UNILEVER PLC.,
Opposer,

-versus-

HENESSY DISTRIBUTORS PHILS.,
Respondent-Applicant.
x----------x

INTER PARTES CASE NO. 3574
Opposition to:

Serial No. 65251
Date Filed: July 18, 1988
Trademark : "CLOX"

DECISION NO. 98-43

DECISION

On August 01, 1990, UNILEVER PLC., a corporation organized and existing under the laws of England, with principal office at Part Sunlight, Wival Merseyside, England, faked its authenticated Verified Notice of Opposition (docketed as Inter Partes Case No. 3574) to Application Serial No. 65251 for the trademark "CLOX" for use on liquid bleach and soap, which application was filed on July 18, 1988 by Henessy Distributor Phils., a corporation duly organized and existing under the laws of the Philippines, with business address at Sta. Mesa, Manila, which was published in the January-February 1990 issue of the BPTTT Official Gazette, Vol. III, No. 1, and officially released for circulation on May 03, 1990.

The ground for Opposition is: "THE REGISTRATION OF THE MARK IN THE NAME OF THE RESPONDENT-APPLICANT IS PROSCRIBED BY SECTION 4(d) OF THE REPUBLIC ACT NO. 166, AS AMENDED.

Opposer relied on the following facts to support its opposition:

"1. Opposer's trademark "CLOX" is confusingly similar to the trademark CLAX which is registered in the Philippine Patent Office (now the Bureau of Patents, Trademarks and Technology Transfer) under Certificate of Registration No. SR-6407 and SR-1497 of which the Opposer is the registered owner which is used in respect of "detergent product and not abandoned, when applied to or used in the goods "liquid bleach soap" of the applicant as both belong to the same class of goods and pass through the same channels of commerce;

"2. The registration of CLOX in the name of Henessy Distributor Phils., will cause great and irreparable injury and damage to oppose within the meaning of Section 8 of the Republic Act No. 166, as amended.

a) The Opposer has adopted and extensively used the said trademark in the Philippines;

b) As a result of long continuous and extensive use by Opposer, the trademark CLAX has become well known in the Philippines and has been identified with the goods and business of the Opposer in the mind of the purchasing public such that the use of any other trademark which is identical thereto is likely to confuse the purchasing public;

c) The mark CLOX sought to be registered and Opposer's registered mark CLAX consisting of four letters the first two and the last letters being similar and although the third letters are different, when pronounced are also similar give rise to absolute confusion, both phonetic and visual.

On September 26, 1990, the herein Respondent-Applicant filed its Answer denying the material allegations in the Opposition and raised herein the following affirmative defenses:

> "6. That Opposer has no valid cause of action and its above Notice of Opposition states none;
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> "7. That the above Notice of Opposition was filed out of time;
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> "8. That the trademark CLOX, subject of Application Serial No. 65251 is neither identical nor confusingly similar to any mark previously registered or used in lawful commerce in the Philippines and not abandoned;
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> "9. That Opposer never used in lawful commerce in the Philippines the trademark CLAX;
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> "10. That the approval of Application Serial No. 65251 is fully in accordance with Republic Act No. 166, as amended, particularly subparagraph (d) thereof. Proof of this, is its approval for publications;
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> "11. That it incorporates by reference all the material, pertinent and relevant allegations in the preceding paragraphs;
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> "12. That inasmuch as Opposer has not substantially used in lawful commerce in the Philippines continuously for five years preceding the filing of the above Notice of Opposition the trademark CLAX, then pursuant to Rule 192 (b) of the Revised Rules of Practice in Trademark Cases, Registration No. SR-1497 and No. SR-6407 must be presumed to have been abandoned and must be therefore be cancelled."

There being no amicable settlement reached in the scheduled Pre-trial Conference, the case proceeded to trial on the merits. The parties subsequently offered their respective testimonial and documentary evidence.

On the basis of the parties' pleadings, the main issue to be resolved in this case is, WHETEHR RESPONDENT'S MARK "CLOX" IS CONFUSINGLY SIMILAR TO THE REGISTERED MARK "CLAX" OF OPPOSER.

Considering, that the abovementioned Application serial No. 65251, was filed on July 18, 1988, when the new law, Republic Act No. 8293 or the "Intellectual Property Code of the Philippines" was not yet force and in effect.

Considering further, that the trial of this case have been commenced and terminated when the Rules of Practice in Trademark Cases and the old Trademark Law (R.A. 166, as amended) were the governing laws pertaining thereof, and in consonance with the provisions of Section 235.2 of R.A. 8293, which states, inter alia that "xxx If such amendment are not made, the prosecution of said applications shall be proceeded with and registrations thereon granted in accordance with the Acts under which said applications were filed, and said Acts hereby continued in force to this extent for this purpose only, notwithstanding the foregoing general repeal thereof.", the Old Trademark Law (R.A. 166, as amended) will be applied in the resolution of the instant case.

Republic Act No. 166, as amended, particularly Section 4(d) thereof, provides as follows:

> "SEC. 4. Registration of trademarks, trade names and service mark on the principal register. – There is hereby established a register of trademarks, trade-names and service marks which shall be known as the principal register. The owner of a trademark, trade name or service mark used to distinguish his goods, business or service

from the goods, business or service of others shall have the right to register the same on the principal register unless it:

xxx

(d) Consist of or comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines of a mark or trade name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers." (underscoring provided)

Interpreting the above-quoted provision, the Supreme Court ruled that in determining whether the two marks are confusingly similar, the test is not simply to take their words and compare the spelling and pronunciation of the said words. Rather it to consider the two marks in their entirety, as they appear in the respective labels in relation to the goods to which they are attached (Please see Mead Johnson & Co. vs. N.V. Van Dorf, Ltd., 7 SCRA 286; Mead Johnson & Co. vs. Director of Patents, et al, 17 SCRA 128-129). Thus, there is no confusing similarity where labels are entirely different in size, background, colors, contents and pictorial arrangements. (American Cyanamide Co. vs. Director of Patents, et. Al, L-23454, April 29, 1977)

In the case at bar, a comparison of the two marks would reveal that there is dissimilarity between them; the mark "CLAX" is inscripted in big, bold letter with thin horizontal shape lines and immediately followed by the word "CRYSTAL" appearing after the word "CLAX" (Exh. "C"), whereas the mark CLOX" is inscribed within an oblong design (Exh. "1-D").

Moreover, the goods upon which both marks are being used fall under different classifications. As shown by Respondent's application, the mark 'CLOX' is being used on liquid bleach and soap, falling under International Classification 3, while Opposer's mark "CLAX" is being used on detergents for medical purposes, disinfectants (other than for laying or absorbing dust) and sanitary substances, falling under International Classification 5, as shown in Cert. of Regn. No. SR-6407, hence, there is no possibility of confusion nor deception on the part of the buying public, mistaking one brand for the other.

Likewise, as shown in the Exh. "C", which is a label (sock container) submitted by Opposer in this case, said sock contains the words CLAX CRYSTAL for 'high performance mainwash powder for stock solution or dry feed use on all cotton and most polycotton classifications, goods which are likewise very much different from the liquid bleach soap being applied for by herein Respondent-Applicant for its trademark CLOX.

In view the foregoing considerations, Respondent-Applicant's contention that Opposer's home registration alone of its mark "CLOX" without proof of use in the Philippines will constitute abandonment therefore becomes immaterial considering Our finding that NO CONFUSING SIMILARITY EXIST BETWEEN THE TWO TRADEMARKS *"CLOX" AND "CLAX"*.

Nevertheless, it is important to mention at this point that as likewise shown by the records of the Intellectual Property Office, Cert. of Regn. No. SR-1497 for the trademark "CLAX" which is one of the basis of Opposer in filing the instant Notice of Opposition has already been cancelled by this Office under Cancellation Order NO. 94-4 dated October 20, 1995, for failure to file the required Affidavit of Use for the 15th Anniversary.

WHEREFORE, premises considered, the instant Opposition to the registration of the trademark "CLOX" filed by herein Opposer is, as it is hereby DENIED. Accordingly, Application Serial No. 65251 for the trademark "CLOX" used on liquid bleach and soap is, as it is hereby, GIVEN DUE COURSE.

Let the file wrapper of CLOX subject matter of this case be forwarded to the Administrative, Financial and Human Resource Development Bureau for appropriate action in

accordance with this Decision with a copy to be furnished the Bureau of Trademarks for information and update of its records.

SO ORDERED.

Makati City, December 28, 1998.

ESTRELLITA BELTRAN-ABELARDO
Caretaker/Officer-In-Charge