



SAN MIGUEL BREWERY INC. and ICONIC BEVERAGES, INC.,	}	IPC No. 14-2013-00106
Opposers,	}	Opposition to:
	}	Appln. Serial No. 4-2012-502674
-versus-	}	Date Filed: 11 October 2012
	}	TM: "DARK HORSE & DEVICE"
	}	
	}	
E. & J. GALLO WINERY,	}	
Respondent-Applicant.	}	
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NOTICE OF DECISION

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**ORTEGA DEL CASTILLO BACORRO
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GREETINGS:

Please be informed that Decision No. 2015 - 177 dated September 08, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 08, 2015.

For the Director:

MARILYN S. RETUAL
 IPRS IV, Bureau of Legal Affairs



SAN MIGUEL BREWERY INC. and ICONIC BEVERAGES, INC.,

Opposers,

-versus-

E. & J. GALLO WINERY,

Respondent-Applicant.

x ----- x

IPC No. 14-2013-00106

Opposition to Trademark

Application No. 4-2012-502674

Date Filed: 11 October 2012

Trademark: "**DARK HORSE & DEVICE**"

Decision No. 2015- 177

DECISION

San Miguel Brewery Inc. and Iconic Beverages, Inc.¹ ("Opposers") filed an opposition to Trademark Application Serial No. 4-2012-502674. The contested application, filed by E. & J. Gallo Winery² ("Respondent-Applicant"), covers the mark "DARK HORSE & DEVICE" for use on "*alcoholic beverages (except beers)*" under Class 33 of the International Classification of Goods³.

The Opposers allege, among others things, that the mark "DARK HORSE" is confusingly similar to their registered mark "RED HORSE" under Certificate of Registration No. 34038 issued on 13 February 1985 by the then Philippine Patent Office ("PPO"). They claim to have registered their other "RED HORSE" marks and derivatives thereof in the Philippines and abroad. According to the Opposers, the competing marks have aural, phonetic and visual similarities as well as commercial impressions despite the difference in font styles. They aver that "RED HORSE" is an arbitrary, if not fanciful, term in relation to alcoholic beverages and that the registration of "DARK HORSE" will indicate a false connection to their company

In support of its Opposition, the Opposers submitted the following:⁴

1. certified true copy of Trademark Application No. 4-2012-502675;
2. copy of the Respondent-Applicant's application as published in the E-Gazette;
3. judicial affidavit of Opposers' brand manager, Louise Anne A. Gomez, with annexes;
4. original printouts from the Intellectual Property Office Philippines (IPOP HL) website showing registration details of some of the trademarks of Ginebra San Miguel, Inc. under Class 33; and

¹ Both are domestic corporations with office address at No. 40 San Miguel Avenue, Mandaluyong City.

² A foreign company with business address at 600 Yosemite Boulevard, Modesto, California 95354, USA.

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.

⁴ Marked as Exhibit "D" to "S", inclusive.

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5. printout from the website www.gallo.com showing the product list.

The Respondent-Applicant filed its Answer on 27 August 2013 alleging, among others, that it has over twenty-three applications and registrations for the mark "DARK HORSE". It claims to have first used the mark in the United States of America (USA) on or around 30 November 2004 and have sold the same in various outlets worldwide. It insists that it likewise exerted effort to advertise and promote its mark. It denies that the competing marks have the same visual and aural impressions as they differ in their first words, number of letters, presentation and connotation. It believes that there can be no confusion because purchasers of alcoholic beverages look for and know exactly what brand to buy. According to the Respondent-Applicant, the word "HORSE" is common for alcoholic beverages, explaining that horse is an epitome of masculinity and strength, associated with the concept of "kick". It further states that there are other registered trademarks in Classes 32 and 33 that contain the word "HORSE".

The Respondent-Applicant's evidence consists of copy of the decision in the case between San Miguel Brewing International Limited and Molson Canada 2005 issued by the Federal Court of Ottawa, Ontario and the affidavit of the Respondent-Applicant's Vice President of International Finance, George Neveling, with annexes.⁵

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. On 22 November 2013, this Bureau's Alternative Dispute Resolution Services submitted a report that the parties refused to mediate. Accordingly, a Preliminary Conference was conducted on 05 February 2014. Upon termination thereof on the same day, the Hearing Officer directed the parties to submit their respective position papers. Both parties filed their position papers on 17 February 2014 and the case is then deemed submitted for resolution.

The issue to be resolved is whether the Respondent-Applicant's mark "DARK HORSE & DEVICE" should be registered.

Section 123.1 (d) of the 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:

- "(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; xxx"***

⁵ Marked as Exhibits "1", inclusive.

Records reveal that at the time the Respondent-Applicant filed an application for registration of the contested mark on 11 October 2012, the Opposer already has valid and existing registrations of its mark "RED HORSE" which were issued on 05 July 2005 and 18 March 2006, respectively, under Certificate of Registration Nos. 4-2002-007003 and 4-2004-009854. This is in addition to the other "RED HORSE" derivative marks such as "RED HORSE STALLION", "RED HORSE BEER PAMBANSANG MUZIKLABAN DESIGN", among others.

But are the competing marks, as shown hereafter, confusingly similar?

Opposers' marks include:

RED HORSE



**RED
HORSE
BEER**

Respondent-Applicant's mark:



The Opposers' marks are word marks. One such mark though includes a device consisting of a horseshoe and a head of a horse. On the other hand, the mark applied for registration by the Respondent-Applicant is a stylized figure of a head of a horse. In this regard, this Bureau finds that confusion, much less deception, is unlikely in this case. The eyes can easily distinguish the Respondent-Applicant's mark from the Opposer's.

Even in respect of aural and conceptual projection, confusion or mistake is remote. This is so because "RED HORSE" is used for a commodity or product which is not covered by the Respondent-Applicant's application. Corollarily, confusion of business is unlikely for the Opposers did not show evidence that they exclusively use the word and/or figure of a "HORSE". What will then identify whether the marks are confusing are the words and/or device surrounding the same. In fact, the Trademark Registry shows that there are other registered marks issued to other proprietors using the same word including "WHITE HORSE", "WHITE HORSE ON BLACK SQUARE

DEVICE", MARCELA FARMS INC. GOLDEN HORSE", "TALL HORSE" and "POWER HORSE" under Certificates of Registration Nos. 4-2009-008442, 063371, 4-2007-013775, 4-2013-500331 and 10882, respectively, all of which pertain to beverages.

Finally, it is 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.⁶

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-502674 is hereby **DISMISSED**. 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 September 2015.


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

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.