

**TRADE MARKS ACT, CAP 257
LAWS OF BELIZE, REVISED EDITION 2011**

**IN MATTER OF APPLICATION NO. 8955.12 BY INDUSTRIAS
ALEN S.A. DE C.V. TO REGISTER TRADE MARK:**

CLORALEX

AND

THE OPPOSITION THERETO BY THE CLOROX COMPANY.

T.M. RULING NO. 1/2019

In Matter of Application No. 8955.12 by Industrias Alen S.A. DE C.V. to register trade mark:

CLORALEX

And the Opposition thereto by The Clorox Company

BACKGROUND

- 1) This opposition relates to an application made by Industrias Alen S.A. DE C.V. (hereinafter referred to as the Applicant), to register the above trade mark. Application was filed on June 28th, 2012 and were published in the Intellectual Property Journal on November 9, 23 and December 7, 2012 with the following specification:

International Class 3: Laundry bleach; and all-purpose cleaners.

The above goods are in Class 3 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter referred to as the Nice Agreement).

- 2) The Clorox Company (hereinafter referred to as the Opponent) filed an opposition against the above application. Clorox Company is the registered proprietor of Trademark Registration No.9501.13 filed on January 31st, 2013 with the following specification:

International Class 3: Bleaching preparations; cleaning, polishing, scouring and laundry preparations, abrasive cloth and soap products.

International Class 5: Disinfectants for hygiene purposes; germicides and deodorants not for personal use.

The above goods are in Class 3 and 5 of the Nice Agreement.

- 3) The Opponent states that they are the owner of the famous CLOROX & Design brand which has obtained numerous worldwide registrations in international class 3 of the Nice Agreement. Specifically, they obtained registration no. 1268376 and No. 153413 DIAMOND DESIGN without the word “CLOROX” in the United Kingdom. Therefore they assert that the mark is deceptive. In addition, the Opponent claims prolonged usage of the mark since 1915 and they have prior to the enactment of the Trademarks Act (CAP 257), published general cautionary notices of their trademarks in Belize stating the ownership of trademark CLOROX and Design for “bleach and other laundry products” in

International class 3. Therefore, the Opponent requests that the application be refused registration.

- 4) The Applicant filed answers to the Opponent's grounds by asserting use of the trademark for more than 60 years, and the Applicant has been providing cleaning products including but not limited to CLORALEX bleach household cleaning and fabric care products. Certain of the Applicant's products, including those bearing the CLORALEX mark, along with those bearing the Pinol brand, are the number one brands in their categories in Mexico. In addition, extensive information on the applicant and mark can be found at the internet website, www.cloralex.com. The Applicant claims that they hold a 40% market share of the overall household cleaning products category in which it competes and they market, promote and sell products throughout the United States, Caribbean and Central America. CLORALEX has been a coined trademark created for the Applicant and in use since 1949 in Mexico and has been used in Belize for approximately the past 13 years up to present day. Furthermore, CLORALEX is used and is a registered trademark in many other countries, including Central America and the Caribbean. It also claimed that the CLORALEX and CLOROX mark are capable of peaceful co-existence within the same market.
- 5) As such, the Applicant argued for the dismissal of the opposition which it asserts had no valid or relevant legal grounds and that its trade mark should be allowed to proceed to registration.
- 6) Both sides filed evidence.
- 7) The case was heard on June 27, 2018. The Applicant was represented by Mr. Rishi A. Mungal of Morgan and Morgan Trust Corp. (Belize) Ltd. The Opponent was represented by Mr. Hector D. Guerra of Marine Parade Chambers.

EVIDENCE

Evidence of the Opponent

- 1) This is furnished by way of a sworn affidavit by Ms. Angela Hilt, dated the 29th day of April 2013. Ms. Hilt is the Vice President – Corporate Secretary of the Opponent, who is conversant with the facts of the present opposition and competent and authorized to depose of this affidavit on behalf of the Company. She has been in employment of the Company since the year 2005 and had full and free access to the books and records that the Company maintains in the normal course of business. She submitted that the Company is a leading manufacturer and marketer of consumer goods and its' history dates back to May 3, 1913, when five entrepreneurs from California invested \$100 apiece to set up the first commercial-scale liquid bleach factory in the United States on the east side of San Francisco Bay. Their plan was to convert the brine available in abundance

from the nearby salt ponds of San Francisco Bay into sodium hypochlorite bleach, using a sophisticated and technologically demanding process of electrolysis.

- 2) Ms. Hilt stated that the Company manufactures products in more than two dozen countries and markets in more than 100 countries with about 8400 employees. The Company markets its products under some of the most trusted and recognized trademarks including CLOROX. The products manufactured and marketed by the Company include bleach and cleaning products, home care products, hand sanitizing, dressings and sauces, water-filtration systems, bags, wraps and containers and personal care products etc. Recognized and trusted for decades, each of the brands of the Company reflects a heritage of quality and experience in cleaning, sanitizing and disinfecting. Annual Reports of the Company for the years 2005 – 2012 were exhibited.
- 3) Ms. Hilt further suggested that the word ‘CLOROX’ was an amalgam of the words “chlorine” and “sodium hydroxide”, which in combination forms the bleach’s active ingredient. The label of diamond shaped design enclosing the word ‘CLOROX’ was also proposed, which was immediately accepted and registered by the Company as its trademark. It is pertinent to mention that the trade mark ‘CLOROX’ forms the prominent and distinguishing part of the Company’s corporate/trading name. In fact, any reference to the trademark CLOROX drew an instant association with the Company and or its products.
- 4) She also further claims that owing to extensive advertising and sales promotion campaigns stressing its purity and versatility and dependability, their products under the trademark/name CLOROX had become a commonplace sight in American laundry rooms, kitchens and bathrooms by the year 1928. That same year, the Company went public and its stock began trading on the San Francisco Exchange. Respectfully there were no evidence to assert such extensive sales in 1928 and much weight will not be placed on these statements. In line with the definition of legal evidence in the 7th edition of the Black’s Law Dictionary, “all admissible evidence, both oral and documentary, of such a character that it reasonably and substantially proves the point rather than merely raising suspicion or conjecture”.
- 5) In addition, Ms. Hilt asserts that in the mid-1950s, the Company’s corporate presence, on its own and through its subsidiaries / affiliates extended throughout the world including Argentina, Australia, Canada, Chile, Hong Kong, Korea, Malaysia, Mexico, New Zealand, South Africa, Spain, Switzerland, United Kingdom, etc.
- 6) Also various assertions that adds to the reputation of the trademark “CLOROX” was garnered through extensive investments in Research and Development of their product and extensive advertisement and promotion of its products. Exhibits of copies of these ads were displayed.
- 7) Certificates of international registrations were also exhibited to indicate prior adoption, extensive worldwide use and excellent quality of products under trade mark CLOROX is well – known. Also, a search of the Google search engine for the word “CLOROX”

provided 8,220,000 hit showing that the internet is a ready medium of exposure to potential customers and members of trade to widespread information about the Company's products.

Evidence of the Applicant

- 8) This is furnished by Mr. Roberto Arochi Escalante dated the 18th day of June 2013. Mr. Escalante is currently employed by Industrias Alen S.A. De C.V and duly authorized as the Legal Representative of the Company. The facts deposed herein were within his own knowledge and are true or they are based on the information supplied to him and / or in the business records of the Applicant to which he has access and are true and accurate to the best of his knowledge, information and belief.
- 9) Mr. Escalante asserts that the Applicant is a company incorporated in Monterrey, Nuevo Leon, Mexico in 1949 as Products Quimicos Alen, now Industrias Alen S.A. de C.V. and has been in the business of manufacturing, selling and distributing, cleaning products, including bleach and household cleaning and fabric care products for more than 60 years throughout Mexico, the United States, the Caribbean and Central America.
- 10) He further stated that the Applicant's first product was laundry bleach, produced and sold under the name CLORALEX which over the course of the years became popular in the market and is the highest selling bleach product in the Republic of Mexico. This growth has been parallel with the advancements in technology, manufacturing, transformation of plastics, marketing strategies, commercialization and distribution, including the expansion of installed capacity. Copies of Publications, Reviews and Awards throughout many years as regards the Applicant and its CLORALEX mark was exhibited.
- 11) Currently, Mr. Escalante deposes that the Applicant has five manufacturing plants and 14 diversified marks in more than 30 products in the categories of bleach, cleaners, powdered detergents, liquid soaps, fabric softeners, dishwashing liquids and descaling agents for the Mexican market as well as that of the United States of America and Latin America. They fully market and advertise its CLORALEX mark along with its various other brands through different means. Exhibit of copies of various promotional and marketing materials as regards the Applicant's mark and through its website (www.cloralex.com.mx) was displayed.
- 12) Certificates of Registration were also displayed to indicate the Applicant's CLORALEX mark been registered throughout the world in international class 3, within Central American, Latin American and the Caribbean region with numerous ongoing and pending applications in numerous territories as well.
- 13) Mr. Escalante further elaborated on the various actions been taken by the Opponent and the agreement both the Applicant and Opponent undertook to settle their grievances and to enable a peaceful co-existence within the United States of America. Exhibit of these agreements are shown.

14) Mr. Escalante also stated that the Applicant's CLORALEX mark was published in Belize by BELIPO on or around the 5th day of November 2012 and a search of the BELIPO register issued around 22nd day of May 2013 for the mark "CLOROX" demonstrated that the Opponent had no previous registrations upon the trademark register of BELIPO and therefore Belize. Also, the filing date of the Opponent's present CLOROX trademark application in Belize was on January 31st, 2013 being several months after the Applicant's CLORALEX application was published. This further indicated that there was lack of good faith on the part of the Opponent as regards its registration and this present Opposition.

15) Finally, Mr. Escalante places emphasis on the actual use of the Applicant's CLORALEX goods in Belize by displaying exhibits of their products been sold.

DECISION

Relevant Law

16) Section 37(1), 37(2)(b), 37(4)(a), 38(1)(a) and 61 of the Trade Marks Act (hereinafter referred to as "the Act"), and Article 6bis of the Paris Convention provides as follows:

Relative Grounds for Refusal of Registration

37.- (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because:-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in Belize is liable to be prevented:-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or

Meaning of earlier trade mark

38.- (1) In this Act, an earlier trade mark means:-

(a) a registered trade mark or an international trade mark (Belize) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade mark;

Protection of well-known trade mark: Article 6bis of Paris Convention

61.-(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well known trade mark are to a mark which is well known in Belize as being the mark of a person who:-

(a) is a national of a Convention country; or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country whether or not that person carries on business, or has any goodwill, in Belize, and references to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well known trade mark is entitled to restrain by injunction the use in Belize of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion, but this right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any bona fide use of a trade mark begun before the commencement of this section.

Conditions of Registration; Independence of Protection of Same Marks in Different Countries

Article 6(3) -

A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.

Well Known Marks

Article 6bis —

(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 trade mark which constitutes a reproduction, an imitation, or a translation, liable to create 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. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well known mark or an imitation liable to create confusion therewith.

In determining the issues within this Opposition, I am guided by the cases of:

Granada Trade Mark [1979]RPC 303

Sabel BV v Puma AG [1998] RPC 199;

Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV [2000] FSR 77; and

Veuve Clicquot Ponsardin v Boutiques Cliquot Ltee, [2006] 1 SCR 824

- 17) There is currently no merit found within the grounds of opposition as it concerns passing off. As highlighted in section 37(4) (a), protection is given to an unregistered trade mark and by way of evidence deposed by the Opponent, the word mark “CLOROX” is a registered mark.
- 18) Furthermore, on the grounds of trademark infringement, the evidence neither corroborates nor indicates any damages suffered. It just merely exhibits receipts that show actual sale of the word mark “CLORALEX” attached to products been sold in Belize. Therefore, it is far reaching to conclude and no reason has been shown to decide on this ground.

Comparison of trade marks

- 19) The trade mark to be compared are:
- a. The Applicant’s trade mark : **CLORALEX**
 - b. The Opponent’s registered trademark: **CLOROX**
- 20) In assessing the similarity of the trademarks, the litmus test as averred to is the perception of an average consumer. They usually perceive a trademark as a whole and don’t analytically examine the details of the trademark (*Sabel BV v Puma AG*). This approach was adopted in the *Vevue Clicquot’s* case, where Judge Binnie approached this view from the perceptive of a hurried consumer. He stated “*The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the name ..., at a time when he or she has no more than an imperfect recollection ..., and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks*” (*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltee*).
- 21) It is noted that both trademarks have a common feature which exists in the prefix “CLOR” and both parties have asserted this similarity. Yet when visual assessment is conducted, the exhibit as shown indicates a distinctive use of their respective mark in the labelling and packaging of their products. For instance, both the Applicant and Opponent make use of a certain font size, shape of each letter and the colors. It even goes on to show the use of the Diamond shape behind the Applicant’s word mark that enables the sign when merging with the word mark to stand out. The importance of this assessment is stressed on the use of these word marks on the products which is capable of being represented graphically.
- 22) From an aural and conceptual point of view, it is noted the dissimilar elements of the words append to the end of the mark that is “OX” and “ALEX” and thus can be concluded using the peripheral of an average and hurried consumer and taking into consideration the assessment of the visual, aural and conceptual dissimilarities, the trade mark CLORALEX is not similar to CLOROX and does not satisfy the test for identical marks in section 37(1) of the Act.

23) **I find that the respective marks are not similar.**

Comparison of goods

24) The goods in question are as follows:

- a. Applicant's goods: *Laundry bleach; and all-purpose cleaners – Class 3*
- b. Opponent's registered goods:
 - i. *Bleaching preparations; cleaning, polishing, scouring and laundry preparations, abrasive cloth and soap product – Class 3 and*
 - ii. *Disinfectants for hygiene purposes; germicides and deodorants not for personal use – Class 5*

25) It is clear that the identical specification, namely, bleach, satisfy the test for identical goods in section 37(2)(b) of the Act. It is clear within the International classes used in the Nice Agreement and other products related to bleach.

26) **I find that the respective goods are similar.**

Likelihood of Confusion

27) The likelihood of confusion must be assessed from the view point of an average and hurried consumer as reiterated in paragraph 20. The average consumer is deemed to be reasonably well informed and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). Also the average consumer rarely has the time to make direct comparisons between trademarks and must rely upon the imperfect picture of the trademarks that he or she has kept in his or her mind (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*) and further alluded to by the previous Deputy in his decision (*Everactive and Everstart v Eveready*)

28) Emphasis is placed on the average consumer which is the equivalent of the Belizean consumer. Being reasonably well informed and observant, I submit that the Belizean consumer would not likely be confused by both marks.

29) **I find that there is no likelihood of confusion.**

Consideration of matter under 38(1) (a) and Protection of well-known trade mark

30) Section 38 incorporates Article 6bis of the Paris Convention which affords protection to a well-known mark whether registered in Belize or in a Member State that is party to the Paris Convention. The requirement of being well – known imposes a relatively high standard.

31) Currently, the Opponent highlighted the numerous certificates of international registrations to indicate prior adoption, extensive worldwide use and excellent quality of

products under trade mark CLOROX and further claims that owing to extensive advertising and sales promotion campaigns stressing its purity and versatility and dependability, their products under the trademark/name CLOROX has become well-known. When limiting the extent of use to the geographical area of Belize, no supporting evidence strongly advocates this use by the Belizean consumer. On the other hand, I see that the Applicant exhibited numerous invoices dating its use of the mark before the filing of its application for registration in Belize.

32) Yet it will be remiss of me not to highlight the fact that filing of the Opponent's mark came after the filing date of the Applicant, upon which registration has been granted. Factoring the use of the mark by the Opponent in other countries party to the Paris Convention played a critical role in its registration. This does not negate the Applicant's use of the mark in Belize. The legislative basis of this reasoning can be found in Article 6(3) of the Paris Convention, which states "A mark duly registered in a country of the (Paris) Union shall be regarded as independent of marks registered in the other countries of the (Paris) Union, including the country of origin".

33) I find that there is evidence to support the claim that the Applicant's mark qualifies for protection as a well-known mark under the Paris Convention.

The Honesty of the Concurrent Use

34) Within the case of Granada, Mr. Myall took into account the extent of the use in time and quantity and the area of trade and the honesty of the concurrent use when deciding whether registration should be issued. Once, it was established that there has been concurrent use, the most important question is the honesty of it.

35) By way of evidence of the receipts as presented by the Applicant, I can see that the Applicant used their mark in a normal and fair manner continuously for all goods since the date of its filing. The evidence as a whole establishes, in my opinion, that the applicants honestly put the word mark "CLORALEX" into use in Belize.

36) I find that there is evidence to support an honest concurrent use of the trade mark by the Applicant.

CONCLUSION

37) The Applicant is allowed to proceed to registration because the mark is not similar to the Opponent's mark. Secondly, there exists no likelihood of confusion in the eyes of the public. Thirdly, there has been honest concurrent use of the mark which has further garnered the protection afforded to well-known marks under the Paris Convention.

COSTS

38) The Applicant, having been successful, is entitled to a contribution towards its costs. I order the Opponent to pay the Applicant the sum of \$1,275.00 (see Annex). This sum is to be paid within seven days of the expiry of the appeal period of twenty-one days, or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of January, 2019.

Olabimpe Akinkuolie
Deputy Registrar
for Registrar of Intellectual Property

APPENDIX

AWARD OF COSTS

ITEM	\$BZ
Receiving and Perusing Notice of Opposition	100.00
Preparing and filing evidence in support	100.00
Filing answer to Opposition	125.00
Evidence in Answer	200.00
Preparation of case for hearing	350.00
Attendance at hearing by Attorney-at-Law	400.00
Total	1,275.00