



**SUNDARAM-CLAYTON LIMITED,**  
Opposer,

**-versus-**

**GRANSTAR MOTORS & INDUSTRIAL  
CORPORATION,**  
Respondent-Applicant.

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**IPC No. 14-2010-00312**  
Opposition to:  
Appln. Serial No.4-2009-002652  
Date filed: 13 March 2009  
TM: **“GRANSTAR TVS  
STARBUSINESS 110”**

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**NOTICE OF DECISION**

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Counsel for the Respondent-Applicant  
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**GREETINGS:**

Please be informed that Decision No. 2015 - 102 dated May 20, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 20, 2015.

For the Director:

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



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Application No. 4-2009-002652  
Date Filed: 13 March 2009  
Trademark: "GRANSTAR TVS  
STARBUSINESS 110"

Decision No. 2015- 102

### DECISION

SUNDARAM-CLAYTON LIMITED<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-002652. The application, filed by GRANSTAR MOTORS & INDUSTRIAL CORPORATION<sup>2</sup> ("Respondent-Applicant"), covers the mark "GRANSTAR TVS STARBUSINESS 110" for use as "motor vehicles namely motorcycles and parts thereof" under Class 12 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x

#### "IV. GROUNDS

"Opposer relies on the following grounds to support its Opposition:

"4.1. Opposer is the true owner and rightful proprietor of the 'TVS' mark and its variants, which is used on various goods in Class 12, among others, and are manufactured and sold by, or at the instance of, the Opposer, who has caused its registrations in numerous countries.

"4.2. Opposer will suffer substantial and incalculable damage due to the use and registration of Respondent-Applicant's trademark TVS STARBUSINESS s it is confusingly similar with Opposer's 'TVS' mark and its variants considering that they all cover motorcycles under Class 12, which confusing similarity is further established by -

"a. A visual comparison of Respondent's TVS STARBUSINESS mark and Opposer's 'TVS' mark and its variants.

<sup>1</sup>A foreign corporation organized and existing under the laws of India with office address at Jayalakshmi Estates, No. 29 (Old No. 8), Haddows Road, Chennai 600 006, India.

<sup>2</sup>A domestic corporation with address at Unit 102 JTIC Building, 622 Shaw Boulevard, Mandaluyong City Philippines.

<sup>3</sup>The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"b. A phonetic and aural comparison of Respondent-Applicant's TVS STARBUSINESS mark and Opposer's 'TVS' mark and its variants.

"4.3. Opposer's 'TVS' mark and its variants are internationally and locally well-known. Opposer's marks are, therefore, entitled to protection under Sec. 123.1 (e) and (f) of the IP Code.

#### "V. DISCUSSION

x x x

"Opposer is the true owner and originator of the 'TVS' mark and its variants. The following historical and factual background gives light to the evolution of the 'TVS' mark and its variants as well as Opposer's ownership thereof:

"The Opposer, which commenced operations in 1962, is part of the \$4 billion TVS Group, one of the largest auto components manufacturing and distribution group in India. The TVS Group has over 30 companies employing a work-force of about 40,000 people.

"While the letters 'TVS' represent the initials of its founder, T V Sundaram Lyengar, to the TVS Group, 'TVS' has always stood for Trust, Value and Service. The founder of the company embodied these values and set an example for all employees to emulate.

"Among the TVS Group's businesses include automobile component manufacturing, components distribution manufacturing of powered two-wheelers (e.g., scooters and motorcycles), computer peripherals, financial services, contract manufacturing services and software development.

"The US\$ 4 billion TVS Group is the third largest two-wheeler manufacturer in India and one among the top ten in the world, with annual turnover of more than US\$ 1 billion in 2008-2009 alone. The TVS Group currently manufactures a wide range of two-wheelers from motorcycles, mopeds, scooters.

"As a testament to the TVS Group's worldwide presence, it has been awarded the 'Star Performer -Silver Shield' in two/three wheelers category, by EEPC India (set up in 1955 under the sponsorship of Ministry of Commerce & Industry Government of India for export promotion of engineering goods, projects and services) in 2010, for excellent export performance for year 2007-08.

"At least 168 marks in India, and 461 marks in over 50 countries, involving the letters 'TVS' have been registered and/or are pending registration. Some of these marks are:

x x x

"Clearly, based alone on the fact that Opposer is the prior user and legitimate owner of the 'TVS' mark and its variants, Opposer has the right to prevent Respondent-Applicant from the unlawful appropriation thereof.

x x x

"A comparison of Opposer's 'TVS' mark and its variants and Respondent-Applicant's TVS STARBUSINESS mark reveals an uncanny similarity between the conflicting marks due to the fact that the Respondent-Applicant's mark appropriates the dominant elements of the Opposer's marks, i.e., the letters 'TVS', leading to the likelihood of confusion among the buying public as to the owner of the 'TVS' brand and the source of the product.

"In resolving the issue of confusing similarity, courts have resorted to the dominance test which focuses on the similarity of the prevalent, essential, or dominant features of the competing marks. In the instant case, the dominant features of Opposer's mark is the letters 'TVS'. Respondent-Applicant conveniently copied this element and made it the dominant element of its TVS STARBUSINESS mark.

"While Respondent-Applicant's mark contains other elements apart from the letters 'TVS', they are not the dominant portion of Respondent-Applicant's mark, hence, do not sufficiently distinguish them from Opposer's 'TVS' mark and its variants. It is a well-settled doctrine that non-essential differences in contending marks do not negate the likelihood of confusion. In fact, the Supreme Court has recognized that infringers usually include differences in their mark so as to give a semblance of dissimilarity. The Supreme Court thus stated in *Del Monte Corp., et. al. v. CA, et. al.*

"As previously stated, the person who infringes a trade mark does not normally copy out but only makes colorable changes, employing enough points of similarity to confuse the public with enough points of differences to confuse the courts..."

"Further, it must be remembered that the letters 'TVS' is a coined or fanciful term. It is thus highly suspect for Respondent-Applicant to copy such term, with the inclusion of minute differences from Opposer's mark, and use the said mark on the same goods as that of the Opposer's, i.e., motorcycles under Class 12. In view of such undeniable fact, the following words of the Supreme Court are most enlightening:

"What is undeniable is the fact that when a manufacturer prepares to package his product, he has before him a boundless choice of words, phrases, colors and symbols sufficient to distinguish his product from the others. When as in this case, Sunshine chose, without a reasonable explanation, to use the same colors and letters as those used by Del Monte though the field of its selection was so broad, the inevitable conclusion is that it was done deliberately to deceive."

"In light of Opposer's worldwide presence, it is really inconceivable how Respondent-Applicant would independently come up with the mark 'TVS' for motorcycles if not for their intent to ride upon the goodwill established by the Opposer. Notably, Respondent-Applicant uses the 'STAR' element of Opposer's 'TVS STAR' marks (4-2006-005763 and 4-2008-000257).

x x x

"Apart from visual similarity, the Supreme Court, as in the case of *Marvex Commercial Co. Inc. v. Petra Hawpia & Co.*, also uses the idem sonans test in determining the presence of likelihood of confusion. In this case the contending marks are both bi-syllabic words, both start with the sound 'BI' (as in 'bee' in the English language) and ending with the sound 'LAKS' (as in 'tax' in the English language). Evidently, the likelihood of confusion is great as both have strikingly identical pronunciation.



"In the instant case, considering that Respondent-Applicant's and Opposer's marks contain the letters 'TVS', there should be no doubt that they are identically pronounced.

"Considering the foregoing, plus the fact that the contending marks not only cover goods that are under the same Class, i.e., Class 12, but also identical goods, i.e., motorcycles, the following Supreme Court pronouncement finds clear application in the instant case:

x x x

"Thus, considering that the Respondent-Applicant's mark is identical to Opposer's 'TVS' mark and its variants, and covers identical goods, Respondent-Applicant's Application No. 4-2009-002652 should not be allowed to proceed to registration pursuant to Section 123.1 (d) of the IP Code. Otherwise, Opposer would suffer immense and incalculable damage brought about by the likelihood of confusion, including the dilution of its 'TVS' mark.

x x x

"Section 123.1 (e) and (f) of the IP Code expressly prohibits the registration of a mark which is identical with or confusingly similar to a well-known trademark.

"Opposer, through its TVS Group, is the third largest two-wheeler manufacturer in India and one among the top ten in the world. As a testament to its worldwide presence, it has gone out of India and has set up a manufacturing plant in Indonesia. In 2010, it was awarded the 'Star Performer- Silver Shield in two/three wheelers category by EEPC India (set up in 1955 under the sponsorship of Ministry of Commerce & Industry, Gov't of India for export promotion of engineering goods, projects and services) for excellent export performance.

"The TVS Group has also ventured into motorcycle racing and has its own TVS Racing team.

"Opposer, through its TVS Group, also become the world's first two wheeler company to win the world's most prestigious recognition in Total Quality Management- the Deming Award 2002. The TVS Group further won the TPM Excellence Award from Japan Institute of Plant Management in 2004.

"Apart therefrom, Opposer has registered or has sought the registration of the 'TVS' mark and its variants in at least 54 countries for at least 461 number of marks; 168 marks in India, and 10 marks in the Philippines.

"Opposer and the TVS Group, through TVS Motor Company Limited, Chennai, have also extensively advertised the TVS Motorcycles worldwide. Among the advertisement expenditures and sales are as follows:

x x x

"Attached are some of the various advertisements used for the TVS Motorcycles.

"Clearly, therefore, Opposer's and the TVS Group's 'TVS' mark and its variants are well-known and are entitled to protection, including the disallowance of the registration of the Respondent-Applicant's mark.

The Opposer's evidence consists of print-out of Respondent-Applicant's application; representative photographs of the TVS Group's two-wheeled vehicles over the past decades; print-outs of the trademark details of Opposer's marks taken from IPOPHL's automated database; print-out of <http://www.tvsmotor.in/milestones.asp> which shows the Indonesian plant; print-out of TVS' Group's Racing Team website, <http://www.tvsmotor.in/racing.asp>; print-out of the TVS Group's website, <http://www.tvsmotor.in/milestones.asp>; print-out of the TVS Group's website, <http://www.tvsmotor.in/milestones.asp>; photographs of some of the TVS Motorcycles advertisements.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 13 May 2011. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark GRANSTAR TVS STARBUSINESS 110?

The Opposer anchors its opposition on Sections 123.1, paragraphs (d), (e) and (f) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

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

x x x

- (d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of :
  - (i) The same goods or services, or
  - (ii) Closely related goods or services, or
  - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;"
- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

<sup>4</sup>Marked as Exhibits "A" to "H", inclusive.

- (f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided further*, That the interests of the owner of the registered mark are likely to be damaged by such use;

Records show that at the time the Respondent-Applicant filed its trademark application on 13 March 2009, the Opposer already owns trademark registration nos. 42008000776, 42008000775, 42008000777, 42008000257, 42008000255, 42008000256, 42008007457 and 42006005763 for use on motorized vehicles, power two-wheelers namely, motorcycles, scooters, mopeds, and parts thereof and fittings therefore, namely, engines, fuel tanks, side panels, front and rear mudguards, head lamp housing, and side tail covers. It must be emphasized, however, that the protection to a trademark under the afore-quoted provisions hinges on a factual finding of the existence of confusing similarity between the trademark sought to be protected, and the other trademark.

But, does GRANSTAR TVS STARBUSINESS 110 resemble TVS mark and its variants such that confusion or deception is likely to occur? The marks are shown below:

**TVS**

Opposer's trademark

GRANSTAR  
TVS STARBUSINESS 110

Respondent-Applicant's mark

In this regard, what draws the eyes and the ears with respect to the Respondent-Applicant's mark is the word "TVS". "TVS" is the prominent, in fact, the definitive feature of the Opposer's trademarks TVS NEO (STYLIZED WORD), TVS GEN-I INTELLIGENT GENERATION BIKE (STYLIZED WORD & DEVICE), TVS NEO GEN-I INTELLIGENT GENERATION BIKE (STYLIZED WORD AND DEVICE), TVS STAR SPORT & DEVICE, TVS APACHE (STYLIZED WORD), TVS APACHE RTR 160 (STYLIZED WORD), TVS FLAME (STYLIZED), TVS STAR (STYLIZED) covered Trademark Registration Nos. 42008000776, 42008000775, 42008000777, 42008000257, 42008000255, 42008000256, 42008007457 and 42006005763. Trademark Application Serial No. 4-2009-002652 covers "motor vehicles namely motorcycles and parts thereof"

under Class 12, product or goods which the Opposer deals in under the TVS mark and its variants under Trademark Reg. Nos. 42008000776, 42008000775, 42008000777, 42008000257, 42008000255, 42008000256, 42008007457 and 42006005763 for use on "motorized vehicles, power two-wheelers namely, motorcycles, scooters, mopeds, and parts thereof and fittings therefore, namely, engines, fuel tanks, side panels, front and rear mudguards, head lamp housing, and side tail covers" (Class 12). Moreover, the Opposer has two registered marks with a combination of the words "TVS" and "STAR". The mark applied for registration by the Respondent-Applicant contains not only one, but two "STAR" words. It is likely therefore, that a consumer who wishes to buy motorcycles and is confronted with the mark GRANSTAR TVS STARBUSINESS 110, will think or assume that the mark or brand is just a variation of or is affiliated with the Opposer's TVS mark and its variants.

The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

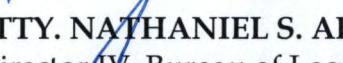
Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.<sup>5</sup>

Accordingly, this Bureau finds that the registration of GRANSTAR TVS STARBUSINESS 110 for motor vehicles namely motorcycles and parts thereof under Class 12 is proscribed by Sec. 123.1, par. (d) (iii) of the IP Code.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2009-002652 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, 20 May 2015.

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

<sup>5</sup> *Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.