

CEMEX, S.A.B. DE C.V.	}	IPC NO. 14-2007-000018
Opposer,	}	Case Filed: 15 January 2007
	}	
-versus-	}	Opposition to:
	}	Serial No. 4-2001-008541
SUPRA SYSTEMS (PHILS)	}	Date Filed: 14 November 2001
INC.	}	
Respondent-Applicant.	}	Trademark: "CEMEXTRA"
x-----x	}	Decision No. 2009-03

DECISION

This pertains to a Verified Opposition filed 15 January 2007 by herein opposer, Cemex, S.A.B. De C.V., a corporation organized and existing under the laws of Mexico with business address at Av. Constitucion 444 Poniente, Colonia Centro, C.P. 64000, Monterrey, Nuevo Leon, Mexico. This instant opposition is against the application filed by Supra Systems (Phils.) Inc. on 14 November 2001 bearing Serial No. 4-2001-008541 for the registration of the trademark "CEMEXTRA" used for goods in Classification No. 19 for building materials namely, cementitious grout for ground support, grout capsules, ready-to-use grout, machinery grout, rockbolts, rock anchors, and soil nails, which application was published in the Intellectual Property Office's Official Gazette and officially released for circulation on 15 September 2006.

The respondent-applicant, Supra Systems (Phils.) Inc., is a corporation organized and existing under the laws of the Republic of the Philippines with address at 17 Francisco Street, North Susana Village, Commonwealth, Quezon City.

The allegation of facts and the grounds for the instant opposition are provided as follows:

7. Opposer is one of the world's leading building-solutions companies and it provides products of consistently high quality and reliable service to customers and communities in more than 50 countries around the world. It advances the well-being of those it serves through its relentless focus on continuous improvements and its efforts to provide sustainable future.

8. Founded in 1903, Opposer has grown from a simple local player into a top global building-solutions company. Today, Opposer is strategically positioned in the Americas, Europe, Africa, the Middle East and Asia. It has operations in more than 50 countries with production capacity of approximately 97 million metric tons of cement per year. It is the leader in the ready-mix concrete and aggregates market with annual production levels of 75 million cubic meter and 170 million metric tons, respectively. Opposer's 2004 and 2005 Annual Reports and printouts from its website www.cemex.com, are hereto attached as Annexes "B", "C" and "D", respectively.

9. Opposer sells about 1.6 billion metric tons of cement each year. It is likewise the largest producer of ready-mix concrete in the world. x x x

10. With present total assets of US\$27.88 Billion US\$16.11 Billion of which is invested in the form of fixed assets, Opposer is a global economic force and is rightly one of the largest cement manufactures in the world. x x x

11. In the Philippines, opposer has licensed the use of its marks and name to its authorized licensees, Solid Cement Corporation ("SOLID") and Apo Cement Corporation ("APO"). The combined sales of SOLID and APO make them one of the leading market players in the country's multi-billion cement industry. SOLID and APO use the Cemex marks and name in all their products and they have invested heavily to promote the goodwill of the Cemex marks and name in the Philippines.

12. In the Philippines, Opposer is the registered owner of the following marks, the certified true copies of the Certificate of registration of which are attached hereto as Annexes "E", "F", "G" and "H", respectively: (in sum) "CEMEX" Registration No. 4-1977-126014; "CEMEX (STYLIZED) & TWO STRIPES DEVICE" Registration No. 4-1997-126015; "CEMEX AND DESIGN, BUILDING THE FUTURE" Registration No. 4-2001-008296; "CEMEX PHILIPPINES AND DESIGN" registration no. 4-1999-005093 x x x

13. Opposer likewise filed the following application, which is deemed registered with the IPO: "CEMEX REWARDS" Registration No. 4-2005-003891 x x.

14. In addition, the following trademark applications in Opposer's name are currently pending with the IPO: (in sum) "CEMEX MAESTRO MASONRY CEMENT" Application No. 4-2004-003508; "CEMEX PALITADA KING MASONRY CEMENT" Application No. 4-2004-003510 x x x

16. The mark "CEMEXTRA" cannot be registered because it is confusingly similar to Opposer's trade name and its registered mark "CEMEX", and related marks, as well as its pending applications for "CEMEX MAESTRO MASONRY CEMENT" and "CEMEX PALITADA KING MASONRY CEMENT", all of which are being used for similar or closely related goods.
x x x

18. Opposer's principal mark "CEMEX" and its related marks "CEMEX (STYLIZED) & TWO STRIPES DEVICE", "CEMEX AND DESIGN, building the future", "CEMEX PHILIPPINES AND DESIGN" are all registered. Moreover, with the exception of "CEMEX REWARDS" which has a filing date of 28 April 2005, all of Opposer's registered marks were filed earlier than respondent-applicant's application for "CEMEXTRA", which was filed only on 14 November 2001.
x x x

20. The word "CEMEX" is the dominant feature of Opposer's and Respondent-Applicant's marks. In fact, the word "CEMEX" in Respondent-Applicant's mark is represented closely similar bold and dark style employed in Opposer's marks. Consequently, the unwary eye will confuse Respondent-Applicant's mark and Opposer's marks because the dominant feature of the said marks is the word "CEMEX".
x x x

22. The word "CEMEX" is a contraction of the words "CEMENTOS MEXICANOS", the name adopted by Opposer when the original Mexican corporation Cementos Hidalgo founded in 1906 merged with Cementos Portland Monterrey in 1931, becoming Cementos Mexicanos, not Cemex. Clearly, Opposer's choice of the mark "CEMEX" is arbitrary since "CEMEX" neither suggests nor describes any quality or characteristic of the goods covered by the Opposer's registration. It is therefore interesting to ask why of all the limitless names in the world, Respondent-Applicant has chosen to use "CEMEXTRA" for its own goods. It could have chosen other names or created its own but it perplexingly chose to use a name which is identical to Opposer's mark, leading to the conclusion that Respondent-Applicant's intention in using "CEMEXTRA" is to unfairly avail itself of the fame and goodwill of Opposer's mark "CEMEX".

23. The striking similarity of "CEMEXTRA" to the "CEMEX" marks buttresses the fact that confusion is inevitable, especially in view of Opposer; leading role in the construction industry and since the marks are used for similar or closely related goods. x x x

24. Since Respondent-Applicant's application covers goods that are closely-related to those that are registered under Opposer's mark, confusion will clearly ensue as the competing marks look and sound the same. The likelihood of purchasers associating the goods of Opposer and Respondent-Applicant to a common origin is not far-fetched. Both from the standpoint of priority of use and for the protection of the buying public and, of course, Opposer's rights to the mark "CEMEX" and the considerable goodwill attached to its, it is plainly evident that the registration of "CEMEXTRA" should be denied.

25. In any event, under Section 123.1(f) of the IP Code, a mark cannot be registered if it is identical with or confusingly similar to a well-known mark which is registered in the Philippines even with respect to goods or services which are not similar to those with respect to which registration is applied for, x x x.

26. "CEMEX" is well-known internationally and in the Philippines. Opposer is known to be the prior adopter and user of "CEMEX" since it was first used in the 1930's. The mark "CEMEX" has also been registered in the name of Opposer in various jurisdictions.

27. Opposer's use of the mark "CEMEX" has also been continuous and uninterrupted. Opposer has been widely advertising, producing and selling various non-metallic construction products bearing the mark "CEMEX" throughout the world. Attached as Annex "D" hereof are printouts of Opposer's website, proving widespread use of the "CEMEX" mark extending around the world, including countries in North America, the Caribbean, South America, Europe, Asia and Africa.

x x x

29. On 01 March 2005, opposer completed its \$5.8 billion acquisition of the London-based RMC Group, which made Opposer the worldwide leader in ready-mix concrete production and increasing its exposure to European markets. With the acquisition, the company increased its annual cement production to 97 million tons, and grew its annual sales of US\$15.321 billion, just shy of the market leader, Lafarge, which has sales of US\$17 billion. Today, Opposer has annual cement production capability of 82 million tons and its cement products are being used by builders worldwide for almost every kind of construction project because of its many favorable qualities.

x x x

31. As a consequence of Opposer's extensive use, sales, advertising and promotion of the mark for decades throughout various countries in the world, the mark: "CEMEX" has become popular among consumers and has achieved a vast and unparalleled public recognition/awareness and positive reputation in the international plane, and, thus, has become an internationally well-known mark. Without a doubt, "CEMEX" is associated with Opposer and no other.

32. It also bears emphasis that "CEMEX" is Opposer's trade name and, for that reason, Opposer is entitled to protection against the unauthorized use of "CEMEX" by Respondent-Applicant. Section 165 of the IP Code provides: x x x

33. There is absolutely no doubt that Respondent-Applicant's use of the mark "CEMEXTRA" would mislead the public. Due to the dominance of Opposer's trade name "CEMEX" in "CEMEXTRA", it is inevitable that the public would believe that Respondent-Applicant's goods originate from or are somehow endorsed by Opposer, especially since the goods covered by "CEMEXTRA" are similar or closely related to Opposer's goods. In fact, "CEMEXTRA" looks like a contraction of "CEMEX" and "EXTRA", misleadingly suggesting that Respondent-Applicant's goods may be Opposer's premium products.

34. The owner of a famous mark shall be entitled to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution. Dilution is the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of competition between the owner of the famous mark and other parties or the likelihood of confusion mistake or deception. x x x

36. The association of the word "CEMEX" to goods sold by Opposer amplifies the distinctiveness of Opposer's goods. "CEMEX" has attained popularity for the distinctiveness of its goods and for its reputation for quality. Certainly, the exclusivity of its use, commercial value of

the mark, the degree of acquired distinction of the mark, its quality-image or reputation as well as the extent of its use worldwide could only attest to the distinctiveness of the mark "CEMEX". x x x

38. Opposer is the first to use "CEMEX" and it is apparent that Respondent-Applicant only began using "CEMEXTRA" after the popularity of the mark "CEMEX" has already been established. As clearly show in the above discussions, the popularity enjoyed by Opposer for over 80 years is unquestionable. Respondent-Applicant only conceptualized its mark recently, thus betraying its intent to ride on the goodwill of "CEMEX" which Opposer has laboriously and painstakingly built.

39. The use of the mark "CEMEXTRA" will seriously dilute Opposer's "CEMEX", and Respondent-Applicant's veiled attempt to associate its mark "CEMEXTRA" with Opposer's "CEMEX" will tarnish the reputation and distinctiveness that the latter's goods and services have attained, seriously undermining the goodwill of Opposer and gravely diluting the fame of its mark "CEMEX".

Respondent-applicant submitted its Verified Answer dated 30 May 2007 containing the following arguments:

"12. Opposer relies heavily on the provisions of Republic Act No. 8293 to bolster its claim that the registration of "Cemextra" should be denied. Particularly, Opposer claims that the application is violative of the instances enumerated in Section 123 of RA 8293 wherein a mark cannot be registered, x x x

13. Contrary to Opposer's allegations, the mark "Cemextra" is not confusingly similar to its registered marks. In *Societe Des Produits Nestle, S.A., et al. v. Court of Appeals* (G.R. No. 112012, 04 April 2001), the Supreme Court reiterated the standard in determining whether two trademarks are confusingly similar as follows:

"The law prescribed a more stringent standard in that there should not only be confusingly similar but that it should not likely cause confusion or mistake or deceive purchasers.

Hence, the question in this case is whether there is a likelihood that the trademark FLAVOR MASTER may cause confusion or mistake or may deceive purchasers that said product is the same or is manufactured by the same company. In other words, the issue is whether the trademark FLAVOR MASTER is a colorable imitation of the trademarks MASTER ROAST and MASTER BLEND.

Colorable imitation denotes such a close or ingenious imitation as to be calculated to deceive ordinary persons, or such a resemblance to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, as to cause him to purchase the one supposing it to be the other. In determining if colorable imitation exists, jurisprudence has developed two kinds of tests – the Dominancy Tests and the Holistic Test. The test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception and thus constitute infringement. On the other side of the spectrum, the holistic test mandates that the entirety of the marks in question must be considered in determining confusing similarity."

14. Respondent-Applicant respectfully submits that there is no confusing similarity between the two marks. In the first place, the goods covered by the two marks are not closely related.

14.1 The marks refer to specifically identified goods which will certainly distinguish one form the other. Respondent-applicant seeks registration of the mark for the following goods:

building materials, namely, cementitious grout for ground support, grout capsules, ready-to-use grout, machinery grout, rockbolts, rock anchors, and soil nails. Grout, in ordinary parlance, refer to materials used for filling spaces. None of the goods covered by opposer's marks, namely non-metallic construction materials non metallic rigid construction pipe, asphalt, pitch and tar, movable non-metallic structures, non-metallic monuments, cement and concrete are closely-related to the good sought to be registered by the present application.

14.2 Moreover, these products are presented to the purchasing public in totally different forms. There is absolutely no evidence to show that there is an intention to deceive the public by making it appear that the goods come, at the very least, from the same source. The components of these goods covered by the marks are different.

x x x

15. Secondly, assuming arguendo that the goods are closely-related as they all refer to building or construction materials, the addition of the syllable "tra" in respondent-applicant's mark is sufficient to distinguish its products and mark from that of opposer. The ruling of the Supreme Court in American Cyanamid Company v. the Director of Patents, et al. (G.R. No. L-23954, 29 April 1977) should be aptly be recalled, to wit:

"Similarly, in the case before Us, as correctly stated by the Director of Patents, the word SULMET is derived from a combination of the syllables "SUL" which is derived from Sulfa and "MET" from methyl both of which are chemical compounds present in the article manufactured by the contending parties, and the addition of the syllable "INE" is respondent's label is sufficient to distinguish respondent's product or trademark from that of petitioner."

16. Applying the ruling in the instant case, the addition of the syllable "tra" should be considered as sufficient to distinguish the products of Opposer from that of respondent-applicant. Accordingly, there is nothing to support Opposer's contention that respondent-applicant's use of the mark "Cemextra" would indicate a connection between those goods and the owner of the mark "Cemex". Plainly, the Opposer's fear that its interest would be damaged by such use is not supported by any evidence. As sufficiently shown, respondent-applicant has already been engaged in this business and selling these goods to the public for almost twenty (20) years. During this period, there is nothing which showed that the Opposer's interests were damaged in any way.

17. Opposer claims that the registration of "Cemextra" should be denied on the ground that it is confusingly similar to its trade name "Cemex" and hence, would mislead the public into believing that respondent-applicant's goods originate from or are somehow endorsed by Opposer. To reiterate, there is absolute nothing to support Opposer's contentions.

18. It should be emphasized that the buyers of the products of respondent-applicant and opposer is not the general public. Moreover, the goods covered by the marks and trade names are not common household products whereby the consumers or the clientele are less discerning in purchasing the same. These products cater to a specific market who would take time scrutinize the product being purchased, including its quality and specifications, would have the inclination to make a thorough examination of the products, and would certainly be inclined to notice the specific features, similarities or dissimilarities of these goods.

x x x

20. Cemextra products have already enjoyed recognition in a specific market in the Philippines long before Opposer's marks have been registered in this country. Large companies have been suing these products as evidenced by the purchase orders and advertisements attached to this Answer. Contrary to Opposer's insinuations, respondent-applicant did not simply ride on to the popularity of Opposer's mark. When Opposer introduced its products in the domestic market, Respondent-Applicant has long established itself to be the manufacturer and seller of these goods. Clearly, it was Opposer who rode on the popularity of respondent-

applicant's products. The Opposer's claim that the registration of the mark "Cemextra" will dilute its mark has no leg to stand on.

On 05 September 2007, the Preliminary Conference for this instant case was held after postponements were granted on 09 July 2007 and 22 August 2007. On the said date, only counsel for opposer appeared despite due notice. Thus, in Order No. 2007 – 1666 dated 11 September 2007, pursuant to Section 14.3 of Office Order No. 79, series of 2005, respondent-applicant's right to submit position paper is deemed waived.

On 19 October 2007, this Bureau received a Motion for Reconsideration by respondent-applicant, on the referred Order dated 11 September 2007, stating that its non-appearance in the Preliminary Conference on 05 September 2007 was due to non-receipt of Order of Notice of Hearing. On the other hand, opposer pleaded in its Opposition thereto dated 24 October 2007 that the said motion was not set for hearing and therefore, has failed to comply with the requirements of Section 4, Rule 15 of the Rules of Court.

Thence, the instant case is deemed submitted for decision.

The Issue –

I. Whether or not opposer's registered marks "CEMEX", "CEMEX (STYLIZED) & Two Stripes Device", "CEMEX and Design, Building the Future", "CEMEX PHILIPPINES and Design" for several classes of goods including class 19 are confusingly similar with respondent-applicant's applied mark "CEMEXTRA" for class 19 goods.

II. Whether or not opposer's aforementioned registered marks are well-known marks.

Relative to respondent-applicant's Motion for Reconsideration to lift Order No. 2007-1666 dated 11 September 2007, this Bureau in espousing Office Order No. 79, series of 2005 or the Amendments to the Regulations on Inter Partes Proceedings, has set the provision on prohibited pleadings in Section 10 thereof, to wit:

"Section 10. *Prohibited pleadings* – No motion to dismiss shall be entertained. X x x Neither shall a motion for bill of particulars, motion for reconsideration of interlocutory orders, and all other pleadings subsequent to the filing of a rejoinder, shall be allowed.

Notwithstanding the same, the Order No. 2007-1666 dated 11 September 2007 is reaffirmed not only because of the express provision under Section 14.3, 2nd par., Office Order No. 79, series of 2005, which waives the corresponding rights of the party who fails to attend the preliminary conference, but more so, respondent-applicant's excuse of non-attendance due to non-receipt of the said Order is too relative and self-serving to absolve respondent-applicant from the consequence of its absence in the conference.

Conversely, respondent-applicant's right to due process of law is not transgressed as what was waived is only the submission of the position paper and/or draft decision. The pleadings and attached evidence admissible under the rules shall be considered in the final determination of the case.

Let us now tackle the crux of the controversy.

After careful perusal of the arguments and evidence presented by herein opposer, this Bureau finds merit in the instant opposition case under the pertinent provision enunciated in Section 123.1 (d), supra. which reads:

“Sec. 123. *Registrability.* – 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;
(Emphasis Supplied)

In a contest involving registration of trademark, the determinative factor is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would *likely* cause confusion or mistake on the part of the buying public.

The existence of confusion of trademark or the possibility of deception to the public hinges on “*colorable imitation*”, which has been defined as “such similarity in form, content, words, sound, meaning, special arrangement or general appearance of the trademark or trade name in their overall presentation or in their essential and substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.” (Emerald Garment Mfg. Corp. vs Court of Appeals, 251 SCRA 600)

Thus, in determining confusion of goods or of origin, it does not require that the competing trademarks must be so identical as to produce actual error or mistake. It is rather sufficient that the similarity between the two trademarks is such that there is a possibility or likelihood of the older brand mistaking the newer brand for it.

In resolving the issue of confusing similarity, the law and jurisprudence has developed two kinds of tests – the *Dominancy Test* as applied in a litany of Supreme Court decisions including Asia Brewery, Inc. vs Court of Appeals, 224 SCRA 437; Co Tiong vs Director of Patents, 95 Phil. 1; Lim Hoa vs Director of Patents, 100 Phil. 214; American Wire & Cable Co. vs Director of Patents, 31 SCRA 544; Philippine Nut Industry, Inc. vs Standard Brands, Inc., 65 SCRA 575; Converse Rubber Corp. vs Universal Rubber Products, Inc., 147 SCRA 154 and the *Holistic Test* developed in Del Monte Corporation vs Court of Appeals, 181 SCRA 410; Mead Johnson & Co. vs N.V.J. Van Dorp, Ltd., 7 SCRA 771; Fruit of the Loom, Inc. vs Court of Appeals, 133 SCRA 405.

The Test of Dominancy has been consistently relied upon by the Honorable Supreme Court in cases relating to infringement of marks. It is in fact incorporated in Section 155 of R.A. 8293 which focuses on the similarity of the prevalent features, or the main, essential and dominant features of the competing trademarks which might cause confusion or deception. As to what constitutes a dominant feature of a label, no set of rules can be deduced. Usually, these are signs, color, design, peculiar shape or name, or some special, easily remembered earmarks of the brand that easily attracts and catches the eye of the ordinary consumer.

The Holistic Test, in the case of Mighty Corporation vs E & J Gallo Winery, 434 SCRA 473, held that, “the discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other.

Opposer’s Registered Trademarks



Respondent-Applicant’s
Trademark

CEMEX

CEMEXTRA

The logo for CEMEX PHILIPPINES features a stylized double-slash symbol to the left of the text "CEMEX PHILIPPINES".

CEMEX

The contending marks albeit not identical, appears confusingly similar. The word “CEMEX” is the dominant feature in the contending marks. The additional letters “TRA” in respondent-applicant’s “CEMEXTRA” mark cannot dispel the confusion because it suggests no meaning at all. Moreover, respondent-applicant did not credibly come-up with a justification in adopting the “CEMEXTRA” mark in its line of business. In fact, the font design and the over-all presentation of the contending marks likewise appear confusingly similar. Thus, this creates a perceivable confusion, visually and aurally.

Moreover, sight should not be lost on the fact that the dominant word and the opposer’s trademark “CEMEX” is part of the corporate name or service name of the opposer company, “CEMEX, S.A.B. DE C.V.”. The legal protection for corporate names has been strengthened by the IP Code, such that “any subsequent use of the trade name by a third party, whether as a trade name or mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.” [Section 165.2(a), par. 2, supra.]

With respect to goods covered by the competing trademarks, opposer’s numerous “CEMEX” marks and its variants cover several classes: 19, 01, 02, 04, 06, 11, 19, 35, 37, 39, 40, 41, 42, 35; (Annex “E”, “F”, “G”, “H” and “I”); whereas, respondent-applicant’s “CEMEXTRA” mark covers class 19 are related because they are construction materials which flow under the same channels of trade – hardware store and/or other construction materials store, for the same class of consumers.

The above-enumeration shows the relatedness of the goods. “Goods are related when they belong to the same class or have the same class or descriptive properties; when they possess the same physical attributes or essential characters with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or sold in grocery store. Thus, biscuits were held related to milk because they are both food products.” (American Foundries vs Robertson, 269 USPO 372, 381)

This legal assemblage affirms the superior right of opposer in accordance to the provision of Sections 123, 155, 165.2 of the IP Code, otherwise known as the “prior registrant rule” or “prior filer rule”, in relation to Section 147.1, supra, which provides for the exclusive right of a registrant mark’s owner to prevent all third parties without consent of the owner from using the same which are identical or similar, resulting in a likelihood of confusion. Records show that opposer’s aforementioned registered trademarks were issued registration for its numerous “CEMEX” marks and its variants in the years 2002, 2006, and 2004; which were filed in dates prior to the filing date of respondent-applicant’s subject mark.

Opposer at the same time seeks the declaration of well-known mark. This Bureau cannot agree as herein opposer failed to submit sufficient and eloquent proof to establish that its mark has actually gained and enjoyed a worldwide reputation internationally and in the Philippines, in accordance to The Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, particularly Rule 102, which enshrines the criteria of a well-known mark, to wit:

“Rule 102. Criteria for determining whether a mark is well-known. – In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial values attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of the litigations dealing with the issue of whether the mark is a well-known; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.”

In view of thereof, following the cited laws and jurisprudence, this Bureau finds merit in this instant opposition to the application for registration of the mark “CEMEXTRA” covering class 19, for being confusingly similar to opposer’s registered marks “CEMEX” and its variants covering several classes including class 19, without however declaring opposer’s trademarks as well-known marks. Hence, the Verified Notice of Opposition is, as it is hereby SUSTAINED. Consequently, Application Serial No. 4-2001-008541 for the registration of the mark “CEMEXTRA” of Supra Systems (Phils) Inc., filed on 14 November 2001 must be REJECTED.

Let the filewrapper of “CEMEXTRA” subject matter in this case be forwarded to the Bureau of Trademarks for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, 12 January 2009.

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