



GOLDEN ABC, INC.,
Opposer,

-versus-

JOHNSON & JOHNSON,
Respondent-Applicant.

} IPC No. 14-2009-00230
} Opposition to:
} Appln No. 4-2008-000213
} Date Filed: 07 January 2008
} TM: "OXYGEN FRESH"
}
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}
}

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NOTICE OF DECISION

OFFICE OF BAGAY-VILLAMOR & FABIOSA
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GREETINGS:

Please be informed that Decision No. 2015 - 176 dated September 03, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 03, 2015.

For the Director:

MARILYN S. RETUTAL
IPRS IV, Bureau of Legal Affairs



GOLDEN ABC, INC.,

Opposer,

-versus-

JOHNSON & JOHNSON

Respondent-Applicant.

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IPC No. 14-2009-000230

Opposition to:

Application No. 4-2008-000213

Date Filed: 07 January 2008

Trademark: "OXYGEN
FRESH"

Decision No. 2015- 176

DECISION

GOLDEN ABC, INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2008-000213. The application, filed by JOHNSON & JOHNSON² ("Respondent-Applicant"), covers the mark "OXYGEN FRESH" for use on "sanitary protection products and pantliners" under Class 05 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"GROUND FOR THE OPPOSITION

x x x

"2. The Opposer since June 14, 1990, has been engaged in the retail business, selling men's and women's wearing apparel, toilette/bath and personal care products, fashion accessories, and paper products bearing the trademark 'OXYGEN' in various department stores, boutiques, outlets and specially stores nationwide. The Opposer operates a total of 42 company-owned 'OXYGEN' boutiques and up to 27 'OXYGEN' concessionaire outlets in major department stores nationwide.

"3. As early as May 10, 1991, the Opposer filed an application for registration of the word 'OXYGEN' as a trademark for Classes 18, 24, and 25 and was subsequently granted registration on July 2, 1993. x x x

"4. When Trademark Certificate of Registration No. 055534 expired, the Opposer applied for the registration of the 'OXYGEN' wordmark and obtained new registrations thereof in Classes 18, 24, and 25. x x x

¹A domestic corporation organized and existing under the laws of the Philippines with principal address at 880 A.S. Fortuna Street, Banilad, Mandaue City, Cebu.

²A foreign corporation with address at One Johnson & Johnson Plaza, New Brunswick, New Jersey, U.S.A.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"5. The Opposer has the following trademark registrations and application for OXYGEN in Class 3: x x x

"6. The Opposer has the following trademark registrations and application for OXYGEN AND DEVICE: x x x

"7. Other than the foregoing trademark registrations for OXYGEN on several Classes, the Opposer likewise applied for and registered a number of 'sub-brands' for its OXYGEN products under Class 3. These are the following: x x x

"8. In addition, the Opposer also uses the sub-brands 'STATIC' and 'G.A.S.' for its OXYGEN products under Class 3.

"9. The Opposer's trademark registration of 'OXYGEN and DEVICE' for Class 03 (x x x) covers the following products: perfumery products namely roll-on and spray; colognes, toilet water and toilet lotions, shampoos, soaps, lathering and softening products for use in bath, toothpaste, cosmetics make-up, eyeliner, eye shadow, blush-on power, lipstick, facial cleanser, moisturizer, hair dyes, hair gels and nail polish.'

"10. Since its adoption in 1990 and its continued use in commerce up to the present day, the 'OXYGEN' trademark has been developed and has been applied for trademark registration for products related to clothing. This same mark was extensively advertised by the Opposer in the Philippines on the following products: shirts, jackets, jeans, footwear, sandals, shoes, towels, bags, socks, handkerchiefs, as well as perfumes, eau de toilette, body sprays, bath soaps, underwear, trinkets, bracelets, and other fashion accessories and paper products. x x x

"11. The Opposer is filing this Opposition against the registration of the mark 'OXYGEN FRESH' on the ground that it creates confusion of origin, source, and business - causing injury and damage on the original trademark 'OXYGEN.'

x x x

"12. Even a cursory look would readily reveal that OXYGEN FRESH is confusingly similar to OXYGEN. It is obvious that the dominant feature of OXYGEN FRESH is the word 'OXYGEN'. The word FRESH in OXYGEN FRESH simply means AIRY, CLEAR, CLEAN, BREEZY COOL, or REFRESHING - such that OXYGEN FRESH could also be called 'OXYGEN AIRY,' 'OXYGEN CLEAR,' 'OXYGEN CLEAN,' 'OXYGEN BREEZY COOL,' or 'OXYGEN REFRESHING.' In other words, any variation of the word FRESH may be interchanged or substituted with the FRESH in OXYGEN FRESH. The bottom line therefore is the word 'OXYGEN,' which is already registered in favor of the Opposer.

"13. In McDONALD'S CORPORATION vs. MACJOY FASTFOOD CORPORATION, G.R. No. 166115, February 2, 2007, it was held:

x x x

"14. The ruling in the MACJOY case is applicable to the instant case. As stated above, the similarity between OXYGEN FRESH and OXYGEN is the dominant word 'OXYGEN.' As illustrated in paragraph 8 herein, the word FRESH in OXYGEN FRESH is but a minor difference. The aural impression created upon hearing the two marks is definitely the word 'OXYGEN.'

"15. Applying the dominancy test, OXYGEN FRESH and OXYGEN are confusingly similar with each other such that an ordinary purchaser can conclude an association or relation between the marks.

"16. In the MACJOY case, the Supreme Court cited with approval the IPO's finding:

x x x

"17. In the same vein, the differences and variations in the styles and fonts of OXYGEN FRESH and OXYGEN are but miniscule variations that are overshadowed by the predominant word 'OXYGEN.'

"18. In the case of SOCIETE DES PRODUITS NESTLE, S.A., et. al., vs. COURT OF APPEALS, et. al., G.R. No. 112012, April 4, 2001, the Supreme Court also quoted with approval the BPTTT's finding that:

x x x

"19. In the same manner, when one looks at OXYGEN FRESH, one's attention is easily attracted to the word 'OXYGEN.'

x x x

"20. The Opposer has priority over the Respondent because the latter's use and dates of registration for the 'OXYGEN' Family of Marks precede the dates of filing of the Respondent's subject trademark application, which was filed only on January 7, 2008. As early as May 10, 1991, the Opposer filed an application for registration of the word 'OXYGEN' as a trademark for Classes 18, 24, and 25 and was subsequently granted registration on July 2, 1993.

"21. The Opposer has 19 other trademark registrations for OXYGEN in different classes, as stated in the Statement of Facts herein.

x x x

"22. The Respondent's proposed mark will dilute the strength of the Opposer's registered 'OXYGEN' marks as unique indicators of the source of the Opposer's goods, especially that the Opposer's registrations of the mark 'OXYGEN' are spread in different classes. The Respondent's proposed mark will lessen the capacity of the Opposer's distinctive 'OXYGEN' marks to distinguish and identify the Opposer's goods from those of others, thereby diluting the distinctive quality of the 'OXYGEN' marks. Dilution of the marks is the damage that this opposition seeks to obviate. Moreover, the Opposer's products project a clean image (i.e., shirts, jackets, jeans, footwear, sandals, shoes, towels, bags, socks, handkerchiefs, as well as perfumes, eau de toilette, body sprays, bath soaps, underwear, trinkets, bracelets, and other fashion accessories and paper products) while the sanitary protection products of the Respondent hold menstrual waste - which is opposite of what the Opposer's products project.

"23. Moreover, if the subject mark is allowed registration, this will forestall the normal potential expansion of the Opposer's business and will likely to lead to a confusion of source, as prospective purchasers would be misled into thinking that the Opposer has extended its business into the field.

x x x

"24. In another case before this Honorable Bureau involving herein Opposer and its 'OXYGEN' marks, (Golden ABC, Inc. vs. Beiersdorf AG, IPC No. 14-2007-00257), the application for the registration of the mark 'OXYGEN FRESH' was rejected for being confusingly similar to the Opposer's 'OXYGEN' marks. Page 10 of this Honorable Bureau's Decision in that case held:

x x x

"25. The Opposer humbly posits that the above cited Decision of this Honorable Bureau is equally applicable in this case.

The Opposer's evidence consists of a copy of Trademark Certificate of Registration No. 055534 for the "OXYGEN" mark in favor of the Opposer; a copy of Trademark Certificate of Registration No. 4-2008-008805 for Class 18; a copy of Trademark Certificate of Registration No. 4-2008-008806 for Class 24; a copy of Trademark Certificate of Registration No. 4-2008-008807 for Class 25; a copy of Trademark Certificate of Registration No. 4-2008-008804 for Class 3; a copy of Trademark Certificate of Registration No. 4-2008-003878 for Class 3; a copy of Trademark Certificate of Registration No. 4-1999-009819 for Class 9; a copy of Trademark Certificate of Registration No. 4-1997-117884 for Class 16; a copy of Trademark Certificate of Registration No. 4-1997-117888 for Class 25; a copy of Trademark Certificate of Registration No. 4-1999-009826 for Class 34; a copy of Trademark Certificate of Registration No. 4-1997-117887 for Class 42; a copy of Trademark Certificate of Registration No. 4-2008-008808 for Class 35; a copy of Trademark Certificate of Registration No. 20-2008-000012 for Class 35; a copy of Trademark Certificate of Registration No. 4-2006-004656 for the mark "RAGE" under Class 3; a copy of Trademark Certificate of Registration No. 4-2006-008721 for the mark "EDGE" under Class 3; a copy of Trademark Certificate of Registration No. 4-2003-011167 for the mark "FLUID" under Class 3; a copy of Trademark Certificate of Registration No. 4-2005-010297 for the mark "CHILLED" under Class 3; a copy of Trademark Certificate of Registration No. 4-2004-011974 for the mark "11:55" under Class 3; a copy of Trademark Certificate of Registration No. 4-2007-003044 for the mark "DARK" under Class 3; a copy of Trademark Certificate of Registration No. 4-2007-008051 for the mark "NITRO2" under Class 3; copies/samples of advertising materials of the Opposer for the mark "OXYGEN".⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 14 October 2009. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark OXYGEN FRESH?

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

Records show that at the time the Respondent-Applicant filed its trademark application on 07 January 2008 for the mark "OXYGEN FRESH", the Opposer already owns trademark registrations for the mark "OXYGEN" and its variations particularly, No. 55534 for the mark OXYGEN (in stylized form), No. 4-2000-003878 for the mark OXYGEN & DEVICE, No. 4-1999-009819 for the mark OXYGEN & DEVICE, No. 4-1997-117884 for the mark OXYGEN AND DEVICE, No. 4-1997-117888 for the mark OXYGEN & DEVICE, No. 4-1999-009826 for the mark OXYGEN & DEVICE, and No. 4-1997-117887 for the mark OXYGEN AND DEVICE (CONSISTS OF A SMALL OBLONG FIGURE AND THE NUMBER "2" PRINTED ON TOP OF THE FIGURE. THE SAID DEVICE APPEARS ABOVE THE WORD "OXYGEN"). The registrations cover shirts, t-shirts, polo shirts, pants, jeans, shoes, towels, belts, socks, patches, handkerchiefs, shorts, canvas bags, leather bags, plastic bags (Classes 18, 24 & 25), perfumery products especially perfumes (roll-on and/or spray) colognes, toilet water and toilet lotions, shampoos, soaps, lathering and softening products for use in bath, toothpaste, cosmetics, make-up, eye-liner, eye shadow, blush-on powder, lipstick, facial cleanser, facial moisturizer, toilet products against perspiration, hair dyes, hair gels, powder and nail polish (Class 3), mouse pads and sunglasses (Class 9), paper and paper articles, cardboard and cardboard articles, goods made from paper and cardboard, printed matter, stationery namely, paper writing products (with and without designs), paper sheets, adhesive tapes, cards, pens, writing materials, envelopes and folders, paper packages, cardboard packages, plastic materials for packaging, pencils, cases for pens and pencils, wrapping paper, greeting cards, tags and calendars (Class 16), ashtrays (Class 34), retailing of clothing and accessories (Class 42).

The marks are shown below:

OXYGEN


OXYGEN

OXYGEN FRESH

Opposer's trademark

Respondent-Applicant's mark

The competing marks are practically identical. The fact that the Respondent-Applicant's mark consists of the combination of the words "OXYGEN" and "FRESH" is of no moment. The word "OXYGEN" as a trademark is highly distinctive in respect of the goods involved. In this regard, the Respondent-Applicant's trademark application covers "sanitary protection products and pantliners" under Class 05, goods that are closely-related to Opposer's products, including shirts, jackets, jeans, footwear, sandals, shoes, towels, bags, socks, handkerchiefs, as well as perfumes, eau de toilette, body sprays, bath soaps, underwear, trinkets, bracelets, and other fashion accessories and paper products, particularly, wearing apparel and personal items. Thus, it is likely that

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the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only on 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, 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.⁵

Succintly, the consumers maybe misled to believe that the Respondent-Applicant's mark is just a variation of the Opposer's.

Public interest therefore 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. 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 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.⁶

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2008-000213 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 03 September 2015.


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

⁵ Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al., G.R. No. L-27906, 08 Jan. 1987.

⁶ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Eihepa v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).