

THE COCA COLA COMPANY  
Opposer,  
- versus -

IPC 14-2006-00170

Opposition to:  
TM Application No. 4-1998-004959  
(Filing Date: 08 July 1998)

UNI-GANI INTERNATIONAL  
PRODUCTS, INC.,  
Respondent-Applicant.  
x-----x

TM: "COLA & DEVICE"

Decision No. 2007-48

## DECISION

Before this Bureau is an Opposition filed by THE COCA COLA COMPANY, a corporation duly organized and existing under the laws of the United States of America, with principal office address at One Coca-Cola, Atlanta, Georgia 30313, United States of America, against the registration of the trademark "COLA & DEVICE" for use on candy products under Class 30, with Application Serial No. 4-1998-004959 and filed on 08 July 1998 in the name of UNI-GAIN INTERNATIONAL PRODUCTS, INC., with business address at Unit 2, Lots 5, 6, 7, Phase IV, C-4 Rd. Dagat-Dagatan, Malabon, Metro Manila.

The subject application was published in the E-Gazette as Mark No. 345 officially released for circulation on July 17, 2006.

The instant Opposition is predicated on the following grounds:

1. The approval of the application is question is contrary to Section 123 (d) and (f) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, which provides as follows:

"Section 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, of
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;"

xxx

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for. Provided, that the use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided, further, That the interest of the owner of the registered mark are likely to be damaged by such use; (emphasis supplied)

- "2. The registration of the mark in question will violate opposer's right to its various trademarks for "COCA-COLA" and its derivatives under the following Applications and Registrations, for

softdrinks and non-alcoholic beverages under Class 32, and right to extend the use thereof to other goods related thereto;

- “3. Respondent-applicant’s mark “COLA” appropriates distinctive elements of opposer’s marks, especially with respect to the manner in which the word “COLA” is written in script don’t, depicted in a similar red rectangular background, and is identical and confusingly similar to the above-mentioned trademarks of the opposer, and respondent-applicant’s use thereof is clearly and obviously intended to ride on the popularity and goodwill of the opposer’s mark and to confuse, deceive and/or mislead the purchasing public into believing that respondent-applicant’s goods are related to or connected with the goods manufactured or sold by the opposer, its licensees and/or distributors;
- “4. The registration of the trademark “COLA” in the name of the respondent-applicant will mislead the general public to believe that opposer has extended its business into the field of respondent-applicant, or would create the impression that opposer is now engaged in the business or respondent-applicant, or that by the nature of its operations, respondent-applicant, or that by the nature of its operations, respondent-applicant is connected with the Opposer’s business activities and operations, one way or the other;
- “5. The registration of the trademark in question in the name of respondent-applicant will, likewise, cause confusion and/or the likelihood of confusion as to the products of respondent-applicant and mostly as to its source as well as the high standard and high quality of products that opposer’s marks suggest and represent, thereby mislead the public and make it more convenient for the respondent-application to pass off its products as those of, if not connected with or emanating from, the authority given by the opposer which would result in damage and/or prejudice to the interest of both the public and the opposer’
- “6. Further, the registration of the mark in question in the name of respondent-applicant will necessarily result in the dilution of the marks of the opposer and result in further damage to the proprietary rights and interest of the opposer on its marks, under the prevailing laws are supposed and required to be protected;
- “7. The approval of the application in question will therefore cause great and irreparable damage and injury to herein opposer;

The facts as set forth are as follows:

- “1. Opposer, through its predecessors-in-interest and license, has been in actual commercial use on the Philippines of the mark since its first use in the late 1920’s, in connection with the manufacture of softdrinks products, drinking waters, energy drinks, syrups, concentrates, juices and other non-alcoholic beverages, and it has, in fact, already built-up considerable goodwill and reputation among the consuming public. Opposer’s rights to the mark “COCA-COLA” had already been perfected even way before respondent-applicant filed the subject application or even thought of using it as its mark. Opposer’s mark may in fact already be considered as an internationally well-known mark;
- “2. Opposer’s trademark has been in sued much earlier than that of respondent-applicant, and said mark “COCA-COLA” enjoys a very good reputation and considerable goodwill for excellent, high standard and high quality goods which its products represent and with which its products are usually associated with. In fact, the use of the world “COCA-COLA” in connection with beverages would most likely be associated with the opposer’s products by the consuming public;
- “3. From the very start, opposer has used and depicted its mark in the same or similar script font, and the depiction thereof in such manner has already been identified and associated by the consuming public with the products of the opposer. The red rectangular field in which the mark “COCA-COLA” is usually depicted on, although introduced later than the script font, has

also been already identified and associated with the opposer. These are elements unique to and have become clearly identified with that of the opposer and of its products;

- “4. By virtue of the opposer’s prior and continued use of its mark in the consistent manner depicted in its various trademark applications and registration, together with the large amounts of money of efforts expended to popularize the same all over the world including the Philippines, by or through printed and/or TV and radio advertisements, said opposer’s mark has become well-known both locally and internationally, and has established valuable goodwill for opposer among its consumers who have identified opposer as the owner, source and originator of the excellent, high standard and high quality products bearing or relating to or associated with the said mark “COCA-COLA”;
- “5. Respondent-Applicant’s mark “COLA” is confusingly similar to opposer’s mark especially with respect to the way the word “COLA” is depicted in a similar script font over a similar red rectangular field, so much so that its use in respondent-applicant’s good would create the false impression on the public that respondent-applicant’s business producing its candy products with the “COLA” marking was licensed by and is connected with that of opposer, thereby defrauding herein opposer as well as the public in the process.
- “6. The depiction of respondent-applicant’s mark “COLA” in the manner it was applied for deceives the consuming public into believing that the opposer has expanded its field of operations to the related field of confectioneries under Class 30 which class, incidentally, the opposer has already several applications and registrations presently pending and/or existing although for other types of products included therein. Respondent-Applicant’s mark integrates distinctive elements of opposer’s mark, thereby implying an association between of respondent-applicant’s products bearing such mark with those of the opposer. Considering that Classes 30 and 32 deal with food products (of which beverages may included), the possibility confusion and of deception is quite real and likely.
- “7. The registration of the mark “COLA” of respondent-applicant diminishes the distinctiveness and strength of opposer’s mark which the public has already identified and associate with the opposer’s products to the opposer’s prejudice and damage not mentioning the violation of opposer’s rights and interest over its mark “COLA-COLA”.

Despite Respondent-Applicant’s receipt on 21 November 2006 of the Notice to Answer issued by the Bureau, whereby it was given thirty (30) days within which to file its Verified Answer, it failed to do so. Consequently, Order No. 2007-369 was issued which declared Respondent to have waived its right to file the Verified Answer. The case was thereafter deemed submitted for decision.

Considering that the case was mandatorily covered by the Summary Rules under Office Order No. 79, this Bureau directed Opposer to file all evidence in original and duplicate copies, and in compliance with said Order, Opposer through Counsel filed its evidence on 14 November 2006.

Filed as evidence for the Opposer based on the records are Annexes “A” and “N” which consisted, among others, of the Special Power of Attorney which appointed Romulo, Mabanta, Buenaventura, Sayoc & De Los Angeles, or any of its lawyers, to be their attorney-in-fact in this present suit; Several pending trademark applications or registrations obtained in the Philippines alone bearing the mark COCA-COLA for different goods such as non-carbonated, non-alcoholic, tonic beverages and syrups for the manufacture of these beverages, clothing, belts, hats, footwear to name a few; Affidavit of Mr. Amormio C. Santiago, Legal Manager of the Coca Cola Company-Philippine Division.

For consideration in particular is the propriety of Application Serial No. 4-1998-004959. The issue hinges on the determination of whether or not Respondent-Applicant is entitled to register the mark COLA & DEVICE for candy products.

The issue stems or springs from Respondent-Applicant's appropriation of the mark COLA & DEVICE, which is visually and phonetically similar, in fact obviously identical to the registered COCA-COLA trademark used and not abandoned by Opposer. There is striking similarity in the style the labels were printed which is uniquely COCA-COLA or Opposer's version of script font or writing when printing the words COCA-COLA including the choice of color red for a rectangular background. This Bureau reproduced Opposer's mark as well as Respondent's mark for purposes of comparison.

Culled from IPP's website [www.ipophil.gov.ph](http://www.ipophil.gov.ph) and Opposer's documentary evidence (Annexes "H-K", Opposer) likewise are earlier applications and registrations obtained between the years 1986-1995 for the trademark COCA-COLA, with the earliest application dating more than thirty (30) years back, more specifically, on 14 February 1974, for the trademark COCA-COLA. Reproduced below are Opposer's old COCA-COLA trademarks:

The distinct and unique script applied in printing the words COCA COLA is Complainant's source identifier. This particular script has long been identified as Complainant's trademark when printing the words COCA-COLA with the letter C in the word COLA extending its line and making its way into the loop of letter L. Respondent even copied and adopted the choice of white in printing the word COLA and using red as background, all these features are unique and distinctive for Opposer insofar as its trademark COCA-COLA is concerned.

A comparison of the competing marks reveal that word COLA appear in both labels of the contending parties. Having shown and proven resemblance of the two marks, we now delve into the matter of ownership and priority in application which certainly has decisive effect in the adjudication of the case.

With R.A. 8293 as basis of registrability, this Bureau adheres to the First-to-File Rule and applying specific provisions of R.A 8293 (Sec. 122 and Sec. 127). The records will show that as between the parties, Opposer has prior application and registration obtained for the COCA-COLA trademark. Opposer's mark COCA-COLA trademark was first filed in the Philippines on 14 February 1974 (Annex "G", Opposer) while Respondent-Applicant's application for the same mark COLA & DEVICE came more than two (2) decades later on 08 July 1998. Being the prior user and registrant of the trademark COCA-COLA in the Philippines, Opposer is the actual owner thereof.

From evidence on record, Opposer is the registered owner in the Philippines of the COCA-COLA marks, as follows:

Trademark	Registration Number	Nice Classification
Coca-Cola/Coke in Colors and Design	4-1995-101286 (reg. November 28, 2005. Filed July 10, 1995)	05
Coca-Cola (Coke in Colors & Design Red Rectangular)	4-1995-102741 (re Jan. 14, 2000. Filed June 2, 1995)	32
Coca-Cola	002001 (reg July 6, 1977)	32
Coca-Cola	R-1610 (reg Dec. 23, 1974. Filed Feb. 14, 1974)	32
Coca-Cola	060586 (reg May 19,	25

	1995. Filed June 11, 1993)	
Coca-Cola	38398 (reg. March 16, 1998. Filed May 30, 1984. First use: Feb. 2, 1979	18, 25
Coca-Cola and Device (Landor)	044928 (reg. June 6, 1989. Filed November 27, 1986)	32
Coca-Cola Drink with Dynamic Ribbon Modified with Bubbles Trade Dress	4-2003-000790 (reg. August 28, 2005. Filed Jan. 29, 2003)	32
Coca-Cola	062232 (reg Dec. 1, 1995. Filed April 16, 1991)	06, 08, 09, 11, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 34

Opposer is also the owner of the following pending trademark applications:

Trademark	Registration Number	Nice Classification
Coca-Cola Party Pack Label in Graphic Color	(App March 18, 2005) 4-2005-002592	32
Coca-Cola Barkada Logo	(App May 30, 2006) 4-2006-005728	32, 36

From the foregoing, one will readily note that as early as December 1974, Opposer already obtained registration for the trademark, COCA-COLA, for goods under Class 32 (Certificate of Registration No. R-1610).

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 opposed, the Respondent-Applicant has the burden of proving ownership (Marvex Commercial Co., Inc. v. Peter Hawpia and Co., 18 SCRA 1178). In the instant case, Respondent-Applicant did not present any evidence to prove its ownership of the COLA trademark, despite being given the opportunity to do so.

A cursory reading of paragraph (d) of R.A. 8293 with emphasis on prior registration and/or application of the same mark states that:

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

xxx

(e) Is Identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- A. The same goods or services, or
- B. Closely related goods or services, or
- C. If it nearly resembles such a mark as to be likely to deceive or cause confusion;”

The preceding section provides that the owner of a registered a mark may bring an action to oppose an application for registration of another mark when he finds the same to be identical and/or confusingly similar with his registered trademark. Form a plain reading of the trademark law (R.A. 8293) in point, what is there to suffice the requirement of the law and thus bar registration by subsequent user of identical or similar mark is confusing similarity between the subject trademark, the likelihood that purchasers may confuse the goods of the Application and Opposer to come from the same manufacturer or source. 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)

In this particular case, the remarkable similarity of the word COLA is both marks is noteworthy. The mark COLA of Respondent-Applicant is the same in sound and spelling vis-à-vis the registered COCA-COLA trademark of Opposer. Anyone is likely to be misleading by its close resemblance or identity with Opposer's trademark. Hence, comparing both marks in plain view there certainly is obvious similarity.

Opposer's products and Applicant's goods are admittedly not in actual competition but they have somehow direct relations in that Opposer's generally carbonated drinks and other types of beverages and Respondent's candy products fall in the category of food products. By their being basically food items, both products are classified as common day-to-day consumer or household items and may be marketed similarly. The hoods involved therefore flow through the same channels of trade. Clearly, their goods are closely related. The Supreme Court in ESSO Standard Eastern, Inc. vs. Court of Appeals, et. al, 201 Phil 803, defined what are essentially closely related good under the trademark law as:

"Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture of quality. They may also be related because they serve the same purpose or are sold in grocery stores. This, biscuits were held related to milk because they are both food products."

Also, the possibility that Opposer's COCA-COLA trademark will be used on goods under the aforementioned class as Respondent's specifically on candy products in the Philippines appears highly probable as they are within the normal or zone of potential business expansion of Opposer. The classes of goods or line of merchandise that Opposer chose to adopt or attach its classical trademark COCA-COLA appear in the category of food or food ingredients. This Bureau has seen an iota of connection between herein Opposer's goods and those of Respondent or to large extent that would apropos place the goods in the same category or fall them within the normal or zone of potential business expansion of Opposer.

Bolstering this view is the pronouncement of the Supreme Court in the case of Jose P. Sta Ana vs. Florentino Maliwat, et. al. G.R. No. L-23023, August 31, 1969 which ruled, thus:

"Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trademark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148 ALR 56 et seq; 53 Am Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business."

Opposer further argues that the mark COCA-COLA is well-known. In the language of R.A. 8293, more particularly Section 123 (e) and (f), it is said that:

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

x x x

- e) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interest of the owner of the registered mark are likely to be damaged by such use;”
- (f) 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 identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall betaken on the knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

x x x

It is clear that the foregoing section applies in the case at bar because the subject trademark application was filed under the new Intellectual Property Code, it follows that it is R.A. 8293 that must be applied with regard to the determination of whether or not a mark is well-known. In determining whether a trademark is well-known, we used paragraph (f) of the foregoing section because the goods involved in this instant suit are dissimilar. The scope of protection of well-known marks under the afforested standards and guidelines covers registered trademarks to be used on dissimilar goods. It may well be worthy to note that as early as the year 1974, Opposer obtained registration of the trademark COCA-COLA on varied products. Although the registration is primarily beverages under Class 32, nevertheless, it is in the same category as food products and beverages which is the same of Respondent’s goods. These registrations are subsisting and have not been abandoned. The appropriation by Respondent-Applicant of the mark COLA & DEVICE as subsequent user show an intent to reap on the established goodwill Opposer has earned over the years from the continued and uninterrupted use of its famous COCA-COLA trademark. Opposer’s registered COCA-COLA trademark is widely and popularly use by Opposer especially on its non-alcoholic beverages. The use and adoption by Applicant as subsequent user of the same word COLA adopting the same red color to complete its device can only mean that Applicant wishes to benefit from the advertising value and reputation of Opposer’s famous trademark.

By appropriating a word which is identical or closely resembles that of a widely used and popularly known trademark, and taking into account the evidence submitted by Opposer, this Bureau holds that indeed there was a deliberate intent by Respondent-Applicant use and advertisement without the Respondent-Applicant having incurred any expense to gain such goodwill and/or reputation.

In the case of American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544, it was observed that:

“Why of the million of terms and combination of letters and designs available the appellee had to choose a mark so closely similar to another’s trademark if thee was no intent to take advantage of the goodwill generated by the other mark”

As the rightful owner and prior user of the mark COCA-COLA, Opposer should be given protection against entities that merely wish to take advantage of the goodwill its marks have generated.

WHEREFORE, premises considered, the Notice of Opposition is, as it is, hereby SUSTAINED. Consequently, Application bearing Serial No. 4-1998-004959 filed by UNI-GAIN INTERNATIONAL PRODUCTS, INC. on 08 July 1998 for the registration of the mark COLA & DEVICE for use on candy products under class 32 is, as it is hereby, REJECTED.

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

SO ORDERED.

Makati City, 30 April 2007.

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