



EVONIK DEGUSSA GMBH,
Petitioner,

-versus-

FIRST IN COLOURS, INCORPORATED,
Respondent-Registrant.

X-----X

} IPC No. 14-2011-00495
}
} Cancellation of:
} Reg. NO. 4-2010-004499
} Date Issued: 25 June 2011
} Trademark: "AEROSIL"
}
}
}

NOTICE OF DECISION

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Quezon City

GREETINGS:

Please be informed that Decision No. 2012 - 164 dated September 03, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 03, 2012.

For the Director:


Atty. RAUSLU SAPAK
Hearing Officer
Bureau of Legal Affairs

CERTIFIED TRUE COPY


MARILYN F. RETUTAL



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Petitioner,

IPC No. 14-2011-00495
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Decision No. 2012- 164

DECISION

EVONIK DEGUSSA GMBH ("Petitioner")¹ filed on 28 October 2011 a petition to cancel Trademark Reg. No. 4-2010-004499. The trademark registration, issued on 25 June 2011 to FIRST IN COLOURS, INCORPORATED ("Respondent-Registrant")², covers the mark "AEROSIL" for use on "*lubricants*" under Class 4 of the International Classification of goods.³

The Petitioners alleges among other things, that it is the owner of the mark AEROSIL which it registered in the Philippines and has more than thirty (30) years of priority over the Respondent-Registrant's. According to the Petitioner, its prior registration for AEROSIL prevents the registration of the Respondent-Registrant's for the same or related goods. The Respondent-Registrant's registration therefore of the mark AEROSIL is contrary to the provisions of the IP Code.

In support of its petition, the Petitioner submitted the following:

1. Authenticated Affidavit of Susanne Reinhart, Director of Strategic Marketing for AEROSIL;
2. certified copy of the Cert. of Trademark Reg. No. 18716 for AEROSIL;
3. Notice of Issuance of the Cert. of Renewal for Phil. TM Reg. No. 18716 for AEROSIL;
4. request for recordation of the changes in name of the Petitioner and supporting documents;
5. photos of AEROSIL products and advertisements for AEROSIL;
6. sales invoices for AEROSIL;
7. printouts on the background of the product AEROSIL from <http://www.aerosil.com/product/aerosil/en/about/pages/default.aspx>;
8. list of worldwide trademark registrations for AEROSIL;

¹ A corporation duly organized under and by virtue of the laws of Germany, with principal office at Rellinghauser Strasse 1-11, 45128 Essen Germany.

² With address at No. 65 Industria Avenue, Bagumbayan, Quezon City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

9. certified copies of trademark registrations for AEROSIL issued by the trademark offices of Bangladesh, Canada, China, Hong Kong, Indonesia, India, Japan, North Korea, South Korea, Malaysia, New Zealand, Philippines, Singapore, Thailand, Taiwan, United States of America, European Union;
10. photocopies of the certificates of trademark registration issued by the trademark offices of the United Arab Emirates, Argentina, Bolivia, Brazil, Chile, Germany, Mexico, Norway, Sweden, Uruguay;
11. printout from the IPO database of TM Application/Reg. No. 4-2010-004499 for AEROSIL; and
12. Printout from the websites:
 - a. <http://composite.about.com/library/glossary/f/bldeff2371.htm>,
 - b. <http://www.aerosil.com/product/aerosil/en/industries/Pages/default.aspx>,
 - c. <http://www.websters-online-dictionary.org/definitions/aerosil?cx=partner-pub-0939450753529744%3Avoqdo1>,
 - d. <http://www.merriam-webster.com/dictionary/lubricant>,
 - e. <http://en.wikipedia.org/wiki/Lubricant>,
 - f. <http://en.wikipedia.org/wiki/Grease%28lubricant%29>, and
 - g. <http://www.thetotalitsolution.com/prtfolio/samples/mc/products/maintenance/geases.php>.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Registrant. The Respondent-Registrant, however, did not file an Answer.

Should Trademark Reg. No. 14-2010-004499 be cancelled?

The Respondent-Registrant's mark is identical to the Opposer's, as shown below:

AEROSIL®

Petitioner's mark¹

Aerosil

Respondent's mark²

In this regard, Sec. 151.1 of Rep. Act No 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides among other things that:

A petition to cancel a registration of a mark under this act may be filed with the Bureau of Legal Affairs by any person who believes that he may be damaged by the registration of a mark under this Act as follows:

xxx

(b)Anytime, if the registered mark xxx or it's registration was obtained fraudulently or contrary to the provisions of this Act, or if the registered mark is being used by or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. xxx

⁴ Marked as Exhibits "A" to "F", inclusive.

Corollary thereto, Sec. 123.1, pars. (d) of the IP Code state that a mark cannot be registered if it:

(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.

Records show that the Petitioner secured on 16 April 1973 Reg. No. 018716 for the mark AEROSIL. The registration was renewed in the year 1993 and valid until 16 April 2013.⁵ The registration covers "*finely divided silica for use in industry and science*" in Class 01. The Petitioner also submitted evidence that in the Philippines, AEROSIL products have been sold since 31 December 1962⁶ and distributed by its authorized distributors. Furthermore, the Petitioner showed that the goods covered by its trademark registration are closely related to the Respondent-Registrant's, to wit:

"1.5.1.1 Fumed silica is a form of oxidized silicon which was heated to form a powder with extreme low bulk density and high surface area.

"1.5.1.2 It is used as a universal thickening agent and has a myriad of industrial applications, such as adhesives and sealants, batteries, catalyst carrier, food, glass, lighting applications, paints and coatings, personal care, pharmaceuticals, plastics, silicone rubber, industrial power technology, toner, unsaturated polyester resins, to name a few.

"1.5.2 On the other hand, Respondent's AEROSIL trademark with Philippine Trademark Registration No. 4-2010-004499 designates 'lubricants' underclass04 in the NICE Classification.

"1.5.3 Lubricants are a substance used to reduce friction between two moving surfaces with an aim to improve efficiency and lessen wear. It comes in both liquid and non-liquid forms. Non-liquid lubricants include grease and powders, among others.

"1.5.4 It also has numerous applications, namely, food, biomedical, personal care, automotive, sealant, and metal work.

"1.5.5 Moreover, silica can be used as an additive in lubricants to form silicone grease, which is a non-liquid type of lubricant.

x x x

"1.6.1 Notably, Petitioner's AEROSIL and Respondent's AEROSIL mark pertain to chemical products with industrial applications in the chemical industry. In fact, the products for which Petitioner's and Respondent's marks are used have overlapping applications (i.e. food, medical, personal care and sealants).

"1.6.2 Therefore, not only is Respondent's AEROSIL identical to Petitioner's AEROSIL mark, it is also for the kind of products which are in fact closely related to the goods listed under Petitioner's registered AEROSIL trademark."⁷

⁵ Exhibits "A-1 and A-2".

⁶ Exhibit "A-9".

⁷ See Petition for Cancellation, pp. 5-6, citing Exhibits "C" to "F".

Both parties used the mark AEROSIL on goods that are, essentially, chemicals for industrial use. Consumers therefore are likely to assume that the Petitioner has expanded its business or has in any way sponsored the activities of or is connected to or associated with the Respondent-Registrant. The confusion or mistake would subsist not only on the purchaser's perception of the goods but on the origin thereof as held by the Supreme Court, to wit:⁸

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

The public interest, therefore, requires that the two marks should not be allowed to co-exist. Confusion, mistake, deception and fraud, should be prevented. It is emphasized that the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secured to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁹

Considering that the mark AEROSIL is already in use, and registered by the Petitioner in the Philippines long before the Respondent-Registrant filed a trademark application the registration of the mark AEROSIL in the latter's favor should have not been allowed as it is proscribed by Sec. 123.1 (d) IP Code.

WHEREFORE, premises considered, the instant petition for cancellation is hereby **GRANTED**. Let the filewrapper of Trademark Reg. No. 4-2010-004499 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 03 September 2012.


ATTY. NATHANIEL S. AREVALO
Director W, Bureau of Legal Affairs



⁸ *Converse Rubber Corporation v. Universal Rubber Products Inc., et.al.* G.R. No. L-27906, 08 Jan. 1987.
⁹ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.