

THE BRITISH BROADCASTING CORPORATION	}	IPC NO. 14-2008-00332
Opposer,	}	Case Filed : 02 December 2008
	}	
- versus -	}	Opposition to:
	}	Appln. No. 4-2007-013218
JRD DYNAMICS CO.,	}	Date Filed: 28 Nov. 2007
Respondent-Applicant.	}	
x-----x	}	Trademark: "TOP GEAR"
	}	Decision No. 2009-56

DECISION

This pertains to a Verified Opposition filed on 02 December 2008 by herein opposer, The British Broadcasting Corporation, a public corporation incorporated under the laws of England and Wales by Royal Charter, with its registered offices at Broadcasting House, Portland Place, London, W1A 1AA, United Kingdom, against the application filed on 28 November 2007 bearing Serial No. 4-2007-013218 for the registration of the trademark "TOP GEAR" used for goods/service in Class 12 for automotive spare parts namely, disc pad, disc rotor, disc plate, CV boots, steering joints, steering wheels, brake master, brake shoe, absorber, clutch cable, spark plug cable, repair kit for all automobiles, which application was published in the Intellectual Property Office Official Gazette, officially released for circulation on 01 August 2008.

The respondent-applicant in this instant opposition is JRD Dynamics Co., a domestic corporation with mailing address at Unit 9-D, Apo Street, Quezon City, Metro Manila.

The grounds for the opposition to the registration of the trademark are as follows:

8. Opposer is the lawful owner of the trademark "TOP GEAR" and was first to adopt and use the said trademark in actual trade and commerce in its home country in 1977 initially in Class 41 in relation to a television program of the same name. As adverted to earlier, Opposer first used the mark in the Philippines in Class 16 in the year 2004.

9. The registration of the mark "TOP GEAR" in favor of Respondent-Applicant would be violative of Section 123.1 (e) & (g) of Republic Act No. 8293, otherwise known as the Intellectual Property Code, x x

10. Additionally, being internationally well-known, Opposer's mark is protected not only under Sections 123 d & e of Republic Act No. 8293, but likewise under Article 6bis of the Paris Convention for the Protection of Industrial Property. x x x

11. Further, owing to the international renown of Opposer's products and services bearing the mark "TOP GEAR" (not least of which is due to said products' and services' ready accessibility internationally via the Opposer's television channels, internet websites and magazine publication), and its actual commercial presence in the Philippines that is further bolstered by the local edition of Opposer's magazine, Respondent-Applicant, in evident bad faith, took advantage by fraudulently misappropriating said mark via a thinly disguised predatory act."

The allegation of facts are as follows:

3. Opposer is one of the world's largest broadcasting and entertainment organizations, mainly operating national and International television channels and radio stations, and producing television and radio program for broadcasting on

those channels and for international sale via its commercial subsidiary, BBC Worldwide.

4. Opposer is the owner of various trade and service marks worldwide, one such popular mark being "TOP GEAR". This mark is the subject of numerous registrations worldwide in various international classes. Attached as Annex "A" to form an integral part hereof is the Affidavit of Mr. Paul Walsh – a Partner in the firm of Solicitors, Bristows, who is charged with the administration of the global trade mark portfolio of the Opposer – containing an inventory represents a true and accurate listing of Opposer's global trade mark registrations for its TOP GEAR brand (either comprising the TOP GEAR mark alone or with other words and/or devices), evidencing said mark's worldwide reach.

Likewise attached as Annex "B" to form an integral part hereof is another Affidavit executed by the same Mr. Walsh, which affidavit contains, as attachments, representative true copies of original registration certificates in respect of Opposer's TOP GEAR trade mark.

Further attached as Annex "C" to form an integral part hereof is the Affidavit of Ms. Susan Payne, the Brand Protection Manager of BBC Worldwide Limited, a wholly owned subsidiary company within the BBC Group, the ultimate parent company being The British Broadcasting Corporation, the herein Opposer.

x x x

4.1 Opposer has a long-running television program entitled "TOP GEAR", a very popular motoring show. The first series of the show, involving thirty-minute episodes, was produced in 1977, and series of the show ran through until 2001, when it was briefly cancelled. In 2002, a new series was commissioned for broadcast on Opposer's BBC2 terrestrial channel, with an updated format of hour-long episodes. The tenth series since the re-launch was broadcast in the United Kingdom in late 2007, with the first episode shown on 07 October 2007 on BBC2.

4.2 "TOP GEAR" is a very popular and well-regarded show. It has been nominated for and won numerous awards including the International Emmy in 2005 for non-scripted entertainment category. In October 2007, for the second year running, "TOP GEAR" won the Most Popular Factual Programme at the National Television Awards held at the Royal Albert Hall in London, while in March 2008 it won the Royal Television Society award for Features and Lifestyle Series.

4.3 The "TOP GEAR" show is broadcast outside the United Kingdom, reaching 150 million households worldwide. It has also been shown in at least 118 countries worldwide via Opposer's own cable and satellite channels BBC World, BBC Prime, BBC Knowledge and BBC Japan. These channels reach countries across the world including in Asia, viz., China, Hong Kong, Indonesia, Japan, South Korea, Macao, Malaysia, Singapore, Taiwan and the Philippines.

x x x

4.4 Additionally, the TOP GEAR mark has an extensive presence in the inherent. For one, the "TOP GEAR" program is supported by a dedicated section on opposer's website at www.bbc.co.uk/topgear. this was launched in October 2002 and contains news and information about the program and presenters, episode guides, quizzes and competitions, video clips and allows fans to sign up to receive a dedicated TOP GEAR newsletter, delivered electronically, and downloads to mobile phones. This website is available

worldwide and readily accessible in the Philippines. Attached as Annex "D" to form an integral part hereof is the cover /first page of said website.

x x x

4.5 Opposer's TOP GEAR mark is not only extensively broadcast via its television show and the internet, but also through its magazine called by the same name. The TOP GEAR Magazine was launched in the United Kingdom with total sales figure during the July-December 2007 period rising over 200,000 copies.

x x x

5. In order to extend protection to the mark here in the Philippines, considering the growing popularity of the "TOP GEAR" program among the Filipino audience, opposer filed an application and subsequently obtained registration for said mark in International Classes 9, 16 and 41. A copy of in-force Certificate of Registration No. 4-2005-012250 for the mark "TOP GEAR" covering the aforementioned classes, is hereto attached as Annex "H" to form an integral part hereof. Relatedly, use of the mark locally initially in Class 16 commenced in 2004."

Subsequently, this Bureau issued a Notice to Answer dated 08 January 2009 to herein respondent-applicant's agent, Nila Mendiola, of Nila N. Mendiola and Company, Certified Public Accountants with office address at Unit 2106 Cityland 10 Tower H.V. Dela Costa Street Salcedo Village, Makati City, directing the filing of a Verified Answer within fifteen (15) days from receipt. The Notice was duly received on 04 February 2009 but despite sufficient lapse of time, this Bureau did not receive an Answer nor any motion related thereto from respondent-applicant or its agent. Thence, in accordance to Section 11 of Office Order No. 79, series of 2005 or the Amendments to the Regulations on Inter-Partes Proceedings, this instant case is deemed submitted for decision on the basis of the opposition and its evidence, offered as follows: Annexes "A", "B", "C", "D", "E", "F", "G", "H" and "I".

The Issues –

- I. Whether or not there is confusing similarity between opposer's registered trademark "TOP GEAR" covering classes 09, 16 and 41 goods; and respondent-applicant's applied mark "TOP GEAR" covering class 12 goods.
- II. Whether or not opposer's registered trademark "TOP GEAR" is a well-known mark.

The ownership of a trademark or trade name is a property right that the owner is entitled to protect. (Converse Rubber Corporation vs Universal Rubber Products, Inc., 147 SCRA 154) As provided under the Trademark Law, RA No. 8293, Section 138, a certificate of registration is prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto. However, when a trademark is used by a party on a product in which the other party does not deal, the use of the same trademark on the latter's product cannot be validly objected to. (ESSO STANDARD EASTERN, INC. vs COURT OF APPEALS, 116 SCRA 336)

The issue on confusion of marks and trade names are split into two types: (1) confusion of goods or services and (2) confusion of business or of origin. In the first type, "the ordinary prudent purchaser would be induced to purchase one product or service because of the similarity of the marks or trade names used thereon. x x x In confusion of goods or services, the confusingly similar marks or trade names are used on the same kind of products or services.

(Sterling Products International, Inc. vs. Farbenfabriken Bayer Aktiengesellschaft, 27 SCRA 1214)

The second type of confusion exists, “when one party’s product or service, though different from that of another, is such as might reasonably be assumed to originate from the latter, and the public would then be deceived into that belief or into the belief that there is some connection or business association between the parties which, in fact, is absent. x x x the goods or services on which the identical or similar marks or trade names are employed are different in kind are non-competing. (ibid., Ang vs Teodoro, 74 Phil. 50)

The instant case revealed confusing similarity of business or of origin.

The trademark application subject of opposition was filed during the effectivity of Republic Act No. 8293 otherwise known as the Intellectual Property Code of the Philippines. Thus, the applicable provision of law in resolving the issue involved is Sec. 123.1 (d) of R.A. 8293, which provides:

“Sec. 123. *Registrability.* – 123.1. A mark cannot be registered if it:

xxx

(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

(Emphasis Ours.)

The contending marks are reproduced as follows:

TOP GEAR

TOP GEAR

Opposer’s Trademark
(Certificate of Registration No. 4-
2005-012250, December 18, 2006)

Respondent-Applicant’s Trademark

The foregoing trademarks are evidently identical in words with non-distinctive fonts and sans any device necessary to differentiate one mark from another.

With respect to the goods they respectively cover, opposer’s goods (Exhibit “H”) consist of classes 09, 16 and 41; whereas respondent-applicant’s goods fall under class 12. (Exhibit “I” and in the file wrapper records) While the contending goods belong to different classes, the dissimilarity of classes do not determine the non-confusion to the general public. While there is no direct competition nor relatedness between the goods, it cannot be negated that opposer’s class 16 goods referring to printed publications and magazines, evidenced by opposer’s Annex “F” is a magazine entitled “Top Gear Philippines”, an automotive magazine dealing with motor vehicles especially cars, its components, parts and other matters related to it. On the other hand, respondent-applicant’s goods under class 12 are automotive spare parts. Thus, the goods complement each other, making it appear in the minds of the public that opposer’s “Top Gear

Philippines” magazine is advertising and selling or sponsoring “Top Gear” spare parts of respondent-applicant.

Indeed, in a contest involving registration of trademark, the determinative factor is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would *likely* cause confusion or mistake on the part of the buying public. The assumption therefore is that they originate from one manufacturer or producer.

The doctrine of confusion or origin is based on cogent reasons of equity and fair dealing. It has to be realized that there can be unfair dealing by having one’s business reputation confused with another. “The owner of a trademark or trade name has a property right in which he is entitled to protection, since there is damage to him from confusion of reputation or goodwill in the mind of the public. x x x” (Ang vs Teodoro, 74 Phil. 50)

Respondent-Applicant has a boundless choice of words, phrases and symbols to adopt as a mark sufficient unto itself to distinguish its products from those of opposer’s and other’s mark. There is no reasonable explanation from respondent-applicant’s choice of the mark “Top Gear” from a field so broad, especially so that opposer’s acquired mark is continuously into distribution and sale in the Philippines of its magazine “Top Gear” and other products.

Anent the issue of whether opposer’s mark is well-known or not, opposer failed to submit eloquent proof to substantiate its allegations that its mark has gained and enjoyed a worldwide reputation internationally and in the Philippines, pursuant to the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, particularly Rule 102, to wit:

“Rule 102. Criteria for determining whether a mark is well-known. – In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and

- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.”

Opposer did not meet the enumerated criteria or any majority combination thereof of a well-known mark. The registration in foreign countries are not sufficient to declare the mark as well-known. Opposer likewise failed to proffer evidence to show the duration, extent and geographical area of the use of the mark, extensive promotional activity in relation to the relevant sector of the consumers in foreign countries and in the Philippines, in recognition of opposer’s exclusivity and reputation of its trademark and the protection of its trademark rights.

IN VIEW of all the foregoing, the instant Verified Opposition is, as it is hereby SUSTAINED. Consequently, trademark application bearing Serial No. 4-2004-013218 for the mark “TOP GEAR” filed on 28 November 2007 for automobile spare parts namely, disc par, disc rotor, disc plate, CV boots, steering joints, steering wheels, brake master, brake shoe, absorber, clutch cable, spark plug cable, repair kit for all automobiles is, as it is hereby, REJECTED.

Let the file wrapper of “TOP GEAR”, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 22 April 2009.

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