



KIMBERLY-CLARK WORLDWIDE, INC.,
Opposer,

-versus-

LYNX-NIA MEDICA, INC.,
Respondent-Applicant.

IPC No. 14-2009-00237

Opposition to:

Application No. 4-2008-015044

Date filed: 15 December 2008

TM: "CLEANIT"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 40 dated March 31, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 31, 2015.

For the Director:


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



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DECISION

KIMBERLY -CLARK WORLDWIDE, INC. ("Opposer"),¹ filed an opposition to the Trademark Application Serial No. 4-2008-015044. The application filed by LYNX-NIA MEDICA, INC. ("Respondent-Applicant"),² covers the mark "CLEANIT" for use on "all purpose cleaner, powder detergent, dishwashing liquid, fabric softener, disinfectant cleaner, hand wash, odor absorber, toilet bowl cleaner, gadget cleaner" under Class 03 and "insect repellent" Class 05 of the International Classification of Goods.³

The Opposer alleges among others, that the registration of CLEANIT is proscribed under Section 123.1(d), (e), (f) and Section 147.1 of the IP Code and Article 16.1 of the TRIPS Agreement because it is confusingly similar to the KLEENEX trademark which covers similar or closely related goods. According to Opposer, KLEENEX was adopted, used, and registered in the Philippines, and also in the United States and other countries across prior to the filing of the application for registration of the CLEANIT mark on 15 December 2008.

Opposer's evidence consists of the following:

1. Exhibit "A" - Authenticated Affidavit of Gregg Marrazzo;
2. Exhibit "B" to "F" - copies of KCWWI's books and records;
3. Exhibit "G" - certified copy of the Certificate of Registration No. 1857 issued on 05 August 1977 for the trademark KLEENEX;
4. Exhibit "G-1" - certified copy of the Certificate of Renewal of Registration No. R- 1857 issued on 05 August 1997 for the trademark KLEENEX;
5. Exhibit "G-2" - certified copy of the Certificate of Registration No. 56729 issued on 17 December 1993 for the trademark KLEENEX;
6. Exhibit "G-3" - certified copy of the Certificate of Registration No. 4-1997-120166 issued on 23 July 2001 for the trademark KLEENEX (Script); Exhibits "H" to "H-5" - Declaration of

¹ A corporation duly organized and existing under the laws of the State of Delaware, U.S.A. with principal address at 401 North Lake Street, Neenah, Wisconsin 54956 U.S.A, filed an opposition to Trademark Application Serial No. 4-2008-15044.
² A domestic corporation, with principal office address at 1033 Kabatuhan Street, Mapulang Lupa, Valenzuela City.
³ The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

Actual Use attesting to the actual commercial use and the date of first use of the KLEENEX mark in the Philippines;

7. Exhibit "G-4" - certified copy of the Certificate of Registration No. 4-1998-004227 issued on 30 October 2004 for the trademark KLEENEX EXPRESSIONS;
8. Exhibit "G-5" - certified copy of the Certificate of Registration No. 4-2005-001585 issued on 18 September 2006 for the trademark KLEENEX PETITE;
9. Exhibit "G-6" - certified copy of the Certificate of Registration No. 4-2006-001524 issued on 25 June 2006 for the trademark KLEENEX CLUB;
10. Exhibit "G-4" - certified copy of the Certificate of Registration No. 4-1998-004227 issued on 30 October 2004 for the trademark KLEENEX EXPRESSIONS;
11. Exhibits "H" to "H-5" - Declaration of Actual Use attesting to the actual commercial use and the date of first use of the KLEENEX mark in the Philippines; and
12. Exhibits "I" to "I-12" - Certificate Registrations of the mark KLEENEX issued in Australia, United States of America, Thailand, India, Brazil, Mexico, Peru, South Africa, OHIM, United Kingdom and Italy.

This Bureau issued on 23 October 2009 a Notice to Answer and personally served a copy thereof upon the Respondent-Applicant's representative on 12 November 2009. On 15 December 2009, the Respondent-Applicant filed its Answer alleging, among others, that the Opposer KCWWI has absolutely no factual and legal bases in opposing respondent-applicant's for registration of CLEANIT as trademark for cleaning products because CLEANIT! and KLEENEX are phonetically and visually different from each other and involves different goods since respondent's goods are cleansing products while Opposer's products are more of a personal care products.

Respondent-Applicant's evidence consists of the following:

1. Exhibits "1" to "7" - sample labels and packaging of Respondent's products where the mark CLEANIT appears;
2. Exhibits "8" to "14" - sample labels and packaging of Opposer's product bearing the KLEENEX mark.

After the termination of the preliminary conference, the Opposer filed its Position Paper on 24 May 2010 while Respondent-Applicant did so on 09 June 2010.

Should the Respondent-Applicant be allowed to register the mark CLEANIT?

The essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into a 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 products.⁴ Thus, Section 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with the registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect to the same goods or services or closely related goods and services, or if it nearly resembles such a mark as to be likely to

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents*, 16 SCRA 495.

deceive or cause confusion.

It is undisputed that at the time the Respondent-Applicant filed its application for registration of the mark CLEANIT on 15 December 2008, Opposer already has an existing registrations of the mark KLEENEX, the earliest of which bears Registration No. 1857 issued on 05 August 1977⁵, and has duly filed the Affidavit of Use for the 5th⁶, 10th⁷, and 15th⁸ Anniversary. Undoubtedly, Opposer's application and registration preceded that of Respondent-Applicant's.

A comparison of the parties' marks are depicted below:



Opposer's Marks



Respondent-Applicant's Mark

A scrutiny of the competing marks shows that they are not confusingly similar. The marks when compared to each other are visually different except for the fact that they both contain seven letters. Aurally, the marks are also different. Opposer's mark is pronounced with a long "e" sound in the middle and ends with "ks" sound while Respondent-Applicant's mark is pronounced with a short "e" sound in the middle and ends with the "t" sound. Hence, Opposer's mark can easily be distinguished from that of Respondent-Applicant's.

Moreover, the likelihood of confusion or deception is also farfetched because the two marks deal with different goods. Opposer's goods belong to Class 16 namely, *facial tissue, toilet tissue, paper towels, paper table napkins and disposable towels and wipers* and under Class 10 namely, *absorbent pads or sheets for removing cold cream* while that of Respondent-Applicant's goods belong to Class 5 namely, *all purpose cleaner, powder detergent, dishwashing liquid, fabric softener, disinfectant cleaner, hand wash, odor absorber, toilet bowl cleaner, gadget cleaner* and under Class 5 for *insect repellants*. Hence, the public will not likely be confused or deceived into believing that the goods of Respondent-Applicant is sourced from the Opposer or vice-versa.

As to Opposer's claim that its mark KLEENEX is well-known and protected under Sec. 123 (e) and (f) of the IP Code because it has been used in the Philippines since 1957 and it has substantial

⁵ See Exhibits "G",

⁶ See Exhibit "H-3", "H-2"; "H-4" and H-5".

⁷ See Exhibit "H".


⁸ See Exhibit "H-1".

market share, extensive marketing and sale, and aggressive promotion in the Philippines, the same is now immaterial in this case. It must be emphasized that protection accorded to well-known marks applies only when there is a finding of confusing similarity between the competing marks. In this case, there is none.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application No. 4-2008-015044 returned together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 March 2015.


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