

SUYEN CORPORATION,  
Opposer,

-versus-

GOLDEN ABC, INC.,  
Respondent- Applicant.

x-----x

}  
} **IPC No. 14-2011-00244**  
} Opposition to:  
} Appln. Serial No. 4-2010-012146  
} Date Filed: 10 November 2010  
} **TM: "AQUAGEL"**  
}  
}  
}  
}  
}

**NOTICE OF DECISION**

**MIGALLOS & LUNA LAW OFFICES**

Counsel for the Opposer  
7<sup>th</sup> Floor, The PHINMA Plaza  
39 Plaza Drive, Rockwell Center  
Makati City

**OFFICE OF BAGAY-VILLAMOR AND FABIOSA**

Counsel for Respondent-Applicant  
LPHI Center, No. 880 A.S. Fortuna St.,  
Banilad, Mandaue City, Cebu

**GREETINGS:**

Please be informed that Decision No. 2016 - 203 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 30, 2016.

For the Director:

**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



SUYEN CORPORATION,

*Opposer,*

-versus-

GOLDEN ABC, INC.,

*Respondent-Applicant.*

x-----x

IPC No. 14-2011-00244

Opposition to:  
Application No. 4-2010-012146  
Date Filed: 10 November 2010  
Trademark: "AQUAGEL"

Decision No. 2016- 203

### DECISION

SUYEN CORPORATION<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-012146. The application, filed by Golden ABC, Inc.<sup>2</sup> ("Respondent-Applicant"), covers the mark "AQUAGEL" for use as "hand sanitizer" under Class 05 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x

#### "GROUND FOR OPPOSITION AND DISCUSSION

"3.1. The mark AQUAGEL of respondent-applicant so resembles the ALCOGEL Trademarks of the opposer that the use of the AQUAGEL mark on hand sanitizers, which are the same goods on which the ALCOGEL Trademarks of Suyen is being used, will certainly result in a common perception among the consuming public that respondent-applicant's products are among the 'ALCOGEL' products of Suyen and/or are connected with Suyen or under the sponsorship of Suyen. This is especially true considering that Suyen also uses the registered trademark 'ACQUA & DEVICE' on its products falling under Class 03.

"3.2 The Intellectual Property Code precludes the registration of a mark which '[I]s 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 x x x' (Sec. 123.1 (d); see also Rule 101 (d), Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers).

<sup>1</sup>A corporation duly organized and existing under the laws of the Republic of the Philippines, with offices located 2214 Tolentino Street, Pasay City.  
<sup>2</sup>With address at LPHI Center, No. 880 A.S. Fortuna St., Banilad, Mandaue City, Cebu.  
<sup>3</sup>The 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.

"3.3 Respondent-applicant's 'AQUAGEL' mark is confusingly similar to opposer's 'ALCOGEL' Trademark, especially considering that the products on which they are used or attached are hand sanitizers contained in small containers.

"3.4 The similarity between respondent-applicant's AQUAGEL mark and Suyen's registered ALCOGEL Trademarks is apparent. The competing marks are similar in the most dominant, noticeable and prominent letters thereof, i.e. 'A' and 'GEL.' Their difference exists only in three unimpressive letters, out of their seven letters. This, coupled by the fact that both marks cover exactly the same goods, i.e. hand sanitizers, and are contained in almost identical, small and transparent plastic containers, definitely establishes their confusing similarity. On the shelves of supermarkets, groceries and drugstores where they are commonly found, ordinary purchasers looking at the competing products at a distance in small containers, would not be able and could not distinguish between them. 'ALCOGEL' and 'AQUAGEL' appearing on very similar containers appear identical.

"3.5 Under the Dominancy Test, there is infringement and likelihood of confusion in the market when there is similarity in the prevalent features of the competing trademarks (Amigo Manufacturing, Inc. v. Cluett Peabody Co., Inc., 354 SCRA 434 [2001]). It is applied when the trademark sought to be registered contains the main, essential and dominant features of the earlier registered trademark, and confusion or deception is likely to result. Duplication or imitation is not even required; neither is it necessary that the label of the applied mark for registration should suggest an effort to imitate. The important issue is whether the use of the marks involved would likely cause confusion or mistake in the mind of or deceive the ordinary purchaser, or one who is accustomed to buy, and therefore to some extent familiar with, the goods in question xxx

"3.6 Section 155.1 of the IP Code explicitly adopts the test of dominancy. It provides -

x x x

"3.7 In American Wire and Cable Co. vs. Director of Patents, the Supreme Court declared that the entire trademark itself can be the dominant word or feature of a trademark. The Supreme Court in that case found the marks 'Duraflex' and 'Dynaflex' confusingly similar to each other, and pronounced that buyers are less concerned with the etymology of the words as with their sound and the dominant features of the design. The semantic difference and connotation of the prefixes 'Dura' and 'Dyna' of the competing trademark cannot make the two marks different. For the dominant and essential feature of the article is the trademark itself.

"3.8 Similarly, the dominant and essential feature of Suyen's hand sanitizer products is the trademark 'ALCOGEL' itself. Ordinary purchasers are less concerned with the etymology of the words 'ALCOGEL' and 'AQUAGEL' as with their sound and dominant features. The differences in the two competing marks are not substantial and do not negate their confusing similarity.

"3.9 It is not necessary to constitute trademark infringement that every word of a trademark should be appropriated, but it is sufficient that enough be taken to deceive the public in the purchase of a protected article. In McDonalds Corporation vs. LC Big Mak Burger, Inc. (citing Co Tiong Sa vs. Director of Patents), the Supreme Court held that '[D]uplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate x x x

"3.10 Aside from being visually similar, the subject marks are also phonetically the same. When the marks ALCOGEL and AQUAGEL are pronounced, the sound effects are confusingly similar. The danger of confusion from phonetic similarity is highlighted by the fact that the marks refer to merchandise of the same descriptive properties.

"3.11 Thus, in the case of Marvex Commercial Co. vs. Hawpia & Co., the registration of the trademark 'Lionpas' for medicated plaster was denied for being confusingly similar in sound with 'Salonpas', a registered mark also for medicated plaster.

x x x

"3.12 Even under the Holistic Test, where the entirety of marks as they appear on the products, including the labels and packaging, are considered, the use of respondent-applicant's AQUAGEL mark will amount to confusion and infringement of Suyen's ALCOGEL Trademarks.

"3.13 One of the questions to be determined is whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods, is the touchstone.

"3.14 It has been held that in making purchases, the consumer must depend upon his recollection of the appearance of the product which he intends to purchase. The buyer having in mind the mark/label of the respondent must rely upon his memory of the petitioner's mark. Unlike the judge who has ample time to minutely examine the labels in question in the comfort of his sala, the ordinary shopper does not enjoy the same opportunity.

"3.15 The use of respondent-applicant's mark would likely cause confusion or mistake in the mind or deceive the ordinary purchaser, or one who is accustomed to buy, and therefore to some extent familiar with, the goods in question. This confusion is all the more apparent considering that Suyen also uses the registered trademark 'ACQUA & DEVICE'. Consumers will almost definitely associate respondent-applicant's 'AQUAGEL' product with Suyen and Suyen's 'ALCOGEL' products and the 'ACQUA & DEVICE' products manufactured and sold by Suyen.

"3.16 Suyen's registered trademarks and the mark of respondent-applicant are used on the same and closely related goods. The goods covered by respondent-applicant's mark directly compete with the ALCOGEL products of Suyen. Clearly, the use of respondent-applicant's mark will mislead the public into believing that its products or goods originated from or are sponsored by Suyen or that its business is affiliated or associated with that of Suyen.

"3.17 There will therefore be confusion of business (source or origin confusion), where a product bearing the mark AQUAGEL might reasonably be assumed to originate from Suyen, and the public would then be deceived either into that belief or into the belief that there is some connection between the two parties though inexistent x  
xx

"3.18 As stated above, Suyen has used the ALCOGEL Trademarks as early as 1998, or long before respondent-applicant adopted and used its AQUAGEL mark. Respondent-applicant should not be allowed to ride on the popularity gained by Suyen's ALCOGEL products. Suyen has an immense and valuable goodwill in its ALCOGEL Trademarks resulting from extensive use and huge investments in the said brand. This Honorable Office cannot allow respondent-applicant to appropriate or unfairly take advantage of this goodwill, to the great damage and injury of Suyen.

"3.19 The registration of respondent-applicant's mark will undoubtedly violate Suyen's rights to and interest in its ALCOGEL Trademarks and will most assuredly result in the dilution and loss of distinctiveness of Suyen's registered trademarks. Suyen will suffer substantial and irreparable damage from such registration.

"3.20 Of course, as in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, respondent-applicant had to choose those so clearly similar to Suyen's ALCOGEL Trademarks? The intent to take advantage of the goodwill generated by Suyen's ALCOGEL Trademarks is clear.

The Opposer's evidence consists of the Affidavit of Suyen's Group Brand Manager, Ms. Kristine Anne C. Lim; copy of Certificate of Registration No. 4-1998-003504 for the mark ALCOGEL issued on 09 February 2007; copies of Certificate of Registration No. 4-1998-006506 for the mark GEL ALCO and Certificate of Registration No. 4-1998-006510 for the mark ALCOGELLO; copy of Certificate of Registration No. 4-2010-005505 for the mark PRESCRIBE ALCOGEL CLEANWIPES; copies of Trademark Applications Nos. 4-2010-013767, 4-2010-013766 and 4-2010-013765 for the marks ALCOGEL MANDARIN BURST, ALCOBEL RAINBOW and ALCOGEL SUNSHINE respectively; copy of Trademark Application No. 4-2010-005482 for the mark ALCOGEL under Classes 03 and 05; a list of all ALGOCEL Trademarks registered in foreign countries; copies of the Certificates of Registration for the mark ALCOGEL as listed in Exhibit "J"; a list of ALCOGEL products; sample promotional materials for the mark ALCOGEL that have been posted, displayed or distributed in the market; copies of press releases for Opposer's ALCOGEL products made in several publications nationwide; copies of advertisements for the mark ALCOGEL made in several local newspapers; copies of advertisements for the mark ALCOGEL and ALCOGEL products made in several popular lifestyle magazines in the country; copies of materials showing celebrities endorsing Suyen's products bearing the ALCOGEL and ACQUA & DEVICE Trademarks; copy of Certificate of Registration No. 4-1997-118323 for the ACQUA & DEVICE mark; photographs of Suyen's products bearing the ACQUA & DEVICE Trademark distributed and sold nationwide; and sample promotional materials and print advertisements posted, displayed, distributed and published nationwide.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 18 July 2011. Said Respondent-Applicant, however, did not file an Answer.

---

<sup>4</sup>Marked as Exhibits "A" to "SS", inclusive.

Should the Respondent-Applicant be allowed to register the trademark AQUAGEL?

Records show that at the time the Respondent-Applicant filed its trademark application on 10 NOVEMBER 2010, the Opposer has an existing trademark registration for the mark ALCOGEL under Trademark Reg. No. 4-1998-003504 issued on 09 February 2007. The registration covers "hand sanitizers" under Class 03. On the other hand, Respondent-Applicant filed its trademark application for the mark AQUAGEL for use on "hand sanitizer" in Class 05.

Thus, Sec. 123.1 (d) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provide:

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

x x x

(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;"

Hence, the question, does AQUAGEL resemble ALCOGEL such that confusion or deception is likely to occur? The marks are shown below:

**ALCOGEL**

**AQUAGEL**

Opposer's trademark

Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur at this instance. Both marks are used for hand sanitizers. A hand antiseptic, hand disinfectant, hand sanitiser or hand sanitizer is a supplement or alternative to hand washing with soap and water. Many preparations are available, including gel, foam, and liquid solutions.<sup>5</sup> Since preparations for hand sanitizers may be made in gel form, it is obvious, therefore, that the parties' marks are derived from the word gel. Succinctly, an opposition cannot be sustained solely for the reason that the contending marks both contain the suffix GEL. Thus, to determine the issue of whether AQUAGEL

<sup>5</sup> Wikipedia, the Free Encyclopedia.


should not be registered on the ground that it is confusingly similar to ALCOGEL, it is imperative to look into the components or other features of the marks that is/are paired or in combination with GEL. In this instance, the use of the first two syllables AQUA to the suffix GEL has rendered Respondent-Applicant's mark a character that is distinct from the Opposer's mark ALCOGEL. AQUAGEL is overwhelmingly visually and aurally different from ALCOGEL. The two syllables AQUA distinguishes it from the sound of Opposer's ALCO. Also, AQUA is the latin word for water<sup>6</sup>, hence, AQUAGEL, as hand sanitizer, may be water-based vis-à-vis Opposer's ALCOGEL, which is alcohol-based. The combination of words and syllables can be registered as trademarks for as long as it can distinguish the goods of a trader from its competitors, although as suggestive 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>7</sup> This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2010-012146 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

**SO ORDERED.**

Taguig City, 30 JUN 2016.

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

<sup>6</sup> Merriam-Webster Dictionary.

<sup>7</sup> Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.