

RED BULL A.G.,
Opposer,

-versus-

BULLSONE CO., LTD.,
Respondent-Applicant.

X-----X

}	IPC No. 14-2015-00118
}	Opposition to:
}	Appln. Serial No. 4-2014-009556
}	Date Filed: 01 August 2014
}	
}	
}	TM: BULLSONE DEVICE

NOTICE OF DECISION

CESAR CRUZ AND PARTNERS
Counsel for Opposer
3001 Ayala Life-FGU Center,
6811 Ayala Avenue, Makati City


OFFICE OF BAGAY-VILLAMOR AND FABIOSA
Counsel for Respondent- Applicant
Unit 205, Business Center B, Oakridge Business Park
880 A.S. Fortuna Street, Banilad, Mandaue City, Cebu

GREETINGS:

Please be informed that Decision No. 2016 - 542 dated 23 December 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 11 January 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

RED BULL A.G.,	} IPC NO. 14-2015-00118
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2014-009556
	} Date Filed: 1 August 2014
BULLSONE CO., LTD.,	} Trademark: "BULLSONE
Respondent-Applicant.	} DEVICE"
	}
x-----x	} Decision No. 2016- 542

DECISION

RED BULL A.G., (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2014-009556. The application, filed by **BULLSONE CO., LTD.** (Respondent-Applicant)², covers the mark **"BULLSONE DEVICE"**, for use on "additives (detergent) to gasoline [petrol]; fuel-savings preparations; additives, chemical, to motor fuels; anti-tarnishing chemicals for windows; anti-freeze; radiator flushing chemicals; anti-static preparations, other than household purposes; decarbonizing engines (chemical preparations for); additives (chemical) for oils; frosting chemicals (glass) under Class 1; Antistatic preparations for household purposes, rust removing preparations; paint stripping preparations; air (canned pressurized) for cleaning and dusting purposes; aromatic for household purposes; Fragrance for household purposes; aromatics for automobiles; windscreen cleaning liquids; detergents for automobiles; automobile polishes" under Class 3; "Dust laying compositions, dust removing preparations; lubricants; dust binding compositions for sweeping; oil for preservation of leather; additives, non-chemical, to motor-fuel; lubricating oil for motor vehicle engines; gas for lighting; carburants; non-chemical additives for oils and fuels" under Class 4; and "Deodorants, other than for personal use; insect repellants; incense (insect repellent); air purifying preparations; air freshening preparations; insecticides; disinfectants for hygiene purposes; sticks (fumigating); fumigating pastilles" under Class 5 of the International Classification of Goods³.

The Opposer anchors its opposition on the ground that the registration would be contrary to Section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code ("IP Code"), which states that:

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

¹ A corporation organized and existing under the laws of Switzerland with address at Poststrasse 3, 6341 Baar, Switzerland

² with address at 7th Floor Dabong Tower Building, 418 Teheran-Ro, Gangnam-Gu, Seoul 135-839

³ 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.

(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.

x x x

(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 and services which are not similar to those with respect to which registration is applied for: Provided, that the use of the mark in relation to the 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.”

Opposer claims to be the owner of the internationally well-known RED BULL, DOUBLE BULL DEVICE and SINGLE BULL DEVICE (“Red Bull marks”) by prior use in commerce and application in the Philippines. It first used the mark in 1987 in Austria when it launched Red Bull Energy Drink. The Opposer further claims that its energy drink product has been sold in 160 countries worldwide, its mark registered in various jurisdictions worldwide, including the Philippines. As a result of extensive promotion and sales of Red Bull Energy drink, Opposer avers that it has built valuable goodwill.

The Opposer alleges that the Respondent-Applicant’s act in adopting the mark BULLS ONE DEVICE for goods under Class 1, 3, 4 and 5 is an attempt to ride upon the goodwill and reputation of Opposer’s internationally well-known marks. The Opposer further alleges that Respondent-Applicant’s bull device is visually and conceptually similar to Opposer’s mark. The Opposer opines that the Respondent-Applicant’s bull device is identical/similar and very closely resembles its Red bull marks. According to the Opposer, the goods of both parties are commercially available through the same channels of trade and because the goods involved are related to the industries where the Opposer is very visible, the likelihood of confusion is a possibility. The Opposer argues that its Red Bull marks are widely used and recognized in the automotive industry, because the brand is endorsed by various celebrities. Locally it has sponsored numerous events, both motoring and motor sporting events. It obtained favorable decisions for the protection of its mark in various courts in jurisdictions abroad and in the Philippines. Thus, the Opposer believes that the registration of the BULLS ONE DEVICE will cause confusion, mistake or deception to the public as to the source of goods, and will falsely suggest a connection between the Opposer to the Respondent-Applicant.

To support its opposition, the Opposer submitted as evidence the Affidavit of Jennifer A. Powers including copies of advertisements, publications, video-clip of Aaron Colton and print-outs of Respondent's website.⁴

The Respondent-Applicant filed its Answer on 16 September 2015, alleging among other things, that it began as an independent entity in 2001 and later on developed the engine system cleaner "BULLSONESHOT" with its own technology. The auto care product division of the company became a separate entity in 2001 with the establishment of the Respondent, Bullsone Co., Ltd. It launched 'Bullspower' an engine coating agent that was jointly developed with the Korea Research Institute of Chemical Technology, and obtained a patent for the product. The Respondent-Applicant avers that it registered its mark in various countries abroad and secured favorable decisions for the registration of the BULL MARK against the opposition of Red Bull A,G. in Korea. It further avers that it has obtained favorable decisions for the registration of its mark in Japan, United Arab Emirates and Thailand.

The Respondent-Applicant raised as its defense, that fact that Opposer's composite mark is different and cannot be confused with its mark because one is a composite mark, accompanied by the words "RED BULL", while the other mark is simply a device with no words. It describes Opposer's device as a single white charging bull with its head down while Respondent-Applicant's red jumping bull has its legs extending forward. The Respondent-Applicant states that the Opposer has no monopoly over the image of bulls as the IPOPhil trademark database reveal a number of registrations using the image of a bull. The Respondent-Applicant further states that the products of Opposer are not related to Respondent's goods. Finally, it argues that the average Filipino buys his automobiles, car-care products and energy drink by brand.

To support its Answer, the Respondent-Applicant submitted as evidence the Affidavit of Chang-Hoon Lee as evidence.⁵

The Preliminary Conference was held on 30 May 2016 where both parties were directed to file their respective position papers. The Opposer and the Respondent-Applicant filed their respective position papers on 28 July 2016 and 17 July 2016.

Should the Respondent-Applicant be allowed to register the trademark BULLSONE AND DEVICE?

Records show that the Respondent-Applicant applied for registration of the mark BULLSONE AND DEVICE on 1 August 2014. The IP database shows Opposer already registered the mark RED BULL for goods namely: "Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; walkie-talkies; portable and mobile telephones and parts, spare parts equipment"

⁴ Annexes "A" to "D", inclusive of submarkings

⁵ Exhibit "1" inclusive of submarkings

under Class 9; “Telecommunications; transmission of radio and television programs; electronic bulletin board services; wireless mobile phone services; providing telecommunications connections to a global computer network...” under Class 38; “Scientific and technological services and research and design relating thereto...” under Class 42; “Tobacco; smoking tobacco, snuff and chewing tobacco; cigars; cigarillos and cigarettes...”; under Class 34; “games and playthings, namely, playing cards, card games and board games; practical jokes (novelties), confetti; gymnastic and sporting articles (included in class 28); gymnastics and sports equipment” under Class 28; “Education, providing of training and entertainment...” under Class 41; and “Services for providing food and drinks...” under Class 43. Respondent-Applicant’s trademark application is applied on goods under Classes 1, 3, 4 and 5.

The question is: Are the competing marks identical or closely resembling each other such that confusion or mistake is likely to occur?

Red Bull



Opposer’s mark



Respondent-Applicant’s mark

The marks identical with respect to their use of the image of a bull. This similarity does not automatically result to a finding of confusing similarity. In Opposer’s mark, there are two bulls depicted in a charging or fighting stance with their neck, head and horns positioned in a lowered position, as if ready to attack. On the other hand, the Respondent-Applicant’s mark is a red colored bull, depicted with in a jumping position. The back of the bull is extended and while Opposer’s bull has an arched or hunched back. The words RED BULL are on top of the bulls while a shield is a background for Respondent-Applicant’s bull image. These peculiarities distinguish one from the other.

In the case of *Great White Shark v. Danilo Caralde*⁶, the Supreme Court upheld the finding that no confusing similarity existed in spite of the use of by the competing marks of the image of a shark on the same type of goods, it held:

In *Great White Shark*’s ‘GREG NORMAN LOGO’, there is an outline of a shark formed with the use of green, yellow, blue and red lines/strokes. In contrast, the shark in ‘Caralde’s ‘SHARK & LOGO’ mark is illustrated in letters outlined in the form of a shark with the letter ‘S’ forming the head, the letter ‘H’ forming the fins, the letters ‘A’ and ‘R’ forming the body, and the letter ‘K’ forming the tail. In addition, the latter mark includes several more elements such as the word ‘SHARK’ in a different font underneath the shark outline, layers of waves, and a tree on the right side,

⁶ G.R. No. 192294, 12 November 2012

and liberally used the color blue, with some parts in red, yellow, green and white. The whole design is enclosed in an elliptical shape with two linings, thus xxx

As may be gleaned from the foregoing, the visual dissimilarities between the (2) two marks are evident and significant, negating the possibility or confusion in the minds of the ordinary purchaser, especially considering the distinct aural difference between the marks. xxx”

Therefore, when the images of the marks are juxtaposed beside each other, bearing in mind the difference in the goods they represent, mistake, confusion as to source or even deception is not likely.

Aside from the visual dissimilarities of the marks, it is evident that the marks are to be applied on totally different goods. Clearly, energy drink is not the same in its characteristics or descriptive properties with goods under classes 1,3,4 and 5. In the case of Taiwan Kolin Corporation, Ltd. v. Kolin Electronics, Co., Inc.⁷, the Supreme Court held:

While both marks refer to the word ‘KOLIN’ written in upper case letters and in bold font, the Court at once notes the distinct visual and aural differences between them: Kolin Electronics’ mark is italicized and colored black while that of Taiwan Kolin is white in pantone red color background. The differing features between the two, though they may appear minimal , are sufficient to distinguish one brand from the other.

It cannot be stressed enough that the products involved in the case at bar are, generally speaking, various kinds of electronic products. These are not ordinary household items, catsup, soy sauce or soap which are of minimal cost. The products of the contending parties are relatively luxury items not easily considered affordable. Accordingly, the casual buyer is predisposed to be more cautious and discriminating in and would prefer to mull over his purchase. Confusion and deception, then, is less likely. xxx”

x x x

It is hornbook doctrine, as held in the above cited cases, that emphasis should be on the similarity of the products involved and not on the arbitrary classification or general description of their properties or characteristics. The mere fact that one person has adopted and used a trademark on his goods would not, without more, prevent the adoption and use of the same trademark by others on unrelated articles of a different kind.”

⁷ G.R. No. 209843, March 25, 2015

AJ

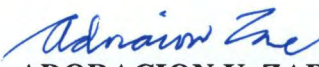
In the instant case, a customer intending to buy Respondent-Applicant's goods, would mull over their purchase. They would not immediately form a connection that the goods are that of the Opposer's simply because the mark of Respondent-Applicant has an image of a bull.

Finally, as correctly argued by the Respondent-Applicant, the IPOPhil trademark database reveals registrations using the image of a "bull", which proves that the Opposer does not have a monopoly over the use a bull to distinguish its goods.⁸ As long as the images are distinct and unique, images of the same animal may be used as valid trademarks without the likelihood of confusion among the buying public.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2014-009556 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 DEC 2016


Atty. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs

⁸ Paragraph 31-35, Verified Answer