

JAPAN TOBACCO INC.,
Opposer,

-versus-

BRITISH AMERICAN TOBACCO
(BRANDS) LIMITED,
Respondent- Applicant.

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IPC No. 14-2014-00489
Opposition to:
Appln. Serial No. 4-2013-00013735
Date Filed: 15 November 2013
TM: "iCONTROL"

x-----x

NOTICE OF DECISION

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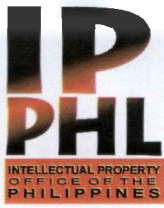
GREETINGS:

Please be informed that Decision No. 2016 - 48 dated February 17, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 17, 2016.

For the Director:

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



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Opposer,	}	Opposition to:
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-versus-	}	Application No. 4-2013-00013735
	}	Date Filed: 15 November 2013
BRITISH AMERICAN TOBACCO	}	
(BRANDS) LIMITED,	}	Trademark: iCONTROL
Respondent-Applicant.	}	
x-----x		Decision No. 2016 - <u>48</u>

DECISION

JAPAN TOBACCO INC.¹ (“Opposer”) filed a Verified Notice of Opposition to Trademark Application No. 4-2013-00013735. The contested application, filed by BRITISH AMERICAN TOBACCO (BRANDS) LIMITED² (“Respondent-Applicant”), covers the mark iCONTROL for use on “cigarettes, tobacco, tobacco products, lighters, matches, smoker’s articles” under Class 34 of the International Classification of goods³.

The Opposer alleges that:

“The mark iCONTROL is not registrable for being descriptive and non-distinctive.

“11. The application for the registration of iCONTROL should be denied considering the prior finding that the said mark is descriptive and non-distinctive.

“12. In fact, the Office for Harmonization in the Internal Market (“OHIM”) has already denied the application for a Community Trademark for the mark iCONTROL. x x x In the Notification of Refusal, the OHIM already ruled that the mark iCONTROL cannot be registered for being descriptive and non-distinctive:

“The trade mark you have applied for is not eligible for registration under Article 7(1) (b) and (c) and Article 7(2) CTMR.

x x x

The trade mark consists of the words iCONTROL with the following meaning(s):

- 1 A corporation duly organized and existing under and by virtue of the laws of Japan, with principal office address at 2-2-1 Toranomom, Minto-ku, Tokyo, Japan.
- 2 A corporation organized and existing under the laws of United Kingdom, with address at Globe House, 4 Temple Place, London WC2R 2PG, United Kingdom.
- 3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This 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.

Which: *'refers to the speaker or writer'*

CONTROL Which, amongst other things is defined as the: *'power to direct or determine'* and *'a means of regulation or restraint'*

The relevant consumer will understand the words iCONTROL as a meaningful expression, simply indicating that the consumer (here referred to as "I") will be endowed with either the power to direct or determine something, or a means of regulation or restraint.

1.) Descriptiveness

For the purpose of assessing descriptiveness, it must be determined whether the relevant public will make a sufficiently direct and specific association between the expression and the goods/services for which registration is sought (judgment of 20/07/2004, T-311/02, 'LIMO', paragraph 30).

The Tobacco goods applied for in class 34, are generally goods containing nicotine which is a substance that, when used regularly, causes addiction.

Taken as a whole, the words iCONTROL therefore immediately informs consumers without further reflection that the goods applied for, will enable the consumer to control a variety of parameters of the said goods.

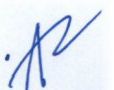
Therefore, the mark conveys obvious and direct information regarding the characteristics of the goods in question.

It follows that the link between the words iCONTROL and the goods referred to in the application for registration is sufficiently close for the sign to fall within the scope of the prohibition laid down by Article 7(1) (c) and Article 7(2) CTMR.

2.) Lack of distinctive character

x x x

Given that the mark has a clear descriptive meaning in relation to the goods applied for, the impact of the mark on the relevant public will be primarily descriptive in nature, thus eclipsing any impression that the mark could indicate a trade origin.



Consequently, taken as a whole, the mark applied for – iCONTROL – is devoid of any distinctive character and is not capable of distinguishing the goods for which registration is sought within the meaning of Article 7(1)(b) and Article 7(2) CTMR.

x x x”

“13. The OHIM therefore, objected to Respondent-Applicant's mark iCONTROL due to its particular meaning in respect of the goods of interest given the clear reference to the addition of the term “I” creating the pronoun of oneself, namely “I Control” which makes this mark descriptive and non-distinctive. Given that it has already been held that the mark iCONTROL cannot function as a trademark as it is descriptive and not distinctive, the same is not registrable under Section 123.1 (j) of the Intellectual Property Code of the Philippines (“IP Code”).

“14. Notably, a mark that consists exclusively of signs that are generic or designates the kind, quality or intended use of goods is not registrable under Sections 123.1 (h) and (j) of the IP Code. x x x

“15. It is submitted that iCONTROL falls under the proscription in Sections 123.1 (h) and (j) of the IP Code as the use of the words “I CONTROL” designate the act of controlling something by the user or consumer. To grant registration to the words “I CONTROL” to the Respondent-Applicant would unfairly preclude third parties from using the same generic or descriptive words in describing their goods or services, lest they be charged with trademark infringement. Surely, the Honorable Bureau will not allow the said situation. In fact, in *Asia Brewery, Inc. v. The Honorable Court of Appeals and San Miguel Corporation*, 224 SCRA 437 adopted the principle long followed in trademark law that: x x x

x x x

“17. The mark iCONTROL is generic and/or descriptive of goods under Class 34 given its connotation to the customer or buyer of the product that the control is in his own hands. This being the case, the words “I CONTROL” is not distinctive and cannot function as a trademark.

“18. Since the mark iCONTROL has already been found to be descriptive and non-distinctive by the OHIM, it necessarily follows that it is also not registrable under the IP Code.”

The Opposer's evidence consists of a copy of the pertinent page of the IPO e-Gazette showing the publication of the Respondent-Applicant's application on 07 October 2014⁴, a copy of the “Notice of Grounds for Refusal of Application for a Community Trade Mark” issued on 29 November 2013 by the OHIM⁵, original

4 Exhibit “A”.

5 Exhibit “B”.

authenticated Certificate executed by Alan Minto in favor of Opposer's counsel⁶.

This Bureau issued an Order dated 08 May 2015 granting the Opposer a final extension of thirty (30) days from 03 May 2015 or until 02 June 2015 within which to file the Verified Answer. The Respondent-Applicant, however, failed to file its Answer despite the extensions given. Thus, Order No. 2015-1104 was issued on 31 July 2015 declaring the Respondent-Applicant in default. Hence, this case is now deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark iCONTROL?

The Opposer anchored its opposition on Section 123.1 (h) and (j) of R. A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), which provides that:

Section 123. *Registrability.* 123.1. A mark cannot be registered if it: x x x

(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;

x x x

(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services; x x x

It is the Opposer's contention that the Respondent-Applicant's mark iCONTROL should be denied registration for being generic and/or descriptive of goods under Class 34 given its connotation to the buyer of the product that the control is in his own hands. Thus, it is essential to make an initial determination of what are generic and descriptive marks.

In the case of *Societe Des Produits Nestle, S. A. vs. Court of Appeals*⁷, the Supreme Court had the occasion to distinguish generic and descriptive marks, to wit:

"Generic terms are those which constitute "the common descriptive name of an article or substance," or comprise the "genus of which the particular product is a species," or are "commonly used as the name or description of a kind of goods," or "imply reference to every member of a genus and the exclusion of individuating characters," or "refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product," and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it "forthwith conveys the

⁶ Exhibit "C".

⁷ G. R. No. 112012, 04 April 2001.

characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is," or "if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods," or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination."

The Respondent-Applicant's mark is a combination of the letter "I" and the word "CONTROL". "I" used to refer to oneself as speaker or writer⁸ while "CONTROL" means to direct the behavior of, to cause to do what you want, or to have power over (something)⁹. "CONTROL", therefore, as part of the mark can mean to direct or to have power over something but that "something" does not necessarily mean or refer to cigarettes or tobacco products. It would require some imagination or perception to associate the word "CONTROL" with cigarettes or tobacco products or to connote something about the product. Indeed, when combined with the letter "I", the Respondent-Applicant's iCONTROL may be considered as distinctive and merely suggestive of one's having control over a product.

In the cited case, the Supreme Court explained that suggestive terms are those which, in the phraseology of one court, require "imagination, thought and perception to reach a conclusion as to the nature of the goods." Such terms, "which subtly connote something about the product," are eligible for protection in the absence of secondary meaning. While suggestive marks are capable of shedding "some light" upon certain characteristics of the goods or services in dispute, they nevertheless involve "an element of incongruity," "figurativeness," or "imaginative effort on the part of the observer."

Such being the case, the Respondent-Applicant's iCONTROL mark is registrable within the purview of the law.

Further, the Opposer contended that since the mark iCONTROL has already been found to be descriptive and non-distinctive by the OHIM, it necessarily follows that it is also not registrable under the IP Code. This assertion must fail. It is settled that our courts do not take judicial notice of foreign judgments and laws. As a rule, no sovereign is bound to give effect within its dominion to a judgment rendered by a tribunal of another country¹⁰. This means that the foreign judgment and its authenticity must be proven as facts under our rules on evidence. The recognition may be made in an action instituted specifically for the purpose or in another action where a party invokes the foreign decree as an integral aspect of his claim or defense.¹¹ Therefore, the notice of refusal of a mark rendered by a foreign administrative body or tribunal for reason of being descriptive and non-distinctive is not binding in this Bureau, more so by the mere presentation of a machine copy of the alleged judgment or notice.

8 <http://www.thefreedictionary.com/I>

9 <http://www.merriam-webster.com/dictionary/control>


10 *Sa. Aviation Services Co., PTE. Ltd. v. Grand International Airways, Inc.*, G. R. No. 140288, 23 October 2006.

11 *Corpus v. Sto. Tomas*, G. R. No. 186571, 11 August 2010.

WHEREFORE, premises considered, the opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-00013735 be returned, together with a copy of this Decision, to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 17 February 2016.


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