





**THE SCOTCH WHISKY  
ASSOCIATION,**

*Opposer,*

-versus-

**BRAINTREE TRI-MEDIA CORPORATION,**  
*Respondent-Applicant.*

**IPC NO. 14-2012-00282**

Opposition to:

Appln. Ser. No. 4-2011-012923  
(Filing Date: 26 October 2011)

Trademark: "**HIGHLAND LIGHT**"

Decision No. 2014- 201

## DECISION

**THE SCOTCH WHISKY ASSOCIATION** ("Opposer")<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2011-012923. The application, filed by **BRAINTREE TRI-MEDIA CORPORATION** ("Respondent-Applicant")<sup>2</sup>, covers the mark "**HIGHLAND LIGHT**", for use on "*wines, liquor, alcoholic beverages*" under Class 33 of the International Classification of Goods<sup>3</sup>. The Opposer alleges the following:

"1. The Scotch Whisky Association (hereafter 'TSWA'), is the trade association for the Scotch Whisky Industry. Its principal objectives are the protection and promotion of the Scotch Whisky trade throughout the world. TSWA has its registered office at 20 Atholl Crescent, Edinburgh, EH3 8HF. It was incorporated as a company limited by guarantee in 1960 at which time it took over the function of the formerly unincorporated Association known as the 'Scotch Whisky Association', which has been in existence since 1942. Attached as Exhibit 'A' is a copy of its current Memorandum and Articles of Association. x x x

"2. TSWA does not itself trade but its members sell their Scotch Whiskies throughout the world, including the Philippines, under such well known marks as JOHNNIE WALKER, CHIVAS REGAL, BALLANTINES, J&B and THE MACALLAN. Although TSWA itself is not doing business in the Philippines, pursuant to Rule 2, Section 4 of the Rules and Regulations, it may bring this petition for opposition. xxx

TSWA is domiciled in Edinburgh, a city on Scotland. In turn, Scotland is a constituent nation of the United Kingdom, which is a signatory to the Paris and Berne Conventions and a member of both the World Intellectual Property Organization ('WIPO') and the World Trade Organization ('WTO'). The Philippines is likewise a signatory to the aforesaid treaties and a member of WIPO and WTO.

<sup>1</sup> An Association registered in Scotland with address at 20 Atholl Crescent, Edinburgh, EH3 8HF

<sup>2</sup> A Philippine corporation with address at Penthouse Solar Century Tower No. 100 Tordesillas Cor. H.V. Dela Costa Streets, Salcedo Village, Makati City

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

"4. 'Scotch Whisky' is whisky wholly distilled and matured in Scotland in accordance with United Kingdom legislation. It is the largest selling whisky in the world and also the largest imported whisky in the Philippines. Attached as Exhibit 'B' is the pertinent excerpt of the International Wine and Spirit Record report on the alcoholic beverage market in the Philippines dated May 2010, showing the prominence of 'Scotch Whisky' in the Philippines.

"5. Whisky has been produced in Scotland for hundred of years. The oldest historical record of its production dates back to 1494. Over the years 'Scotch Whisky' has acquired a great reputation throughout the world and due to the long and strong presence of 'Scotch Whisky' in the market, whisky drinkers are likely to associate whisky with Scotland before any other country.

"6. Scotch Whisky has been defined in UK law since 1933. The current definition is contained in the Scotch Whisky Regulations 2009. Those Regulations contain other provisions including the protection of regions and localities of Scotland specifically associated with the production of Scotch Whisky, including the Highland region.

"7. The applicant is seeking to register the mark 'Highland Light' for 'wine, liquor and alcoholic beverages'. This specification includes, *inter alia*, whiskies produced outside of Scotland, e.g. in the Philippines, and whisky-based liquers which may contain alcoholic constituents other than Scotch Whisky and which may also have been produced outside of Scotland.

"8. Highland is region of Scotland which is particularly associated with the production of Scotch Whisky. Attached hereto as Exhibit 'B' is a map of Scotland printed for TWSA showing the location of Scotch Whisky distilleries. The map distinguishes between malt and grain Scotch Whisky distilleries and identifies the different regions in which those distilleries are located. Given that Speyside is a subset of the Highlands, it can be seen that eighty seven (87) of the one hundred eight (108) distilleries referred to on the map are located in the Highlands of Scotland.

"9. The classification of Scotch Whiskies into particular regions has been recognized for centuries. The 1909 Royal Commission on Whisky and other Potable Spirits identified five (5) distinct groups of Scotch Whisky in the recognized custom of the trade at that time, to wit: (1) Highland malts (2) Lowland Malts (3) Campbeltowns (4) Islays and (5) Grains. Details of the regional classification can also be found in books by renowned whisky writers, Michael Jackson and Charles McLean. Attached hereto as Exhibit 'D' is a copy of an excerpt from the book 'The World Guide to Whisky' by Michael Jackson, and attached as Exhibit 'E' is an excerpt from the book 'Malt Whisky' by Charles Maclean.

"10. The longstanding significance of the Highlands in relation to Scotch Whisky can also be seen from a picture of an old Scotch Whisky Label for 'The Glen Graham', attached hereto as Exhibit 'F', which is described as 'Old Highland Whisky' to signify its origin in the Highlands of Scotland. Over the years the labels of Scotch Whiskies distilled in the Highlands have used descriptions such as 'Highland Malt Scotch Whisky' to identify their place of distillation. Examples of such labels are attached hereto as Exhibit 'G-series'.

"11. Further, the significance of the Highlands as a famous area of Scotland and one specifically associated with the production of Scotch Whisky, is reflected in the use of word 'Highland' in the brand names of many Scotch Whiskies, including Highland

park, Highland Queen and Teacher's Highland cream. Sample labels are attached as Exhibit 'H-series'.

"12. In the light of the significance and reputation of the Highland region of Scotland regarding the production of Scotch Whisky, it was afforded specific provision as a region geographical indication in the Scotch Whiskey Regulations 2009, as referred to in paragraph 6 above.

"13. Republic Act No. 8293, otherwise known as the Intellectual Property Code (hereafter 'IP Code'), provides:

'Sec. 123. Registrability- 123.1 A mark cannot be registered if it:

xxx

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

xxx

"14. The use of the trademark 'Highland Light' under Application No. 42011012923, on any whisky, is likely to suggest that the product is Scotch Whisky, because of the reputation of Scotch Whisky. The applicant is located in the Philippines and the use of the protected Scottish regional name, 'Highland', on Whisky produced in the Philippines is likely to mislead the public into believing that it is a Scotch whisky, and indeed, one that has been distilled in the Highlands of Scotland in particular. The public is likely to be similarly misled by the use of the mark on whisky based liqueur unless all the alcoholic content of the product is Highland Scotch Whisky and the liqueur has been produced in Scotland.

"15. TSWA thus opposes the registration of 'Highland Lite' as a trademark.

"16. TSWA has taken objection to, and achieved a considerable success in preventing the registration in many countries worldwide, of trademarks for whisky products, which include 'Highland' as a component. For example, attached as Exhibit 'I-series' are copies of three undertakings relating to applications to register such marks in South Africa and Australia, which undertakings recognize the Scottish geographical indication, 'Highland'.

"16.1 As a further example, in India, the Division Bench of the Delhi High Court refused an application to register the mark 'Highland Chief' by Mohan Meakin Breweries, stating:

'It is plain that the description "Scotch Whisky" relates solely to a geographical region for the product. The "Highlands" is a region in Scotland most famous for Scotch Whisky, is synonymous with Scotch Whisky and is used as a part of the label for whisky. This being so, it is likely that the public would understand the word "Highland", used as part of the brand name for whisky, to be a Scotch Whisky, i.e. one produced in Scotland.'

The court went on to state:

'In these circumstances, once it is conceded that the words "HIGHLAND CHIEF" used in relation to whisky are synonymous with Scotch Whisky, anyone using the word "Highland" as part of a brand name for whisky would thereby denote that the

Whisky is Scotch Whisky. The public would understand seeing the word "Highland" used for whisky that whisky was produced in Scotland.'

Attached as Exhibit 'J' is a copy of the judgment in the said case.

"17. The Philippines is a signatory to the WTO Agreement of Trade-Related Aspects of Intellectual Property Rights ('TRIPS'), which provides, inter alia, protection of Geographic Indications. Article 22.1 thereof, states:

'Geographic indications are, for the purposes of the Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin'.

Scotland has a pre-eminent reputation for the production of whisky. The use of the name of a Scottish region on a whisky is an indication which identifies the whisky as having been produced in Scotland. As discussed above, 'Highland' is a Scottish region with eighty-seven (87) Scotch whisky distilleries. 'Highland' is a geographical indication as defined in the said Article 22.1 and its use on whisky which is not of Scottish origin, and, indeed, not from the Highlands of Scotland would be contrary to Article 22 and 23 of the said TRIPS agreement.

"18. Overall, the registration of the name of a Scottish region, namely 'Highland', as a trademark, is likely to mislead the public into believing that the whisky on which it is used is of Scottish origin. Scotland, and in particular the Highlands of Scotland, are known worldwide for whisky production. Through TSWA, Scotch Whisky producers have endeavored, and are entitled, to protect their reputation as quality whisky producers. For this, and the reasons cited above, the subject trademark application for 'Highland Light' should be refused registration.

19. In support of this Opposition, Petitioner additionally submits the affidavit of Kenneth Murray Cobb Gray, attached hereto as Exhibit 'K'."

This Bureau served upon the Respondent-Applicant a Notice to Answer on 24 September 2012. The Respondent-Applicant, however, did not file an Answer.

It must be 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.<sup>4</sup>

In this regard, the Opposer anchors its opposition on Sec. 123.1(g) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), which proscribes registration if the mark misleads the public, particularly as to the nature, quality, characteristics or geographic origin of the goods or services.

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<sup>4</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

But is the mark HIGHLAND LIGHT misleads the public as to the nature, quality, characteristics or geographic origin of the Respondent-Applicant's whisky?

The Opposer established that the term "Highland" is associated with Scotland, to wit:

"7. The applicant is seeking to register the mark 'Highland Light' for 'wine, liquor and alcoholic beverages'. This specification includes, *inter alia*, whiskies produced outside of Scotland, e.g. in the Philippines, and whisky-based liquers which may contain alcoholic constituents other than Scotch Whisky and which may also have been produced outside of Scotland.

"8. Highland is region of Scotland which is particularly associated with the production of Scotch Whisky. Attached hereto as Exhibit 'B' is a map of Scotland printed for TWSA showing the location of Scotch Whisky distilleries. The map distinguishes between malt and grain Scotch Whisky distilleries and identifies the different regions in which those distilleries are located. Given that Speyside is a subset of the Highlands, it can be seen that eighty seven (87) of the one hundred eight (108) distilleries referred to on the map are located in the Highlands of Scotland.

"9. The classification of Scotch Whiskies into particular regions has been recognized for centuries. The 1909 Royal Commission on Whisky and other Potable Spirits identified five (5) distinct groups of Scotch Whisky in the recognized custom of the trade at that time, to wit: (1) Highland malts (2) Lowland Malts (3) Campbeltowns (4) Islays and (5) Grains. Details of the regional classification can also be found in books by renowned whisky writers, Michael Jackson and Charles McLean. Attached hereto as Exhibit 'D' is a copy of an excerpt from the book 'The World Guide to Whisky' by Michael Jackson, and attached as Exhibit 'E' is an excerpt from the book 'Malt Whisky' by Charles Maclean.

"10. The longstanding significance of the Highlands in relation to Scotch Whisky can also be seen from a picture of an old Scotch Whisky Label for 'The Glen Graham', attached hereto as Exhibit 'F', which is described as 'Old Highland Whisky' to signify its origin in the Highlands of Scotland. Over the years the labels of Scotch Whiskies distilled in the Highlands have used descriptions such as 'Highland Malt Scotch Whisky' to identify their place of distillation. Examples of such labels are attached hereto as Exhibit 'G-series'.

"11. Further, the significance of the Highlands as a famous area of Scotland and one specifically associated with the production of Scotch Whisky, is reflected in the use of word 'Highland' in the brand names of many Scotch Whiskies, including Highland park, Highland Queen and Teacher's Highland cream. Sample labels are attached as Exhibit 'H-series'.

"12. In the light of the significance and reputation of the Highland region of Scotland regarding the production of Scotch Whisky, it was afforded specific provision as a region geographical indication in the Scotch Whiskey Regulations 2009, as referred to in paragraph 6 above."<sup>5</sup>

Thus, the use by the Respondent-Applicant of the mark HIGHLAND LIGHT on wines, liquor, and alcoholic beverages – especially whisky – will mislead consumers

<sup>5</sup> Verified Notice of Opposition, pp. 4-6.

into thinking or assuming that the products originate from SCOTLAND and/or possess the nature, quality and characteristics of wine and liquor products coming from the said geographic location. This Bureau agrees with the Opposer's arguments:


"14. The use of the trademark 'Highland Light' under Application No. 42011012923, on any whisky, is likely to suggest that the product is Scotch Whisky, because of the reputation of Scotch Whisky. The applicant is located in the Philippines and the use of the protected Scottish regional name, 'Highland', on Whisky produced in the Philippines is likely to mislead the public into believing that it is a Scotch whisky, and indeed, one that has been distilled in the Highlands of Scotland in particular. The public is likely to be similarly misled by the use of the mark on whisky based liqueur unless all the alcoholic content of the product is Highland Scotch Whisky and the liqueur has been produced in Scotland."<sup>6</sup>

In Inter Partes Case No. 14-2012-00283 involving the same parties, this Bureau sustained the Opposer's (Scotch Whisky Association) opposition to the application for the registration of the mark "HIGHLAND LITE" filed by the Respondent-Applicant (Braintree Tri-Media Tree Corporation). As in the instant case, Inter Partes Case No. 14-2012-00283 involved the application of Sec. 123.1(g) of the IP Code. The decision (No. 2014-06), promulgated on 13 January 2014, became final and executory on 27 February 2014. This Bureau finds no cogent reason to deviate from the said decision.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2011-012923 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 08 August 2014.

  
Atty. **NATHANIEL S. AREVALO**  
Director IV, Bureau of Legal Affairs

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<sup>6</sup> Verified Notice of Opposition, pp. 6-7.