

UNILEVER, PLC	}	INTER PARTES CASE No. 3512
Opposer,	}	Opposition to:
	}	Serial No. : 65947
	}	Date Filed : October 10, 1988
-versus-	}	Trademark : "TUX"
	}	Goods : "shampoo"
	}	
HERWAY, INC.,	}	Decision no. 2000 - 03
Respondent-Applicant.	}	February 4, 2000
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DECISION

This is an opposition in the matter of the application for the registration of the trademark "TUX" filed on October 10, 1988 under Serial No. 65947 allegedly used for "SHAMPOO" Class 3 in the international classification of goods the above-subject trademark application at San Juan, Metro Manila which application was published on page 7 volume II, No. 10, October 31, 1989 issue of the Bureau of Patents, Trademarks and Technology Transfer Official Gazette and released officially for circulation on November 7, 1989.

Unilever PLC, the herein Opposer, is a foreign corporation with address at P.O. Box 68, Unilever House, Blackfairs, London EC4P4Bq, England.

The ground for the opposition is:

THE REGISTRATION OF THE MARK IN THE NAME OF RESPONDENT-APPLICANT IS PROSCRIBED BY SEC. 4 (d) OF R.A. No. 166 AS AMENDED.

The Opposer relied on the following facts to support its opposition.

"1. Opposer is the registered owner of the trademark "LUX" bearing Reg. Nos. 20890 issued on December 10, 1983 for soaps and detergent, R-2907 issued on December 14, 1980, and renewal of 1778-1 issued on September 29, 1971 for toilet preparations, lotions, dentifrices and 38407 issued on March 16, 1989 for detergents preparations and substances for laundry use, bleaching essential oils, anti-perspirants and deodorants and dentifrices.

"1.1 Applicant's trademark is confusingly similar to Opposer's registered trademark LUX as to be likely when applied to or used in the goods of the applicant to cause confusion or mistake or deceive the purchasing public, in that both trademarks pertaining to goods under the same class, both trademarks consists of only three letters, the last two letter (UX) of which are the same giving rise to close similarity, both visual and phonetic.

"2. Opposer's trademark had been used on goods sold in and distributed as early as August 21, 1921 and continued to be used until now and has not been abandoned.

"2.1. As a result of long, continuous and extensive use by Opposer, the trademark LUX has become well-known and has been identified with the goods and business of the Opposer in the mind of the purchasing public, such that the use of an identical trademark is likely to confuse the purchasing public, in that the purchasing public might be led to believe that the mark of

Respondent-Applicant and the goods on which Respondent-Applicant's mark are used or to be used are those of the Opposer herein or vice versa which may cause irreparable damage or injury to the goodwill and business reputation of the latter."

On March 9, 1990, Respondent-Applicant filed its Answer to the Notice of Opposition denying all the material allegations therein and interpose its Affirmative defenses as follows:

- "9. The Notice of Opposition does not establish Opposer's capacity to sue:
- "10. Opposer has no valid cause of action against the Respondent-Applicant to the following facts:
 - "a) Respondent has never represented that the goods use which it has applied or used its trademark TUX originate from the Opposer;
 - "b) The presentation of the trademark TUX is radically different from that of the trademark LUX;
 - "c) The presentation of the trademark TUX specifically in the use of the letters U and X is also different from that presentation of the same letters in the mark LUX so that there could not be any visual similarity between the two trademarks
 - "d) There is no phonetic similarity between TUX and LUX;
 - "e) There can be no confusing similarity between the marks TUX and LUX such that no confusion will arise in the mind of purchasers as to the source or origin of RESPONDENT'S goods because, even while the letters U and X appear in RESPONDENT'S trademark, the sound produced from an utterance of the word TUX is stronger and masculine in impact, as distinguished from the sound produced from an utterance of the word LUX which is definitely softer and feminine in impact.
 - "f) Significantly, RESPONDENT has specifically selected the male gender as its exclusive market target for goods bearing the trademark TUX in line with its marketing philosophy that the sound of the word TUX would appeal specifically and exclusively to the male sex such that accordingly, the goods under such mark, namely: cologne, anti-dandruff shampoo, masculine hygiene and foot powder are sold in black colored containers against which background the trademark TUX is drawn in white to appeal to the masculine or what is otherwise known as the "macho" psyche of the Filipino;
 - "g) RESPONDENT does not sell or otherwise distribute its goods to commercial establishments such as supermarkets, grocery stores, drug stores and sari-sari stores where goods bearing the trademark LUX are sold;
 - "h) On the contrary, RESPONDENT markets all of its goods, including those upon which the trademark TUX is used, by way of accredited dealers who, in turn, hire the services of

individuals to sell Respondent's goods directly to individual customers;

- "i) Accordingly, Opposer does not possess nor is vested with any property right that; may be materially impaired or injured by the registration of Respondent's trademark "TUX".

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

WHETHER OR NOT THERE EXISTS CONFUSING SIMILARITY BETWEEN RESPONDENT-APPLICANT'S TRADEMARK "TUX" AND THE OPPOSER'S MARK "TUX".

The applicable law in resolving the issue in this proceedings is SEC 4(d) of R.A. No. 166 as amended, which provided:

"SEC. 4 – Registration of trademarks, tradenames and services marks on the principal register. There is hereby established a register of trademarks, tradenames and servicemarks which shall be known as the principal register. the owner of a trademark, tradename or servicemarks 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:

- "(d) Consists of or comprises a mark which so resembles a mark or tradename registered in the Philippines or a mark or tradename previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or service of the applicant to cause confusion or to deceive purchasers."

(Underscoring provided)

After a careful and deliberate evaluation of the issues, the evidences as well as the arguments presented in this case, this Office is convinced that Respondent-applicant's trademark "TUX" is confusingly similar to Opposer's trademark "LUX" which is a registered mark and not abandoned.

It must be noted that the two competing marks consists only of one syllable and three (3) letters. The only distinction they have is that the Opposer's mark "LUX" has the letter "L" while Respondent-Applicant's mark "TUX" has the letter "T" at the beginning of the mark. However, when the two marks are pronounced, they are almost the same if not identical, hence, there is no doubt that the similarity between the two competing marks is apparent.

Attention must be given to the observations of the Supreme Court in the case of "American Wire and Cable Co. vs. Director of Patents", 31 SCRA 544, to wit:

xxx The similarity between the competing trademarks "DUPAFLEX and DYNAFLEX" is apparent. Not only are the initial letters and the least half of the applications identical but the difference exists in only two out of the eight literal elements of the designations. Coupled with the fact that both marks cover insulated flexible wires under class 20 xxx no difficulty is experienced in reaching the conclusion that there is a deceptive similarity that would lead the purchasers to confuse one product will another."

In another case, the Supreme Court uniformly ruled that the trademark "LIONPAS" for medicated plaster cannot be registered because it is confusingly similar to "SALONPAS" a registered mark also for medicated plaster. The Honorable Supreme Court stated:

"Although two letters of "SALONPAS" are missing in "LIONPAS", nevertheless, when the two words are pronounced, the sound effects are confusingly similar. When goods are advertised over the radio, similarity of sound is a sufficient ground for holding that the two marks are confusingly similar when applied to merchandise of the same descriptive properties (Marvex Commercial Co. Inc. m vs. petro Hawpia & Co., L-19297, Dec. 22, 1966, 18 SCRA 1178)

In the case of CO TIONG SA vs. Director of Patents, (5378, May 24, 1954, 95 Philippines) the application for the registration of the mark "FREEDOM" was rejected over the existing registration of the trademark "FREEMAN" for the same class of goods.

In another case, "Operator, Inc. vs. Director of Patents, 15 SCRA 149, the Supreme Court ruled that:

"Considering that similarities in appearance and sound between the marks "AMBISCO and NABISCO", the nature and similarity of the products of the parties, confusion of purchasers is likely."

It cannot be gainsaid that in the case at bar, the mark "TUX" of Respondent-Applicant and "LUX" of the Opposer are phonetically similar. The similarity of the trademarks in question as to sound is so clear beyond further examination and hearing aid to determine the same is no longer necessary.

Also, in CALANES Corp., or America vs. E.I. DU PONT (1946), 154 F. 2D 146, 148), the marks "CELDURA" and "CORDURA", considered as a whole, were deemed similar in meaning and appearance, also in SKOL, Co., Inc., vs. OLSON (151 F 2D, 200), "SKOAL" was held identical to "SKOL".

Moreover, in ESSO Standard Oil Company vs. SUN Oil Company, et.al. (46 TMR, 444), the marks "SUNVIS" and "UNIVIS" were considered confusingly similar in appearance because of their having identical suffixes and three letter prefixes with the same two letters "UN" in the same order.

Finally, as enunciated in the cases of "ANG vs. TEODORO", 74 Phil. 50) and "STA ANA vs. MALIUAT (24 SCRA 1018), the Supreme Court ruled that the scope of protection afforded to a registered trademark includes related goods. It bears mentioning in this case that the "LUX" and "TUX" marks are both apply to related and/or competing goods falling under the same purpose thus, aggravating the likelihood of confusion or deception on the part of the buying public.

IN VIEW OF THE FOREGOING, the Notice of Opposition is SUSTAINED. Accordingly, Application for the trademark "TUX" for shampoo bearing Serial No. 65947 filed on October 10, 1988 by HERWAY INCORPORATED is, as it is hereby REJECTED.

Let the filewrapper of the mark TUX subject of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau for appropriate action in accordance with this Decision with a copy thereof to be furnished the Bureau of Trademarks for information and to update its records.

SO ORDERED.

ESTRELLITA BELTRAN-ABELARDO
Director