

BORER CHEMIE AG,

Opposers,

- versus -

CHEMVALLEY RESOURCES, INC.,

Respondent-Applicant.

X-----X

IPC NO. 14-2014-00473

Appl. No. 4-2014-008046

Date Filed: 25 June 2014

TM - "50 FF"

NOTICE OF DECISION

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Metro Manila

CHEMVALLEY RESOURCES, INC.,

Respondent-Applicant


168 Westriverside Street

Quezon City

GREETINGS:

Please be informed that Decision No. 2016 - 369 dated October 10, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 10, 2016.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

**Republic of the Philippines
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BORER CHEMIE AG,
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CHEMVALLEY RESOURCES, INC.,
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IPC NO. 14-2014-00473

Opposition to:
Appln. Ser. No. 4-2014-008046
Filing Date: 25 June 2014
Trademark: **50 FF**

Decision No. 2016 - 369

DECISION

BORER CHEMIE AG,¹ ("Opposer") filed an Opposition to Trademark Application No. 4-2014-008046. The application, filed by CHEMVALLEY RESOURCES, INC.² ("Respondent-Applicant") covers the mark **50 FF** for use on "cleaning disinfectant" under Class 05 of the International Classification of goods³.

The Opposer alleges the following grounds:

I

THE SUBJECT APPLICATION FOR THE MARK '50 FF' SHOULD BE DENIED BECAUSE IT IS OPPOSER THAT IS THE TRUE AND RIGHTFUL OWNER THEREOF.

II

RESPONDENT-APPLICANT'S APPLICATION SHOULD BE DENIED FOR HAVING BEEN FILED IN UTTER BAD FAITH.

The Opposer's evidence consists of the following:

1. Exhibit "A" - Copy of Respondent-Applicant's application for registration of the mark 50 FF;
2. Exhibits "B" to "E" - Print-out of Company History of Opposer from its website [http://www.borer/ch/en/company/company history](http://www.borer/ch/en/company/company%20history);
3. Exhibit "F" - legalized Affidavit of Dr. Markus Borer;
4. Exhibit "G" to "G-8" - Copies of Distributorship Agreement and Letters of Extension between Opposer and Respondent-Applicant;
5. Exhibits "H" - Copy of the Declaration of Actual Use filed on 10 December

¹ A corporation duly organized and existing under the laws of the Switzerland with business address at Gewerbstrasse 13, 4528 Zuchwil, Switzerland.

² A domestic corporation with office address at 168 Westriverside St. Quezon City.

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.

- 2003;
6. Exhibits "I"- copy of the facsimile letter dated 10 September 1996 from Respondent-Applicant requesting for delivery of products bearing the mark 50 FF;
 7. Exhibits "J" to "J-2" Sample Invoices issued by Opposer to Respondent-Applicant ;
 8. Exhibit "K" - Copy of the letter terminating the Distributorship Agreement dated 23 May 2014 ; and
 9. Exhibit "L" - Legalized and authenticated Certificate authorizing Cruz Marcelo and Tenefrancia.

This Bureau issued on 10 February 2015 a Notice to Answer and served to the Respondent-Applicant's address on 20 February 2015. The Respondent-Applicant, however, did not file its Answer. 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 50 FF?

The records show that when Respondent-Applicant applied for registration of the mark 50 FF on 25 June 2014, Opposer has no existing registration or pending application for registration of a similar trademark. What Opposer has is a registration of the mark DECONEX issued on 21 May 2004. Thus, it would appear that there is no hindrance or bar to the registration of Respondent-Applicant's mark 50 FF. However, a further scrutiny of the records of this case would show that Respondent-Applicant is not the originator or owner of the subject mark. According to an Agreement dated 10 July 1992 executed between Opposer and Respondent-Applicant, the latter was the sole distributor of the complete range of products of Opposer here in the Philippines. Among the range of products of Opposer that Respondent-Applicant was authorized to promote and sell were DECONEX disinfectants which has many variants including 50 FF as shown by the Invoices issued by Opposer to Respondent-Applicant.

In *Unno Commercial Enterprises, Inc. v. General Milling Corporation, et. Al.*,⁴ the Supreme Court enunciated:

The right to register trademark is based on ownership. When the applicant is not the owner of the trademark being applied for, he has no right to apply for the registration of the same. Under the Trademark Law only the owner of the trademark, trade name or service mark used to distinguish his goods, business or service from the goods, business or service of others is entitled to register the same.

The term owner does not include the importer of the goods bearing the trademark, trade name, service mark, or other mark of ownership, unless such

⁴G.R. No. L-28554, February 28, 1993

importer is actually the owner thereof in the country from which the goods are imported. xxx

Thus, this Court, has on several occasions ruled that where the applicant's alleged ownership is not shown in any notarial document and the applicant appears to be merely an importer or distributor of the merchandise covered by said trademark, its application cannot be granted. [Emphasis supplied.]


Thus, it is clear that the right to register trademarks, trade names and service marks by any person, corporation, partnership or association domiciled in the Philippines or in any foreign country, is based on ownership, and the burden is upon the applicant to prove such ownership. ⁵ Since Respondent-Applicant is merely a distributor, it has no right to register the mark **50 FF**.

Finally, it must be emphasized that 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.⁶ The mark applied by Respondent-Applicant did not meet this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-008046, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **10 OCT 2016**


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

⁵ *Marvex Commercial Co., Inc. vs. Petra Hawpia*, G.R. No. L-19297, promulgated on December 22, 1966 citing *Operators, Inc. vs. Director of Patents*.

⁶See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.