

VALMONT, INC.,
Opposer,

INTER PARTES CASE NO. 3019

OPPOSITION TO:

- versus -

Application Serial No. 54446
Filed : August 14, 1984
Applicant : The Wellcome
Foundation Limited
Trademark : PYNOL
Used on : Disinfectants (other than
for laying or absorbing)

THE WELLCOME FOUNDATION LIMITED,
Respondent-Applicant.

x-----x

DECISION NO. 89-25 (TM)
May 11, 1989

DECISION

On December 21, 1987, Valmont, Inc., filed a Notice of Opposition against the registration of the trademark "PYNOL" for disinfectants (other than for laying or absorbing) applied for by The Wellcome Foundation Limited of London, England on August 14, 1984 under the Application Serial No. 54446, published in the Philippines Star and posted at the bulletin board of the Bureau of Patents, Trademarks and Technology Transfer on October 22, 1987.

Opooser is a foreign corporation organized and existing under the laws of the State of Delaware, U.S.A., with business address at No. 90 Park Avenue, New York, New York, U.S.A.; while Respondent-Applicant is likewise a foreign company with business address at 183 Euston Road, London, NW1 2BP, England.

The grounds alleged in the Notice of Opposition filed on December 21, 1987 are:

"1. The opposer VALMONT, INC. is an old establishment and has become well known throughout the United States of America and the other countries and territories of the world as the owner of the trademark "LYSOL" used on antiseptics and disinfectants.

2. The opposer is the owner of Certificate of Renewal No. 1023 covering the trademark "LYSOL" used on DISINFECTANTS AND ANTISEPTICS issued by the Philippine Patent office, now Bureau of Patents, Trademarks and Technology Transfer, on April 28, 1972.

3. Certificate of Renewal No. 1023 is a renewal of Certificate of Registration No. 3968-R which was issued on November 11, 1952 x x x.

4. Opposer, and its related companies (opposer being wholly-owned subsidiary of Sterling Drug, Inc.), has also registered the trademark "LYSOL" in seventy-eight (78) countries including the Philippines x x x.

5. The Opposer`s trademark "LYSOL" is well-known in the Philippines and throughout the world and have an excellent reputation because of the high and superior quality of Opposer`s products.

6. The Opposer`s date of first use of the mark "LYSOL" in commerce in the Philippines and/or in the United States of America and other countries of the world was very much earlier than that of the applicant. x x x

xxx

9. The Opposer respectfully alleges that the applicant's act in adopting the trademark PYNOL which is similar or identical to that of Opposer, was made with the illegal and immoral intention of cashing in on the goodwill and popularity of opposer's reputation and will cause great and irreparable damage and injury to the opposer pursuant to Section 8, and other pertinent provisions of Republic Act No. 166, as amended, and Rule 187 x x x of the Revised Rules of Practice in Trademark Cases.

10. Opposer also respectfully alleges that the applicant's use of PYNOL must necessarily result in confusion and deception of the public x x x."

In its Answer filed on April 8, 1988, after several extensions, Respondent-Applicant denied the material allegations made in the Notice of Opposition and invoked the following affirmative defenses:

"15. Respondent-Applicant is entitled to the registration of PYNOL which is an arbitrary and fanciful derivative or contraction of the chemical compound PHENYLPHENOL, which the active ingredients in most commercial disinfectant, including Opposer's.

16. PYNOL is different and distinguishable from LYSOL not only in pronunciation and spelling but also in visual impression as used in actual labels and cannot cause confusion or deception of consumers.

17. Opposer's trademark LYSOL has not become distinctive of Opposer's goods since there is no substantially exclusive and continuous use of the trademark by Opposer.

18. Respondent-Applicant's PYNOL trademark has through continuous use and its registration in many other countries developed business goodwill and reputation for respondent-applicant and has identified respondent-applicant as the source or origin of the goods bearing said trademark."

Issues having been joined, the pre-trial conference was set to May 24, 1988. After several postponements, the pre-trial was held on July 5, 1988 where the parties submitted their respective pre-trial briefs. The hearing on the merits was set on September 20, 1988 but was reset to October 28, 1988 upon agreement of counsels, with the joint manifestation that the parties are exploring avenues for the settlement of the case.

On April 21, 1989, Opposer through counsel filed a motion to withdraw its Notice of Opposition in this case because it "has decided not to proceed with the Opposition and therefor begs leave to withdraw its Opposition".

WHEREFORE, this Opposition case is DISMISSED. Accordingly, Application Serial No. 54446 for the registration of the trademark "PYNOL" in the name of the herein Respondent should now be given due course.

Let the records of this case be forwarded to the Application, Issuance & Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director