

LOCTITE CORPORATION
Opposer,

INTER PARTES CASE NO. 2054

OPPOSITIO TO:

- versus -

Application Serial No. 53530
Filed : April 4, 1984
Applicant : Jardine Nell Corp.
Trademark : LOC-IT
Used on : Cyanoacrylate adhesive,
etc.

JARDINE NELL CORPORATION
Respondent-Applicant.

x-----x

DECISION NO. 89-57 (TM)
August 3, 1989

DECISION

On March 12, 1987, Loctite Corporation filed an Unverified Notice of Opposition against the registration of the trademark "LOC-IT" used on cyanoacrylate adhesive, screw locking grade, wicking (penetrant grade) and nut and belt locking grade applied for by Jardine Nell Corporation on April 4, 1984 under Serial No. 53530 published on Page 12, Volume 82, No. 6 of the Official Gazette released for circulation on February 11, 1987.

Opposer is a foreign corporation of Newington, Connecticut, U.S.A., while Respondent-Applicant is a domestic corporation organized under the laws of the Philippines with business address at 222 Sen. Gil J. Puyat Avenue, Makati, Metro Manila, Philippines.

The grounds alleged in the Verified Notice of Opposition are:

"1. Opposer is the owner of the trademark 'LOCTITE' for a settable resinous liquid composition suitable for use as a bonding agent, registered under Certificate of Registration No. SR-670 issued on March 4, 1965 and renewed for twenty (20) years effective March 4, 1985 by the Patent Office.

2. On April 4, 1984 respondent-applicant filed with the Patent Office an application for registration of trademark 'LOC-IT' for 'cyanoacrylate adhesive, screw locking grade, wicking (penetrant grade) and nut and belt locking grade' under Application Serial No. 53530 and said application was duly published in the Official Gazette.

3. The trademark 'LOCTITE' which opposer has created, adopted and used is so well known all over the world, having acquired international recognition and goodwill for its quality products bearing said mark. Opposer has been manufacturing and selling in the Philippines and other countries products bearing the mark 'LOCTITE' which are similar if not identical to the alleged products of respondent-applicant bearing the mark 'LOC-IT' under application serial No. 53530.

4. The mark 'LOC-IT' appearing on the drawings and facsimiles submitted by respondent-applicant in its application for registration are confusingly similar to opposer's aforementioned registered mark 'LOCTITE' as used on the goods of opposer.

x x x

6. The use and adoption by respondent-applicant of the mark 'LOC-IT' which is confusingly similar to opposer's mark 'LOCTITE' would tend to falsely suggest a connection with the business of opposer and therefore contribute an intent to defraud opposer."

In its Answer, Respondent-Applicant denied the material allegations made by Opposer and by way of affirmative defenses alleged that:

"a) x x x confusion is unlikely to occur as the products upon which these labels bearing the questioned trademark are industrial products being marketed by technically trained people and procurement by the users are coursed through trained buyers;

x x x

b) The trademark 'LOC-IT' as appearing on the drawings and facsimiles and used on goods is different from the Opposer's allegedly registered mark as used on its goods as it appears on the xerox copies of their trademark. x x x

c) The label specifies that the products are made in Japan which clearly contradicts and erases any doubt that the purchasers would tend to associate the products as being the products of the opposer."

The case was set for pre-trial to July 21, 1987 and was terminated on August 21, 1987 without prejudice to the ongoing negotiation for its amicable settlement by the parties.

On July 18, 1989, after several resetting, Opposer by counsel filed a Compromise Agreement dated July 11, 1989 wherein the parties have mutually agreed to settle their differences involving their respective marks, as follows:

"a) Respondent-Applicant hereby withdraws its pending Application SN 53530 filed on April 4, 1984 and voluntarily abandons its Registration Certificate No. SR. 6967 issued on January 2, 1984.

b) In consideration for the above-mentioned withdrawal and abandonment, Opposer is willing to grant Respondent-Applicant a period of three (3) months commencing from July 1, 1989 within which to dispose of its products in the Philippines bearing the mark LOC-IT and Respondent-Applicant hereby binds itself not to import further any products bearing the said mark LOC-IT.

c) Respondent-Applicant further binds itself not to apply for registration of the mark LOC-IT or similar mark covering the abovementioned Application Serial No. 53530 and Registration SR-6967 or for any products which are competing with the products of the Opposer presently bearing the mark LOCTITE."

WHEREFORE, this opposition is DISMISSED subject to the provisions of the attached Compromise Agreement. As agreed upon, Application Serial No. 53530 for the trademark "LOC-IT" is hereby declared voluntarily WITHDRAWN/ABADONED.

Let the records of the case be forwarded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO

Director