

SARA LEE HOUSEHOLD AND
BODY CARE NEDERLAND B.V.
Opposer,

-versus-

P.T. SAYAP MAS UTAMA
Respondent-Applicant,
x-----x

IPC NO. 14-2004-00108
Opposition to:
Serial No : 4-1997-122232
Filed : 04 July 1997
Trademark: "SANTEX"

Decision No. 06-79

DECISION

Before this Office is an Opposition filed by Sara Lee Household and Body Care Nederland B.V., a corporation duly organized under and by virtue of the laws of Netherlands, with business address at Traverse 2, 3905 NL Veenendaal, The Netherlands, against the application for registration of the trademark "SANTEX & DEVICE" for goods under class 3, specifically *Bath Soaps, Wash Soaps, Cream Detergents, Powder Detergents, Cream Soaps, Liquid Detergent, Liquid Shampoo, Powder Shampoo, Toothpaste, Perfumes, Hair Oils, Hair Pomade, Eau de Cologne, Tissue Cologne, Face Cream, Lipstick, Nail Polish, Talcum* with Application Serial No. 4-1997-122232 and filed on 04 July 1997 in the name of Respondent-Applicant, P.T. SAYAP MAS UTAMA with address at Jalan, Tipar Cakung Kav, 5-7, Cakung Drain, Jakarta Timur, Indonesia.

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

- "1. The Opposer is the owner/registrant of the trademark "SANEX", and Respondent-Applicant's mark is confusingly similar therewith, hence the Respondent-Applicant's mark cannot be registered pursuant to the Intellectual Property Code;
- "2. The trademark "SANEX" is well-known throughout the world.

Opposer relies on the following facts to support its contentions in this Opposition:

- "1. The Opposer is the owner of the mark "SANEX";
- "2. The trademark "SANEX" has been used in trade and commerce since 1985 in Spain and has been used all throughout the world since then. The mark "SANEX" has been granted registrations in the following countries and territories: African Union Territories, Angola, Armenia, Australia, Austria, Azerbaijan, Bangladesh, Belarus, Benelux, Bosnia Herzegovina, Brazil, Brunei, Bulgaria, China, Columbia, Croatia, Cyprus, Czech Republic, Denmark, Ecuador, Estonia, European Community, Finland, France, Georgia, Greece, Hong Kong, Hungary, Iceland, India, Indonesia, Iran, Ireland, Israel, Italy, Kazakhstan, Kenya, Republic of Korea, Kyrgyz Republic, Latvia, Lechtenstein, Lithuania, Macao, Macedonia, Malawi, Malaysia, Malta, Moldova, Mongolia, Mozambique, New Zealand, Nigeria, Norway, Pakistan, Peru, Poland, Portugal, Romania, Russian Federation, Serbia & Montenegro, Slovakia, Slovenia, South Africa, Spain, Sweden, Switzerland, Taiwan, Tajikistan, Thailand, Turkey, Turkmenistan, Uganda, Ukraine, United Kingdom, Uzbekistan, Venezuela, Vietnam, Zambia, Zimbabwe.
- "3. In the Philippines, the mark "SANEX" has been issued Certificate of Registration No. 57323 under Class No. 3, issued on March 15, 1994. Judicial notice and recognition can be taken by this Honorable Office in regard to the above registration.
- "4. Respondent-Applicant's mark "SANTEX" is confusingly similar to Opposer's trademark. Moreover, the goods covered by both marks are related. The mark "SANEX" has been registered in the Philippines for "Perfumery, essential oils, cosmetics namely

lotions, creams, ointments and powder for the care of the skin of the hands, feet, head and body, talcum powders, hair lotions, dentifrices, toilet soap, soapy gels, shampoos, deodorants for personal use”, goods which are similar to the goods covered by the Respondent-Applicant’s mark and within the same classification of Class 3 of the Nice Classification of Goods and Services.

“5. The registration of the applicant’s alleged mark would violate Opposer’s rights and interest in its trademark “SANEX”. The marks are confusingly similar such that the resulting dilution and loss of distinctiveness of Opposer’s trademark becomes inevitable.

Both the Philippines and the Netherlands, the country of domicile of the Opposer, are members of the Berne, Paris Conventions. These conventions relate to the intellectual property rights or the repression of unfair competition.

The Notice to Answer dated August 23, 2004 was sent to Respondent-Applicant by registered mail. There was confusion, however, as to the date when the Notice to Answer was received by Respondent-Applicant upon verification with the Postmaster. Finding the necessity to send the summons anew, Opposer through Counsel moved for the issuance of an Alias Notice to Answer, service of an Alias Notice to Answer was effected by registered mail, but this time received by the Respondent-Applicant through Counsel on September 30, 2005. For failure of the Applicant to file the required Answer within the prescribed period or within fifteen (15) days from receipt of aforesaid notice, and by virtue of Order NO. 2006-141, Respondent-Applicant was declared as IN DEFAULT.

Considering that the case was mandatorily covered by the Summary Rules under Office Order NO. 79, this Bureau directed Opposer to file within a period of thirty (30) days from receipt of the subject notice all evidence in original and duplicate copies, and in compliance with said Order, Opposer through Counsel filed its evidence on April 20, 2006.

Filed as evidence for the Opposer based on the records are Exhibits “A” and “B” inclusive of submarkings which consisted, among others, of the affidavit of Mr. Steenhoof, Counsel for Sara Lee Household and Body Care Nederland B.V. and the affidavit of Ms. Melissa Lucas, Vice-President for Marketing of Sara Lee Direct Selling Philippines, Inc.

For consideration in particular is the propriety of Application Serial No. 4-1997-122232. The issue hinges on the determination of whether or not Respondent-Applicant is entitled to register the trademark SANTEX on goods belonging to Class 3 for use specifically on *bath soaps, wash soaps, cream detergent, cream soaps, liquid detergent, liquid shampoo, powder shampoo, tooth paste, perfumes, hair oils, hair pomade, eau de cologne, tissue cologne, face cream, lipsticks, nail polish, talcum*.

Considering that the Application subject of the instant opposition is filed under the old Trademark Law (R.A. 166, as amended), and that Respondent, through Counsel, manifested in writing their desire to prosecute this application under the provisions of Republic Act No. 166, as amended, hence, the case shall be resolved 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 provisions of the Trademark Law, Section 4(d) provides:

“Section 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 services of others shall have a right to register the same on the Principal Register, unless it:

(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 in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchaser.”

xxx

An examination and evaluation of the records and evidence at hand would reveal that Opposer based its right to pursue this instant opposition on the strength of its ownership and prior use of the subject mark SANEX as applied to goods under Class 3 of the Nice Classification of goods and services, specifically *perfumery, essential oils, cosmetics namely lotions, creams, ointments and powder for the care of skin of the hands and feet, hand and body, talcum powder, hair lotions, dentrifices, toilet soap, soapy gels, shampoos, deodorants for personal use.*

Opposer filed its application to register the mark SANEX in the Philippines on 08 February 1991 and was granted registration on 15 March 1994 under a duly issued Certificate of Registration No. 57323. Opposer had earlier obtained Benelux registration of the mark on 18 May 1990. Respondent-Applicant first applied for the registration of the mark SANTEX in Indonesia on 13 November 1996, or more than six (6) years after Opposer obtained its registration at Benelux. Respondent’s trademark application in the Philippines based on foreign (Indonesia) registration of the mark SANTEX was filed on 04 July 1997.

The basis for this instant opposition was the invocation by Opposer of its right as trademark owner and prior user under R.A. 166, as amended. It is clear from a reading of Section 4 (d) as above-cited that the intention of the law is to protect not only the owner of the trademark, likewise, and more importantly, the buying public that they may not be confused, mistaken or deceived by goods they are buying.

In this particular case, the striking or overwhelming similarity of the trademarks in question is noteworthy. The mark SANTEX of Respondent-Applicant is phonetically similar to the registered mark SANEX used and not abandoned by the Opposer and applied on similar goods as well, all covered under the same international class or category of cosmetics, toiletries and detergents and serving the same purpose. It bears mentioning at this juncture the adoption by Respondent-Applicant of all letters in Opposer’s mark SANEX to arrive at its allegedly original mark SANTEX.

Further, the mark SANTEX in question is almost identical to the mark SANEX of Opposer, that accordingly Respondent-Applicant’s attempt to rise it to the level of distinctiveness necessary to gain registration, by inserting the letter T and used small letters in stylized form with a short bar atop the letters “e” and “x”, as compared to Opposer’s mark SANEX which has all the letters capitalized or has only the first letter capitalized, emerged *unsuccessful*. The court observed in *Philippine Refining Co., Inc. vs. Dir. Of Patents and Sparklets Corp. vs. Walter Kidde Sales Co.*, 104 F. 2d 396, 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 contract with it to recognize instantly the identity of the user. It must be affirmative and definite, significant and distinctive, capable to indicate the origin.”

The mark SANEX is a coined, invented or made-up word and therefore is not open for appropriation by anyone. It is a word that not exist in any dictionary, examples of famous coined words are the trademarks *Rolex, Kodak and Kotex*, to name a few. The adoption of such coined word in Opposer’s business excludes others similarity situated from using the same, hence, the use by Respondent of the mark SANTEX vis-à-vis Opposer’s SANEX as applied to similar goods may lead to confusion in trade and would damage obviously Opposer’s business.

In a long line of cases, the Supreme Court has observed and upheld confusing similarity in the following trademarks: DURAFLEX and DYNAFLEX (*American Wire and Cable Co. vs.*

Director of Patents, 31 SCRA 244); LIONPAS and SALONPAS (Marvex Commercial Co. Inc. vs. Petro Hawpia & Co., 18 SCRA 1178); FREEDOM and FREEMAN (Co Tiong Sa vs. Director of Patents, May 24, 1954); AMBISCO and NABISCO (Operator, Inc. vs. Director of Patents, 15 SCRA 149); and SUNVIS and UNIVIS (Esso Standard Oil Company vs. SUN Oil Company, et al., 46 TMR 444).

Opposer has adopted and has been selling in commercial quantity its products with the mark SANEX since 1985 in Spain (Exhibit "A") and has marketed the same in the Philippines since April 2003 (Exhibit "B") Significant to note as well is that the goods of Opposer and Respondent are of the same general description and serves the same purpose, to wit:

(under Class 3 of Nice Classification)	
<u>Opposer's goods/products</u>	<u>Respondent's goods</u>
<i>Perfumery</i>	<i>Perfumes</i> <i>Eau de Cologne</i> <i>Tissue cologne</i>
<i>Essential oils</i>	<i>hair oils</i>
Cosmetics namely: <i>Lotions,</i> <i>Creams,</i> <i>ointments and</i> <i>powder for the care</i> <i>of the skin of the hands,</i> <i>feet, hand and body,</i> <i>talcum powder</i> <i>hair lotions,</i> <i>dentrifices,</i>	<i>face cream</i>
<i>toilet soap,</i> <i>soapy gels,</i>	<i>talcum</i>
<i>shampoos,</i>	<i>toothpaste</i>
<i>deodorants for personal use.</i>	<i>bath soap</i> <i>wash soap</i> <i>cream soaps</i> <i>liquid shampoo</i> <i>powder shampoo</i>

Other goods of Respondent include: *Cream Detergents, Powder Detergent, Liquid Detergent, Hair Pomade, Lipstick, Nail Polish*, likewise covered under Class 3.

Having shown and proven the resemblance of the two marks at issue, we now delve on the matter of priority in use which certainly has decisive effect in the adjudication of the case. From the evidence presented, the stand of Opposer as prior user was put forth with plausibility. Opposer has been in the business and was using the trademark SANEX on goods under class 3 since 1985 in Spain. As held in the case on Unno Commercial Enterprises, Inc. vs. General Milling Corporation "*prior use by one will controvert a claim of legal appropriation by subsequent users*". Hence, it may be concluded inevitably that Respondent-Applicant's use of the identical mark on the same or related goods will result in an unlawful appropriation of mark previously used by Opposer and not abandoned, thereby contravening Section 4(d) of Republic Act No. 166, as amended.

The two (2) competing marks in all approach are evidently similar, in spelling, pronunciation and sound. Opposer has shown that it is the first user of the mark. For its part, Respondent-Applicant has failed to present any evidence to show commercial use of the mark in the Philippines or elsewhere, its foreign registration likewise bears no date of alleged first use, therefore, in the absence of proof of earlier use of the mark vis-à-vis Opposer's mark, we may therefore surmise or it is safe to construe that Respondent-Applicant is the later user of

substantially the same trademark. With that as premise, and with the evidence presented to show Opposer's commercial use of the mark which was not refuted by the Respondent-Applicant, Opposer, therefore, has prior use and registration of the trademark in question.

Note should be taken as well of the fact that Respondent-Applicant was validly served with summons, and was afforded the opportunity to refute the claim of and/or controvert the allegation of prior use by Opposer of the subject trademark if he filed an Answer but Respondent defaulted. Obviously, therefore, pursuant to Office Order No. 79 and the Rules under the old Trademark law, the case shall be decided on the basis of the evidence thus presented. The Opposer having shown its entitlement to the mark in question, that it was Opposer which first adopted the questions mark on cosmetics and toiletries and other similar goods under Class 3, Respondent-Applicant application for the same or substantially the same trademark should therefore be rejected.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, application bearing Serial No. 4-1997-122232 filed by P.T. Sayap Mas Utama on 04 July 1997 for the registration of the mark "SANTEX" used on *Bath soaps, Wash Soaps, Cream Detergents, Powder Detergents, Cream Soaps, Liquid Detergents, Liquid Shampoo, Powder Shampoo, Toothpaste, Perfumes, Hair Oils, Hair Pomade, Eau de Cologne, Tissue Cologne, Face Cream, Lipstick, Nail Polish, Talcum* is hereby REJECTED.

Let the filewrapper of SANTEX, subject matter of this case be forwarded to the Bureau of Trademarks for appropriate action in accordance with this DECISION.

SO ORDERED.

Makati City, August 8, 2006.

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