

GOLDEN ABC, INC.,	}	IPC No. 14-2008-00085
Opposer,	}	Case Filed on: April 11, 2008
	}	
-versus-	}	Opposition to:
	}	Appln. Serial No. 4-2007-500726
MULTI CHANNELS ASIA PTE LTD.,	}	Date filed: 31 Oct. 2007
Respondent-Applicant.	}	TM: "OXYGEN"
	}	
x-----x	}	Decision No. 2008-236

DECISION

Before us is a Verified Notice of Opposition filed against the application for registration of the mark "OXYGEN" used for television broadcasting; operation of cable television systems; operation of cable television networks under Class 38 of the international classification of goods bearing Application Serial No. 4-2007-500726 which was published in the Intellectual Property Office Electronic Gazette on 08 February 2008.

Opposer, GOLDEN ABC, INC., is a domestic corporation, with business and postal address at 880 A.S. Fortuna Street, Banilad, Mandaue City. On the other hand, Respondent-Applicant, MULTI CHANNELS ASIA PTE LTD., is a corporation organized and existing under the laws of Singapore, with address at 45 Cantonment Road, Singapore.

GROUND FOR OPPOSITION

The subject mark "OXYGEN" is exactly the same as the Opposer's registered "OXYGEN" mark. If the subject mark is allowed registration, this will lead to a confusion of source, as prospective customers would be misled into thinking that the Opposer has extended its business into the field, thus, the subject application should be rejected.

Opposer relied on the following facts to support its opposition:

1. The Opposer, since June 14, 1990, has been engaged in the retail business, selling men's and women's apparel, toilette/bath and personal care products, fashion accessories, and paper products bearing the trademark "OXYGEN" in various department stores, boutiques, outlets and specially stores boutiques and up to 27 "OXYGEN" concessionaire outlets in major department stores nationwide.

2. As early as May 10, 1991, the Opposer filed an application for registration of the word "OXYGEN" as a trademark for Classes 18, 24, and 25 and was subsequently granted registration on July 2, 1993.

3. As early as February 14, 1997, the Opposer filed an application for registration of "OXYGEN and DEVICE" as a service mark for Class 42 and was subsequently granted registration on July 4, 2002.

4. The Opposer has the following trademark registrations and application for "OXYGEN AND DEVICE".

- a. Trademark Certificate of Registration No. 4-1990-009819 for Class 9;
- b. Trademark Certificate of Registration No. 4-1997-117884 for Class 16;
- c. Trademark Certificate of Registration No. 4-1999-009822 for Class 16;

- d. Trademark Certificate of Registration No. 4-1999-009824 for Class 16;
- e. Trademark Certificate of Registration No. 4-1997-117883 for Class 24;
- f. Trademark Certificate of Registration No. 4-1997-117888 for Class 25;
- g. Trademark Certificate of Registration No. 4-1999-009825 for Class 26;
- h. Trademark Certificate of Registration No. 4-1999-009826 for Class 34;
- i. Trademark Certificate of Registration No. 4-2000-003878 for Class 3; and
- j. Trademark Certificate of Registration No. 4-1997-117885 for Class 18;

5. Since its adoption in 1990 and its continued use in commerce up to the present day, the “OXYGEN” trademark and service mark have been extensively developed and advertised by the Opposer.

Attached herewith are the advertising materials of the Opposer for “OXYGEN”

The foregoing exhibits would show the extent of the promotional expenses spent to promote the OXYGEN brand. As shown by these exhibits, among the A-list celebrity endorsers of Oxygen are as follows:

- a. Eraserheads – popular pinoy rock band;
- b. Mr. Bernard “BJ” Palanca – popular actor and model;
- c. Mr. Derek Ramsay – popular model and actor; and
- d. Ms. Karel Marquez – popular video jockey (“VJ”)

6. The Opposer is filing this opposition against the registration of the subject mark on the ground that it creates confusion of origin, source, and business, causing injury and damage on the original trademark “OXYGEN”. The Opposer is entitled to the preservation of the valuable link between it and marks on its business, services and products by restraining the use by the Opposer of the subject mark. By reason of the Opposer’s exclusive, extensive and uninterrupted use of the OXYGEN mark for almost 20 years, the Opposer has established goodwill and a distinct reputation for its products and services and consumers recognize them to belong to the Opposer.

Attached to the Verified Opposition are the following evidences:

Exhibits	Description
“A”	Certified copy of Opposer’s Trademark Certificate of registration No. 055534 for the “OXYGEN” mark
“B”	Certified copy of Opposer’s Trademark Certificate of Registration No. 4-1997-117887 for “OXYGEN and DEVICE”
“C”	Certified copy of Trademark Certificate of Registration No. 4-1990-009819 for Class 9 for OXYGEN and DEVICE
“D”	Certified copy of Trademark Certificate of Registration No. 4-1997-117884 for Class 16
“E”	Certified copy of Trademark Certificate of Registration No. 4-1999-009822 for Class 16

"F"	Certified copy of Trademark Certificate of Registration No. 4-1999-009824 for Class 21
"G"	Certified copy of Trademark Certificate of Registration No. 4-1997-117883 for Class 24
"H"	Certified copy of Trademark Certificate of Registration No. 4-1997-117888 for Class 25
"I"	Certified copy of Trademark Certificate of Registration No. 4-1999-009825 for Class 26
"J"	Certified copy of Trademark Certificate of Registration No. 4-1999-009826 for Class 34
"K"	Certified copy of Trademark Certificate of Registration No. 4-2000-003878 for Class 03
"L"	Certified copy of Trademark Certificate of Registration No. 4-1997-117885 for Class 18
"M" to "M-35"	Certified copy of the advertising materials of the Opposer for "OXYGEN"

On 29 April 2008, this Bureau issued a Notice to Answer, which notice was served personally to Respondent-Applicant's representative on May 14, 2008. On June 13, 2008, Respondent-Applicant filed a Motion for Extension of Time to File Verified Answer. On 18 June 2008, Order No. 2008-905 was issued granting the motion for extension. Again, on July 9, 2008, Respondent-Applicant filed a Motion for Extension of Time to File Verified Answer, said motion was granted under Order No. 2008-1003. However, despite the extension of time given by this Bureau, Respondent-Applicant failed its verified answer. Thus, the case is now submitted for decision.

The sole issue to be resolved in this case is: WHETHER OR NOT THE MARK "OXYGEN" OF RESPONDENT-APPLICANT SHOULD BE REGISTERED.

To determine the registrability of a mark, Republic Act No. 8293, as amended particularly Section 123.1 (d) thereof provides:

"Section 123.1 (d) of Republic Act No. 8293, as amended, provides:



"SEC. 123. Registrability. – 123.1 A mark cannot be registered if it:

x 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 marks of the parties are hereunder reproduced for comparison:

Opposer's marks	Respondent-Applicant's Mark
	

Indeed, as correctly pointed out by Opposer, the above marks need no further comparison to show that Respondent-Applicant's mark OXYGEN is similar in spelling and appearance with the Opposer's registered mark OXYGEN. Both marks have the same six (6) letters, which are arranged precisely in the same way. Except for the font used, there is no other difference between the marks as to distinguish one from the other. Respondent-Applicant's mark is clearly a literal copy of the Opposer's mark. It is also phonetically identical with Opposer's mark. In view of their similarity, what remains to be determined is whether Respondent-Applicant's use of the similar mark would cause confusion or mistake on the public as to the source or origin of the goods with which Respondent-Applicant deals. The rule that ownership of a trademark or trade name is a right that the owner is entitled to protect has been upheld in our jurisdiction. This is supported by Section 138 of Republic Act No. 8293 which states that: "a certificate of registration is *prima facie* evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto". However, when a trademark is used by a party on a product in which the other party does not deal, the use of a same trademark on the latter's product cannot be validly objected to. In the instant case, Opposer's marks are used on goods classified under Classes 03, 09, 16, 18, 24, 25, 26, 34 and 42 while Respondent-Applicant's mark is for television broadcasting; operation of cable television systems; operation of cable television networks under Class 38 of the international classification of goods.

Opposer posits that the registration of Respondent-Applicant's similar mark will lead to a confusion of source, as prospective customers would be misled into thinking that the Opposer has extended its business into the field.

We do not agree.

"There are 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." . . . 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 or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist." In cases of confusion of business or origin, the question that usually arises is whether the respective goods or services of the senior user and the junior user are so related as to likely cause confusion of business or origin, and thereby render the trademark or trade names

confusing similar. Thus, it is inevitable for us to determine whether the goods of the parties are related.

In the often-cited case of *ESSO STANDARD EASTERN, INC. vs. COURT OF APPEALS*, the Supreme Court held that:

“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. Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays. The trademark “Ang Tibay” for shoes and slippers and pants were disallowed to be used for shirts and pants because they belong to the same general class of goods. Soap and pomade, although non-competitive, were held to be similar or to belong to the same class, since both are toilet articles.”

In the case at bar, it is evident that the goods of the parties are unrelated and non-competing. Opposer’s goods belong to Classes 03, 09, 16, 18, 24, 25, 26, 34 and 42 and these goods are made available in department stores, bookstores and in the exclusive stores of Opposer for which Respondent-Applicant does not deal with as the mark is for use on television broadcasting; operation of cable television systems; operation of cable television networks belonging to Class 38. Indeed, the goods of the parties are poles apart that confusion of business is unlikely to occur.

In the case of *FABERGE, INCORPORATED vs. INTERMEDIATE APPELLATE COURT*, the High Court states: “judging from the physical attributes of petitioner’s and private respondent’s products, there can be no doubt that confusion or the likelihood of deception to the average purchaser is unlikely since the goods are non-competing and unrelated. The glaring discrepancies between the two products had been amply portrayed to such an extent that indeed, “a purchaser who is out in the market for the purpose of buying respondent’s BRUTE brief would definitely be not mistaken or misled into buying BRUT after shave lotion or deodorant” as categorically opined in the decision of the Director of Patents relative to the inter-partes case.” The disparity of the goods of the parties buttress the fact that it is unlikely that the use by Respondent-Applicant of the mark on its services would likely cause confusion or mistake on the buying public or that it will deceive and/or confuse purchasers into believing that Respondent-Applicant’s services bearing the trademark OXYGEN emanate from or are under the sponsorship of Opposer. The mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the trademark by others on unrelated articles of a different kind. Thus, the evident disparity of the products of the parties in the case at bar renders unfounded the apprehension of Opposer that confusion of business or origin might occur if Respondent-Applicant is allowed to use the mark OXYGEN.

WHEREFORE, premises considered, the Notice of Verified Opposition filed by Opposer, GOLDEN ABC, INC. against Respondent-Applicant’s OXYGEN is, as it is hereby DENIED. Consequently, the trademark application for the registration of the mark OXYGEN used for television broadcasting; operation of cable television systems; operation of cable television networks under Class 38 of the international classification of goods bearing Application Serial No. 4-2007-500726 filed by respondent-applicant Multi Channels Asia, Pte. Ltd., filed on 31 October 2007 is, as it is hereby, GIVEN DUE COURSE.

Let the filewrapper of OXYGEN be transmitted to the Bureau of Trademarks (BOT) for appropriate action in accordance with this DECISION.

SO ORDERED.

Makati City, 12 December 2008.

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