



OCCIDENTAL CHEMICAL CORPORATION,  
Opposer,

-versus-

OXYCHEM CORPORATION,  
Respondent-Applicant.

x-----x

IPC No. 14-2011-00285

Opposition to:

Appln. Serial No. 4-2009-007342

Filing Date: 23 July 2009

TM: "OXYCHEM CORPORATION  
AND LOGO"

### NOTICE OF DECISION

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140 L.P. Leviste St., Salcedo Village  
Makati City

**OXYCHEM CORPORATION**  
c/o **SHELA B. REYES**  
Respondent-Applicant  
No. 50 San Joaquin Street, Brgy. Plainview  
Mandaluyong City

#### GREETINGS:

Please be informed that Decision No. 2014 - 318 dated December 05, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 05, 2014.

For the Director:

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



<b>OCCIDENTAL CHEMICAL CORPORATION,</b>	}	<b>IPC NO. 14-2011-00285</b>
Opposer,	}	Opposition to:
	}	
-versus-	}	Appln. Ser. No. 4-2009-007342
	}	Filing Date: 23 July 2009
	}	
<b>OXYCHEM CORPORATION</b>	}	Trademark: <b>OXYCHEM</b>
Respondent-Applicant.	}	<b>CORPORATION AND LOGO</b>
x-----x	}	Decision No. 2014- <u>318</u>

**DECISION**

OCCIDENTAL CHEMICAL CORPORATION, (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2009-007342. The application, filed by OXYCHEM CORPORATION (Respondent-Applicant)<sup>2</sup>, covers the mark “OXYCHEM CORPORATION ANG LOGO”, for use on “disinfectant concentrate, sanitizer, oven cleaner, carpet shampoo, fuel, gel, chafing dish, wax stripper, all purpose detergents, windshield cleaner, tire black degreaser, dashboard polish, water marks remover, radiator coolant, radiator cleaner, smokehouse cleaner, table top sanitizer, stainless cleaner, liquid hand soap, chlorinated alkaline cleaner, rust and scale cleaner, liquid detergent for food industry, powder bleach, oxygen bleach, anti-yellowish agent, alkali, laundry starch, softener paint and oil greaser remover, rust stain cleaner, fabric freshener, fabric cologne, dry cleaning solution, buffable emulsion wax, stone polish, automatic dishwashing machine cleaner, drying agent for automated dishwashing machine, tub and tile cleaner, insecticide-food grade, juice dispenser cleaner, special dishwashing solution, flame wax solution, and other products for industrial and institutional industry products related to preventive maintenance chemicals namely, cleaning chemicals for washing stainless surfaces and cleaning-in-place (cip) cleaning chemical solution food industry, vegetable peeler” under Class 3 and 8 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the following grounds:

“The mark OXYCHEM is confusingly similar, AND IS IN FACT IDENTICAL, to Opposer’s trademark OXYCHEM and cannot be registered under Sec. 123 (d), Rep. Act No. 8293.

The Respondent-Applicant adopted the same mark OXYCHEM in bad faith and with full knowledge of the prior existence and fame of Opposer’s mark as shown by the imitative logo type and lettering displayed on Respondent’s mark”

<sup>1</sup> A foreign corporation with address at 5005 LBJ, Freeway, Dallas, Texas 75224, USA

<sup>2</sup> A domestic corporation with address at #50 San Joaquin Street, Brgy. Plainview, Mandaluyong City 1550

<sup>3</sup> The nice Classification of Goods and Services is for registering trademarks and service marks based on 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.

According to the Opposer:

"1. OCCIDENTAL CHEMICAL CORPORATION ('Opposer') is a wholly owned subsidiary of OCCIDENTAL PETROLEUM CORPORATION ('OPC'), a public company whose shares are traded on the NEW YORK STOCK Exchange. Opposer is a well-known chemical manufacturer with headquarters in the United States of America ('US'). For every product it makes, Opposer's market position is number 1 to 2 in the U.S. and number 1,2, or 3 in the world. Accordingly, Opposer's use of the mark OXYCHEM is well known.

"2. The mark OXYCHEM was first used by OPC or Opposer in the 1960s. 142 registrations of the mark in 65 countries have been obtained since 1968. Opposer currently owns 109 registrations for the mark in 61 countries and in the Europe community.

"3. The Opposer is the owner of the world famous trademark OXYCHEM which was first adopted on or about September 1968. Attached as Annex 'A' (Exh. G') is a list of registration/applications for the mark OXYCHEM owned by Opposer in various countries.

"4. Annex 'B' (Exh. 'F') is a certified true copy of Opposer's US Reg. no. 1,457,861 issued on September 12, 1987 and shows the current registration of the mark in its home country. Annex 'C' (Exh. 'G') is a certified copy of the Opposer's Reg. No. 893.532 showing earliest registration of the mark at least as of June 30, 1970.

"5. Opposer also owns Trademark Registration No. 54893 in the Philippines. Presented herewith as Annex 'D' (Exh. 'H') is a copy of the trademark registration issued in the Philippines. Annex 'D-1' (Exh. 'H-1') shows the details of this registration as published in the website of the Intellectual Property Office of the Philippines (IPO).

"6. Presented as Exhibit 'I' of this opposition is an Affidavit of lawyer Roane Alfredo P. Lopez III who obtained issuance of Opposer's Reg. No. 54893 for OXYCHEM and who currently maintains the aforesaid registration. Xxx

"7. Opposer has built its goodwill and reputation through extensive use and advertisement of the mark OXYCHEM worldwide. The worldwide sales from 2006-2010 under the mark OXYCHEM have been:

YEAR	AMOUNT
2006	US\$4,531,908,000
2007	US\$4,584,024,000
2008	US\$4,993,362,000
2009	US\$3,011,752,000
2010	US\$3,741,484,000

“8. Opposer has actually sold products bearing the mark in the Philippines through its distribution in the Philippines. Attached as Annexes ‘E’ to ‘I’ are copies of invoices evidencing sales in the Philippines. Attached as ‘Annexes ‘K’ and ‘L’ are photographs of packaging in which goods are shipped to the Philippines. Annexes E to L show Opposer’s mark OXYCHEM as used.

“9. Opposer has diligently promoted and advertised the mark. Philippine customers are exposed to such promotion and advertisement when they (like many customers) access the following website:

[www.oxy.com](http://www.oxy.com)

“10. As creator and originator of the mark OXYCHEM, Opposer’s use of the mark OXYCHEM is much earlier than Respondent-Applicant’s use and adoption of the same mark with knowledge of the goodwill and popularity of Opposer’s mark. The visual similarity of Respondent’s mark to Opposer’s mark become apparent in a side-by-side comparison xxx”

To support its opposition, the Opposer submitted as evidence the following:

1. Legalized verification and certification against forum shopping dated 1 June 2011; Copy of Special Power of Attorney dated 1 June 2011;
2. Copy of Secretary’s Certificate dated 1 June 2011;
3. Sworn Statement of Mr. Scott A. King dated 9 June 2011;
4. List of Opposer’s registration of the mark OXYCHEM around the world;
5. Certified copy of US Registration No. 1,457,861 for the mark “OXYCHEM”;
6. Certified copy of US Registration No. 893,532 for the mark “OXYCHEM”
7. Copy of Reg. No. 54893 for the mark “OXYCHEM” and print-out of IPO webpage showing registration details of the mark “OXYCHEM”;
8. Affidavit of Roane Alfredo P. Lopez dated 9 July 2011;
9. Invoices showing “OXYCHEM” mark on the letterhead;
10. Photograph of Opposer’s Sodium Metasilicate packaging with “OXYCHEM” logo; and
11. Photograph of Opposer’s Dry Caustic Potash packaging with “OXYCHEM” logo.

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 24 August 2011. The Respondent-Applicant, however, did not file an Answer. Thus, the Hearing Officer issued on 5 January 2012 Order No. 2012-24 declaring the Respondent-Applicant to have waived its right to file an Answer.

Section 123.1 (d) of Rep. Act No. 8293, also known as the intellectual Property Code of the Philippines (“IP Code”) provides:

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<sup>4</sup>Annexes “A” to “Q”

Sec. 123.1. Registrability. 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 at the time Respondent-Applicant applied for registration of the mark "OXYCHEM" the Opposer already registered the mark "OXYCHEM" under Certificate of Registration No. 54893. The goods covered by the Opposer's trademark registration are also under Class 1, 17 and 19, namely: "cementitious composite materials in the form of a dry mix for producing shaped articles. Plastics in the form of sheets, industrial chemicals, namely chlorine, caustic soda, phosphorous, phosphoric acid, sulfur monochloride<sup>4</sup>, ammonia etc.. These goods are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application.

The competing marks, depicted below, are practically identical:

**OXYCHEM**

Opposer's mark



Respondent-Applicant's mark

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 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.<sup>5</sup>

Succinctly, because the Respondent-Applicant uses or will use the mark OXYCHEM on goods that are identical and/or closely related to the Opposer's it is likely that the consumers will have the impression that these goods originate from a single source or origin

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<sup>5</sup>Pribhdas J. Mirpuri v Court of Appeals, G. R. No. 114508, 19 November 1999.

A handwritten signature in blue ink, consisting of a stylized 'A' followed by a checkmark-like flourish.

or mislead them into believing that the patties are connected to each other. The confusion or mistake would subsist not only the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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, through the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff's 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.<sup>6</sup>

The public interest, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented.

**WHEREFORE**, premises considered, th instant Opposition to Trademark Application No. 4-2009-007342 is hereby **SUSTAINED**. Let the file wrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 5 December 2014.

  
**Atty. NATHANIEL S. AREVALO**  
Director IV  
Bureau of Legal Affairs

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<sup>6</sup>Converse Rubber Products, Inc., et. al., G. R. No. L-27906, 08 January