



VIRGIN ENTERPRISES LIMITED,  
Opposer,

-versus-

TOYOTA ALABANG, INCORPORATED,  
Respondent –Applicant.

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} IPC No. 14-2011-00528  
} Opposition to:  
} Appln. Serial No. 4-2010-013742  
} Date Filed: 17 December 2010  
} TM: "HOME OF THE VIRGIN  
} CARS"

**NOTICE OF DECISION**

**PLATON MARTINEZ FLORES**  
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Legaspi Village, Makati City

**TOYOTA ALABANG, INC.**  
Respondent-Applicant  
Alabang Zapote Road corner  
Concha Cruz Drive  
Las Pinas City

**GREETINGS:**

Please be informed that Decision No. 2014 - 66 dated March 03, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 03, 2014.

For the Director:

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



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Decision No. 2014- 66

## DECISION

VIRGIN ENTERPRISES LIMITED (“Opposer”)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2010-013742. The application, filed by TOYOTA ALABANG, INC. (“Respondent-Applicant”)<sup>2</sup>, covers the mark “HOME OF THE VIRGIN CARS” for use on “*transport services*” under Class 39 of the International Classification of Goods or Services.<sup>3</sup>

The Opposer anchors its opposition on Section 123.1 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”). To support its opposition, the Opposer submitted as evidence the following:

1. Exh. “A” – duplicate original of the Certificate of Incorporation for Virgin Enterprises Limited (“VEL”), showing that VEL is a company incorporate in England and Wales with company number 01073929 and is a member of a group of companies known collectively as the Virgin group of companies (the “Virgin Group”);
2. Exh. “B” – duplicate original copy of a portfolio of over 3,000 trade mark applications and registrations (“Virgin Marks”) in over 150 countries spanning all 45 classes of goods and services, showing the diversity of the Virgin Group of business and global their presence;
3. Exh. “C” – duplicate original copy of the selection of the marks contained within the portfolio (Exh. “B”), showing that VEL’s trademark applications and registrations cover a wide variety of goods and services that reflect the diversity of the Virgin Group’s worldwide business interests;

<sup>1</sup> A corporation organized and existing under the laws of the United Kingdom with registered office address at the School House, 50 Brook Green, London W6 7RR, England, United Kingdom.

<sup>2</sup> A Philippine corporation with address at Alabang-Zapote Road corner Concha Cruz Drive, Las Pinas City.

<sup>3</sup> 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.

4. Exh. "D" - duplicate original copy of the details of over 4,500 domain names incorporating the VIRGIN name and showing that VEL is the registered proprietor thereof;
5. Exh. "E" - duplicate original copy of the various publications and documents showing use of the Virgin Marks in relation to airline services and other goods and services provided by Virgin Atlantic Airways;
6. Exh. "F" - duplicate original copy of the fact sheets summarizing the services provided within the Virgin Club House in the United Kingdom and showing that the Virgin Marks are used in relation to the provision of food and drink both on aircraft and in aircraft lounges;
7. Exh. "G" - duplicate original copy of extracts from the [www.virginatlantic.com](http://www.virginatlantic.com) website relating to the Opposer Class Virgin Atlantic Airways chauffeur driven car service;
8. Exh. "H" - duplicate original copy of examples of in-flight catalogues provided on Virgin Atlantic Airways flights, showing that over time many goods bearing the Virgin Marks have been made available to customers;
9. Exh. "I" - duplicate original copy of examples of Virgin travel packs provided to customers;
10. Exh. "J" - duplicate original copy of examples of in-flight magazines showing details of the flight entertainment activities;
11. Exh. "K" - duplicate original copy of extracts from [www.virgin-atlantic.com](http://www.virgin-atlantic.com) showing further details about Virgin Atlantic Airways;
12. Exh. "L" - duplicate original copy of examples of activities of Virgin Galactic, a company established by Virgin Group to become the world's first commercial space tourism operator;
13. Exh. "M" - duplicate original copy of a Virgin Holiday fact sheet together with extracts taken from the website at [www.virginholidays.com](http://www.virginholidays.com) providing details of the range of holiday destinations available; as well as copies of extracts from a small selection of holiday brochures;
14. Exh. "N" - duplicate original copy of materials showing use of the Virgin Trade Marks in relation to trains operated by virgin Trains, a company established by Virgin Group;
15. Exh. "O" - duplicate original copy of extracts from the website at [www.virginlimobike.co.uk](http://www.virginlimobike.co.uk), the website of Virgin Limobike, which is a motorcycle taxi service company established by Virgin Group to transport celebrities and business people around London and to and from airports quickly;
16. Exh. "P" - duplicate original copy of documents showing use of VIRGIN in the United Kingdom in relation to balloon flights;
17. Exh. "Q" - duplicate original copy of extracts from the website [www.virginexpress.com](http://www.virginexpress.com), which is the website of the Virgin Express, a low cost airline carrier acquired by Virgin Group;
18. Exh. "R" - duplicate original copy examples of use of the Virgin Trade Marks in relation to mobile phones;
19. Exh. "S" - duplicate original copy of the information of the Best Media Owner Award and the Webby Award for Radio won by Virgin Radio, a company established by Virgin Group;
20. Exh. "T" - duplicate original copy of the information showing use of the Virgin Trade Marks in relation to radio services;
21. Exh. "U" - duplicate original copy of examples of the Vfestivals held around the world and sponsored by Virgin Group companies;



22. Exh. "V" - duplicate original copy of examples of use of the Virgin Trade Marks in relation to financial services;
23. Exh. "W" - duplicate original copy of general information about Virgin Active, a fitness and health club business established by Virgin Group;
24. Exh. "X" - duplicate original copy of examples of the range of clothing and accessories sold under the Virgin Marks as well as screen shots from the TLC Sport website, where such products are available online;
25. Exh. "Y" - duplicate original copy of the extracts from the Virgin Games website ([www.virgingames.com](http://www.virgingames.com));
26. Exh. "Z" - duplicate original copy of extracts from Virgin catalogues of Virgin Books, which uses the Virgin Name and Virgin Signature and Virgin Signature under license from VEL;
27. Exh. "AA" - duplicate original copy of extracts from the Virgin Comics website at [www.virgincomics.com](http://www.virgincomics.com), which was the creative collaboration of writer Deepak Chopra, film maker Shekhar Kapur, and the Virgin Group;
28. Exh. "BB" - duplicate original copy of extracts from the Virgin Drinks website at [www.virgindrinks.com](http://www.virgindrinks.com);
29. Exh. "CC" - duplicate original copy of materials showing use of the Virgin Marks for both alcoholic and soft drinks;
30. Exh. "DD" - duplicate original copy of materials showing use of the Virgin Trade Marks for bridal wear and related goods and services;
31. Exh. "EE" - duplicate original copy of details of a range of clothing under the trade mark Virgin Ware that includes loungewear, nightwear, swimwear, T shirts, jerseys, jeans and trousers;
32. Exh. "FF" - duplicate original copy of extracts from the figleaves.com website showing sales of VIRGIN products;
33. Exh. "GG" - duplicate original copy of extracts from the Virgin Cosmetics website at [virgincosmetics.com](http://virgincosmetics.com);
34. Exh. "HH" - duplicate original copy of the Virgin VIE catalogues for the years 1999 and 2005, which include many cosmetics and healthy and beauty products as well as beauty services, makeup bags and wash bags;
35. Exh. "II" - duplicate original copy of printouts from the Virgin cosmetics website along with copy of a catalogue, both illustrate the products offered by The Virgin Jewellery Company, a member of the Virgin Group;
36. Exh. "JJ" - duplicate original copy of a list of Virgin Cinemas as at 4<sup>th</sup> December 1998;
37. Exh. "KK" - duplicate original of extracts from the Virgin Unite website at [www.virginunite.com](http://www.virginunite.com);
38. Exh. "LL" - duplicate original extracts from the Virgin Green Fund website at [www.virvingreenfund.com](http://www.virvingreenfund.com) and further information regarding Virgin Green Fund (formerly "Virgin Fuels", which is a member of the Virgin Group that invests in renewable energy such as hydro, solar, wind, bio fuel, bio mass, fuel cells and geothermal energy;
39. Exh. "MM" - duplicate original copy of examples of articles of published relating to the Virgin Earth Challenge, which was launched by the Virgin Group to offer a price of \$25m for whoever can demonstrate to the judges' satisfaction a commercially viable design which results in the removal of anthropogenic, atmospheric greenhouse gases so as to contribute materially to the stability of Earth's climate;
40. Exh. "NN" - duplicate original copy of extracts from the Virgin Earth Challenge

- website [www.virginearth.com](http://www.virginearth.com);
41. Exh. "OO" - duplicate original copy of extracts from the website of Virgin Energy, which was launched by the Virgin Group to provide energy in the United Kingdom for domestic use;
  42. Exh. "PP" - duplicate original copy of examples of some press releases dating back February 2008 that illustrate the high profile nature of the Carbon War Room, including its discussion at the start of the UN debate on climate change, that was founded by Virgin Group's Chairman, Sir Richard Branson, along with other successful entrepreneurs, business leaders, policy experts, researchers, and thought leaders to focus on market-driven solutions to climate change;
  43. Exh. "QQ" - duplicate original copy of the first issue (May 2011) of Carbon War Room's publication 'Creating Climate Wealth' ("CCW), which features Sir Richard Branson on the front cover and a feature interview with him inside;
  44. Exh. "RR" - duplicate original copy of extracts from the Carbon War Room website at [www.carbonwarroom.com](http://www.carbonwarroom.com);
  45. Exh. "SS" - duplicate original copies of a variety of press articles which illustrate the Virgin Group's commitment to activities in the renewable sustainable energy sectors;
  46. Exh. "TT" - duplicate original copy of an advertisement for a forum on Global Sustainability, at which Sir Richard Branson, Virgin Group's Chairman, spoke alongside Arnold Schwarzenegger and Bill Clinton;
  47. Exh. "UU" - duplicate original copy of examples showing how various businesses in the Virgin Group, such as Virgin Atlantic, are committed to assisting with environmental issues. Carbon offsetting is discussed prominently on Virgin Atlantic's website;
  48. Exh. "VV" - duplicate original copy of Virgin Group's report on corporate responsibility and sustainable development;
  49. Exh. "WW" - duplicate original copy of specimens of articles in newspapers, magazines and other periodicals containing advertisements for goods and services provided by reference to the Virgin Marks;
  50. Exh. "XX" - duplicate original copy of a list of the celebrities who were accepted to run in the 2011 London marathon sponsored by Virgin Group;
  51. Exh. "YY" - duplicate original copy of a screen print from the music video of "Telephone", a top hit in the UK as well as numerous other countries by Lady Gaga and Beyonce, showing Lady Gaga holding the Virgin Mobile telephone;
  52. Exh. "ZZ" - duplicate original copy of pre-festival advertisement of the "Ideas for Sustainable Living" festival sponsored by Virgin Money, a member of Virgin Group;
  53. Exh. "AAA" - duplicate original copy of double page spread found in the Superbrands Annual 2010 together with listings from both Business Superbrands and Consumer Superbrands and an extract from the website [superbrands.uk.com/virgin](http://superbrands.uk.com/virgin);
  54. Exh. "BBB" - duplicate original copy of the official results for 2010/2011 Coolbrand surveys showing that Virgin Atlantic were Coolbrand category winners for "Travel-General";
  55. Exh. "CCC" - duplicate original copy of a marketing awareness survey conducted by HPI in 2009 which found that VIRGIN was the number 1 most admired brand in the UNK and the number 4 most respected brand in the UK;
  56. Exh. "DDD" - duplicate original copy of the results of survey conducted by Reputation Institute, which measures over 200 of the UK's biggest and most



- visible organizations as part of its global "Rep Trak" reputation study, showing the Virgin Group ranked at 14<sup>th</sup>;
57. Exh. "EEE" - duplicate original copies of various press releases and articles referring to Sir Richard Branson and the Virgin Group showing that Virgin brand has become a household name;
  58. Exh. "FFF" - duplicate original copy of a list of examples of current and historical uses of the Virgin Name with additional words or elements;
  59. Exh. "GGG" - duplicate original copies of decisions favorable to VEL in cases filed opposing the registration of VIRGIN BATHROOM CONCEPT on the Community Trade Marks Register, as well as VIRGIN OIL on the UK Trade Marks Register;
  60. Exh. "HHH" - copy of Philippine Reg. No. 41995102674 for the mark "VIRGIN", filed on 31 May 1995 and registered on 21 Oct. 2002 under Classes 17 and 33;
  61. Exh. "III" - copy of Philippine Reg. No. 42000005332 for the mark "VIRGIN", filed on 28 June 2000 and registered on 14 Dec. 2003, under Class 38;
  62. Exh. "JJJ" - copy of Philippine Reg. No. 42000006935 for the mark "VIRGIN", filed on 21 Sept. 2000 and registered on 18 Jan. 2004, under Class 09;
  63. Exh. "KKK" - copy of Philippine Reg. No. 42000008016 for the mark "VIRGIN", filed on 21 Sept. 2000 and registered on 11 Mar. 2004, under Class 32;
  64. Exh. "LLL" - copy of Philippine Reg. No. 42010013133 for the mark "VIRGIN", filed on 03 Dec. 2010 and registered on 12 May 2011, under Classes 04, 39 and 40;
  65. Exh. "MMM" - copy of Philippine Reg. No. 42011002233 for the mark "VIRGIN", filed on 01 Mar. 2011 and registered on 18 Aug. 2011 under Class 33;
  66. Exh. "NNN" - copy of Philippine Reg. No. 41995102673 for the mark "VIRGIN SIGNATURE", filed on 31 May 1995 and registered on 23 July 2001, under Class 33;
  67. Exh. "OOO" - copy of Philippine Reg. No. 42000008015 issued by 21 September 2000 and registered on 01 Oct. 2005 under Class 32;
  68. Exh. "PPP" - copy of Philippine Reg. No. 42010013132 for the mark "VIRGIN SIGNATURE", filed on 03 Dec. 2010 and registered on 14 Apr. 2011 under Classes 04, 39 and 40;
  69. Exh. "QQQ" - copy of Philippine Reg. No. 42006002764 for the mark "VIRGIN MOBILE", filed on 10 Sept. 1997 and registered on 14 Dec. 2003 under Class 03;
  70. Exh. "RRR" - copy of Philippine Reg. No. 41997124590 for the mark "VIRGIN VIE", filed on 10 Sept. 1997 and registered on 14 Dec. 2003, under Class 03; and
  71. Exh. "SSS" - authenticated Affidavit, dated 13 Jan. 2012, of Victoria Wisener, Trademark Attorney of VEL, attesting to the truthfulness and correctness of the facts contained in her Affidavit, which includes the Exhibits attached thereto, based on her personal knowledge and/or authentic records.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 06 February 2012. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the mark "HOME OF THE VIRGIN CARS" in its favor?

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 the sale of an inferior and different article as his product<sup>4</sup>. Thus, Sec. 123.1 (d) of the 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, mark as to be likely to deceive or cause confusion.

The record and submitted evidence shows that, at the time the Respondent-Applicant filed its trademark application on 17 December 2010, the Opposer already has existing trademark applications and/or registrations for the mark "VIRGIN" and variations thereof. Two of these applications or registrations cover, among other things, the services "*transportation of energy and fuels*", "*transportation of people and goods*" and "*travel arrangements*" all under Class 39, to wit:

1. Application/Reg. No. 4-2010-013132, filed on 03 Dec. 2010 (registration issued on 14 April 2011); and
2. Application/Reg. No. 4-2010-013133, filed on 03 Dec. 2010 (registration issued on 12 May 2011).

Also, the Trademark Registry, the contents of which this Bureau can take judicial notice of, yields the information that there are three trademark applications/registrations for the mark "VIRGIN" or variations thereof and for use on the services mentioned above, in the name of the Opposer, to wit:

1. Application/Reg. No. 4-2007-005386, filed on 28 May 2007 (registration issued on 22 Oct. 2007);
2. Application/Reg. No. 4-2007-005387, filed on 28 May 2007 (registration issued on 22 Oct. 2007); and
3. Application/Reg. No. 4-2010-013131, filed on 03 Dec. 2010 (registration issued on 14 April 2011);

In this regard, the Respondent-Applicant indicated in trademark application that the mark HOME OF THE VIRGIN CARS is for use on "transport services" under Class 39. The mark is described as "*pertaining to brand new vehicles sold and released xxx which has the least mileage as compared to other dealers because the vehicles purchased from the plant are transported via carriers thus incurring zero mileage on the new vehicles. The customers then shall enjoy the privilege of having the first drive.*" The mark therefore is used not as a brand/trademark for goods (i.e. cars) but for services, specifically, transporting a newly purchased car. This is confirmed by the Declaration of Actual Use filed by the Respondent-Applicant on 20 September 2011 stating, among other things, that the contested mark is for

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<sup>4</sup> Prabhudas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

"transport services" and is being used in the Philippines for "car/vehicle carriers".<sup>5</sup>

Succinctly, the services indicated by the Respondent-Applicant in its trademark application is similar to the services covered by the above-cited trademark registrations already in the name of the Opposer.

The marks, shown below, are practically identical:

**VIRGIN**

*Opposer's mark*

Home of the  
**Virgin**  
Cars

*Respondent-Applicant's mark*


The words "home", "of", "the" and "cars" accompanying the word "VIRGIN" in the mark applied for registration by the Respondent-Applicant failed to confer sufficient visual and aural properties for one to be able to distinguish one mark from the other, taking into account that both marks are used or for use on similar services.

This Bureau therefore finds that the subject trademark application is proscribed by Sec. 123.1(d) of the IP Code.

WHEREFORE, premises considered, the opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2010-013742 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 03 March 2014.

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

<sup>5</sup> See filewrapper of Trademark Application Serial No. 4-2010-013742.