T.C. PHARMACEUTICAL INDUSTRIES CO. LTD.
Opposer,
- versus -

OSBORNE Y. COMPANIA S.A.,
Respondent-Applicant.
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IPC 14-2006-00028

Opposition to:
TM Application No. 4-2004-000337
(Filing Date: 14 January 2004)

TM: "DEVICE OF A BULL"

Decision No. 07-49

DECISION

For resolution is the Opposition filed by T.C. Pharmaceutical Industries Co., Ltd., (the "Opposer") against Application No. 4-2004-000337 filed by Osborne Y. Compania S.A. (the "Respondent-Applicant") on 14 January 2004 for the registration of the mark DEVICE OF A BULL covering goods in Classes 25, 29, 30, 32, 33, 35, 38 & 42, upon the ground that the mark DEVICE OF A BULL is identical with and/or confusingly similar with its registered trademarks DOUBLE BULL DEVICE and RED BULL.

Opposer, T.C. PHARMACEUTICAL CO., LTD. (hereafter, the "Opposer") is a corporation duly organized and existing under the laws of Thailand, with principal office at 39 Mu 8, Ekachai Road, Bangdon Sub-District, Bangkunthien District Bangkok, Thailand.

Respondent-Applicant, OSBORNE Y. COMPANIA S.A, is a corporation organized and existing under and by virtue of the laws of Spain with business address at Fernan Caballero, 3 11500 Puerto De Santa Maria Cadiz, Spain.

On 02 February 2006, Opposer filed the instant Opposition against Respondent-Applicant's Application for registration of the mark DEVICE OF A BULL for goods under Classes 25/29/30/32/33/35/38.

Grounds for Opposition

Opposer filed the instant Opposition and alleged as follows:

1. "Opposer is filing the present Opposition under the following laws:

2. "Opposer is the owner of the marks "DOUBLE BULL DEVICE" and "RED BULL", having used, registered and popularized the same in various countries of the world. In the Philippines, Opposer has filed an application for registration of the marks (a) "DOUBLE BULL DEVICE" and (b) "RED BULL" for the following goods: beer, mineral and aerated waters and other non-alcoholic drinks, fruit juices, syrups and other preparations for making beverages in Class 32 on July 16, 1993. Opposer's mark "DOUBLE BULL DEVICE" was registered on March 29, 1995 per Certificate of Registration No. 60093 while Opposer's "RED BULL" was registered on March 14, 1995, per Certificate of Registration No. 60086. On the other hand, the application for registration of the mark "DEVICE OF A BULL" subject of the present opposition, was filed only on January 14, 2004 for different Classes including beer, ale and porter; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages under Class 32, which are exactly the same goods of Opposer.

3. "Clearly, Opposer's marks "DOUBLE BULL DEVICE" and "RED BULL" were filed and registered much earlier than that of Respondent's.

4. "Opposer has been using its marks for 13 years now, having first used and adopted the same as early as 1993. In the Philippines, Opposer has first used the marks "DOUBLE BULL DEVICE" and "RED BULL" on June 10, 1993. Opposer's products were used/are currently used

in the Philippines by Energy Food & Drinks, Inc., of 199-E, West Avenue, Quezon City, Philippines.

5. "Clearly, Opposer is the rightful owner of the marks "DOUBLE BULL DEVICE" and "RED BULL", having used, adopted and registered the same in the Philippines and on several countries in the world much earlier than Respondent. Being the owner of the mark, Opposer has sought the registration of the same in Thailand and in various countries of the world, including Philippines, Thailand, Hong Kong, Indonesia, Singapore, China, Cambodia, Myanmar, Vietnam, Taiwan, Korea and Austria.

6. "Though widespread and extensive use by the Opposer in most parts of the world, Opposer's marks have acquired inherent or acquired distinction.

7. "Opposer has developed goodwill and reputation for its marks "DOUBLE BULL DEVICE" and "RED BULL" through extensive promotions, worldwide registrations and use.

8. "Opposer has built, for its marks "DOUBLE BULL DEVICE" and "RED BULL", superior quality-image or reputation through its long use characterized by high standards.

9. "From the foregoing, it is apparent that Opposer's marks satisfy the criteria set by the Rules and Regulations Implementing RA 8297 to be considered as a well-known marks, entitled to protection under Section 123 (e) and (f) of R.A. 8293.

10. "In presentation, general appearance and pronunciation, Respondent-Applicant's mark DEVICE OF A BULL and Opposer's marks "DOUBLE BULL DEVICE" and "RED BULL" are confusing similar, and hence, will cause confusion among their prospective market, coupled by the fact that goods covered are the same or related, sold in the same channels and belonging to the same Class 32.

11. "Considering the above circumstances, registration is proscribed by R.A. 8293 Section 123 (d).

12. "If allowed contrary to existing laws and jurisprudence, Respondent's use of the mark DEVICE OF A BULL, which is confusingly similar to Opposer's marks "DOUBLE BULL DEVICE" and "RED BULL", will indicate a connection between the latter's goods and those of Respondent's, and will likely mislead the buying public into believing that the goods of Respondent's are produced or originated from, or are under the sponsorship of Opposer, to the detriment and damage of Opposer's interest, considering the goods are the same or related.

13. "Opposer hereby alleges that the Respondent-Applicant's adoption of DEVICE OF A BULL trademark which is similar to that of Opposer's "DOUBLE BULL DEVICE" and "RED BULL", was clearly done with the illegal intent of riding on the popularity and goodwill of Opposer's quality-built reputation and will cause great and irreparable damage and injury to the Opposer.

14. "Further, Respondent-Applicant is clearly in bad faith in so using and adopting the same trademark as that of Opposer's "DOUBLE BULL DEVICE" and "RED BULL" which Opposer has, because of its prior use and registrations, gained worldwide notoriety for said marks.

On 16 March 2006, this Bureau issued a Notice to Answer, copy of which together with the Opposition was received by Respondent-Applicant on 29 March 2006. The Notice to Answer required Respondent-Applicant to submit its Verified Answer within thirty (30) days from receipt thereof. Respondent-Applicant filed its Verified Answer to the Opposition on 10 April 2006.

Respondent in its Answer interposed the following ADMISSIONS and DENIALS:

a. “It hereby affirms the existence of the laws cited therein which are pertinent sections of the Intellectual Property Code, but denies the allegations in pars. 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15 and 16 for lack of knowledge as to the truth thereof.

b. “Respondent-Applicant’s Device of a Bull has been in use in Spain, South America and other Latin American countries for so many hundred years, very much ahead than the Asian countries like Thailand which barely has any bull thereat except cows. To state now the Red Bull or Double Bull device was used much ahead will have to be positively shown in the evidence which we very much doubt.

c. “Furthermore, the claim that the mark “Device of a Bull” is similar to “Red Bull” or “Double Bull” and, therefore, is confusingly similar is not correct. These marks are not identical. The presence of the worlds “RED” and “DOUBLE” with respondent’s “DEVICE” spells the difference. These words are now more distinctive than the almost abused and much used word “BULL”. Said word has become generic, that so many have been using it. When we use it i.e. “BULL HEAD”, “BULL SHIT”, “BULL RUN” etc. Hence, we respectfully submit that opposer’s objection to the registration of respondent’s mark “DEVICE OF A BULL” should be denied.

From receipt of the aforementioned Answer and Reply filed by herein Opposer on 20 April 2006, this Bureau required the parties to attend the Preliminary Conference which finally took place on 08 January 2007 after several postponements and on the same day, the parties agreed to terminate the conference and then submitted the case for decision.

Filed as evidence for the Opposer, based on the records, are Exhibits A to CCC, comprising of numerous certificates of registration obtained in the Philippines and abroad, several sales invoice and advertising materials, among others.

Issues

The issues set forth in this instant Opposition were summarized as follows:

(a) Whether or not Respondent-Applicant’s mark DEVICE OF A BULL is confusingly similar to Opposer’s marks DOUBLE BULL DEVICE and RED BULL such that Opposer will be damaged by registration of the mark DEVICE OF A BULL in the name of Respondent-Applicant; and

(b) Whether or not Respondent-Applicant’s trademark application for DEVICE OF A BULL should be granted registration.

Considering that the case was mandatorily covered by the Summary Rules under Office Order No. 79, this Bureau required the parties through their counsels to submit their respective position papers. Opposer filed its position paper on 02 March 2007 while Respondent-Applicant filed theirs on the same day as well.

It is basically the use of the device-mark, a pictorial representation of a BULL, that forms an essential part of Respondent-Applicant’s mark for use on Classes 25, 29, 30 & 32 that is being put to issued in this suit for determination and for this Bureau to consider whether Opposer has a priority or preferential right/s over the use of the BULL as device for a distinctive mark on goods falling under Classes 25, 29, 30 & 32, such as but not limited to beverages and wearing apparel. Below is a side-by-side comparison between one of Opposer’s registered marks, “DOUBLE BULL DEVICE”, and Respondent Applicant’s “DEVICE OF A BULL”, both used on beverages or goods under Class 32;

Opposer's DOUBLE BULL DEVICE Respondent's DEVICE OF A BULL

Opposer has likewise combined the word-mark RED BULL and the device-mark DOUBLE BULL to connote power for its energy drinks.

RED BULL

The combination of the word-mark RED BULL and DOUBLE BULL device presents a very unique and distinctive choice of word/device combination to arrive at a registrable trademark for an energy drink, this concept of association a bull for an energy drink becomes Opposer's source identifier. Consequently, Respondents' use of the same BULL device for beverages or goods falling or belonging to classes 29, 30 & 32 creates or becomes a source of confusion between competing marks because the subject trademark application is identical to or closely resembles Opposer's registered trademarks RED BULL and DOUBLE BULL device. Anyone is likely to be misled by the adoption of the same BULL device for beverages. The court observed in Philippine Refining Co, Inc., vs. Dir. of Patents and Sparklets Corp. vs. Walter Kidde Sales Co., 104 F. 2d 396, that "a trademark is designed to identify the user. But it should be so descriptive and sufficiently original as to enable those who come into contact with it to recognize instantly the identity of the user. It must be affirmative and definite, significant and distinctive, capable to indicate the origin." Likewise, our trademark law does not require identity, confusion is likely if the resemblance is so close between two trademarks. Bolstering this observation is the pronouncement by the court in the case of Forbers, Munn & Co. (Ltd) vs. Ang San To, 40 Phil. 272, 275) where it stated that *the test was similarity or "resemblance between the two (trademarks) such as would be likely to cause the one mark to be mistaken for the other. . .* (But) *this is not such similitude as amounts to identity."*

This present Opposition is anchored on Opposer's claim of ownership over the use of a BULL device for energy drink or beverages falling under Classes 29, 30 & 32 pursuant to Section 123.1 (d) of R.A.8293, to wit:

"Section 123. Registrability. – 123.1. A mark cannot be registered if it:

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(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,"

xxx

Clearly etched in Converse Rubber Corp. vs. Universal Rubber Products, Inc. is the concept of likelihood of confusion where it said "The similarity in the general appearance of respondent's trademark and that of petitioner would evidently create a likelihood of confusion among the purchasing public. xxx "The law does not require actual confusion, it suffices that confusion is likely to occur in the sale of the goods and adoption of both marks (Philips Export B.V., et. al vs. Court of Appeals, et. al G.R. No. 96161, February 21, 1992). Hence, the likelihood that prospective buyers may perceive that Respondent's goods are manufactured by or is associated or connected with Opposer is probable.

What added to the confusion is the use of these competing marks for identical or similar goods: *beer, mineral and aerated waters and other non-alcoholic drinks, fruit juices, syrups and other preparations for making beverages.* (Class 32); *COFFEE, INSTANTCOFFEE, COFFE-BASED BEVERAGES, TEA, INSTANT TEA, TEA-BASED BEVERAGES, ICE, COCOA, INSTANT COCOA, COCOA-BASED BEVERAGES, CHOCOLATE, INSTANT CHOCOLATE, CHOCOLATE-BASED BEVERAGES, ARTIFICIAL COFFEE, ARTIFICIAL TEA, ARTIFICAL COCOA, ARTIFICIAL CHOCOLATE* (Class 30) CREAM (DAIRY PRODUCTS), FLAVOURED MILK BEVERAGES, YOUGHURTS, EDIBLE OIL, FRIED OR BAKED POTATOES, JAM, PRESERVED FRUITS (Class 29), all constituting beverages, of all forms.

The goods involved, henceforth, flow through the same channels of trade and are of the same as they both constitute beverages. These are commodities that are seen or bought in the market or groceries. The fact that products as such are classified a common day-to-day or household items and are marketed similarly would likely result in confusion.

Having shown and proven resemblance of the two marks at issued, we now delve on the matter of priority in use which certainly has decisive effect in the adjudication of the case. From the evidence on records, Opposer established prior use of these trademarks in commerce and his continuous adoption and use thereof consisting of sale and promotional works. Oppose has prior registration for both trademarks, RED BULL and DOUBLE BULL device and was using these trademarks on goods under class 32 with its pieces of evidence dating back in 1993 in the Philippines. Actual use of the marks and trademark applications thereof have all transpired in 1993, more than a decade earlier than Respondent-Applicant's trademark application in 2004. As held in the case on Unno Commercial Enterprises, Inc. vs. General Milling Corporation *"prior use by one will controvert a claim of legal appropriation by subsequent users"*.

The right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration (Bert R. Bagano v. Director of Patents, et. al., G.R. No. L-20170, August 10, 1965). And where a trademark application is opposes, the Respondent-Applicant has the burden of proving ownership (Marvex Commercial Co., Inc. v. Peter Hawpia and Co., 18 SCRA 1178).

Opposer's trademarks, RED BULL and DOUBLE BULL DEVICE, were both registered with the BPTTT in March 1995 for goods falling under Class 32 (Exhibits "D" and "E", Opposer) with its date of first use in the Philippines on January 01, 1993.

Opposer has also registered or applied for the registration of these trademarks for various goods but primarily for goods belonging to Class 32, including those in other classes not in the category of beverages and food items, more specifically goods under Classes 05, 25, 35 and 38 in other countries such as Thailand, Hong Kong, Indonesia, Singapore, China, Cambodia, Myanmaer, Vietnam, Taiwan, Korea and Australia, to name a few. Anent these goods or service of Opposer using the labels DOUBLE BULL DEVICE and REB BULL belonging to Classes 05, 25, 35 and 38 that do not constitute beverages and food items, although they do not move in the same channels of trade and the possibility appears remote that purchasers will confuse one product, or the service/s to which these labels will be attached with that of Respondent's goods and services, nevertheless, the trademark owner is entitled to protection when the use of the junior user, a Philippine applicant, "forestalls the normal expansion of their business". It is noteworthy at this juncture to cite the numerous trademark registration of Opposer for DOUBLE BULL DEVICE and RED BULL showing use of these marks to these goods and services.

Listed below are trademark registrations of Opposer for the marks DOUBLE BULL DEVICE and RED BULL for various goods and services including those in Classes 05, 25, 35 and 38 in many countries, including the following:

Country	Trademark	Registration Number	Classification of goods/services
Australia (Exhibit "F" *Opposer)*	DOUBLE BULL DEVICE	A484047	05
Brunei (Exhibit "G" *Opposer)*	DOUBLE BULL DEVICE	11,065	05
Brunei (Exhibit "G-1" *Opposer)*	DOUBLE BULL DEVICE	34,271	25
Brunei (Exhibit "R" *Opposer)*	RED BULL	14,715	05
Cambodia (Exhibit "H-1" *Opposer)*	DOUBLE BULL DEVICE	15516/01	25
Germany (Exhibit "J-1" *Opposer)*	DOUBLE BULL DEVICE	2 056 374	32 & 5
Hong Kong (Exhibit "J-2" *Opposer)*	DOUBLE BULL DEVICE	02718	25
Hong Kong (Exhibit "X-1" *Opposer)*	RED BULL	02719	25
Indonesia (Exhibit "J-2" *Opposer)*	DOUBLE BULL DEVICE	02393	05
New Zealand (Exhibit "P" *Opposer)*	DOUBLE BULL DEVICE	225163	05
Singapore (Exhibit "P" *Opposer)*	DOUBLE BULL DEVICE	5471/91	05
Thailand (Exhibit "AA-1" *Opposer)* *Filing Date: Dec. 22,1998*	DOUBLE BULL DEVICE	6807	1,2,3,4,5,6,7,8,9,10,11, 12,13,14,15,17,18,19,20, 21,22,23,24,25,26,27,28, 29,30,31,32,34,35,36,37, 38, 39,40,41 and 42

Being the prior user and registrant of the marks RED BULL and DOUBLE BULL DEVICE in the Philippines and abroad, Opposer is the actual owner thereof.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, Application bearing Serial No. 4-2004-000337 filed by Osborne Compania S.A. for the registration of the mark "DEVICE OF A BULL" used on goods/services under Classes 25, 29, 30, 32, 33, 35, 38 is, as it is hereby, REJECTED.

Let the filewrapper of DEVICE OF A BULL, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

30 April 2007, Makati City

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office