BENNETT A. GO, Opposer, **-versus-** **PRIMAL ENTERPRISES CORPORATION,** Respondent-Applicant.	}	**IPC No. 14-2010-00087** Opposition to: Appln. Serial No. 4-2009-008801 Date Filed: 03 September 2009 **TM: "XENON-PRO"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 248 dated October 07, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 07, 2014.

For the Director:

Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

BENNETT A. GO,
Opposer,

-versus-

PRIMAL ENTERPRISES CORPORATION,
Respondent-Applicant.

IPC No. 14-2010-00087
Opposition to:

Appln. Serial No. 4-2009-008801
Date Filed : 03 September 2009
Trademark: **"XENON-PRO"**

Decision No. 2014 - 248

DECISION

BENNET A. GO, ("Opposer")[1] filed an opposition to Trademark Application Serial No. 4-2009-008801. The application, filed by PRIMAL ENTERPRISES CORPORATION (Respondent-Applicant"),[2] covers the mark "XENON-PRO" for use on "igniter, ballasts, wire for HID, parts, components; automotive bulbs, industrial bulbs, household lighting, halogen bulbs, HID lamp" under classes 09 and 11, respectively of the International Classification of Goods and Services[3].

The Opposer alleged:

"The grounds of the opposition are as follows:

"1. The approval of the application in question is contrary to Section 123.1(d) of the IP Code.

"2. The approval of the application in question will violate Opposer's right to the exclusive use of his registered trademark 'XENON BULBS AND LOGO Consisting of the Representation of a Half-Moon and Electricity'.

"3. The approval of the application in question has caused and will continue to cause great irreparable damage and injury to herein Opposer.

"4. Respondent-applicant is not entitled to register the trademark 'XENON-PRO' in its favour.

"Opposer will rely on the following facts to support his opposition:

"1. That last August 6, 2004, Opposer applied for the registration of the trademark 'XENON BULBS AND LOGO Consisting of the Representation of a Half-Moon and Electricity' for use on various kinds of light bulbs. Last February 12, 2007, the said trademark was registered in favour of Opposer under registration No. 4-2004-007054, which registration continues to be in full force and effect.

"2. That Opposer, through his exclusive distributor, Hummer Phils., Inc. has continued the use of his registered trademark 'XENON BULBS AND LOGO Consisting of the Representation of a Half-Moon and Electricity'.

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1 With postal address at 20 Don Pedro Street, Quezon City.
2 With address at 8 Miller Street, Barangay Bungad, Quezon City.
3 The Nice Classification of goods and services is for registering trademark and service marks, based on a Multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

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x x x

"3. That the trademark 'XENON-PRO' being applied for registration by respondent-applicant is confusingly similar, if not identical to Opposer's registered trademark 'XENON BULBS AND LOGO Consisting of the Representation of a Half-Moon and Electricity'. Hence, the approval of respondent's application is contrary to Section 123.1(d) of the IP Code.

x x x

"4. That the approval of the application in question is violative of the right of Opposer to the exclusive use of his registered trademark 'XENON BULBS AND LOGO Consisting of the Representation of a Half-Moon and Electricity' as provided by Section 147 of the IP Code. Hence, its approval has caused and will continue to cause great and irreparable damage and injury to Opposer.

"5. That clearly, respondent-applicant is not entitled to register the trademark 'XENON-PRO' in its favour under the IP Code.

The Opposer's evidence consists of the following

1. Exhibit "A"	-	Certificate of Registration No. 4-2004-007054 dated 12 February 2007 for the trademark 'XENON BULBS AND LOGO Consisting of the Representation of a Half-Moon and Electricity' for use on various kinds of light bulbs;
2. Exhibit "B"	-	Declaration of Actual Use for Application/Registration No. 4-2004-007054;
3. Exhibits "C"-"C-12"-		Official receipts and charge invoices of Hummer Phils., Inc. indicating sale of products of the trademark 'XENON BULBS AND LOGO consisting of the Representation of a Half-Moon and Electricity';
4. Exhibit "D"	-	Printout of respondent's Application Serial No. 4-2009-008801; and,
5. Exhibit "E"	-	Affidavit of BENETT A. GO.

On 17 August 2010, Respondent-Applicant filed its Answer alleging the following affirmative defense:

"2.1 The mark herein opposed is XENON-PRO for the following goods – igniter, ballasts, wire for HID, parts, components falling under class 9 and automotive bulbs, industrial bulbs, household lighting; Halogen bulbs, hid lamps falling under Class 22.

"2.1.1 On the other hand, the Opposer owns the mark XENON BULBS and LOGO.

"2.1.2 Clearly, the common word in the competing marks is XENON.

"2.2 In this regard, XENON is an element which in chemistry is part of the noble gas family. On the other hand, noble gas if a family of elements which are used as filaments for lighting systems. The other members of the halogen family are NEON, KRYPTON etc. In this regard, neon is used for neon lighting system for advertising, halogen in general is used for high density lamps, krypton is presently used for flash lights while xenon is widely used for high density illumination.

"2.2.1 Thus, when it comes to electric bulbs/lights – halogen (or all of its family members) are terms that should be considered as generic, i.e. neon lights, halogen lights, xenon bulbs, and the like. Being generic, halogen, neon and xenon words are not capable of exclusive appropriation. Thus, Opposer has no right to oppose the registration of the mark XENON PRO because the Respondent has all the right to use the word XENON for goods covering lighting fixtures.

"2.2.2 If not, it is with due respect that the word 'paper' can be registered for drinking cups made of paper; or 'plastic' for drinking cups made of plastic; or 'rubber' for tires made of rubber.

"2.3 On the other hand, existing jurisprudence dictates that a generic term may be part of a mark if in essence it is presented together with other registrable portion which is this case is XENON and PRO.

"2.4 The box showing primal.

"2.6 The buyers are very intelligent.

"3.0 If ever, the registration of the mark XENON bulbs by Opposer if not to be cancelled for being generic, should be amended to reflect that XENON is to be disclaimed apart from the composite mark presented in the registration."

The Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" - Affidavit of Charlie Tiu; and,
2. Exhibit "2" - Wikipedia article on Noble Gases downloaded from internet.

On 19 August 2010, Opposer filed its Reply. Thereafter, the preliminary conference was called and terminated, and pursuant to Order No. 2011-1012 dated 15 July 2011, this instance case is deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark XENON-PRO?

It is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article or 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.[4]

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 03 September 2009, the Opposer has already an existing trademark registration for the mark "XENON BULBS AND LOGO Consisting of the Representation of a Half-Moon and Electricity" bearing Registration No. 4-2004-007054 issued on 12 February 2007.[5] In fact, Opposer has shown the continuous and actual use of its registered mark by presenting official receipts and charge invoices of Hummer Phils., Inc. indicating sale of products bearing the said mark.[6]

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?

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4 Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.
5 Exhibit "A" of Opposer.
6 Exhibits "C" to "C-12" of Opposer.

Opposer's Trademark

XENON-PRO

Respondent-Applicant's Trademark

The contending marks consist of the identical word mark "XENON". This is the feature that gives the marks their distinctive property. Because the goods covered by both marks are similar and/or related for goods falling under class 11, particularly light bulbs, there is the likelihood that consumers will have the impression that the parties as well as their respective goods are connected to each other.

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.[7] The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:[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. Hence, 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.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

The Respondent-Applicant raised an affirmative defense that the word XENON is generic, and therefore, it has the right to use the word for goods covering lighting fixtures since the word is "not capable of exclusive appropriation".[9]

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7 American Wire and Cable Co. v. Director of Patents, et al., (31 SCRA 544) G.R. No. L-26557, 18 February 1970.
8 Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.
9 Par. 2.2.1, page 2 of Answer.

As a rule, generic marks are non-registrable.[10] Generic marks comprise the genus of which the particular product is a species.[11] In this regard, XENON is described as a chemical and physical property which normally is a colorless gas but emits a blue glow when excited by an electrical discharge.[12] Certainly, it is not the name or descriptive of "igniter, ballasts, wire for HID, parts and component" which are indicated in the Respondent-Applicant's trademark application. Neither is XENON the generic name or descriptive of the term "light bulbs and lamps". While it may be true that XENON is used for lighting system, it is generic term or descriptive term only if the good is specifically XENON lights or lamps. One cannot say, for example, that an incandescent light bulb is known as the XENON bulb and vice-versa. Ironically, assuming arguendo, that XENON is a generic term for electric light bulbs/lamps, the more reason to reject the Respondent-applicant's trademark application.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2009-008801 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 October 2014.

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

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10 Sec. 123.1(h), R.A. No. 8293.
11 Societe Des Produits Nestle v. Court of Appeals, et al., G.R. No. 112012, April 4, 2001.
12 Xenon Facts, available at http://chemistry.about.com/od/element facts/a/xenon/htm (last accessed 07 August 2014).