

VAN CLEEF & ARPELS,
Opposer,

INTER PARTES CASE NO. 3205

OPPOSITION TO:

- versus -

Application Serial No. 57966
Filed : December 11, 1985
Applicant : Blendax-Werke R.
Schneider Gmbh & Co.
Used on : Perfumery, soaps,
essential oils,
cosmetical products for
body and beauty care,
hair lotions, dentifrices
(except for medical
purposes)

BLENDAX WERKE R. SHNEIDER
GmbH & CO.,
Respondent-Applicant.

x-----x

DECISION NO. 89-2 (TM)
January 26, 1989

DECISION

On August 16, 1988, Van Cleef & Arpels filed its Opposition to the registration of the trademark "CLIFF" used on perfumery, soaps, essential oils, cosmetical products for body and beauty care, hair lotions, dentifrices (except for medical purposes) applied for on December 11, 1985 by Blendax Werke R. Schneider GmbH under Application Serial No. 57966, which was published for opposition on Page 60 of the BPTTT Official Gazette, Volume I, No.5, officially released on July 18, 1989.

Opposer is a foreign company of France with business address at 22, Place Vendome Paris (1), France, while Respondent-Applicant is a foreign corporation organized and existing under the laws of Germany with business address at Mainz, Germany.

The grounds alleged in the Opposition are:

"1. The opposer is the owner of the trademark 'VAN CLEEF & ARPELS' having been to adopt the same in trade and commerce for perfumery, essential oils and soap.

2. Opposer`s trademark 'VAN CLEEF & ARPELS' was registered in France as early as 29 July 1965 under Certificate of Registration No. 266, 380. Subsequently, or on 19 February 1980, herein Opposer applied for trademark registration in this Jurisdiction for the said mark and was issued Certificate of Registration No. 35766 on 22 July 1986.

3. The trademark 'VAN CLEEF & ARPELS' which opposer originated and adopted is well known in the Philippines and throughout the world and its products enjoy the reputation of being superior quality goods. x x x"

In its Answer, Respondent-Applicant denied all the material allegation made in the Notice of Opposition and, by way of special and affirmative defenses alleged that:

"9. Respondent is the registered owner of the mark "CLIFF" under German Certificate of Registration No. 918,541 issued on 15 May 1974 and renewed from 1

December 1981, covering perfumery, soaps, essential oils, commercial products for body and beauty care, hair lotions, dentifrices (except for medical purposes) and is well known internationally, said mark having been used and registered in at least 45 countries;

10. On the basis of the drawings and facsimiles submitted to the Patent Office, the mark 'CLIFF' of Respondent is totally different from the mark 'VAN CLEEF & ARPELS' of Opposer in appearance, sound and meaning. These differences will not produce confusion in the minds of the purchasers of the products of either Opposer or Respondent bearing the marks in question.

11. The labels and packaging of the products on which the mark 'CLIFF' is used by Respondent is likewise clearly different in design, wordings, colors, etc. from the labels or packaging of the goods on which the Opposer's mark 'VAN CLEEF & ARPELS' is used. Consequently, there is no valid reason for purchasers of Respondent's goods to confuse the same as products of the Opposer.

12. Purchasers of goods of both Opposer and Respondent are very discreet and discerning people who make their purchases based on personal experience, recommendation of friends, and information given by brochures, magazines and other advertising media publication, and are therefore more careful than casual purchasers. Therefore, there is very little possibility of likelihood of confusion that may be caused to the purchasers of the beauty, health and care products sold and distributed by Opposer and Respondent bearing the different marks in question.

13. to show lack of confusing similarity between Respondent's mark 'CLIFF' and opposer's mark 'VAN CLEEF & ARPELS', undersigned, on information and belief, allege that both Respondent's mark 'Cliff' and Opposer's mark 'VAN CLEEF & ARPELS' are registered in the Intellectual Property Registers in at least 15 countries, thereby indicating that the authorities in those countries do not consider there exists confusing similarity between the two marks in question."

The case was originally scheduled for pre-trial conference on November 11, 1988 but was reset to December 16, 1988 upon agreement of the parties' counsel. On that hearing (Dec. 16, 1988), counsel for the Opposer manifested in open court that it will be filing a written manifestation to withdraw herein Notice of Opposition to subject mark.

Indeed, on January 5, 1989, counsel for the Opposer filed its written manifestation formally informing the Bureau of its withdrawal of the above-captioned Opposition.

WHEREFORE, the herein Notice of Opposition is DISMISSED. Accordingly, Respondent's Application Serial No. 57966 for the registration of the mark 'CLIFF' 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