

MONSTER ENERGY COMPANY,
Opposer,

-versus-

WILSON DY GO,
Respondent- Applicant.

x-----x

IPC No. 14-2012-00046
Opposition to:
Appln. Serial No. 4-2011-007475
Date Filed: 27 June 2011
**TM: "DEVICE REPRESENTING
A SCRATCH"**

NOTICE OF DECISION

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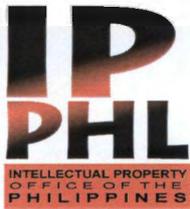
GREETINGS:

Please be informed that Decision No. 2016 - 116 dated April 11, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 11, 2016.

For the Director:


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



MONSTER ENERGY CORPORATION,
Opposer,

- versus -

WILSON DY GO,
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IPC No. 14-2012-0046
Opposition to:

Appln. No. 4-2011-007475
Date Filed: 27 June 2011
Trademark: **"DEVICE REPRESENTING
A SCRATCH"**

Decision No. 2016 - 116

DECISION

MONSTER ENERGY CORPORATION ("Opposer")¹ filed a verified opposition to Trademark Application Serial No. 4-2011-007475. The application, filed by WILSON DY GO ("Respondent-Applicant")², covers the mark "DEVICE REPRESENTING A SCRATCH" for use on goods under the following classes³ namely: "29 - milk; 30 - coffee, chocolate, tea; 32 - energy drinks.

The Opposer alleges the following grounds for opposition:

"8. Opposer is the owner of numerous trademark registrations for its mark, and is Registrant in the Philippines of Trademark Registration Nos. 4-2010-011799 and 4-2009-012640 for the Claw Icon mark. x x x

"9. The Respondent-Applicant's registration of his mark 'DEVICE REPRESENTING A SCRATCH' chiefly contravenes Section 123.1 sub-paragraph (d) of Republic Act No. 8293.

"10. Respondent-Applicant's mark so resembles the Opposer's mark for goods falling under International Classes 29, 30, and 32, as to be likely when applied to or used in connection with the Respondent-Applicant's Classes 29, 30, and 32 goods, to deceive or cause confusion with those of Opposer's goods.

"11. The use by Respondent-Applicant of the mark 'DEVICE REPRESENTING A SCRATCH' on goods that are similar, identical or closely related to the Opposer's goods that are produced by, originate from, offered by, or are under the sponsorship of herein Opposer bearing the latter's Claw Icon Mark, will greatly mislead the purchasing/consumer public into believing that Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer.

¹ A corporation organized and existing under the laws of the State of Delaware, U.S.A., with address at 550 Monica Circle, Suite 201, Corona, California 92880, U.S.A.

² With address at 2066 Candido Street Mapulang Lupa, Valenzuela City.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

"12. Opposer has not abandoned the use in other countries around the world, including here in the Philippines, of its Claw Icon Mark.

"13. In view of the foregoing, the Respondent's Mark may also be considered in contravention of Section 123.1 (f) of the IP Code."

The Opposer submitted the following evidence:

1. Certified/legalized copy of a Certificate of Amendment of Certificate of Incorporation from the Secretary of the State of Delaware, U.S.A.;
2. Certified copies of Registration Certificates featuring the Opposer's Claw Icon Mark issued to Opposer;
3. Complete sets of filings relative to requests for recordals, bearing IPO's notations of receipt and payment of official fees;
4. List of Registrations of Opposer's Claw Icon Mark;
5. Notarized and legalized Affidavit of Opposer's witness, Mr. Rodney Cyril Sacks;
6. Certified true copies of selected registration certificates issued by the Intellectual Property Offices of the following countries: Europe, Hong Kong, Japan, Korea, Singapore, United States; and, Taiwan for the Clas Icon mark;
7. Point of sale materials used to promote MONSTER ENERGY brand;
8. Photographs from various Supercross and Motocross competitions;
9. Press releases regarding the Busch brothers;
10. MONSTER ENERGY Facebook page From 16 February 2012;
11. Cover and certain pages from the March 2007 issue of MX Magazine;
12. Cover and certain pages from the 02 January 2008 issue of CycleNews Magazine; and,
13. Page of the MONSTER ENERGY website - www.monsterenergy.com.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 18 February 2012. Respondent-Applicant however, did not file an answer. Thus, this case is deemed submitted for decision.⁴

Should the Respondent-Applicant be allowed to register the trademark DEVICE REPRESENTING A SCRATCH?

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 out into the market a superior 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.⁵

The instant case is anchored on the ground that the trademark application is contrary to the provision of Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code ("IP Code"):

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:

⁴ Order No. 2012-1069 dated 24 July 2012.

⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

- (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;

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 27 June 2011, the Opposer already has an existing registration for the "Claw Icon Mark" under Registration Nos. 4-2010-011799 issued on 24 March 2011 (classes 29, 30 and 33); and, 4-2009-012640 issued on 01 July 2010 (classes 5 and 32). The Opposer has also shown its various international registrations for the "Claw Icon Mark"⁶, and proof of commercial promotions and advertisement.⁷

The contending marks are hereby reproduced as follows:



Opposer's Mark



Respondent-Applicant's Mark

The contending marks appear identical. Respondent-Applicant's mark is described as a device representing four spaced diagonally disposed elongated members of different length each having crooked edges, said diagonal elongated members representing a scratch.⁸ Opposer's mark, on the other hand, is entitled M Claw Consisting of the Stylized Presentation of the Letter "M". Comparing the marks, they both represent a "scratch". The word claw, if used as a noun is defined as a sharp, usually curved, nail on the foot of an animal, as on a cat, dog, or bird; and, if used as a verb, means to tear, scratch, seize, pull, etc., with or as if with claws.⁹ While Opposer's mark is a stylized presentation of the letter "M", it is in the same way visible as a "scratch". Thus, any slight difference in the position and number of scratches appear insignificant, in contrast to the physical properties of the competing marks. As regards the goods covered by the marks, they are similar and/or related particularly covering classes 29, 30 and 32. They both cover beverages of various types which flow on the same channels of trade and available to the same class of purchasers. It is likely therefore, that the consumers will have the impression that these goods or products originate from a single source or origin. 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:¹⁰

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily 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. Hence, 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

⁶ Exhibits "E", "G" to "R" of Opposer.

⁷ Exhibits "S" to "Y" of Opposer.

⁸ File wrapper.

⁹ Dictionary.com, available at <http://www.dictionary.com/browse/claw> (last accessed 11 April 2016).

¹⁰ Converse Rubber Corporation v. Universal Rubber Products Inc., et al., G.R. No. L-27906, 08 Jan. 1987.

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.

The public interest, therefore, requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. Thus, Respondent-Applicant's mark should not be allowed registration because it resembles Opposer's mark as to be likely to deceive or cause confusion.¹¹

In contrast, the Respondent-Applicant despite the opportunity given, failed to explain how it arrived at using the mark "DEVICE REPRESENTING A SCRATCH" as it failed to file a Verified Answer. The Opposer's mark "Claw Icon Mark" is unique and highly distinctive with respect to the goods it is attached with. It is incredible for the Respondent-Applicant to have come up with the same mark practically for related goods by pure coincidence.

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2011-007475 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, 11 April 2016.


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

¹¹ Sec. 123.1 (d), IP Code.