



FORMULA ONE LICENSING B.V.,

-versus-

DALLAS ENERGY AND PETROLEUM
CORPORATION,
Respondent-Applicant.

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}
} IPC No. 14-2011-00552
} Opposition to:
} Appln. Serial No. 4-2011-740140
} Date filed: 08 August 2011
} **TM: "F1 LOGO"**

NOTICE OF DECISION

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DALLAS ENERGY AND PETROLEUM CORPORATION

Respondent-Applicant
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GREETINGS:

Please be informed that Decision No. 2013 - 36 dated February 20, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 20, 2013.

For the Director:


Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



FORMULA ONE LICENSING B.V.,
Opposer,

IPC No. 14-2011-00552
Case Filed: 13 February 2012

-versus-

Opposition to:
Appln. Serial No.: 4-2011-740140
Filing Date: 08 August 2011

**DALLAS ENERGY AND PETROLEUM
CORPORATION,**
Respondent.

TM: "F1 LOGO"

x-----x

Decision No. 2013- 36

DECISION

FORMULA ONE LICENSING B.V. ("Opposer")¹ filed on 13 February 2012 an opposition to Trademark Application Serial No. 4-2011-740140. The application, filed by DALLAS ENERGY AND PETROLEUM CORPORATION ("Respondent-Applicant")², covers the mark "F1 LOGO" for use on "business management-gasoline refilling station" under Class 35 of the International Classification of Goods.³

The Opposer anchors its opposition on the ground that Respondent-Applicant's mark "F1 LOGO" is identical with its registered well-known marks "F1 Marks". To supports its opposition, the Opposer submitted the following:

1. Exhibit "A" – Certified true copy of several annexed documents attached to complaint filed on 03 December 2009 docketed as IPV No. 10-2009-00014 entitled Formula One Licensing B.V. and Formula One Administration Limited, (Complainant) vs. First Global Byo Corporation and Philip Cea, (Respondent);
2. Exhibit "B" – Certified true copy of annexed documents (Affidavit of Patricia Anne Heavey dated 07 December 2011) are copies on file with the records of this office of IPV No. 10-2009-00014 entitled Formula One World Championship Limited, (Complainant) vs. First Global Byo Corp., and Philip Cea, (Respondent);

¹ Formerly known as GISS Licensing BV and FIA BV, is a corporation duly organized and existing under the laws of the Netherlands, with principal place of business at Rokin 55, 1012 KK Amsterdam, The Netherlands.

² Is a corporation duly organized and existing under the Philippine Laws, with office address at TH3 Green Heights, Garden Village Diversion Road, Davao City.

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.

3. Exhibit "C" – Certified true copy of annexed documents (Affidavit of Teresa Paz B. Grecia Pascual dated 25 July 2011, with its Annexes) are copies on file of the records of IPV No. 10-2009-00011 entitled Formula One World Championship Limited, (Complainant) vs. First Global Byo Corp., and Philip Cea, (Respondent);
4. Exhibit "D" – Certified true copy of Certificate of Reg. No. 4-1997-126894 for the mark F1 Formula 1 Logo issued on 30 October 2004; and
5. Exhibit "E" – Copy of letter from Opposer's counsel addressed to the Respondent-Applicant dated 02 December 2011.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant. However, no answer was filed. Accordingly, the Hearing Officer issued an Order on 09 July 2012 declaring the Respondent-Applicant in default and the case submitted for decision based on the opposition and evidence submitted by the Opposer.

Should the Respondent-Applicant's trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owner of the 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 products.⁴ Thus, Sec. 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 08 August 2011, the Opposer has already an existing trademark registration for the mark "F1 FORMULA 1 LOGO" Reg. No. 4-1997-126894, issued on 30 October 2004 for use on goods or services under Class 35 of the International Classification of Goods. The Opposer also registered its mark "F1 Formula Logo" in other Classes of goods namely, 9, 12, 16, 18, 25, 28, 35, 38, 41 and 42.⁵

In this regard, this Bureau finds that the mark applied for registration by the Respondent-Applicant practically identical to the Opposer's, as shown below.

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

⁵ Annex "NN" of IPV No. 10-2009-00014.



Opposer's Mark



Respondent-Applicant's Mark

All the elements of the Opposer's mark "F1" are present in the Respondent-Applicant's mark. The only difference is the addition of the symbol of a red drop incorporated in the Respondent-Applicant's F1 LOGO is insufficient to distinguish it from the Opposer's mark.

The Respondent-Applicant's trademark application covers "business management-gasoline refilling station" under Class 35. The Opposer's Trademark Reg. No. 4-1997-126894 indicates services that relate to business operations. Moreover, the Opposer's Trademark Reg. No. 4-1997-126887 covers goods under Class 4, particularly, "industrial oils and fats; lubricants; substance-absorbing, moisturizing and binding mixtures; fuels (including motor fuels) and lighting substances; candles; tapes". Also, Trademark Reg. No. 4-1997-126889 shows that the Opposer's mark is used on "vehicles; apparatus for locomotion by land, air or water, motors and engines for land vehicles" under Class 12.

There is no doubt therefore that there is the likelihood of confusion, or even deception, in this instance. The "F1" mark has been shown to be known in motor racing. It is a unique mark such that it is likely for consumer, especially motorist, to associate it with the Opposer's mark. The Opposer's marks F1 Formula 1 Logo have been registered in various countries of the world including the Philippines.⁶ Formula one racing is the most popular form of motor sport in the world⁷ and in the Philippines and has acquired tremendous goodwill and reputation, not only in the racing industry but with the general public as well. In addition to television coverage, F1 racing has been covered in the national and international press. The F1 races are regular news features in newspapers and magazines in the Philippines, such as the broadsheets Philippines Daily Inquirer, Business World, Business Mirror, Manila Bulletin and tabloid, Abante Tonite.⁸ Consumers may thus assume that one mark is just a variation of the other and there is a connection or association between the two marks and/or between the contending parties themselves, when in fact there is none.

The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters available, the Respondent-Applicant had come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁹

⁶ (Exhibit "A") Annexes "E" to "E-18" in IPV No. 10-2009-00014.

⁷ Annex "N" to the Affidavit of Atty. Grecia Pascual.

⁸ Exhibit "B" of Paragraph 23 of the Affidavit of Ms. Heavey.

⁹ American Wire and Cable Co. v. Director of Patents et.al. SCRA 544, G.R. No. L-26557, 18 February 1970.

It is stressed that the laws on trademarks and tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourage fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another.¹⁰

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-740140 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 20 February 2013.


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



/joanne

¹⁰ See *Baltimore Bedding Corp., v. Moses*, 182 and 229 34A (2d) 338.