INTELLECTUAL PROPERTY
PHILIPPINES

GOLDEN ABC, INC.,	}	**IPC NO. 14-2007-00257**
Opposer,	}	Case Filed on : 30 August 2007
	}	
-versus-	}	Opposition to:
	}	App.Serial No. 4-2006-005710
BEIERDORF AG,	}	Date Filed: 30 May 2006
Respondent-Applicant.	}	**TM: "OXYGEN POWER"**
	}	
x----------x		**DECISION NO. 2009-** 40

DECISION

Before us is a Verified Notice of Opposition filed against the application for registration of the mark "OXYGEN POWER" used for preparations for body and beauty care, namely, skin creams, gels and lotions, skin cleansing creams, face lotions under Class 03 of the international classification of goods bearing Application Serial No. 4-2006-005710 which was published in the Intellectual Property Office Electronic Gazette on 01 June 2007.

Opposer, GOLDEN ABC, INC., is a domestic corporation, with business and postal address at 880 A.S Fortuna Street, Banilad, Mandaue City, Cebu. On the other hand, Respondent-Applicant, BEIERDORF AG, is a corporation organized and existing under the laws of Germany with address at Unnastrabe 48, 20253, Hamburg, Germany.

GROUND FOR THE OPPOSITION

The subject mark "OXYGEN POWER" is confusingly similar to Opposer's registered "OXYGEN" marks. Moreover, the subject mark is applied for Class 03, the same class where the OXYGEN mark is also registered. Thus, the subject application should be rejected.

Opposer relied on the following facts to support its opposition:

1. The Opposer, since June 14, 1990, has been engaged in the retail business, selling men's and women's apparel, toilette/bath and personal care products, fashion accessories, and paper products bearing the trademark "OXYGEN" in various department stores, boutiques, outlets and specially stores nationwide. The Opposer operates a total of 42 company-owned "OXYGEN" boutiques and up to 27 "OXYGEN" concessionaire outlets in major department

stores nationwide

2. As early as May 10, 1991, the Opposer filed an application for registration of the word "OXYGEN" as a trademark for Classes 18, 24, and 25 and was subsequently granted registration on July 2, 1993.

3. As early as May 12, 2000, the Opposer filed an application for registration of "OXYGEN and DEVICE" as a trademark for Class 03 and was subsequently granted registration on May 21, 2004.

4. The Opposer has the following trademark registrations and application for "OXYGEN AND DEVICE".

a. Trademark Certificate of Registration No. 4-1990-009819 for Class 9;

b. Trademark Certificate of Registration No. 4-1997-117884 for Class 16;

c. Trademark Certificate of Registration No. 4-1999-009822 for Class16;

d. Trademark Certificate of Registration No. 4-1999-009824 for Class 16;

e. Trademark Certificate of Registration No. 4-1997-117883 for Class 24;

f. Trademark Certificate of Registration No. 4-1997-117888 for Classes 25;

g. Trademark Certificate of Registration No. 4-1999-009825 for Class 26;

h. Trademark Certificate of Registration No. 4-1999-009826 for Class 34;

i. Trademark Certificate of Registration No. 4-1997-117887 for Class 42;

j. Trademark Certificate of Registration No. 4-1997-117885 for Class 18;

5. Other than the foregoing trademark registrations for OXYGEN on several classes, the Opposer likewise applied for and registered a number of sub-brands for its OXYGEN products under Class 03. These are the following:

a. RAGE with a status of deemed registered as of April 23, 2007 for Class 03;

b. EDGE with a status of deemed registered as of June 25, 2007 for Class 03;

c. FLUID with Trademark Certificate of Registration No. 4-2003-011167 for

Class 03;

d. CHILLED with a status of deemed registered as of March 19, 2007 for Class 03;

e. 11:55 with Trademark Certificate of Registration No. 4-2004-011974 for Class 03;

f. DARK with Trademark Certificate of Registration No. 4-2007-003044 for Class 03; and

g. NITRO2 with Trademark Application No. 4-2007-008051

6. In addition, the Opposer also uses the sub brands STATIC and G.A.S. for OXYGEN products under Class 03;

7. The Opposer's trademark registration of OXYGEN and DEVICE for Class 03 covers the following products: "perfumery products namely roll-on and spray; colognes, toilet water and toilet lotions, shampoos, soaps, lathering, and softening products for use in bath, toothpaste, cosmetics make-up, eyeliner, eye shadow, blush-on powder, lipstick, facial cleanser, facial moisturizer, toilet products against perspiration, hair dyes, hair gels, powder and nail polish."

8. Since its adoption in 1990 and its continued use in commerce up to the present day, the "OXYGEN" trademark and service mark have been extensively developed and has been applied for trademark registration for products related to clothing. This same mark was extensively advertised by the Opposer in the Philippines on the following products: shirts, jackets, jeans, footwear, sandals, shoes, towels, bags, socks, handkerchief, as well as perfumes, eau de toilette, body sprays, bady soaps, underwear, trinkets, bracelets, and other fashion accessories and paper products.

The exhibits would show the extent of the promotional expenses spent to promote the OXYGEN brand. As shown by these exhibits, among the A-list celebrity endorsers of Oxygen are as follows:

a. Eraserheads- popular pinoy rock band;

b. Mr. Bernard "BJ" Palanca- popular actor and model;

c. Mr. Derek Ramsay- popular model and actor; and

d. Ms. Karel Marquez- popular video jockey ("VJ")

9. The Opposer is filing this opposition against the registration of the subject mark on the ground that it creates confusion of origin, source, and business - causing injury and damage on the original trademark **"OXYGEN"**.

10. The Respondent is applying for the registration of OXYGEN POWER for Class 03 for the following goods: "preparations for body and beauty care, namely, skin creams, gels and lotions, skin cleansing creams, face lotions."

11. In its website www.beierdorf.com, the Respondent issued press releases on July 3, 2007 on its OXYGEN POWER products. In the said press releases, the Respondent revealed that it integrated "pure oxygen" into its cream products.

Attached to the Verified Opposition are the following evidences:

Exhibits	Description
"A'	Copy of Opposer's Trademark Certificate of registration No. 055534 for the "OXYGEN" mark
"B"	Certified copy of Trademark Certificate of Registration No. 4-2000-003878 for Class 03
"C"	Copy of Trademark Certificate of Registration No. 4-1990-009819 for Class 9 for OXYGEN and DEVICE
"D"	Copy of Trademark Certificate of Registration No. 4-1997-117884 for Class 16
"E"	Copy of Trademark Certificate of Registration No. 4-1999-009822 for Class16
"F"	Copy of Trademark Certificate of Registration No. 4-1999-009824 for Class21
"G"	Copy of Trademark Certificate of Registration No. 4-1997-117883 for Class 24
"H"	Copy of Trademark Certificate of Registration No. 4-1997-117888 for Class 25
"I"	Copy of Trademark Certificate of Registration No. 4-1999-009825 for Class 26
"J"	Copy of Trademark Certificate of Registration No. 4-1999-009826 for Class 34
"K"	Copy of Opposer's Trademark Certificate of Registration No. 4-1997-117887 for "OXYGEN and DEVICE"
"L"	Copy of Trademark Certificate of Registration

	No. 4-1997-117885 for Class 18
"M"	Certified true copy of Application Serial No. 4-2006-004656 for the mark RAGE for Class 03
"N"	Certified true copy of Application Serial No. 4-2006-008721 for the mark EDGE for Class 03
"O"	Certified true copy of Certificate of Registration No. 4-2003-11167 for the mark FLUID for Class 03
"P"	Certified true copy of Application Serial No. 4-2005-010297 for the mark CHILLED for Class 03
"Q"	Certified true copy of Certificate of Registration No. 4-2004-011974 for the mark 11:55 for Class 03
"R"	Certified true copy of Application Serial No. 4-2007-003044 for the mark DARK for Class 03
"S"	Certified true copy of Application Serial No. 4-2007-008051 for the mark nitroO2 for Class 03
"T"	Product Catalog Fragrances of Oxygen
"U" inclusive of sub-markings	Samples of the advertising materials of the Opposer for "OXYGEN"

On 12 September 2007, this Bureau issued a Notice to Answer. After granting two Motions for Extension of Time to File Verified Answer, Respondent-Applicant filed its Verified Answer on November 14, 2007 stating among others the following Special and Affirmative Defenses:

"1. Opposer has no cause of action.

2. OXYGEN POWER is by itself a distinctive mark. Its use on goods in Class 3 is arbitrary. Contrary to what Opposer would like this Bureau of Legal Affairs to believe, OXYGEN POWER does not consist exclusively of signs or of indications that may serve in trade to designate the kind, quality quantity, intended purpose, value geographical origin, time or production of the goods, or other characteristics of the goods. Its registration, therefore, is not proscribed under Section 124(i) of Republic Act No. 8293, the Intellectual Property Code of the Philippines.

3. The goods in Class 3 covered by Respondent-Applicant's Trademark

Application No. 4-2006-005710 for OXYGEN POWER are the following: " preparations for body and beauty care, namely, skin creams, gels and lotions, skin cleansing creams, face lotions. Even a specious look or consideration of the trademark preparations for body and beauty care, namely, skin creams, gels and lotions, skin cleansing creams, face lotions in the light of the cited goods will not immediately elicit and impression of the kind,quality, quantity, intended purpose of the kind, quality, quantity or other characteristics of the mentioned goods.

4. The Opposer's claim and assertions that OXYGEN POWER merely describes the stated goods since it contains pure oxygen and is using the power of oxygen to boost the skin's energy level, as supposedly admitted in the Respondent-Applicant's press releases of July 3, 2007, are quite misleading and utterly erroneous assumption and conclusion.

5. The Opposer's claims and assertions were obviously reached through a clever selection and misplaced emphasis on statements from the press releases of July 3, 2007 and not based on actual independent facts. It is important to stress in this respect that the statements pertaining to the oxygen and the description of our skin are plain scientific facts. Needless to say, OXYGEN pervades or permeates our environment and atmosphere. Consequently, such claims and assertions do not in any way establish that OXYGEN POWER is primarily and solely a characteristic of the Class 3 goods embraced by Trademark Application Serial No. 4-2006-005710 of Respondent-Applicant.

Withal, the different foreign registrations involving OXYGEN POWER in Class 3 and closely related goods effectively establish the registrability of OXYGEN POWER.

6. As a matter of fact, a reading and interpretation of the press releases of July 3, 2007 will ineludibly lead to a clearly different conclusion. The second paragraph of page 16 of the verified opposition is quoted below for proper stress.

> "The new solution from NIVEA VISAGE is called Oxygen Power. We named this range for the pioneering technology that enabled us to integrate pure oxygen into cream. It took almost two years to develop the efficient recipe that keeps the volatile O^2 stable, retaining its full effectiveness. It's all down to innovative mixing process developed by the experts at NIVEA VISAGE. The day and night creams from the new NIVEA VISAGE Oxygen Power moisturizing range are guaranteed to contain 15% pure oxygen."

7. Ironically, the Opposer's claim that POWER is definitely a potential sub-brand for its OXYGEN's Class 03 products constitutes a subtle admission that the combination of the word POWER and OXYGEN or OXYGEN POWER, is registrable. Clearly, with the numerous words and phrases in English dictionary that could be employed along with the word OXYGEN it is incredulous, if not ridiculous, for Opposer to assert that the use of POWER is a normal potential expansion of its marks.

8. The records of the Intellectual Property Office show that there are other registrations obtained by other entities in the Philippines covering composite marks involving OXYGEN used on goods in Class 3 and closely related classes. Accordingly, the mere presence of the word OXYGEN does not necessarily warrant the finding of confusing similarity between Respondent-Applicant's OXYGEN POWER and the Opposer's mark.

9. The labels of the OXYGEN POWER, NIVEA OXYGEN POWER, and NIVEA VISAGE OXYGEN POWER products of the Respondent-Applicant clearly reflect the nature, quality, characteristics and origin of the mark. Thus, any tinge of similarity between the Respondent-Applicant's OXYGEN POWER and the Opposer's marks would be consigned to oblivion.

10. All the foregoing conclusion will dovetail into one conclusion, that is, Respondent-Applicant's OXYGEN POWER is distinctive, registrable and not confusingly similar to Opposer's mark."

Together with the Verified Answer, Respondent-Applicant marked and attached the following documentary evidence:

Exhibits	Description
"1"	Authenticated and legalized Affidavit of Peter Nota and Hans-Henning Bernhardt
"2"	Affidavit Testimony of Jan Abigail Ponce-Roxas
"3"	Authenticated and Legalized Special Power of Attorney
"4"	Lists of trademark registrations of Respondent-Applicant for the mark OXYGEN POWER
"5" to "5-M"	Certified copies of trademark registrations owned by Respondent-Applicant for the mark OXYGEN POWER under Class 3.
"6"	Examples of worldwide media campaign
"7"	List of trademark search conducted by

	Belgian Search Institute Compumark for similar mark either containing the word OXYGEN or POWER
"8"	Print-out of the Intellectual Property Office database showing the list of trademark registrations containing the word OXYGEN under third party registrants
"9" to "16"	Authentic and true copies of the printouts of the electronic records of Intellectual Property Office registrations and registered in the name of entities other than the Opposer
"17"	Printout of the USTPTO Online Database showing list of trademark registrations containing the word OXYGEN
"18" to "26"	Printouts of electronic documents showing the details of some of the registrations in Exhibit "17"
"27"	Printout of the Canadian Intellectual Property Office Database showing lists of trademark registrations containing the word OXYGEN
"28" to "31"	Printouts of the electronic documents showing the details of some registrations in Exhibit "27"
"32"	Printout of the Australian Intellectual Property Office Database showing lists of trademark registrations containing the word OXYGEN under third party registrants
"33" to "41"	Printouts of the electronic documents showing the details of some registrations in Exhibit "32"
"42"	Printout of the Australian Intellectual Property Office Database showing lists of trademark registrations containing the word OXYGEN under third party registrants
"43" to "50"	Printouts of the electronic documents showing the details of some registrations in Exhibit "42"
"51"	Printout of the Office for Harmonization in the Internal Market Database showing lists of trademark registrations containing the word OXYGEN under third party registrants
"52" to "61"	Printouts of the electronic documents showing the details of some registrations in Exhibit "51"
"62"	Printout of the WIPO Database showing lists of trademark registrations containing the word OXYGEN under third party registrants

"63" to "70"	Printouts of the electronic documents showing the details of some registrations in Exhibit "62"
"71"	Printout of Beierdorf website
"72" to "74"	2004 to 2006 Annual Reports of Respondent-Applicant
"75" to "75-K"	Printouts of the Nivea website

On December 3, 2007, a Reply was filed by Opposer and on December 17, 2007, Respondent-Applicant filed its Rejoinder. During the Preliminary Conference of the case, the parties manifested that they will explore the possibility of a compromise agreement. However, despite the considerable time given to the parties to settle their case, they failed to submit a compromise agreement, so that the preliminary conference was terminated. The parties were then directed, under Order No. 2008-1368 to file their respective position. On 20 October 2008, Respondent filed its Position Paper while Opposer filed its own Position Paper on 24 October 2008. Hence, the case was submitted for decision.

The sole issue to be resolved in this case is: **WHETHER OR NOT THE MARK "OXYGEN POWER" OF RESPONDENT-APPLICANT SHOULD BE REGISTERED.**

To determine the registrability of a mark, **Republic Act No. 8293, as amended particularly Section 123.1 (d)** thereof provides:

"SEC. 123. *Registrability*. - 123.1 A mark cannot be registered if it:

x x x x

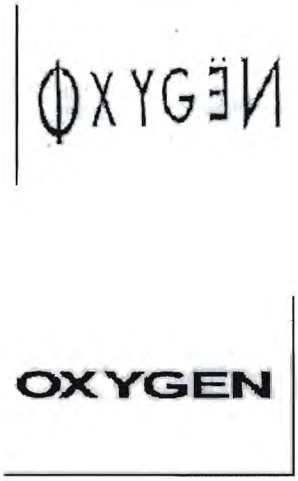
(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

i. The same goods or services, or

ii. Closely related goods or services, or

iii. If it nearly resembles such a mark as to be likely to deceive or cause confusion;"

In determining the existence of confusing similarity, it becomes essential for this Bureau to make a comparison of the marks involved to determine the points where these marks are similar, in spelling, sound and manner of presentation or general appearance. For a better appreciation of the respective claims and arguments of the parties, the two marks are reproduced hereunder exactly as it appears in the application or the facsimile copy of the registration records filed with this Office

Opposer's marks	Respondent-Applicant's Mark
	OXYGEN POWER

As can be seen from the above-reproduced marks of the parties, it is apparent that Respondent-Applicant's mark OXYGEN POWER is similar to Opposer's registered mark OXYGEN. It appears that the dominant word in both mark is "OXYGEN". Although as the illustration of Respondent mark would disclose, apart from the use of the word OXYGEN, the word "Power" is added after the word OXYGEN. Such difference, however, pales into insignificance because of the presence of the word OXYGEN which is Opposer's mark itself. Moreover, time and again it has been held that **the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term.[1] Applying said principle in this case, likelihood of confusion or mistake cannot be avoided by the adding the term POWER after the dominant word OXYGEN, as in this case.**

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand mistaking the newer brand for it.

Colorable imitation does not mean such similitude as amounts to identity. Nor does it require that all the details be literally copied. Colorable imitation refers to such similarity in form, content, words, sound, meaning, special arrangement, or general appearance of the

1 Continental Connector Corp. vs. Continental Specialties Corp. 207 USPQ 60.

trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely mislead or confuse persons in the ordinary course of purchasing the genuine article.[2]

Aside from the presence of the dominant word OXYGEN, the goods of the parties on which the marks are used are similar or related goods which belong to Class 03 of the International Classification of goods which, all the more makes apparent the likelihood of confusion and mistake on the public apparent.

It must be always emphasized that the protection of trademarks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trademark is a merchandising shortcut, which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, due aim is the same — to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trademark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.[3]

WHEREFORE, premises considered, the Notice of Verified Opposition filed by Opposer, GOLDEN ABC, INC. against Respondent-Applicant's OXYGEN POWER is, as it is hereby **SUSTAINED**. Consequently, the trademark application for the registration of the mark OXYGEN POWER used for preparations for body and beauty care, namely, skin creams, gels and lotions, skin cleansing creams, face lotions under Class 03 of the international classification of goods bearing Application Serial No. 4-2006-005710 filed by respondent-applicant Beierdorf AG, filed on 330 May 2006 is, as it is hereby, **REJECTED**.

Let the filewrapper of **OXYGEN POWER** be transmitted to the Bureau of Trademarks (BOT) for appropriate action in accordance with this DECISION.

SO ORDERED.

Makati City, 16 March 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs

2 Emerald Garments Manufacturing Corporation vs. Court of Appeals, G.R. No. 100098. December 29, 1995.
3 Supra.