

**INTELLECTUAL PROPERTY OFFICE  
OF THE PHILIPPINES**  
BUREAU OF TRADEMARKS  
Intellectual Property Center, 28 Upper McKinley  
Rd., McKinley Hill Town Center, Fort Bonifacio,  
Taguig City 1634, Philippines  
Website: <http://www.ipophl.gov.ph>

DOCUMENT NO.	2019/21984
DATE OF NOTIFICATION	25 January 2019

The International Bureau  
World Intellectual Property Organization  
34, chemin des Colombettes  
1211 Geneva 20  
Switzerland

**NOTIFICATION OF A PROVISIONAL REFUSAL OF PROTECTION  
OF AN INTERNATIONAL REGISTRATION DESIGNATING  
THE PHILIPPINES  
Rule 17(1)**

International Registration No: **1387991**

IR Date/Subsequent Designation Date: 11 December 2017

Holder: **GUANGZHOU DARING INTERNATIONAL FORWARDING CO., LTD. [CN]**

Mark: **LUX**

Supervising Examiner: **MARITES O. SALVIEJO**

The mark has been examined, allowed and published for opposition. However, a **Verified Notice of Opposition** was filed with the Bureau of Legal Affairs (BLA) and this prevents the Intellectual Property Office of the Philippines (IPOPHL) from granting the registration of the mark for **all the goods and/or services**.

***Information relating to the Opposition:***

Name and address of Opposer:

**BISWANATH HOSIERY**

P.S. Srijan Tech Park, DN-52, Sector-V, 10th Floor, Salt Lake City, Kolkata-700 091, India

Name and address of Counsel for Opposer:

**OCLaw**

2F, AGS Building, 446 EDSA Makati City, Metro Manila 1211

Date on which the opposition period begins: **26 March 2018**

Date on which the opposition period ends: **25 April 2018**

Filing date of Verified Opposition: **24 July 2018**

***Information relating to subsequent procedure:***

The Respondent-Applicant must file a **VERIFIED ANSWER** within thirty (30) days from receipt of a copy of the Notice to Answer (hereto attached), with proof of service thereof to the opposer or petitioner. The respondent shall attach to the Answer the affidavits of witnesses and other documentary or object of evidence, which must be duly-marked starting from Exhibit "1". The verification and the document showing the authority of the signatory thereto, the affidavits and other pertinent documents, if executed and notarized abroad, must be authenticated by the appropriate Philippine diplomatic or consular office. The execution and authentication of these documents must have been before the filing of the Answer. **[Rule 2, Section 9(a) of the Amended Rules and Regulations on Inter Partes Proceedings]**

Upon proper motion founded on meritorious grounds, and the payment of the applicable fees, an additional period of thirty (30) days within which to file the answer may be granted. A second motion for extension of thirty (30) days may

be granted on compelling grounds and upon payment of the applicable fees; provided, that in no instance shall the filing of the Verified Answer exceed one hundred twenty (120) days from the date of receipt of the copy of the Notice to Answer [Rule 2, Section 9(b) of the Amended Rules and Regulations on *Inter Partes* Proceedings]. The motion for extension (if any) and the Verified Answer must be filed by the respondent-applicant's local representative in the Philippines (the list of agents in the Philippines is available on the IPOPHL website).

Failure to file the Verified Answer or to complete the requirements, the respondent-applicant shall be declared in default. The Hearing or Adjudication Officer shall issue the Order of Default and shall require in the said order the opposer or petitioner to submit or present within ten (10) days from receipt thereof the originals and/or certified copies of the affidavits, documentary evidence and object evidence, if necessary. The case shall then be decided on the basis of the petition or opposition, the affidavits of the witnesses and the documentary or object of evidence submitted by the petitioner or opposer. [Rule 2, Section 14 of the Amended Rules and Regulations on *Inter Partes* Proceedings]

All responses or communications should be addressed to: THE DIRECTOR OF BUREAU OF LEGAL AFFAIRS, Intellectual Property Office of the Philippines, 16/F Intellectual Property Center, No. 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio, Taguig City 1634, Philippines.

***Additional information:***

The IPOPHL requires the submission of the Declaration of Actual Use (DAU) within three (3) years from the date of international registration or the date of subsequent designation, as the case may be; within one (1) year from the fifth anniversary of the date of grant of protection of the mark, within one (1) year from the renewal date, and within one (1) year from the fifth anniversary of each renewal. The provisions governing the filing of the DAU are contained in the Trademark Regulations of 2017.

**BISWANATH HOSIERY MILLS LTD.,**

Opposer,

-versus-

**GUANGZHOU DARING INTERNATIONAL  
FORWARDING CO., LTD.,**

Respondent-Applicant.

**IPC NO. 14-2018-00249**

Opposition to:

Appin. Ser. No. 1387991

Date Filed: 11 December 2017

Trademark: **LUX**

### NOTICE TO ANSWER

**GUANGZHOU DARING INTERNATIONAL  
FORWARDING CO., LTD.**

Respondent-Applicant

Rm. 719, No. 799, Sanyuanli Avenue

Baiyun Dist. Guangzhou

510000 China


### GREETINGS:

BISWANATH HOSIERY MILLS LTD., filed a Verified Notice of Opposition to your Trademark Appin. No.1387991.

The Verified Notice of Opposition being compliant with the requirements under Rule 2, Sec. 7 and Rule 7, Sec. 2 of the Office Order 99 as amended by IPOPHIL Memorandum Circular No. 16-007 of the Revised Rules and Regulations on Inter Partes Proceedings which took effect on 29 July 2016, you are hereby required to file a **VERIFIED ANSWER** within thirty (30) days from receipt hereof. Your Verified Answer must conform to Rule 2, Sec.5 of the revised rules. Non-compliance with the requirements shall be deemed failure to file the answer.

Corollarily, Rule 2, Sec. 12 of the revised rules provides that a respondent shall be declared in default in case of failure to file the answer or if the answer is filed out of time. Consequently, the case shall be decided on the basis of the opposition and evidence submitted by the Opposer.

Taguig City, 07 August 2018.

  
**ATTY. NATHANIEL S. AREVALO**  
Director IV, Bureau of Legal Affairs

Copy furnished:

**DC LAW**

Counsel for Opposer  
2F, AGS Building, 446 EDSA  
Makati City, Metro Manila

REPUBLIC OF THE PHILIPPINES  
INTELLECTUAL PROPERTY OFFICE OF THE PHILIPPINES  
BUREAU OF LEGAL AFFAIRS  
TAGUIG CITY, METRO MANILA

**BISWANATH HOSIERY  
MILLS LTD.,**

IPC No. 14-2018-00249

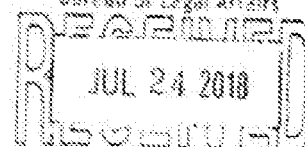
*Opposer,*

*-versus-*

**GUANGZHOU DARING  
INTERNATIONAL  
FORWARDING CO., LTD.,**  
*Respondent-Applicant.*

Opposition to International  
Registration No.: 1387991  
Date Filed: 11 December 2017  
Date Published: 25 March 2018  
Class : 25

Trademark: "Lux"  
Property Office of the Phils  
Bureau of Legal Affairs



X-----X

BY: CATH DATE: 2:20

**VERIFIED NOTICE OF OPPOSITION**

Opposer, **BISWANATH HOSIERY MILLS LTD.** ("Biswanath Hosiery"), through the undersigned counsel, most respectfully states:

**PARTIES**

1. Biswanath Hosiery is a corporation duly organized and existing under the laws of the Republic of India, with principal place of business at Lux Industries Limited ("Lux Industries"), P.S. Srijan Tech Park, DN -52, Sector-V, 10th Floor, Salt Lake City, Kolkata – 700 091, India.

1.1. It is represented in these proceedings by the undersigned law firm, where it may be served with orders, notices and other processes of this Honorable Office at the address indicated below. The original and authenticated Special Power of Attorney ("SPA") executed by the duly authorized representative of Biswanath Hosiery in favor of DCLaw dated 07 May 2018 is attached as "Exhibit A" while the original and authenticated Certification dated 02 May 2018, showing the authority of Biswanath Hosiery's representative to execute the SPA is attached as "Exhibit B".

1.2. Biswanath Hosiery has a real and effective industrial establishment in the Republic of India, which is a party to the Paris Convention for the Protection of Industrial Property (the "Paris Convention") and the Trade-Related Aspects of Intellectual Property Rights ("TRIPS") Agreement. Biswanath Hosiery is filing this Opposition based on Section 3<sup>1</sup> of Republic Act ("RA") 8293 or the Intellectual Property Code of the Philippines ("IP Code").

2. It appears that the Respondent-Applicant has an address located at Rm. 719, No. 799, Sanyuanli Avenue, Baiyun Dist. Guangzhou, China, where it may be served with summons, pleadings, notices, and other court processes of the Honorable Office.

### STATEMENT OF FACTUAL ANTECEDENTS

3. On 11 December 2017, the Respondent-Applicant sought the registration of the trademark for LUX belonging to Biswanath Hosiery for goods under Class 25 consisting of "Tee-shirts; smocks; clothing; sports jerseys; knitwear [clothing]; shoes; hats; hosiery; scarves; leather belts [clothing]." A copy of International Registration No. 1387991 is attached as "Exhibit C".

4. On 25 March 2018, the Respondent-Applicant's trademark application was published for allowance in the Bureau of Trademarks E-Gazette. A copy of the application published in this Honorable's Office website is attached as "Exhibit D".

5. Within the period allowed by the Regulations on *Inter Partes* Proceedings, as amended ("Amended Regulations"), Biswanath Hosiery requested on 25 April 2018, on 24 May 2018 and on 22 June 2018 for additional periods to file the Verified Notice of Opposition ("Opposition"), or until 24 July 2018.

6. Hence, this Opposition is timely filed.

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<sup>1</sup>Section 3. *International Conventions and Reciprocity.* — Any person who is a national or who is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law, shall be entitled to benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by this Act.

## **GROUND S IN SUPPORT OF THE OPPOSITION**

### **I**

THE REGISTRATION OF THE MARK "LUX" SUBJECT OF THIS OPPOSITION IS CONTRARY TO THE PROVISIONS OF SECTION 123.1 (E) OF RA No. 8293, AS AMENDED.

- A. BISWANATH HOSIERY IS THE FIRST TO ADOPT, USE AND REGISTER THE MARK, "LUX."
- B. BISWANATH HOSIERY'S MARK, "LUX", IS A WELL-KNOWN TRADEMARK.

### **II**

THE RESPONDENT-APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO BISWANATH HOSIERY'S MARK AND USED FOR IDENTICAL AND SIMILAR GOODS.

- A. THE RESPONDENT-APPLICANT'S MARK MAY NOT BE REGISTERED BECAUSE IT IS IDENTICAL AND LIKELY TO CAUSE CONFUSION WITH BISWANATH HOSIERY'S MARK, "LUX", WHICH IS A WELL-KNOWN MARK.
- B. THE REGISTRATION OF RESPONDENT-APPLICANT'S MARK WILL INDICATE A FALSE CONNECTION BETWEEN THE GOODS OFFERED BY RESPONDENT-APPLICANT AND BISWANATH HOSIERY.

### **III.**

THE REGISTRATION OF THE MARK "LUX" BY THE RESPONDENT-APPLICANT IS IN BAD FAITH.

### **IV.**

"LUX" IS ALSO BISWANATH HOSIERY'S TRADE NAME OR CORPORATE NAME AND MUST BE PROTECTED AS SUCH UNDER SECTION 165.2 OF RA 8293.

## DISCUSSION

- I. THE REGISTRATION OF THE MARK "LUX" SUBJECT OF THIS OPPOSITION IS CONTRARY TO THE PROVISIONS OF SECTION 123.1 (E) OF RA No. 8293, AS AMENDED.
- A. BISWANATH HOSIERY IS THE FIRST TO ADOPT, USE AND REGISTER THE MARK, "LUX".
- B. BISWANATH HOSIERY'S MARK, "LUX," IS A WELL-KNOWN TRADEMARK.

7. Biswanath Hosiery is a subsidiary of Lux Industries Limited ("Lux Industries"), also a corporation duly organized and existing under the laws of the Republic of India and with principal place of business at Lux Industries Limited, P.S. Srijan Tech Park, DN-52, Sector-V, 10th Floor, Salt Lake City, Kolkata – 700 091, India.

8. Biswanath Hosiery and Lux Industries have more than fifty (50) years of experience in manufacturing, distribution and retail in the hosiery industry. Biswanath Hosiery was established in 1957 in India by the late Girdharilalji Todi. The next 20 years saw the company growing 100 times in size through a series of marketing and manufacturing innovations.<sup>2</sup>

9. In the early 1990's, the Biswanath Hosiery launched export operations and quickly established a strong presence overseas, with offices in the Middle East, Europe, and Africa. In the span of a few years, it has gained a strong foothold in the global hosiery arena and has increased global exports by over 60%.<sup>3</sup>

10. In the year 1995, Biswanath Hosiery was incorporated into Lux Industries under the leadership of Mr. Ashok Todi and Mr. Pradeep Todi. Biswanath Hosiery became a subsidiary of Lux Industries, which started marketing its products under the brand name, 'Lux', throughout the hosiery market.<sup>4</sup>

11. The export operation of Lux Industries and Biswananth Hosiery was followed in short order by the establishment of over

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<sup>2</sup> Exhibit "E."

<sup>3</sup> Exhibit "E."

<sup>4</sup> Exhibit "E."



500,000 retail outlets all over India, and offices in Kolkata, Delhi, Agra, Indore, Mumbai, Ludhiana, Jaipur, and Roorkee.<sup>5</sup>

12. In 2001, Lux Industries went public and for the first time, ownership of the company was available outside of the Todi family. In 2003, Lux Industries launched its first initial public offering.<sup>6</sup>

13. Lux Industries has manufacturing facilities/factories in six locations across India housing modern and top grade infrastructure and state-of-the-art equipment to allow it to create top-notch products for consumers. It has over 350 circular knitting machines, including Sinker, Rib and Interlock machines, used to create top quality products.<sup>7</sup>

14. Lux Industries takes pride in its cutting-edge technology orientation by introducing a bouquet of modern machineries and equipment imported from reputed brands from all over the world like Singapore, Italy, Germany and China. In its Dankuni plant, imported state of the art equipment from Morgan Tecnica, Mayer & Cie, Bierrebi, Hi-tech Fabric Inspection Machines, Eastman Machineries, Siruba, Juki and Brothers, etc. are installed which reduce wastages and help bringing efficiency in manufacturing process, reduce time and improve quality.<sup>8</sup>

15. Lux Industries now employs people in over a dozen offices. This helps Lux Industries to meet all demands from clients all around the world.<sup>9</sup>

16. Aside from identifying its corporate name, the expression "LUX" also constitutes the brand name and trademark of Lux Industries and Bawanath Hosiery's products. Lux Industries founder conceived and adopted the trademark LUX as early as 1957, which Bawanath Hosiery and Lux Industries have extensively used ever since in respect to goods under Class 25.<sup>10</sup>

17. Bawanath Hosiery and Lux Industries have coined and adopted a number of LUX variant trademarks, which are used in commerce in India, and several countries and regions around the world. These trademark variants are LUX PREMIUM, LUX and LUX COZI ONN.<sup>11</sup>

18. Bawanath Hosiery, as a holder of LUX trademark, remains the holder of LUX trademark.

variants for goods registered under Class 25 in over 100 jurisdictions namely:

TRADEMARK	COUNTRY	Registration No.	Filing Date	Registration Date
LUX PREMIUMS (LABEL)	AFGHANISTAN	2141	19/05/2014	19/05/2014
LUX (LABEL)	ALGERIA	120784	05/03/2012	
LUX PREMIUMS (LABEL)	ALGERIA	120783	05/03/2012	
ONN (Label)	ALGERIA	DZ/T/2013/004571	08/12/2013	
LUX PREMIUMS (LABEL)	ANGOLA	40499	20/06/2014	
LUX PREMIUMS (LABEL)	BAHRAIN	TM92266	28/05/2012	28/05/2012
LUX	BAHRAIN	TM41499	01/06/2004	
LUX	BANGLADESH	169321	27/10/2013	
LUX	BANGLADESH	56705	18/06/1998	
LUX	BHUTAN	BT/M/98/01485	07/10/98	07/10/1998
LUX PREMIUMS (Label)	BOTSWANA	BW/M/2015/00326	24/04/2015	24/04/2015
LUX PREMIUMS (LABEL)	CTM countries namely: Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania	11087178	01/08/12	01/08/12

	Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, and United Kingdom			
LUX PREMIUMS (Label)	DJIBOUTI	095/13	20/05/2013	
LUX MAESTRO	EGYPT	369286	15/04/2018	
LUX PREMIUMS	ETHIOPIA	FTM/0565/1 3	26/09/2012	
LUX PREMIUMS (LABEL)	GAMBIA	GM/M/2014/ 00262	17/06/2014	
ONN (Label)	GHANA	2565/13	21/11/2013	
GENX	GHANA	000396/2014	14/02/2014	
ONN (LABEL)	HONG KONG	302847448	23/12/2013	23/12/2013
LUX PREMIUMS (LABEL)	IRAN	191070900	02/10/2012	
LUX VENUS (LABEL)	IRAN	189032409	21/06/2010	
LUX PREMIUMS (LABEL)	IRAQ		18/02/2018	
LUX MAESTRO	ISRAEL	304286	08/04/2018	
LUX PREMIUMS (LABEL)	JORDAN	21231 (125306)	20/05/12	
ONN (Label)	KENYA	80882	25/11/2013	25/11/13
LUX (word per se)	KENYA	74251	05/03/2012	05/03/2012
LUX MAESTRO	KUWAIT	2018/002385	13/03/2018	
LUX PREMIUMS (Label)	LESOTHO	LS/M/2015/1 70	04/05/2015	
LUX	LIBYA	24127	10/09/2013	

PREMIUMS (LABEL)				
LUX PREMIUMS (LABEL)	MALAYSIA	2012011895	12/07/201	12/07/201
LUX (word per se)	MALAYSIA	2013007955	10/06/2013	10/06/2013
LUX (Label)	MALAYSIA	2013007956	10/06/2013	10/06/2013
LUX PREMIUMS (LABEL)	MEXICO	1338220	09/01/2013	09/01/2013
LUX MAESTRO	MOROCCO	193350	09/04/2018	
LUX PREMIUMS (LABEL)	MOROCCO	193348	09/04/2018	
LUX COZI	MOROCCO	193352	09/04/2018	
ONN (Label)	NEPAL	1812 (38167)	15/12/2013	15/12/2013
LUX	NEPAL	16711/058	11/07/2001	11/07/2001
ONN (word per se)	NIGERIA	F/TM/O/201 3/10977	16/09/2014	
ONN (Label)	NIGERIA	F/TM/O/201 3/10976	07/11/2013	
LUX PREMIUMS (LABEL)	NIGERIA	F/TM/2010/2 158	15/02/2010	
GENX	NIGERIA	F/TM/0/2014 /13883	05/02/14	
LUX PREMIUMS (LABEL)	OAPI countries namely Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo Republic, Equatorial Guinea, Gabon, Guinea, Guinea- Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal	3201302192 (76099)	05/07/2013	05/07/2013

	and Togo			
LUX	OMAN	13208	24/03/1996	24/03/1996
LUX PREMIUMS	OMAN	74602	28/05/2012	28/05/2012
LUX	PAKISTAN	149603	20/08/1998	
ONN (word per se)	PAKISTAN	346630	28/10/2013	28/10/2013
LUX	PANAMA	2013-133 (219870 01)	15/01/2013	15/01/2013
LUX PREMIUMS	QATAR	74898	21/05/2012	21/05/2012
LUX	QATAR	33065	15/07/2004	15/07/2004
LUX COTT'SWOOL (label) in Colour	SAUDI ARABIA	1438020250	29/05/2017	29/05/17
LUX PREMIUMS (LABEL)	SAUDI ARABIA	186734	29/09/2012	29/09/2012
LUX	SAUDI ARABIA	89691	16/05/2004	16/05/2004
ONN (Label)	SINGAPORE	T1318442H	14/11/2013	14/11/2013
LUX PREMIUMS (LABEL)	SINGAPORE	T1209737H	09/07/2012	09/07/2012
LUX PREMIUMS (LABEL)	SOUTH AFRICA	2014/00275	06/01/2014	06/01/2014
ONN (word per se)	SRI LANKA	183781	04/10/2013	04/10/2013
LUX	SRI LANKA	89220	03/09/1998	03/09/1998
LUX PREMIUMS	SUDAN	48565	23/07/2013	23/07/2013
LUX	TANZANIA	TZ/T/2012/1 31	02/02/2012	02/02/2012
LUX COZI	THAILAND	965248	08/12/2014	08/12/2014
LUX PREMIUMS (LABEL)	TUNISIA	TN/E/2014/0 0532	13/05/2014	13/05/2014
ONN (word per se)	UAE	199731	21/10/2013	21/10/2013

LUX	UGANDA	2012/45298	02/02/2012	
LUX	UNITED KINGDOM	2196144	01/05/99	01/05/99
LUX PREMIUMS	YEMEN	58756	20/05/2012	20/05/2012
LUX PREMIUMS (LABEL)	ZAMBIA	583/2014	30/05/2014	30/05/2014
LUX PREMIUMS (Label)	ZIMBABWE	TM/T/2015/4 58	24/04/2015	24/04/2015

19. Apart from the LUX brand, Biswanath Hosiery and Lux Industries own premium brands like ONN, GenX and Lyra for women, men and kids' innerwear such as vests, briefs, boxers, winter wear, panties, racer back, camisole straps, slips, shorts. The brands are synonymous with high quality and performance as all its hosiery products are crafted in 100% pure cotton sourced from the top Global Market.<sup>12</sup>

20. As such, Biswanath Hosiery and Lux Industries Limited is a recipient of the following awards: Asia's Greatest Brands (2016); The World's Greatest Brands & Leaders (2015); The Admired Brand of India (2014 to 2015); Master Brand (2013 to 2015); and Asia's Most Promising Brand (2013).<sup>13</sup>

21. These products under the LUX brand are exported to the aforementioned countries through Lux Industries' extensive sales networks and business partners throughout the world.<sup>14</sup>

22. Biswanath Hosiery, as holder of the LUX trademark and its variants, has permitted Lux Industries and J.M. Hosiery Factory to market, distribute and sell LUX products in various countries.<sup>15</sup>

23. The LUX brand has gained wide acceptance since its introduction in the world market. A sampling of sales record shows a steady increase in the volume of orders and purchases of LUX products.<sup>16</sup>

24. Biswanath Hosiery and Lux Industries have spent considerable resources in advertising and promoting the LUX brand worldwide. <http://www.luxinnerwear.com/> is the official online site of the LUX brand. The brand is also marketed online among the widest

<sup>12</sup> Exhibit "E."

<sup>13</sup> Exhibit "E."

<sup>14</sup> Exhibit "E."

<sup>15</sup> Exhibit "E."

<sup>16</sup> Exhibit "E."

online shopping websites such as amazon.com and facebook.com among others. The reach of these sites is global.<sup>17</sup>

**II. THE RESPONDENT-APPLICANT'S MARK IS CONFUSINGLY SIMILAR TO BISWANATH HOSIERY'S MARK AND USED FOR IDENTICAL AND SIMILAR GOODS.**

**A. THE RESPONDENT-APPLICANT'S MARK MAY NOT BE REGISTERED BECAUSE IT IS IDENTICAL AND LIKELY TO CAUSE CONFUSION WITH BISWANATH HOSIERY'S MARK, "LUX", WHICH IS A WELL-KNOWN MARK.**

25. Section 3 of RA 8293 provides, to wit:

**"Section 3. *International Conventions and Reciprocity.* –** Any person who is a national or who is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law, shall be entitled to benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by this Act."

26. In relation thereto, the Paris Convention provides as follows:

**"Article 6bis  
Marks: Well-Known Marks**

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create a confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods, xxx" (emphasis supplied)

27. Section 123.1 (e)<sup>18</sup> of the RA 8293 prohibits the registration of the mark which is identical with or confusingly similar to

<sup>17</sup> Exhibit "E."

<sup>18</sup> Section 123.1 (e) of the RA 8293 states in full: A mark cannot be registered if it: xxx (e) is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for

a mark which is considered to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services. Based on the aforequoted provisions of the Paris Convention and RA 8293, the registration of a mark must be refused where it is likely to confuse a well-known mark, whether registered or not, when used for identical or similar goods.

28. The registration of the Respondent-Applicant's mark is proscribed under the aforequoted provisions in view of the exact similarity of the mark and the goods for which it is sought to be registered and the trade channels as well as the conditions under which sales of these goods are made.

29. There is no question that the mark sought to be registered is exactly identical to Biswanath Hosiery's trademark, "LUX". Thus, the registration and use of the "LUX" mark by the Respondent-Applicant to identify identical and similar goods under Class 25 will likely cause confusion or deceive the relevant public.

30. Among the factors to determine whether there is likelihood of confusion are: (1) **strength of the senior user's mark**; (2) **degree of similarity between the marks**; (3) **proximity of the products**; (4) likelihood that the senior user of the mark will bridge the gap; (5) evidence of actual confusion; (6) defendants' bad faith; (7) quality of defendants' products; and (8) sophistication of the relevant consumer group.<sup>19</sup>

31. Not only is Biswanath Hosiery's mark exactly the same as that of and the goods it covers identical and similar to those of Respondent-Applicant's, but it also is a strong, distinctive mark that raises the likelihood of confusion to a much higher degree. Other than Biswanath Hosiery's trademark and Respondent-Applicant's application for registration, no other entity has registered with the Bureau of Trademarks the "LUX" trademark under Class 25 and closely-related classes.

32. The distinctiveness or "strength" of a mark measures its capacity to indicate the source of the goods or services with which it is used. The greater the distinctiveness of the mark, the greater the likelihood of confusion that prospective purchasers will associate the same or a similar designation found on other goods, services or businesses with the prior user. "Strong" marks that have a high

identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark; xxx.

<sup>19</sup> Cf. *Polaroid Corporation vs. Polaroid Electronic Corp.*, 387 F.2d 492 (1968).



degree of distinctiveness are thus protected against the use of similar marks against a wider range of goods or services than are "weak" designations that have less distinctiveness or market recognition.<sup>20</sup>

33. Thus, by virtue of the similarity and strength of the marks, the Respondent-Applicant's use of the "LUX" mark will cause confusion in the minds of potential consumers not only as to the identity of the products but also with regard to their the source, affiliation or sponsorship.

34. If the mark "LUX" is allowed to be registered in the name of the Respondent-Applicant, its registration and use will greatly diminish the distinctiveness of Biswanath Hosiery's trademark and dilute its goodwill and reputation which it has painstakingly built over the decades.

35. In sum, the registration of the mark "LUX" in favor of the Respondent-Applicant should be denied because it is identical with Biswanath Hosiery's well-known trademark.

**B. THE REGISTRATION OF  
RESPONDENT-APPLICANT'S MARK  
WILL INDICATE A FALSE CONNECTION  
BETWEEN THE GOODS OFFERED BY  
RESPONDENT-APPLICANT AND  
BISWANATH HOSEY.**

36. Respondent-Applicant's use of and attempt to register "LUX" as a trademark is tantamount to giving the appearance that Respondent-Applicant's clothing goods are affiliated to or under the sponsorship of Biswanath Hosiery. If a consumer sees a clothing product marked "LUX", he may likely think that the said product is under the licensing or sponsorship of Biswanath Hosiery. Thus, Respondent-Applicant's application must be refused to prevent the mark's false association to Biswanath Hosiery and the likelihood of causing damage or prejudice to Biswanath Hosiery's goodwill and reputation painstakingly built for decades.

**III. THE REGISTRATION OF THE MARK  
"LUX" BY THE RESPONDENT-  
APPLICANT IS IN BAD FAITH.**

37. In *Lim Hoa vs. Director of Patents*,<sup>21</sup> the Court posed a rhetorical question, thus:

<sup>20</sup> See, 24-48, *McCarthy on Trademarks*.

<sup>21</sup> O.R. No. L-8072, 31 October 1955, citing *Clarke vs. Mardie Candy Co.*, 100 Phil. 38 (1917).

"We ask, however, why, with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from, the defendant company selected two roosters as its trade-mark, although its directors and managers must have been well aware of the long-continued use of a rooster by the plaintiff in connection with the sale and advertisement of his goods?"...

38. The same may be asked of Respondent-Applicant on its choice of a mark that is confusingly similar to Biswanath Hosiery's "LUX" trademark. Considering the widespread presence of "LUX" clothing products in the global market, it cannot be doubted that Respondent-Applicant is fully aware of brands belonging to the Biswanath Hosiery. Thus, it may be properly asked of Respondent-Applicant whether its attempt to register a mark for the same clothing goods smacks of bad faith, knowing that the "LUX" is already the registered trademark of another entity, herein the Biswanath Hosiery, who has established goodwill and business reputation worldwide in the clothing industry.

IV. "LUX" IS ALSO BISWANATH  
HOSIERY'S TRADE NAME OR  
CORPORATE NAME AND MUST BE  
PROTECTED AS SUCH UNDER  
SECTION 165.2 OF RA 8293.

39. "LUX" is also the corporate and/or trade name of Biswanath Hosiery's parent company, Lux Industries. The latter's corporate name must be protected, even going as far as registration, against any unlawful act committed by third parties. In particular, under Section 10(2) of the Indian Trademark Act, 1999, which reads:

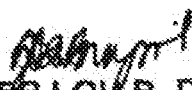
"Applicant is user of 'LUX' trademark, advertised and is famous amongst customers abroad, or any such mark of a trader having acquired a reputation among persons carrying on business in connection with goods."

[illegible]

Makati City for the City of Taguig, 23 July 2018.

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