

THE WELLA CORPORATION
Opposer,

INTER PARTES CASE NO. 3048

OPPOSITION TO:

- versus -

Application Serial No. 58828
Filed : April 8, 1986
Applicant : Philippine Refining
Co., Inc.,
Trademark : WHEEL
Used on : Toilet soaps

PHILIPPINE REFINING
CO., INC.,
Respondent-Applicant
x-----x

DECISION NO. 89-103 (TM)
November 2, 1989

DECISION

The Wella Corporation filed on February 19, 1988 an Unverified Notice of Opposition against the registration of the trademark "WHEEL" used for toilet soaps applied for by Philippine Refining Co., inc. on April 8, 1988 under Application Serial No. 58828 which was posted for opposition at the BPTTT Bulletin Board on January 20, 1988.

Opposer is a foreign corporation organized and existing under the laws of the United States of America, while Respondent-Applicant is a domestic company organized under the laws of the Philippines domiciled and doing business at 1351 United Nations Avenue, Manila, Philippines.

The grounds alleged In the Verified Notice of Opposition submitted on May 13, 1988 are:

"1. Applicant's trademark 'WHEEL' is confusingly similar to the trademark 'WELLA' owned by opposer which is used in respect of 'preparation of use of in the trademark of hair, namely: hair dyes, hair lotions, hair creams, hair lacquers, liquid hair conditioner, preparation for waving and curling the hair' and not abandoned, as to be likely, when applied to or used with the goods of the applicant to cause confusion or mistake or to deceive purchaser's thereof;

2. The registration of WHEEL in the name of Philippine Refining Company, Inc. will cause great and irreparable injury and damage to oppose within the meaning of Section 8 of Republic Act No. 166, as amended."

In its Answer filed on time, Respondent-Applicant denied the material allegations made by the Opposer and alleged the following affirmative and special defenses:

"9. Respondent-applicant adopted and started using, as he continues to use subject mark, in good faith."

10. In the actual use of subject mark as well as in the promotion and advertisement thereof, no attempts have been made to suggest that the goods upon which subject mark are being used come from Opposer or that respondent's business is connected with the business of Opposer.

11. Opposer has no valid cause of action against respondent-applicant and that the above Notice of Opposition was filed purely for purposes of harassment.

12. Despite the long and continued use by the respondent-applicant of the subject mark on his products which are being marketed openly and publicly, opposer has not interposed any objection, or protest until now implying, if not signifying, opposer's acquiescence to the use of the subject mark by respondent-applicant. For all intents and purposes, opposer is now estopped from opposing the application by respondent-applicant.

13. Assuming arguendo that there is similarity between the two marks, applicant has a better right to the mark applied for."

After receipt of the Answer, the case was set for pre-trial conference to July 7, 1988 which was reset for several times in view of a pending negotiation for possible settlement.

On January 16, 1989, despite an on-going negotiation for settlement, Opposer initially presented its evidence (Exhs. "A" to "F") and continued it on February 8, 1989 (Exhs. "C-26" to "H"). Upon manifestation by counsels, the succeeding hearings were reset from one date to another because the parties are already at the stage of finalizing the terms of their settlement.

At the hearing of October 23, 1989, the parties' respective counsels, in open court, submitted a Joint Motion to dismiss herein case, subject to the following covenants:

"a. RESPONDENT-APPLICANT shall withdraw, as it had in fact withdrawn, its application for registration of the mark 'WHEELA', under Serial No. 58224, with prejudice to the refilling thereof and hereby undertakes and agrees that it shall not refile and/or revive or otherwise pursue such application for the registration of said trademark at any time hereafter.

b. Herein OPPOSER shall withdraw, as it hereby withdraws, its opposition to the application for the registration of the trademark 'WHEEL', Serial No. 58828, for toilet soaps.

c. RESPONDENT-APPLICANT hereby undertakes and warrants that it shall use the trademark 'WHEEL' for laundry and toilet soaps and that it shall not use the same, at any time after registration thereof in its name, in connection with any hair care or cosmetic products, such as hair dyes, hair cream, hair lacquers, hair conditioners, hair curling or waving preparations, or other products included in International Class 3 particularly perfumery, essential oils, cosmetics and dentifrices.

3. The foregoing undertakings and warranties of RESPONDENT-APPLICANT shall be considered as integral parts of its Trademark Application for 'WHEEL' under Serial No. 58828 and as essential conditions for the approval thereof."

WHEREFORE, this opposition is DISMISSED for having become moot. Subject to the provisions of the foregoing covenant between the parties, Application Serial No. 58828 for the trademark "WHEEL" is given due course.

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

SO ORDERED.

IGNACIO S. SAPALO
Director