



BORER CHEMIE AG,
Opposer,

-versus-

CHEMVALLEY RESOURCES, INC.,
Respondent-Applicant.

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} **IPC No. 14-2014-00474**
}
} Opposition to:
} Appln. Serial No. 4-2014-008048
} Date Filed: 25 June 2014
} **TM: "53 PLUS"**

NOTICE OF DECISION

CRUZ MARCELO & TENEFRANCIA

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Taguig City

CHEMVALLEY RESOURCES, INC.,

Respondent-Applicant
168 Westriverside Street
QuezonCity

GREETINGS:

Please be informed that Decision No. 2015 - 196 dated September 18, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 18, 2015.

For the Director:

Edwin A. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



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CHEMVALLEY RESOURCES, INC.,
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IPC NO. 14-2014-00474

Opposition to:
Appln. Ser. No. 4-2014-008048
Filing Date: 25 June 2014
Trademark: **53 PLUS**

Decision No. 2015 - 196

DECISION

BORER CHEMIE AG,¹ ("Opposer") filed on 05 January 2015 a Verified Opposition to Trademark Application No. 4-2014-008048. The application, filed by CHEMVALLEY RESOURCES, INC.² ("Respondent-Applicant") covers the mark 53 PLUS 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 '53 PLUS' 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 53 PLUS;
2. Exhibit "F" - legalized and authenticated Affidavit of Dr. Markus Borer;
3. Exhibit "G" to "G-8" - Copies of Distributorship Agreement and Letters of Extension between Opposer and Respondent-Applicant;
4. Exhibits "H" - Copy of the Declaration of Actual Use filed on 10 December 2003;
5. Exhibits "I" and "I-1" - photographs of Opposer's products bearing the

¹ A corporation duly organized and existing under the laws of the Switzerland with business address at Gewerbestrasse 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.

- mark 53PLUS;
6. Exhibit "J" - Certificate of Product Registration of 53 PLUS disinfectant issued by the BFAD;
 7. Exhibit "K" to "K-3 - Sample Invoices issued by Opposer to Respondent-Applicant ;
 8. Exhibit "L" - Copy of the letter terminating the Distributorship Agreement ; and
 9. Exhibit "M" - Legalized and authenticated Certificate authorizing Cruz Marcelo and Tenefrancia.

This Bureau issued on 04 February 2015 a Notice to Answer and served to the Respondent-Applicant's address on 11 February 2015. The Respondent-Applicant, however, did not file its Answer. On 06 July 2015, Order No. 2015- 1003 was issued declaring Respondent-Applicant in default. 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 "53 PLUS"?

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.⁴

The records show that when Respondent-Applicant applied for registration of the mark on 25 June 2014, Opposer has no existing registration or pending application for registration of a similar trademark. However, the records also show that it is not Respondent-Applicant who is the originator or owner of the subject mark but Opposer. Opposer presented overwhelming evidence of its ownership of the mark 53 PLUS. In an Agreement between Opposer and Respondent-Applicant, Respondent-Applicant was made the sole distributor of the complete range of products of Opposer's here in the Philippines since 1992 up to 2014. Among the range of products of Opposer, Respondent-Applicant was authorized to promote and sell DECONEX disinfectants which has many variants including 53 PLUS as shown by the Invoices issued by Opposer to Respondent-Applicant. The Certificate of Product Registration issued by the Food and Drug Administration for the disinfectant 53 PLUS also show that Respondent-Applicant is merely the importer/distributor of the product and Opposer as manufacturer.

In *Unno Commercial Enterprises, Inc. v. General Milling Corporation, et. Al.*,⁵ the Supreme Court enunciated:

⁴ *Marvex Commercial Co., Inc. vs. Petra Hawpia, G.R. No. L-19297, promulgated on December 22, 1966 citing Operators, Inc. vs. Director of Patents.*

⁵ *G.R. No. L-28554, February 28, 1993*

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 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.]

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. 4-2014-008048, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 18 September 2015.


Atty. **NATHANIEL S. AREVALO**
Director IV
Bureau of Legal Affairs

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