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| HOYU KABUSHIKI KAISHA<br>(also trading as Hoyu Co., Ltd.),<br>*Opposer,*<br><br>-versus-<br><br>CHEMINOVA INTERNACIONAL S.A.<br>*Respondent-Applicant.* | }<br>}<br>}<br>}<br>}<br>}<br>}<br>}<br>} | Inter Partes Case No. 14-2000-00012<br><br>Opposition to:<br><br>Appl'n Serial No. : 114232<br>Date Filed : September 25, 1996<br>Trademark : "EPIGEN"<br>For : "Bleaching Preparations, laundry bleach, etc."<br><br>Decision No. 2002 – 26 |

DECISION

This pertains to the Opposition filed by HOYU KABUSHIKI KAISHA (also trading as Hoyu Co., Ltd.), a corporation organized and existing under the laws of Japan, with office address at 501 Tokugawa 1-Chome, Higashi-Ku, Nagoya-Shi, Aichi-Ken, Japan, against the registration of the trademark EPIGEN for "bleaching preparations, laundry bleach, chemical preparations for brightening colors; laundry colors; laundry glaze; color removing preparations; laundry soaking preparations; laundry starch; detergents other than for use in manufacturing operations and for medical purposes; laundry wax" under Class 3, bearing Application Serial No. 114232 and filed on 25 September 1996 in the name of CHEMINOVA INTERNACIONAL S.A., a corporation organized and existing under the laws of Spain, with principal office at C/ Macarena, 14, 28016, Madrid, Spain.

The subject application was published on page 4, Volume II, No. 5, September-October 1999 issue of the Official Gazette, which was officially released for circulation on 30 March 2000. Opposer filed the Verified Notice of Opposition on 27 July 2000, having been granted by this Office an extension of time to do so, upon Motion for Extension filed by the Opposer on 28 June 2000.

The grounds for the opposition to the registration of the trademark EPIGEN are as follows:

> "1. The trademark EPIGEN of the Respondent-Applicant so resembles the trademark of BIGEN of the Opposer that the use of EPIGEN on the goods of the Respondent-Applicant would indicate a connection between said goods and the Opposer to the damage and prejudice of the Opposer's goodwill and interests. In other words, the use of Respondent-Applicant's EPIGEN will cause confusion or mistake upon, or deceive purchasers in that purchasers will tend to believe that the Respondent-Applicant's goods are those of, or coming from the Opposer. Hence, under Section 123(e) and (f) and Section 147 of Republic Act 8293 [Intellectual Property Code of the Philippines], the trademark EPIGEN cannot be registered in favor of the Respondent-Applicant.
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> "2. The trademark EPIGEN sought to be registered by the Respondent-Applicant is confusingly similar to the trademark BIGEN of the herein Opposer that the latter had much earlier adopted and used in commerce in the Philippines.

"3. Opposer has registered/applied for the registration of the trademark BIGEN and its variations in different countries of the world including the Philippines.

"4. Opposer has already spent much for the advertisement and promotion of the trademark BIGEN and its variations. Hence, Opposer's business and goodwill clearly be damaged and will suffer irreparable injury by the registration and use of a confusingly similar mark EPIGEN by the Respondent-Applicant.

"5. Japan, the country where Opposer is a subject, is a member of the Convention of the Paris for the Protection of Industrial Property (Paris Convention). Opposer is thus entitled to protection under the said Paris Convention."

To support opposition, Opposer relied upon the following facts, among others:

"1. The trademark EPIGEN of the Respondent-Applicant is confusingly similar to the trademark BIGEN of the Opposer in terms of general appearance, manner and style of presentation, sound/pronunciation and in respect of the goods to which they are respectively used.

"2. The trademark BIGEN in Japanese characters has been used and registered in Japan by the Opposer since October 27, 1990 and the trademark BIGEN in Roman letters has been used and registered in Japan since July 5, 1970. In the Philippines, the Opposer has already registered the mark BIGEN & DEVICE under Trademark Registration No. 12689, the mark BIGEN ELITE under Trademark Registration No. 42237 and the mark BIGENSPEEDY under Trademark Registration No. 50528. Moreover, Opposer has a pending trademark application for BIGEN Trademark Application Serial No. 108641. The trademark BIGEN is likewise registered/applied for in different countries of the world.

"3. The trademark BIGEN has been popularized internationally in different media of advertisement at the great expense of the Opposer.

"4. The trademark BIGEN has been extensively used in commerce in the Philippines since 1963 through a local distributor. As such, it already acquired tremendous amount of goodwill. In other words, the trademark BIGEN and BIGEN products are already too well-known in the Philippines as those of the Opposer.

"5. BIGEN is a recognized well-known mark of the Opposer not only in Japan but also in most countries of the world that are members of the Paris Convention. Hence, Opposer is entitled of the mantle of protection afforded under the Paris Convention provisions.

"6. Considering that its trademark BIGEN is known locally and internationally, the Opposer deserves protection under the Intellectual Property (IP) Code of the Philippines, particularly Sections 123, 134, 147 and relevant Sections thereof.

"7. Opposer's mark BIGEN as a well-known international trademark is entitled to protection under the new Intellectual Property (IP) Code of the Philippines because the use by Respondent-Applicant of the confusingly similar mark EPIGEN on its goods would indicate a connection between those goods and the Opposer, thereby damaging the interests of the Opposer."

The Notice to Answer, dated 01 August 2000, was sent to the Respondent-Applicant and received by Respondent-Applicant's counsel on 03 August 2000. For failure of the Applicant to file the required Answer within fifteen (15) days from receipt of aforesaid notice, the Applicant was declared in default by the Bureau of Legal Affairs as per Order No. 2000-451 and the Opposer was allowed be present its evidence ex-parte.

Admitted in evidence for the Opposer are Exhibits "A" to "Q"" inclusive of sub-markings consisting of: (a) certified true copy of Philippine Certificate of Registration No. 12689 issued on 09 February 1967 for the trademark BIGEN WITH SHINESE EQUIVALENT AND DESIGN, for cosmetics, toilet preparations and hair dyes; (b) certified true copy of Philippine Certificate of Registration No. 42237 issued on 12 December 1988 for the trademark BIGEN ELITE, for hair dye, shampoo, rinse hair dressing and cold wave lotion; (c) certified true copy of Philippine Certificate of Registration No. 50528 issued n 13 May 1991 for the trademark BIGEN SPEEDY, for hair dye; (d) certified true copy of Trademark Application Serial No. 108641 filed on 05 June 1996 for the trademark BIGEN for bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, hair dyes and hair colorants; (e) certified true copy of U.S. Certificate of Registration No. 783,348 issued on 12 January 1965 for the trademark BIGEN, for hair dyeing preparations; (f) certified true copy of Trademark Registration No. 1142624, issued by Great Britain and Northern Ireland on 25 October 1980, for the trademark BIGEN for hair dyes and hair conditioners; (g) Affidavit of Mr. Shimpei Mizuno, Vice-President of Opposer corporation; (h) Notice of Opposition and supporting documents; (i) list of trademark registrations of the mark BIGEN and its variations from different countries around the world, consisting of three (3) pages; (j) copies of certificates of registrations of the trademark BIGEN and its variations from countries around the world; (k) packages and labels of BIGEN products actually sold in the Philippines; (l) sworn affidavit of Mr. Co Bok, owner and proprietor of Komei Enterprise, distributor of BIGEN products; and (m) Business Agreement between Opposer and Mr. Co Bok dated 24 April 2001.

The issues to be resolved in this particular case are: (a) whether or not there exists a confusing similarity between the Opposer's trademark BIGEN and Respondent-Applicant's trademark EPIGEN; and (b) who between the Opposer and the Respondent-Applicant is the prior user entitled to protection under the Trademark Law.

Considering that the application subject of the instant opposition was filed under the old Trademark Law (R.A. 166, as amended), this Office shall resolve the case under said law so as not to adversely affect rights already acquired prior to the effectivity of the new Intellectual Property Code (R.A. 8293).

The applicable provision of the Trademark Law, Section 4(d) provides:

"Sec.4. *Registration of trademarks, trade-names and service-marks on the principal register* – xxx The owner of a trademark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or service of others shall have a right to register the same on the Principal Register, unless it:

"x x x

"(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a

> mark or trade-name 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 mistake or to deceive purchasers."

The determinative factor in a contest involving registration of trademark 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 law does not require that the competing trademarks must be so identical as to produce actual error or mistake. For infringement to exist, it would be 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 the case of *Etepha vs. Director of Patents (16 SCRA 502)*, the Supreme Court states that:

> "The essential element of infringement is colorable imitation. This term has been defined as "such a close or ingenious imitation as to be calculated to deceive ordinary purchasers, or such resemblance of the infringing mark to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one, supposing it to be the other."

The Supreme Court, in determining whether or not there is confusing similarity between trademarks, has relied on the dominancy test or the assessment of the essential or dominant features in the competing trademarks. Even the spelling and the similarity in sounds and pronunciation are taken into consideration. Thus, in the case of *Co Tiong Sa vs. Director of Patents (95 Phil 1)* the application for the registration of the trademark "FREEDOM" was rejected due to the existing registration of the mark "FREEMAN" over the same class of goods.

In the case of *Marvex Commercial Co. vs. Hawpia & Co. (18 SCRA 1178)*, The Supreme Court found that:

> "The trademark 'LIONPAS' for medicated plaster cannot be registered because it is confusingly similar to 'SALONPAS', a registered trademark also for medicated plaster. xxx Although the two letters of 'SALONPAS' are missing in 'LIONPAS' the first letter *a* and the letter *s.* Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. xxx"

In the case of *American Wire and Cable Co. vs. Director of Patents (31 SCRA 544),* the Supreme Court observed that:

> "xxx The similarity between the two competing trademarks, DURAFLEX and DYNAFLEX is apparent. Not only are the initial letters and the last half of the appellations but the difference exists in only 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 purchaser to confuse one product with the other."

In the instant case, the only difference between the Opposer's and Respondent-Applicant's trademarks are the initial letters, i.e., the letter "B" for the Opposer and the letters "EP for the Respondent-Applicant. The last letters "IGEN" are identical such that when the two words are pronounced, the sound effects are confusingly similar. Both trademarks also cover goods under Class 3 such that purchasers are likely to confuse one product with the other. Opposer's trademark BIGEN and its variations cover bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, hair dyes and hair colorants. On the other hand,

Respondent-Applicant's trademark EPIGEN cover bleaching preparations, laundry bleach, chemical preparations for brightening colors, laundry colors, laundry glaze, color removing preparations; laundry soaking preparations, laundry starch, detergents other than for use in manufacturing operations and for medical purposes, laundry wax.

As per the evidence presented, the trademark BIGEN was first used by the Opposer in Japan in 1960. The trademark BIGEN in Japanese characters was registered in Japan on 27 October 1960 while the trademark BIGEN in Roman letters was registered in Japan on 05 July 1970. The trademark BIGEN was first used in the Philippines as early as August 1963 when Komei Enterprise, distributor of BIGEN products in the Philippines, started the sale of BIGEN cosmetics, health and beauty care products. Subsequently, Opposer applied for and secured registrations for the subject trademark and its variations with the Bureau of Patents Trademark and Technology Transfer and was issued Certificate of Registration NO. 12689 dated 09 February 1967 (renewed on 09 February 1987) for the trademark BIGEN WITH CHINESE EQUIVALENT AND DESIGN; Certificate of Registration No. 42237 dated 12 December 1988 for the trademark BIGEN ELITE; AND Certificate of Trademark Registration No. 50528 dated 13 May 1991 for the trademark BIGEN SPEEDY. On the other hand, no evidence was presented pertaining to the first use of the trademark EPIGEN by the Respondent-Applicant in the Philippines. Thus, it is clear from the foregoing that between the Opposer and the Respondent-Applicant, the former has sufficiently proven that it is the prior user of the trademark BIGEN and is therefore entitled to protection from infringement thereof. Consequently the mark EPIGEN of Respondent-Applicant cannot be allowed registration for being confusingly similar to Opposer's BIGEN.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, Application bearing Serial No. 11432 filed on 25 September 1996 for the mark "EPIGEN" filed by CHEMINOVA INTERNACIONAL, S.A. for use on bleaching preparations, laundry bleach, etc., is hereby REJECTED.

Let the filewrapper of trademark EPIGEN subject matter of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau (AFHRDSB) for appropriate action in accordance with this Decision and a copy thereof to be furnished the Bureau of Trademarks (BOT) for information and update of its records.

SO ORDERED.

Makati City, 2 December 2002.

EDWIN DANILO A. DATING
*Assistant Director / Officer-in-Charge*
*Bureau of Legal Affairs*