

**OCCIDENTAL CHEMICAL CORPORATION,**  
*Opposer,*

**-versus-**

**OXYCHEM CORPORATION,**  
*Respondent-Applicant.*

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}	<b>IPC No. 14-2015-00452</b>
}	Opposition to:
}	Appln. Serial No. 4-2012-00012881
}	Date Filed: 19 October 2012
}	
}	
}	<b>TM: OXYCHEM CORPORATION</b>
}	<b>AND LOGO</b>

**NOTICE OF DECISION**

**DEL ROSARIO & DEL ROSARIO**  
*Counsel for Opposer*  
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Bonifacio Global City 1630 Taguig City


**OXYCHEM CORPORATION**  
*Respondent- Applicant*  
50 San Joaquin Street, Brgy. Plainview,  
Mandaluyong City

**GREETINGS:**

Please be informed that Decision No. 2017 - 03 dated 12 January 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 16 January 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs

<b>OCCIDENTAL CHEMICAL CORPORATION,</b>	} <b>IPC NO. 14-2015-00452</b>
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2012-00012881
	} Date Filed: 19 October 2012
	}
<b>OXYCHEM CORPORATION,</b>	} <b>Trademark: OXYCHEM</b>
Respondent-Applicant.	} <b>CORPORATION AND LOGO</b>
	}
x-----x	} <b>Decision No. 2017-03</b>

**DECISION**

OCCIDENTAL CHEMICAL CORPORATION, (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2012-00012881. The application, filed by OXYCHEM CORPORATION (Respondent-Applicant)<sup>2</sup>, covers the mark “OXYCHEM CORPORATION AND LOGO”, for use on “disinfectant concentrate, sanitizer, oven cleaner, carpet shampoo, fuel, gel, chaufing dish, wax stripper, all purpose detergents, windshield cleaner, tire black degreaser, dashboard polish, water marks remover, radiator coolant, radiator cleaner, smokehouse cleaner, table top sanitizer, stainless cleaner, liquid hand soap, chlorinated alkaline cleaner, rust and scale cleaner, liquid detergent for food industry, powder bleach, oxygen bleach, anti-yellowish agent, alkali, laundry starch, softener paint and oil greaser remover, rust stain cleaner, fabric freshner, fabric cologne, dry cleaning solution, buffable emulsion wax, stone polish, automatic dishwashing machine cleaner, drying agent for automated dishwashing machine, tub and tile cleaner, insecticide-food grade, juice dispenser cleaner, special dishwashing solution, flame wax solution, and other products for industrial and institutional industry products related to preventive maintenance chemicals” under Class 3 of the International Classification of Goods<sup>3</sup>.

The Opposer anchors its opposition on the ground that the mark OXYCHEM CORPORATION LOGO is confusingly similar to the dominant portion of its well known mark OXYCHEM under Registration No. 54893 which was issued on 4 May 1993. According to the Opposer, the previous decision of the Bureau of Legal Affairs which barred its registration is *res judicata* in this instant case. In addition, the Opposer contends that the World Intellectual Property Organization (WIPO), Arbitration and Mediation Center rendered a decision dated 5 September 2015 stating that Respondent-Applicant's use of the associated website was not in good faith. According to the Opposer, the Respondent-Applicant is using the disputed domain name in an attempt to

<sup>1</sup> A foreign corporation with address at 5005 LBJ, Freeway, Dallas, Texas 75224, USA

<sup>2</sup> A domestic corporation with address at #50 San Joaquin Street, Brgy Plainview, Mandaluyong City 1550

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

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misdirect or divert internet users to the associated website by creating a likelihood of confusion of the trademark.

The Opposer is a North American manufacturer of chemical products necessary for a variety of products such as plastics, pharmaceuticals and water treatment chemicals. It claims to be the owner of the registered "OXYCHEM" for goods under classes 1, 17 and 19. It argues that the use by the Respondent-Registrant on goods that are closely related to its products will cause confusion and mistake as to the origin of the goods.

To support its opposition, the Opposer submitted as evidence copies of its US trademark registrations for "OXYCHEM"; Copy of Registration No. 54893; list of trademark registration in various countries; Affidavit of Mr. Wade L. Alleman; Copy of decision in IPC Case No. 14-2011-00285; and certified copy of WIPO Administrative Panel Decision dated 9 September 2015.<sup>4</sup>

This Bureau served upon the Respondent-Applicant a "Notice to Answer" on 15 February 2016. The Respondent-Applicant, filed on 28 March 2016 a Manifestation/Comment to the Opposition.

Section 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

Sec. 123.1. Registrability. A mark cannot be registered if it:

- (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.

Records show that at the time Respondent-Applicant applied for registration of the mark "OXYCHEM" the Opposer already registered the mark "OXCHEM" under Certificate of Registration No. 54893<sup>5</sup>.

The competing marks, depicted below, are identical:

**OXYCHEM**

Opposer's mark



Respondent-Applicant's mark

<sup>4</sup> Annexes "A" to "I"


<sup>5</sup> Annex "F"

Scrutinizing the marks, the word component, OXYCHEM is identical. It is also noted that Opposer's registered mark has already expired. Be that as it may, it cannot be ignored that in the previous decision by the Bureau of Legal Affairs in IPC Case No. 14-2011-00285, the Opposer was recognized as the prior adopter, owner and registrant of the mark OXYCHEM. In fact, the OXYCHEM CORPORATION AND LOGO of the Respondent-Applicant, bears an uncanny resemblance to the mark of the Opposer in the list of Opposer's trademarks. In the instant case, the goods covered by the Opposer's trademark registration are related to "other products for industrial and institutional industry products related to preventive maintenance chemicals" indicated in the Respondent-Applicant's trademark application. There is a likelihood that consumers will be mistaken, confused or deceived as to the origin or affiliation of the Respondent-Applicant's goods if the registration of the OXYCHEM CORPORATION AND LOGO is allowed.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2012-00012881 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 12 JAN 2017

  
**ATTY. ADORACION U. ZARE, LL.M.**  
Adjudication Officer  
Bureau of Legal Affairs