



GOLDEN ABC, INC.,  
Opposer,

-versus-

CITIME FRANCE,  
Respondent-Applicant.

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}  
} IPC No. 14-2013-00101  
} Opposition to:  
} Appln. Serial No. 4-2012-004300  
} Date Filed: 04 October 2012  
} TM: "OXYGEN"  
}

**NOTICE OF DECISION**

**OFFICE OF BAGAY-VILLAMOR AND FABIOSA**

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Unit 107, Oakridge Business Center A  
No. 880 A. S. Fortuna Street  
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**BUCOY POBLADOR AND ASSOCIATES**


Counsel for Respondent-Applicant  
21<sup>st</sup> Floor, Chatham House  
116 Valero corner V.A. Rufino Streets  
Salcedo Village, Makati City

**GREETINGS:**

Please be informed that Decision No. 2015 - 243 dated November 04, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 04, 2015.

For the Director:

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



GOLDEN ABC, INC.,	}	IPC NO. 14-2013-00101
Opposer,	}	Case Filed on : 04 April 11, 20138
	}	
-versus-	}	Opposition to:
	}	App.Serial No. 4-2012-004300
CITIME FRANCE,	}	Date Filed: 10 April 2012
Respondent-Applicant.	}	TM: "OXYGEN"
	}	
x-----x	}	DECISION NO. 2015- <u>243</u>

DECISION

GOLDEN ABC, INC.,<sup>1</sup> ("Opposer") filed on 04 April 2013 an Opposition to Trademark Application Serial No. 4-2012-004300. The application, filed by CITIME FRANCE<sup>2</sup> ("Respondent-Applicant") covers the mark OXYGEN for use on "*precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; watches, horological and chronometric instruments*" under Class 14 of the International Classification of goods<sup>3</sup>.

Opposer opposes the application for registration on the ground that the subject mark "OXYGEN" is exactly the same as the Opposer's registered "OXYGEN" marks. According to Opposer, if the subject mark is allowed registration, this will lead to a confusion of source, as prospective customers would be misled into thinking that Respondent's Class 14 goods come from the Opposer, thus, the subject application should be rejected.

Opposer's evidence consists of the following:

1. Exhibit "A" - Trademark Certificate of Registration No. 55534 for the mark OXYGEN under Classes 18, 24 & 25;
2. Exhibit "B" - Trademark Certificate of Registration No. 4-2008- 008805 for the mark OXYGEN under Class 18;
3. Exhibit "C" - Trademark Certificate of Registration No. 4-2008- 008806 for the mark OXYGEN under Class 24;
4. Exhibit "D" - Trademark Certificate of Registration No. 4-2008- 008807 for the mark OXYGEN under Class 25;
5. Exhibit "E" - Trademark Certificate of Registration No. 4-2008- 008804 for the mark OXYGEN under Class 03;
6. Exhibit "F" - Trademark Certificate of Registration No. 4-2000- 003878 for the mark OXYGEN & DEVICE under Class 03;
7. Exhibit "G" - Trademark Certificate of Registration No. 4- 1997- 117888 for the mark OXYGEN & DEVICE under Class 25;

1 A domestic corporation, with business and postal address at 880 A.S Fortuna Street, Banilad, Mandaue City, Cebu.

2 A French entity with address at 162 Rue Du Faubourg Saint-Honore 75008 Paris, France.

3 The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

8. Exhibit "H" - Trademark Certificate of Registration No. 4- 1997- 117887 for the mark OXYGEN & DEVICE under Class 42;

9. Exhibit "I" - Trademark Certificate of Registration No. 4-2008- 008808 for the mark OXYGEN under Class 35;

10. Exhibit "J" - Trademark Application Serial No. 4-1999- 009821 for the mark OXYGEN & DEVICE under Class 14 which was removed from the register for non-use;

11. Exhibit "K" - copy of Trademark Application Serial No. 4-2013- 001834 for the mark OXYGEN under Class 14 filed on 19 February 2013;

On 12 April 2013, this Bureau issued a Notice to Answer, which notice was served personally to Respondent-Applicant's counsel on 19 April 2013. On 17 May 2013, Respondent-Applicant filed an Urgent Motion for Extension of Time to File Verified Answer which was granted. However, despite the extension of time given by this Bureau, Respondent-Applicant failed to file its verified answer. On 04 November 2013, an Order of Default was issued. Accordingly, pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended, the case is deemed submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the mark "OXYGEN"?

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>4</sup> Thus, Sec. 123.1 (d) of the IP Code 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 a mark as to be likely to deceive or cause confusion.

But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

The marks of the parties are reproduced below for comparison:

**OXYGEN**

Opposer's Marks

**OXYGEN**

Respondent-Applicant's Mark

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<sup>4</sup> See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 11450 8, 19 Nov. 1999.

There is no doubt that Opposer's and Respondent-Applicant's mark are identical.

The records show that at the time the Respondent-Applicant filed its application for the mark OXYGEN on 10 April 2012, the Opposer already has an existing registrations for its trademark OXYGEN covering goods falling under Classes 03, 18, 24 and 25; OXYGEN & DEVICE under Classes 03, 25, 35 and 42. As early as 1999, Opposer has applied for registration of its mark OXYGEN & DEVICE although it was removed from the register for non-filing of the declaration of actual use but Opposer continued to use it. On 19 February 2013, they filed an application for registration of the mark OXYGEN for goods under Class 14. On the other hand, Respondent-Applicant's mark OXYGEN is being applied for goods under Class 14.

Records will also show that as early as 1991, Opposer has been using the mark OXYGEN in apparels and bags. In the later years, the range of products where the mark was used expanded to bags; bed and table covers and towels; shoes, boots, flip-flops; perfumery; and trinket, watches, clocks and other accessories. Opposer's mark OXYGEN is also used in services like retailing of clothes and accessories as well as exporting, wholesaling, franchising, marketing and advertising. On the other hand, Respondent-Applicant's mark OXYGEN will be used in "precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; watches, horological and chronometric instruments" under Class 14. Considering that Opposer deals with fashion clothing and accessories and Respondent-Applicant's goods relates also to accessories like jewelry and watches, the goods of the parties are so related as to cause likelihood of confusion or mistake on the part of the consuming public as to the source or origin of goods.

In *Mighty Corporation, et. Al. v. E. & J. Gallo Winery*, the Supreme Court held:

A crucial issue in any trademark infringement case is the likelihood of confusion, mistake or deceit as to the identity, source or origin of the goods or identity of the business as a consequence of using a certain mark. Likelihood of confusion is admittedly a relative term, to be determined rigidly according to the particular (and sometimes peculiar) circumstances of each case. Thus, in trademark cases, more than in other kinds of litigation, precedents must be studied in the light of each particular case. There are two types of confusion in trademark infringement. The first is "confusion of goods" when an otherwise prudent purchaser is induced to purchase one product in the belief that he is purchasing another, in which case defendant's goods are then bought as the plaintiff's and its poor quality reflects badly on the plaintiff's reputation. The other is "confusion of business" wherein the goods of the parties are different but the defendant's product can reasonably (though mistakenly) be assumed to originate from the plaintiff, thus deceiving the public into believing that there is some connection between the plaintiff and defendant which, in fact, does not exist.

In this case, the diversity of the products or goods of Opposer and its long continued use of the mark OXYGEN in commerce has identified it as the source of goods bearing the mark OXYGEN. To allow the registration of Respondent-Applicant's identical mark will likely cause confusion or mistake on the public that Respondent-Applicant's goods originated or is sourced from Opposer or vice versa or that there is some connection between Opposer and Respondent-

Applicant.

Furthermore, the trademark owner is entitled to protection when the use of a same mark would forestall the normal expansion of the business. Thus, the Supreme Court in McDonald's Corporation and McGeorge Food Industries, Inc. v. L.C. Big Mak Burger, Inc.<sup>5</sup>, enunciated that:

The registered trademark owner may use his mark on the same or similar products, in different segments of the market, and at different price levels depending on variations of the products for specific segments of the market. **The Court has recognized that the registered trademark owner enjoys protection in product and market areas that are the normal potential expansion of his business.** Thus, the Court has declared:

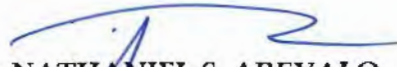
Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade-mark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148 ALR 56 et seq; 53 Am Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business (v. 148 ALR, 77, 84; 52 Am. Jur. 576, 577).

Thus, to allow registration of Respondent- Applicant's similar trademark for use on goods within the zone of natural and logical operation of Opposer's business will forestall the normal potential expansion of its business.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. . 4-2012-004300, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 04 November 2015.

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

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<sup>5</sup> G.R. No. 143993. August 18, 2004