



BYD COMPANY LIMITED,
Opposer,

-versus-

ROBERT ONG CUA,
Respondent-Applicant.

X-----X

} IPC No. 14-2012-00440
} Opposition:
} Appln. Serial no. 4-2012-005539
} Date filed: 09 May 2012
} TM: "BYD"

NOTICE OF DECISION

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ROBERT ONG CUA

Respondent-Applicant
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GREETINGS:

Please be informed that Decision No. 2013 - 187 dated October 08, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 08, 2013.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



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IPC No. 14-2012-00440

Opposition to:
Serial No. 4-2012-005539
Date Filed: 09 May 2012

Trademark: **"BYD"**
Decision No. 2013- 187

DECISION

BYD Company Limited¹ ("Opposer") filed on 03 December 2012 an opposition to Trademark Application Serial No. 4-2012-005539. The contested application, filed by Robert Ong Cua² ("Respondent-Applicant"), covers the mark "BYD" for use on *"apparatus for lighting, heating, steam generating, cooking, drying, ventilating, water supplying and sanitary purposes"* under Class 11 of the International Classification of Goods³.

According to Opposer, BYD Company Limited was founded in February 1995 by Mr. Wang Chuanfu, a Chinese national, with a capital of Two Million and Five Hundred Thousand Renminbi Yuan (RMB2.5 Million) and with twenty (20) employees. It explains that "BYD" was derived from its founder's saying "Build Your Dreams." Opposer claims to be selling its products with the mark "BYD" worldwide since 2005. Allegedly, its products have been widely advertised, featured in various publications, showcased in trade shows and advertised through its website www.byd.com. It states that a Google search of "BYD" yields results pointing to it as the source of "BYD" products and not the Respondent-Applicant. It maintains that its sales and advertising budget shows the extent of its well-known mark. In the Philippines, it claims that it does not only sell its products but that it also seeks to put up an assembly plant for its electronic and automotive product lines. Its automobile products are sold in a showroom in Balintawak, Quezon City. Through a joint venture of the LKG Group and Yuchengco Group of Companies, its products are sold in the Philippine market.

¹ A corporation formed and existing under the laws of the People's Republic of China with business address at Yan'an Road, Kuichong Town, Longgang District, Shenzhen, China.

² With address at 3672 Buenos Aires St, Sta. Mesa, Manila, Metro Manila, Philippines.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

Republic of the Philippines

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Opposer asserts that Respondent-Applicant's mark "BYD" is confusingly similar to that of its own well-known "BYD" mark and thus, proscribed under Section 123.1 (e) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It maintains that in order to protect its interest over the said mark, Opposer filed its own application for registration over the contested mark on 23 November 2012 in the Philippines. All over the world, it has various registrations and pending applications. While Respondent-Applicant seeks to be registered under Class 11, Opposer claims to have used its marks for Classes 09, 11, 12, 18, 25 and 35.

Opposer imputes bad faith on Respondent-Applicant's application claiming that the latter is aware of its ownership of the mark. Allegedly, Respondent-Applicant was in talks with Opposer for the purchase of its LED light bulbs as early as first quarter of 2012. Even after filing the application, Respondent-Applicant allegedly continued his discussion with Mr. Gillian Li, member of Opposer's Overseas Business Division, for the purpose of purchasing Opposer's goods and having them shipped in the Philippines.

The Opposer submitted the following as evidence:

1. Respondent-Applicant's application as published in the IPO E-Gazette and released for publication on 03 September 2012;
2. filing letter dated 23 November 2012 and enclosures by Opposer for the mark "BYD";
3. internet article by New York Times dated 29 May 2012;
4. internet article by New York Times dated 22 March 2012;
5. internet article by China Car Times dated 13 March 2012;
6. internet article by Reuters dated 14 November 2011;
7. internet article by Business Wire dated 20 December 2011;
8. internet article by Wall Street Journal dated 12 December 2010;
9. internet article by Bloomberg dated 05 May 2012;
10. internet article by Gasgoo dated 10 December 2010;
11. internet article by PVTech dated 31 August 2012;
12. internet article by Reuters dated 04 November 2012;
13. internet article by China Daily dated 27 October 2012;
14. media info collection of BYD Autoexport Trade Division dated 20 January 2009;
15. New Energy Vehicles 2009 brochure;
16. Future Starts from Now brochure;
17. 2010 BYD Collection brochure;
18. Undated internet article of Autocar;
19. internet article by New York Times dated 29 May 2012;
20. internet article by Gizmag dated 23 August 2012;
21. internet article by Inquirer dated 02 March 2010;

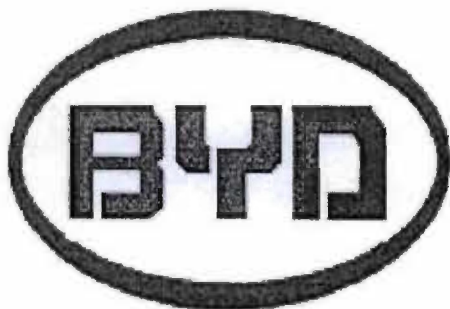
22. pictures of various BYD booths;
23. BYD website printouts;
24. Printouts of Google search for "BYD";
25. certification that the attached "G-1" to "H-66" are certified true copies on file with the IPO which form part of the records of opposition for the mark "BYD Top Gear";
26. various BYD registrations and application in other jurisdictions;
27. Manila Bulletin news article dated 04 March 2011;
28. Internet article entitled "Honda Cars Philippines stakeholder to bring in BYD cars from China";
29. email dated 16 March 2012;
30. attachment to email dated 16 March 2012;
31. email order dated 28 May 2012;
32. email dated 11 June 2012;
33. email dated 21 June 2012; and,
34. attachment to email dated 21 June 2012.

A Notice to Answer dated 29 January 2013 was furnished to Respondent-Applicant. Despite receipt thereof, it failed to comply. On 03 May 2013, Order No. 2013-294 was issued declaring Respondent-Applicant in default and submitting the case for decision. Respondent-Applicant thereafter moved to set aside the Order of Default. Finding the same unmeritorious, the motion was denied and the ruling in Order No. 2103-294 was affirmed.

Essentially, issue to be resolved is whether Application No. 4-2012-005539 should be allowed.

The records reveal that Respondent-Applicant filed its application for registration of the contested mark "BYD" on 09 May 2012. On the other hand, the Opposer filed its application only on 23 November 2012. Unquestionably, Respondent-Applicant is the first to file an application for registration.

A comparison of the two competing marks depicted below :



Opposer's mark



Respondent-Applicant's mark

would show that indeed, they are confusingly similar. When one looks at the Opposer's mark, what is impressed in the eyes and mind is the letter combination "byd". Looking at Respondent-Applicant's mark will lead us to the same conclusion. That Opposer's mark is enclosed in a ring lends scant effect, if at all, in eradicating any likelihood confusion and/or deception to the consuming public. In the eyes of the average purchaser, the competing marks are identical in both spelling and pronunciations. They even both claim to stand for the acronym "Build Your Dream/s". For these reasons, the two marks cannot co-exist, especially that they both pertain to goods under Class 11.

While the Opposer admits that it is Respondent-Applicant which filed an earlier application for registration, it accuses the latter of bad faith. Basically, it raises the issue of ownership over the contested mark.

A cursory evaluation of the evidence presented, this Bureau finds that it is sufficiently supported that Opposer has obtained various registrations over the mark "BYD" in different jurisdictions way before 09 May 2012, the filing date of Respondent-Applicant's application. As early as 14 September 2004, Opposer was granted registration over the mark for Class 12 in China. For Class 11, it was able to obtain registration as early as 23 July 2010 in Hongkong.⁴ The internet articles from different sources likewise show Opposer's presence in the market as early as 2010.⁵ Clearly, Opposer first used the mark "BYD" on its products.

Moreover, Section 165.2 of IP Code states that:

"165.2.(a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful." (Emphasis supplied.)

Therefore, since "BYD" is not only used by the Opposer as a trademark but more importantly as a tradename, registration is not a prerequisite for its protection under the law. Regardless of its earlier filing date, the law prohibits the use of Respondent-Applicant of "BYD" whether as a mark or a tradename or collective mark. This is further explained by the Supreme Court, in the case of **Coffee Partners, Inc. vs. San Francisco Coffee and Roastery, Inc.**, as follows:

⁴ Exhibit "G".

⁵ Exhibit "C".

"In Philips Export B.V. v. Court of Appeals, this Court held that a corporation has an exclusive right to the use of its name. The right proceeds from the theory that it is a fraud on the corporation which has acquired a right to that name and perhaps carried on its business thereunder, that another should attempt to use the same name, or the same name with a slight variation in such a way as to induce persons to deal with it in the belief that they are dealing with the corporation which has given a reputation to the name."

Furthermore, Respondent-Applicant cannot deny the fact that it is aware of the Opposer's prior existence even before filing a trademark application. Exhibits "J", "J-1", "K" and "K-1" shows exchanges in communication via email between Respondent-Applicant and a representative of the Opposer. The emails reveal a negotiation between the parties for the shipment of Opposer's goods. The inescapable conclusion is that in arriving at the mark "BYD", the Respondent-Applicant obviously copied or at least drew inspiration from Opposer's mark. Hence, despite its earlier filing of the application, the registration cannot be granted in its favor. After all, ownership is the basis of trademark registration.

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁶

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2012-005539 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 08 October 2013.


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

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.