

PAGODA PHILIPPINES, INC.,	}	Inter Partes Case No. 14-2003-00036
Opposer,	}	Opposition to:
	}	Application Serial No. 4-1998-003504
	}	TM: "ALCOGEL"
-versus-	}	Date Filed: May 13, 1998
	}	Goods: "hand sanitizer"
SUYEN CORPORATION,	}	
Respondent-Applicant.	}	
x-----x		
SUYEN CORPORATION	}	Inter Partes Case No. 14-2003-00018
Opposer,	}	Opposition to:
	}	Application Serial No. 4-2000-002714
	}	TM: "FAMILY ALCOGEL"
-versus-	}	Date Filed: April 5, 2000
	}	Goods: "hand sanitizer"
PAGODA PHILIPPINES, INC.,	}	
Respondent-Applicant.	}	
x-----x		Decision No. 2006-154

DECISION

This resolves the consolidated Notice of Opposition docketed as Inter Partes Case No. 14-2003-00018 filed on 19 February 2003 by Suyen Corporation against Application Serial No. 4-2000-002714 with filing date April 5, 2000 by applicant Pagoda Philippines, Inc., and the Notice of Opposition docketed as Inter Partes Case No. 14-2003-00036 filed on May 22, 2003 by Pagoda Philippines, Inc. against Application Serial No. 4-1998-003504 with filing date May 13, 1998 filed by applicant Suyen Corporation.

In Inter Partes Case No. 14-2003-00036, Pagoda Philippines, Inc. relied on the following grounds for the opposition which are as follows:

1. The registration of the trademark ALCOGEL in favor of the Respondent-Applicant violates Section 123(h) of Republic Act 8293, as said mark consists exclusively of sign/word that is generic for the goods that it seeks to identify;
2. The registration of the mark ALCOGEL in favor of the Respondent-Applicant violates Section 123(i) of Republic Act 8293, as said mark consist exclusively of sign or indication that has become customary or usual to designate the goods in everyday language or in a bona fide and established trade practice;
3. The trademark ALCOGEL sought to be registered by the respondent-applicant for instant hand sanitizer is confusingly similar, if not identical, to the trademark FAMILY ALCOGEL of the herein Opposer which has been approved and published earlier and is being used for the same kind of goods in commerce in the Philippines.
4. The registration of the mark ALCOGEL in the name of the Respondent-applicant will cause grave and irreparable injury and damage to the Opposer and other manufacturers of the same/similar products, as well as the public in general, within the meaning of Section 134 of Republic Act 8293.

Respondent Suyen Corporation, in its Answer raised the following special and affirmative defenses:

- "8. ALCOGEL is a distinctive if not fanciful designation for hand sanitizer goods. It is not a generic term. It is a coined mark for it is not a dictionary word or term. The mark ALCOGEL therefore is capable of being

exclusively appropriated and as such is registrable like any other distinctive marks. No less than this Honorable Office found the mark ALCOGEL to be registrable when it allowed the application for publication. It is interesting to note that during the merit examination of the application the issue that the mark is considered generic or has become customary or usual designation of goods was never raised by the Examiner and the Bureau of Trademarks.

9. Respondent has registered the mark ALCOGEL in Japan, Australia, Hong Kong, Singapore, South Korea, Taiwan, Malaysia, Thailand and Brunei. Copies of the Certificate of Registration of the mark in the aforesaid countries are hereto attached as Annexes "1" to "9" and made integral parts thereof. The registration of the mark ALCOGEL in the aforesaid countries show that the mark is recognized by other intellectual property offices as distinctive and registrable.
10. Respondent was the first to use ALCOGEL as a trademark for instant hand sanitizer. The said mark was applied with the Intellectual Property Office on May 13, 1998 which is much earlier than the date the mark FAMILY ALCOGEL was filed by the Opposer on April 5, 2002. Being the first to apply for registration Respondent has superior right to register and own the mark ALCOGEL than the Opposer."

In Inter Partes Case No. 14-2003-00018 Opposer Suyen Corporation relied on the following grounds for the opposition:

1. The trademark FAMILY ALCOGEL sought to be registered by the Respondent-Applicant for hand sanitizer is confusingly similar if not identical to the trademark ALCOGEL of the herein Opposer which the latter had much earlier adopted and used for the same kind of goods in commerce in the Philippines and in other countries of the world;
2. The registration of the trademark FAMILY ALCOGEL in favor of the Respondent-Applicant is in violation of Section 123 (d) and Section 147 of Republic Act 8293 (Intellectual Property Code of the Philippines) since Opposer has filed its application for registration of the trademark ALCOGEL for hand sanitizer long before Respondent-Applicant applied for the registration of the trademark FAMILY ALCOGEL for hand sanitizer;
3. The registration of the mark FAMILY ALCOGEL in the name of the Respondent-Applicant will cause grave and irreparable injury and damage to the Opposer within the meaning of Section 134 of Republic Act 8293."

Respondent-Applicant Pagoda Philippines, Inc. raised the following affirmative and special defenses in its Amended Answer:

- 3.1.1. Subject application was examined, found to be meritorious and approved pursuant to the IP Code and the implementing rules and regulations; and
- 3.1.2. Subject application was filed by respondent-applicant in good faith as registered owner of the trademark FAMILY for various goods;
- 3.2. Opposer is barred by the equitable principles of laches, estoppel, and acquiescence from opposing subject application."

The pre-trial conference was held on August 13, 2004 wherein no amicable settlement was reached by the parties. Having identical parties and issues, both inter partes cases were consolidated.

Suyen Corporation offered the following evidence in support of its position:

EXHIBIT	DOCUMENTS
"A", "A-1"	Affidavit (including Annexes) of Mr. Dale Gerald Dela Cruz, Marketing Manager of Suyen Corporation
"B"	Amended Articles of Incorporation of Suyen Corporation
"C", "C-1", "C-2"	Copy of trademark Application No. 4-1998-003504 for the trademark ALCOGEL filed by Suyen Corporation with the IPO on May 13, 1998
"D", "D-1"	Declaration of Actual Use for Suyen Corporation's trademark ALCOGEL
"E", "E-1"	Certificate of Registration of the trademark ALCOGEL in Japan
"F"	Certificate of Registration of the trademark ALCOGEL in Australia
"G"	Certificate of Registration of the trademark ALCOGEL in Hong Kong
"H"	Certificate of Registration of the trademark ALCOGEL in Singapore
"I", "I-1", "I-2"	Certificate of Registration of the trademark ALCOGEL in South Korea and its English translation
"J", "J-1", "J-2"	Certificate of Registration of the trademark ALCOGEL in Taiwan and its English translation
"K", "L"	Certificate of Registration of the trademark ALCOGEL in Thailand and its English translation
"L-1"	Certificate of Registration of the trademark ALCOGEL in Malaysia and its English translation
"M"	Certificate of Registration of the trademark ALCOGEL in Brunei Darussalam
"N", "N-1" to "N-5"	Certificate of Registration of the trademark ALCOGEL in Vietnam and its English translation

	Translation
“O”	Certificate of Registration of the trademark ALCOGEL in India

Pagoda Philippines, Inc. offered the following evidence in support of its position:

EXHIBIT	DESCRIPTION
“1”	Certification issued by Bureau of Legal Affairs, Intellectual Property Office on May 14, 2003 regarding certain documents from the file of Application Serial No. 14-2000-002714.
“1-a”	Trademark Application Serial No. 4-2000-002714 for the mark “FAMILY ALCOGEL” filed on April 5, 2000 by Pagoda Philippines, Inc.
“1-b”	Drawing and facsimile of the trademark “FAMILY ALCOGEL”.
“1-c”	Notice of Allowance and Payment of Publication Fee for Application Serial No. 4-2000-002714 for the trademark “FAMILY ALCOGEL”.
“1-d”	Publication of Application Serial No. 4-2000-002714 for the mark “FAMILY ALCOGEL” in the Official Gazette.
“2”	Forwarding Letter for the Declaration of Actual Use filed on April 4, 2003 in Application Serial No. 4-2000-002714.
“2-a”	Declaration of Actual Use for Application Serial 4-2000-002714 for the mark “FAMILY ALCOGEL” filed on April 4, 2003.
“2-b”	Sales Invoice No. 3404 of Pagoda Philippines, Inc. dated June 7, 2000 indicating sale of 1 case (72 bottles, 100 ml.) of FAMILY ALCOGEL.
“2-c”	Sales Invoice No. 3405 of Pagoda Philippines, Inc. dated June 7, 2000 indicating sale of 1 case (72 bottles, 100 ml.) of FAMILY ALCOGEL.
“3”	Notarized affidavit of Elaine Gwendolyn M. Amistad dated May 8, 2006
“3-a”	Page 2 of Exhibit 3
“3-b”	Page 3 of Exhibit 3

"3-b-1"	Signature of Elaine Gwendolyn M. Amistad
"4"	Certified true copy of registration Certificate No. 51745 for the trademark "FAMILY & REP. OF A RIBBON" issue on November 5, 1991 in favor of Violeta Y. Alday and assigned to Pagoda Philippines, Inc., together with the Assignment document dated March 26, 1992; Accepted 5 th anniversary affidavit of use; Accepted 10 th anniversary affidavit of use.
"5"	Certified true copy of Registration Certificate No. 29065 for the trademark "FAMILY & REP/ OF A RIBBON" issued on April 13, 1981 in favor of Violeta Y. Alday
"6"	Certified true copy of Registration Certificate No. 65188 for the trademark "FAMILY" issued on September 2, 1997 in favor of Violeta Alday and assigned to Pagoda Philippines, Inc., together with the accepted Affidavit of Use filed its 5 th year anniversary.
"7"	Certified true copy of Registration No. 4-1994-96831 for the trademark ""FAMILY & REPRESENTATION OF A FAMILY CONSISTING OF A FATHER, MOTHER AND THREE CHILDREN INSIDE A HEXAGONAL DEVICE" issued on July 12, 2000 in favor of Pagoda Philippines, Inc.
"8"	Certified true copy of registration Certificate No. 4-2000-002713 for the trademark "FAMILY VITAGEL WITH VITAGEL WRITTEN VERTICALLY BELOW FAMILY" issued on January 20, 2003 in favor of Pagoda Philippines, Inc., together with the Declaration of Actual Use filed on April 4, 2003
"9"	Certified true copy of Registration Certificate No. 4-1993-085710 for the trademark "FAMILY" issued on July 8, 2004 in favor of Pagoda Philippines, Inc., together with the Declaration of Actual Use filed on November 23, 2001
"10"	Certified true copy of Registration Certificate No. 4-1992-080068 for the trademark "FAMILY" issued on October 30, 2004 in favor of Pagoda Philippines, Inc., together with the Declaration of Actual Use filed on December 3, 2001
"11"	Certified true copy of Trademark Application Serial No. 4-2000-002712 for the trademark "FAMILY ALOEGEL" filed on April 5, 2000 in favor of Pagoda Philippines, Inc., together with the Drawing Notice of Allowance and Payment

	of Publication Fees, and Declaration of Actual Use.
"12"	Certified true copy of Trademark Application Serial No. 4-2004-004128 for the trademark "FAMILY ALCOLOGNE" filed on May 7, 2004 in favor of Pagoda Philippines, Inc., together with the Drawing.
"13"	Photograph of a FAMILY ALCOGEL bottle.
"13-a"	Actual sample of FAMILY ALCOGEL bottle
"14"	Sales Invoice No. 288632 of Pagoda Philippines, Inc. dated May 4, 2006 indicating sale of 1 box (36 bottles) of FAMILY ALCOGEL (100 ml)
"14-a"	Sales Invoice No. 288633 of Pagoda Philippines, Inc. dated May 4, 2006 indicating sale of 1 box (36 bottles) of FAMILY ALCOGEL (100 ml)
"15" to "15-a"	Suyen's labels bearing the mark BENCH ALCOGEL for instant hand sanitizer

The issues are whether the word "ALCOGEL" is registrable. Corollary issue is, whether Suyen Corporation is entitled to register the mark "ALCOGEL" of Pagoda Philippines in entitled to register the mark "FAMILY ALCOGEL"?

Both parties through the testimony of their respective witnesses, Dale Gerald de la Cruz (Exhibit "A") and Elaine Gwendolyn Amistad (Exhibit "3") claim that the mark ALCOGEL which they adopted in their respective marks are derived from a contraction of two dictionary words namely alcohol and gelatin, thus ALCOGEL. Pagoda Philippines, Inc. argues that the word "ALCOGEL", which is a combination of the words alcohol and gelatin, the two being the main components of "hand sanitizers", render the word "ALCOGEL" generic for the goods, hand sanitizer and therefore unregistrable under Section 123.1(h) of Republic Act 8293. It further argues that the mark has become customary or usual to designate the goods in everyday language which makes the word ALCOGEL unregistrable under Section 123.1(i) of republic Act 8293.

To bolster its contention that its mark is registrable, Suyen Corporation presented Certificates of Registration of its mark "ALCOGEL" obtained from several countries abroad. (Exhibits "E", "F", "G", "H", "I", "J", "K", "L", "M", "N", "O").

Based on the Bureau's own examination of the mark, the word "ALCOGEL" is not a generic term. In *Societe des Produits Nestle, S.A. v. Court of Appeals* [G.R. No. 112012. April 4, 2002.], the Supreme Court explains:

"Generic terms are those which constitute "the common descriptive name of an article or substance," or comprise the "genus of which the particular product is a species," or are "commonly used as the name or description of a kind of goods," or "imply reference to every member of a genus and the exclusion of individuating characters," or "refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular products," and are not legally protectable."

A hand sanitizer may not necessarily be alcohol in a gelatinous state. Neither is alcohol in a gel form called ALCOGEL in ordinary parlance. The combination of alcohol and gelatin or gelatinous alcohol does not instantly signify a hand sanitizer.

At most, the term is merely suggestive of the product hand sanitizers.

By scrutiny of the word ALCOGEL itself, its first letters "ALCO" or "ALC" does not denote alcohol. The use of ALCO as a prefix may only intimate or hint at the use of alcohol. However, there are other English words that start with these letters. Likewise, the letters "GEL" used as a suffix does not automatically bring to mind or evoke a gelatine or a gel. The word "Gelatine" is defined as:

"Glutinous material obtained from animal tissues by boiling; 2. any of various substances resembling gelatin 2b an edible jelly made of gelatin. 3. a thin colored transparent sheet used over a stage light to color it."

A "gel" is defined as:

"a colloid in a more solid form than a sol." (Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc. Publishers, Massachusetts, U.S.A. 1991.)

Therefore, the use of ALCO merely implies or suggests the use of alcohol in a product which may or may not be a hand sanitizer, while GEL merely implies the form in which a product is made. In this case, one can only conjure or imagine that the hand sanitizer is formed by alcohol in a gel state by seeing the term ALCOGEL. It must be emphasized however, that the term suggests it which makes the term distinct and capable of being registrable under trademark law.

In the aforementioned Societe des Produits Nestle, the Supreme Court elaborates;

"Suggestive terms are those which, in the phraseology of one court, require "imagination, thought and perception to reach a conclusion as to the nature of the goods." such terms, "which subtly connote something about the product," are eligible for protection in the absence of secondary meaning. While suggestive marks are capable of shedding "some light" upon certain characteristics of the goods or services in dispute, they nevertheless involve "an element of incongruity," "figurativeness," or "imaginative effort on the part of the observer."

A mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. (USPTO, Trademark Trial and Appeal Board, In re: Matsushita electric Corporation of America, Serial No. 76/021,398, page 3)

Records show that in point of time, Suyen Corporation's application for the mark "ALCOGEL" precedes the filing by Pagoda Philippines, Inc. of its application for the mark "FAMILY ALCOGEL". The former filed its application on May 13, 1998 while the latter filed its application on April 5, 2000. Evidence further shows that Suyen Corporation filed on 16 March 2001 its Declaration of Actual Use of the mark "ALCOGEL" alleging use since July 2, 1998 (Exhibit "D-1"). On the other hand, Pagoda Philippines, Inc, showed evidence of commercial use through sale invoices dated in June 2000 and its Declaration of Actual Use filed on April 4, 2003. (Exhibit "2", "2-a", "2-b", "2-c").

Under Republic Act 8293, under which the application for the mark "FAMILY ALCOGEL" was filed by Pagoda Philippines, Inc., a mark cannot be registered if it is identical or confusingly similar to a mark belonging to another with an earlier filing date. Sec. 123.1 of Republic Act 8293 provides:

“123.1. A mark cannot be registered if it:

xxx

(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;”

Clearly, in the instant case, Suyen Corporation’s application precedes that of Pagoda Philippines, Inc.

Likewise, Suyen Corporation has filed its Declaration of Actual Use ahead of Pagoda Philippines, Inc. (Exhibit “D”).

The only remaining question is whether “FAMILY ALCOGEL” is confusingly similar to “ALCOGEL” which if contemporaneously used would lead to deception and confusion.

In this regard, Pagoda Philippines, Inc. submitted evidence showing its registration of the mark “FAMILY” (Exhibit “4”) and registrations of the such word in with other words such as “Vitagel” (Exhibit “8”); “Aloegel” (Exhibit “11”); “Alcologne” (Exhibit “12”).

Even if the word “FAMILY” is affixed to the word “ALCOGEL” to form a composite mark, the fact remains that the word “ALCOGEL” is a coined and arbitrary word, adopted earlier by Suyen Corporation. In *Philippine Refining Co., Inc. v. Ng Sam*, No. L-26676, 30 July 1982, the Supreme Court held that “a trademark is designed to identify the user. But it should be so distinctive and sufficiently original as to enable those who come into contact with it to recognize instantly the user. It must be affirmative, definite, significant and distinctive, capable to indicate origin.

Hence, ALCOGEL being a coined word which is distinctive mark capable of indicating origin, its use together with Pagoda Philippine’s “FAMILY” mark is likely to lead to confusion among purchasers, considering that both marks are used on identical goods, namely, hand sanitizers.

The Supreme Court emphasizing unlimited choices of trademarks in *Teodoro Kalaw Ng Khe v. Lever Brother Co.* (citing *Kassman & Kessner, Inc. v. Rosenberg Bros. Co.* 10F (2d) (83 Phil. 947) held:

“Where doubt arises upon such a question, the courts are inclined to resolve the doubt against the newcomer. The reason for this rule is that the field from which a person may select a trademark is unlimited, and hence there is no excuse for impinging upon or even closely approaching the mark of a business rival.”

WHEREFORE, premises considered, the Opposition filed by PAGODA PHILIPPINES, INC. is hereby DISMISSED and Application Serial No. 4-1998-003504 for the registration of the trademark “ALCOGEL” for “hand sanitizers” filed by SUYEN CORPORATION on May 13, 1998 is hereby GIVEN DUE COURSE. Accordingly, the Opposition filed by SUYEN CORPORATION against PAGODA PHILIPPINES, INC. for the registration of the mark “FAMILY ALCOGEL” is hereby SUSTAINED. Consequently, Application Serial No. 4-2000-002714 for the registration of the mark “FAMILY ALCOGEL” used on “hand sanitizers” FILED BY Pagoda Philippines, Inc. on April 5, 2000 is, as it is hereby, REJECTED.

Let the filewrapper of ALCOGEL and FAMILY ALCOGEL subject matters of these cases together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 22 December 2006.

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