



TEA BOARD OF INDIA,
Opposer,

-versus-

JAKE MALVIN N. TANSANCO,
Respondent-Applicant.

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}
} IPC No. 14-2012-00176
} Opposition to:
} Appln. Serial No. 4-2012-000103
} Filing Date: 04 January 2012
} TM: "ASSAM"

NOTICE OF DECISION

LAW FIRM OF REYES RARA & ASSOCIATES

Counsel for Opposer
Ground Floor, W Tower
39th Street, Bonifacio Global City
Taguig City

JAKE MALVIN N. TANSANCO

For the Respondent-Applicant
106-C 4th Street, New Manila
Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 28 dated February 08, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 08, 2013.

For the Director:


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



TEA BOARD OF INDIA,
Opposer,

IPC No. 14-2012-00176
Case Filed: 04 June 2012

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TM: "ASSAM"

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Decision No. 2013- 28

DECISION

TEA BOARD OF INDIA ("Opposer")¹ filed on 04 June 2012 an opposition to Trademark Application Serial No. 4-2012-000103. The application, filed by JAKE MALVIN N. TANSANCO, ("Respondent-Applicant")², covers the mark "ASSAM" for use on "beverages made of milk, soybean milk, soy milk, milk products such as ice cream, milk drinks and yogurt; milk tea drink under Class 29 and beverages made of tea, tea bags, cocoa, coffee, sago, chocolate food beverages not being dairy based or vegetable based; milk tea drinks" under Class 30 of the International Classification of Goods³.

The Opposer alleges among other things, the following:

1. "ASSAM" is a geographical indication that must be protected as an Intellectual Property Right under Article 22 of the TRIPS Agreement and Section 123.1 (g) of the IP Code which proscribed the registration of the marks that are likely to mislead the public as to the geographical origin of the goods;
2. Respondent-Applicant's use and adoption of "ASSAM" for goods in Classes 29 and 30 is likely to cause confusion, mistake, or deception as regards its affiliation, connection or association with the Opposer, or as to the origin, sponsorship, or approval of its products by the Opposer, and constitutes false designation of origin, false description or representation under Section 169 of Republic Act. No. 8293;

¹ Is a statutory body of the Central Government of INDIA under the Ministry of Commerce & Industry, established under the Tea Act, 1953, with address at 14, B.T.M. Sarani (Brabourne Road) P.O. Box No. 2172 Kolkata 700 001, India.

² Is a citizen of the Philippines with address at 106-C 4th Street, New Manila, Quezon City, 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.

3. "ASSAM" has acquired invaluable goodwill as a geographical indication, which must be protected from acts of unfair competition under Article 10bis of the Paris Convention and Section 168 of the IP Code;
4. Registration of the "ASSAM" trademark in the name of Respondent-Applicant will cause grave and irreparable injury and damage to Opposer as it will dilute the distinctiveness of ASSAM as a geographical indication, and impair the established goodwill and reputation of ASSAM tea as regulated and promoted by Opposer; and
5. Assuming in *ARGUENDO* that "ASSAM" may be registered as a trademark, Respondent-Applicant is a mere distributor of goods bearing said mark. As Respondent-Applicant is not the owner of the "ASSAM" trademark, he is not entitled to the registration thereof.

The Opposer's evidence consists of the following:

1. Exhibit "A" – the duly executed, notarized and legalized Secretary's Certificate;
2. Exhibits "B" to "B-1" – Copies of excerpts from the Tea Act. 1953 on the establishment of the Tea Board and its objects;
3. Exhibit "C" – Print outs from the website of the Tea Board of India which shows tea statistics, relating to monthly tea production during 2011-2012 financial year;
4. Exhibit "D" - Certified true copy of copyright registration of the ASSAM Logo;
5. Exhibit "E" – Certified true copy of registration of ASSAM (Orthodox) word and logo as a Geographical Indication in Class 30 for tea under Geographical Indications of Goods (Registration and Protection) Act, 1993 of India;
6. Exhibit "F" – Print out from the website www.englishteastore.com.states;
7. Exhibit "G" – Print out from the website <http://www.englishteastore.com>;
8. Exhibit "H" – Print out from the website <http://teasource.com>;
9. Exhibit "I" – Print out from the website <http://teasource.com>;
10. Exhibits "J" to "J-5" – Print out of pages from the <http://granzon.sulit.com.ph/>;
11. Exhibit "K" – Print out of the facebook page;
12. Exhibit "L" – Print out of the Wikipedia entry on ASSAM Tea;
13. Exhibit "M" – Print out of the LinkedIn entry of Respondent-Applicant; and
14. Exhibit "N" – Affidavit of Satrajit Banarjee, Deputy Director of Tea Promotion of the Tea Board of India.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 19 June 2012. However, no answer was filed. Accordingly, the Hearing Officer issued an Order on 12 October 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?

The Opposer anchors its case on Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines, which provides:

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

(g) is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;

Records show that the ASSAM LOGO is copyright protected and registered as an artistic work with the Copyright Office of India under Reg. No. A-67290/2004 dated 05 November 2004⁴. Likewise Opposer also secured registration of ASSAM (Orthodox) word and Logo as a Geographical Indication in Class 30 for tea under the Geographical Indications of Goods (Registration and Protection) Act, 1999 of India⁵.

ASSAM refers to tea grown in the tea gardens in the State of ASSAM, which has a special quality, reputation and characteristics due to the unique agro-climatic conditions prevailing in the said region⁶.

In this regard a cursory examination of the mark ASSAM subject of the opposition, automatically creates the impression that the goods covered are made in the State of ASSAM in India or the goods are originating in that territory.

However, the Respondent-Applicant is a citizen of the Philippines with address at 106-C 4th Street, New Manila, Quezon City, Philippines and sells ASSAM MILK TEA in several locations and advertises the same on <http://granson.sulit.com.ph/>. The products are indicated as MADE IN TAIWAN⁷.

It is very clear that the Respondent-Applicant is not based in the State of ASSAM in eastern India located in South Eastern Himalayan. Further, he is not a member of the body corporate established under the Tea Act of 1953.

Therefore, the Respondent-Applicant's products covered by the trademark ASSAM particularly beverages made of tea, tea bags, cocoa, coffee, sago, chocolate food, beverages not being dairy based or vegetable based, milk tea drinks under Class 30 of the International Classifications of Goods which are similar to Opposer's goods and manufactured outside ASSAM in India clearly mislead the public into believing that such goods or products originate in ASSAM, which in fact they do not but somewhere in Taiwan⁸.

Further, the use of the Respondent-Applicant of the mark ASSAM in relation to his goods or products under Class 29 which are other than tea and not having produced or manufactured in the State of ASSAM in India is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with other person or as to the origin, sponsorship of his goods, thus deceiving the public into believing that there is some connection between the Respondent-Applicant and Opposer when in fact there is none.

⁴ Exhibit "D".

⁵ Exhibit "E".

⁶ Wikipedia, the free encyclopedia.

⁷ Exhibits "J" to "J_5".

⁸ Exhibits "J" to "J-5".

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-000103 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 08 February 2013.



ATTY. NATHANIEL S. AREVALO

Director IV

Bureau of Legal Affairs

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