusingly similar mark POLIDO of respondent-applicant Mitsui Chemicals Agro, Inc.”

In support of the Opposition, the Opposer submitted the following evidence:

Exhibit "A" – Duly signed, notarized and legalized Affidavit-Testimony of Mike Damman dated 29 January 2014;

Exhibit "B" – Certificate of Registration under the Intellectual Property Office of the mark "SOLITO";

This Bureau issued a Notice to Answer and served a copy to the Respondent-Applicant on 4 March 2014. On 1 April 2014, the Respondent-Applicant filed a Motion for Extension of Time to File Verified Answer,. This Bureau granted the Motion. However, the Respondent-Applicant still failed to file an Answer to the Opposition. In view of thereof, an Order dated 28 August 2014 was issued declaring the Respondent-Applicant in default. The order of default was received by the Respondent-Applicant on 4 September 2014. Consequently, this case was deemed submitted for decision.

The issue to resolve in the present case is whether the respondent - applicant should be allowed to register the trademark "POLIDO."

The Opposition is anchored on Section 123.1 par. (d) of Republic Act No. 8293, also known as, the Intellectual Property Code of the Philippines ("IP Code"), to wit:

123.1. A mark cannot be registered if it:

x x x

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

The competing marks are reproduced below for comparison:

SOLITO

Polido

Opposer's Trademark

Respondent's – Applicant's
Trademark

Upon careful examination of the two competing trademarks and the evidence submitted by the opposer, this office finds merit to the contentions of the Opposer that the respondent-applicant's mark POLIDO is confusingly similar with the trademark SOLITO of the Opposer.

Both the competing word marks consist of three (3) syllables compose of six (6) letters. The four (4) of the six (6) letters composing each mark are identical, specifically the letters, "O", "L", "I" and "O." From a visual and aural standpoints, the

two word marks closely resemble each other. The words PO-LI-DO and SO-LI-TO have almost identical sounds. The difference on the first and fifth letters of the two marks are negligible and not enough to distinguish one over the other. Jurisprudence says that trademarks with *idem sonans* or similarities of sounds are sufficient ground to constitute confusing similarity in trademarks.⁴ Confusion or even deception is likely because the goods or products covered by the competing trademarks are similar and/or closely related goods. The products subject of the applied trademark of the respondent-applicant includes, preparations for killing weeds and herbicides under Class 5 of the Nice Classification of Goods and Service, which are also the products covered by the Opposer's mark.

It is very likely therefore that the goods of the Respondent-Applicant may be confused with those of the Opposer's or the public maybe mistaken or deceived, in assuming that the Respondent-Applicant's goods originated from the Opposer or there is a connection between the two parties and/or the goods.

Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁵

Time and again, it has been held in our jurisdiction that 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.⁶ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.⁷ Because the respondent-applicant will use his mark on goods that are similar and/or closely related to the opposer's, the consumer is likely to assume that the respondent-applicant's goods originate from or sponsored by the opposer or believe that there is a connection between them, as in a trademark licensing agreement. 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.⁸

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 one 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 former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, 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

⁴ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

⁵ American Wire & Cable Company vs. Dir. Of Patent, G.R. No. L-26557, February 18, 1970.

⁶ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

⁷ Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

⁸ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

WHEREFORE, premises considered, the instant opposition to Trademark Application Serial No. 42013002443 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42013002443 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 30 JUN 2016


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs