N.V. BEKEART S.A., Opposer, **-versus-** **WILTON N. DY,** Respondent- Applicant.	}	**IPC No. 14-2015-00580** Opposition to: Appln. Serial No. 4-2014-505327 Date Filed: 11 November 2014 **TM: "DRAMIX"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 15 dated January 20, 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, January 23, 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

N.V. BEKEART S.A,
Opposer,

versus-

WILTON N. DY,

Respondent-Applicant.
x----------x

IPC NO. 14-2015-00580

Opposition to:
Appln. Ser. No. 4-2014-505327
Filing Date: 11 November 2014

Trademark: **DRAMIX**

Decision No. 2017 - 15

DECISION

N.V. BEKEART S.A[1] ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2014-505327. The application, filed by WILTON N. DY[2] ("Respondent-Applicant") covers the mark **DRAMIX** for use on *"chemicals, cements, water proofing, glue for industrial purposes, adhesives for tiles"* under Class 1; "*paints*" under Class 2; and "*grout*" under Class 19 of the International Classification of goods[3].

The Opposer alleges the following grounds:

"1. The trademark DRAMIX Respondent-Applicant seeks to register in respect of 'chemicals, cements, water proofing, glue for industrial purposes, adhesive for tiles' in class 01, 'paints' in class 02, and 'grout' in class 19, is identical with Opposer's prior trademark registration **DRAMIX** for "concrete containing steel wire shaped to lengths for its reinforcement" also in class 19, and 'steel wire shaped to lengths for the reinforcement of mixed concrete, concrete material and concrete products' in class 6.

"1.1. The registration of an identical trademark DRAMIX also for concrete products and/or industrial materials will be a breach of the clear provision of Section 123.1 (d) of the Intellectual Property Code of the Philippines ("Code") which provides:

xxx

"1.2. Respondent-Applicant's trademark DRAMIX is identical with Opposer's registered trademark **DRAMIX**.

"1.3. Opposer's trademark **DRAMIX** with Philippine Trademark Registration No. 4-2003-000205 has earlier filing and registration dates than Respondent-Applicant's trademark

[1]A a corporation duly organized and existing of the laws of Belgium, with principal office at Bekaertstraat 2, B-8550 Zwevegem, Belgium.
[2]A Filipino citizen with address at 2216 Oroquieta Street, Sta. Cruz, Manila.
[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.

application for DRAMIX .

"1.4. Respondent-Applicant seeks to register the mark DRAMIX for various concrete products and industrial materials, which are the very same goods covered by Opposer's trademark registration for **DRAMIX.**

"1.5. Due to the identity of: (a) Respondent-Applicant's trademark DRAMIX with Opposer's trademark **DRAMIX;** and (b) the goods they cover, the public is likely to assume that Respondent-Applicant's goods originate from Opposer.

"1.6. Thus, the identity between: (a) DRAMIX and **DRAMIX;** and (b) the goods for which said marks are used clearly place Respondent-Applicant's trademark application for DRAMIX within the scope of proscription found in *Section 123.1 (d)* of the IP Code.

"2. It is well settled that if the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place.

"2.1. Duplication or imitation is not necessary; nor is it necessary that the infringing mark should suggest an effort to imitate.

"2.2. Rather, it is enough that colorable imitation of the mark exists to make a finding of infringement. As defined, colorable imitation refers to such similarities between both marks with respect to their essential, substantive, and distinctive parts.

"2.3. In this case, there is no doubt that DRAMIX contains the word "Dramix", which is the sole feature of the registered mark **DRAMIX.** The only visible difference between the two marks is the slight variation in presentation of the syllable "DRA" in Respondent-Applicant's mark.

"2.4. This negligible difference in presentation is inconsequential as confusion cannot be avoided by merely adding, dropping, and/or changing some of features of a registered mark. In any case, the overall impression and pronunciation of both marks remain identical.

"2.5. Hence, any use of the mark DRAMIX which is but a reproduction of the registered mark **DRAMIX,** constitutes trademark infringement under *Sec. 155 of the IP Code,* which states:

xxx

3. Opposer's trademark **DRAMIX** is well-known internationally and in the Philippines. Hence, the registration of a confusingly similar trademark DRAMIX will constitute a breach of the clear provisions of *Article 6bis of the Paris Convention and Section 123.1 (f) of R.A. 8293* on well-known marks, to wit:

xxx

"4. The registration of and/or use of DRAMIX , will dilute the distinctiveness of **DRAMIX.**

"5. Finally, the adoption by Respondent-Applicant of the trademark DRAMIX is clearly tantamount to unfair competition.

"6. The foregoing considered, the interests of Opposer as the owner of the internationally well-known **DRAMIX** trademark, will be damaged and prejudiced by the unauthorized use and adoption as well as the registration by Respondent-Applicant of the trademark DRAMIX ."

The Opposer's evidence consists of the following:

1. A copy of Philippine Trademark Registration No. 4-2003-000205 for DRAMIX issued on 12 May 2005;
2. List of the worldwide trademark registrations and/or applications for DRAMIX;
3. Certified copies of trademark registrations and/or applications for DRAMIX in other countries;
4. Certified copy of the certificate of international trademark registrations and/or applications for DRAMIX;
5. Certified copy of the certificate of trademark registrations and/or applications for DRAMIX in class 6 issued in China;
6. Certified copy of the certificate of trademark registrations and/or applications for DRAMIX in class 19 issued in China;
7. Certified copy of the certificate of trademark registrations and/or applications for DRAMIX in Malaysia and U.S.A.;
8. Sample promotional materials for DRAMIX;
9. Pictures of products bearing the trademark DRAMIX;
10. Downloaded pages from the following websites:
- http://www.bekaert.com/en/products/construction/concrete-reinforcement
- https://www.youtube.com/watch?v=UrPW89EmN0I
- http://www.ribaproductselector.com/Product.aspx?ci=17706&pr=bekaert-Dramix
- http://www.ncg.solutions/assets/files/products/01_materials_for_industrial_floors/1_fibri_za_beton/Dramix%20ZP%20305_en.pdf
- http://www.vandekerckhove-devos.be/blog/post/bekaert-dramix
- http://www.dramicom.com/dramix.htm
- http://www.kingspanpanels.co.nz/multideck/dramix.htm
- http://www.shining-light-solutions.co.uk/proconfloors.com/pages/fibres_tech.html
- http://tunnelbuilder.com/News/Bekaert-launches-new-Dramix-fibres.aspx
- http://www.bm-underground.com/en_gb/products/detail/39/dramix%C2%AE+3d+fibres; and

11. A legalized copy of a certified extract from the Belgian Official Gazette (with English translation).

This Bureau issued on 01 February 2016 a Notice to Answer and served it to Respondent-Applicant on 12 February 2016. Despite receipt of the Notice, Respondent-Applicant failed to file the answer. On 22 July 2016, this Bureau declared Respondent-

Applicant in default. Hence, this case is submitted for decision on the basis of the opposition, the affidavits of witnesses, if any, and the documentary evidence submitted by the Opposer pursuant to Rule 2 Section 10 of the Rules and Regulations on Inter Partes Proceedings, as amended.

Should the Respondent-Applicant be allowed to register the mark "DRAMIX"?

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.[4] Thus, Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records will show that at the time Respondent-Applicant filed his application for the DRAMIX mark on 11 November 2014, Opposer already has an existing registration for the same mark issued on 12 May 2005, or nine (9) years earlier. As such, between Opposer and Respondent-Applicant, the former has priority right over the other.

But are the marks of the parties confusingly similar as to likely cause confusion or mistake on the public? The marks of the parties are shown below:

Opposer's Mark	Respondent-Applicant's Mark
Dramix	DRAMIX

There is no doubt that Respondent-Applicant's mark is confusingly similar to the Opposer's. Confusion is likely in this instance because of the resemblance of the competing trademarks. The competing marks contain the word "DRAMIX" which constitute the marks of the parties. While Opposer's mark which consists of the word "DRAMIX" is written plainly without any device or other feature unlike Respondent-Applicant's where the letters "D-R-A" is written in uppercase letters in white color inside a black rectangle, still there is a likelihood that consumers or the public will be confused, mistaken or deceived that the goods upon which the

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

competing marks are used come from the same source or origin because of the presence of the word "DRAMIX".

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.[5]

A boundless choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his product from those of others. When, however, there is no reasonable explanation for the defendant's choice of such a mark though the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive.[6]

As to the goods, Opposer's mark is used on "*steel wire shaped to lengths for the reinforcement of mixed concrete, concrete material and concrete products*" under Class 6 and "*concrete containing steel wire shaped to lengths for its reinforcement*" under Class 16. On the other hand, Respondent's mark is used on "*chemicals, cements, water proofing, glue for industrial purposes, adhesives for tiles*" under Class 1; "*paints*" under Class 2; and "*grout*" under Class 19. Both goods of Opposer and Respondent-Applicant are used for industrial purposes, as such they are related. Thus, the relatedness of the goods upon which the marks of the parties are used will likely cause confusion, mistake or deception on the part of the public into believing that the goods of the parties comes from the same source or originated or manufactured from

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.[7]

Thus, the registration of Respondent-Applicant's mark is proscribed by Section 123.1(d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby ***SUSTAINED***. Let

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[5] *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.
[6] *Converse Rubber Corporation vs. Universal Rubber Products, Inc., G.R. No. L-27906. January 8, 1987.*
[7] *Societe Des Produits Nestle, Et. Al. vs. Court of Appeals. G.R. No. 112012. April 4, 2001*

the filewrapper of Trademark Application Serial No. 4-2014-505327, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 JAN 2017

MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs