



INTELLECTUAL PROPERTY
OFFICE OF THE
PHILIPPINES

MONSTER ENERGY COMPANY,
Opposer,

-versus-

HENRY TAN UY,
Respondent-Applicant.

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IPC No. 14-2012-00068
Opposition to:
Appln. Serial No. 4-2011-14020
Date Filed: 23 November 2011

**TM: MONSTER ENERGY
AND DEVICE**

NOTICE OF DECISION

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HENRY TAN UY

Respondent- Applicant
80 T. Concepcion Street,
Marulas, Valenzuela City

GREETINGS:

Please be informed that Decision No. 2017 - 77 dated 15 March 2017 (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, 16 March 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

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MONSTER ENERGY COMPANY,	} IPC NO. 14-2012-00068
Opposer,	} Opposition to:
	}
-versus-	} Appln. Ser. No. 4-2011-14020
	} Date Filed: 23 November 2011
	}
HENRY TAN UY,	} Trademark: " MONSTER ENERGY
Respondent-Applicant.	} AND DEVICE "
x-----x	} Decision No. 2017- 77

DECISION

MONSTER ENERGY COMPANY, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2011-14020. The application, filed by HENRY TAN UY (Respondent-Applicant)², covers the mark "MONSTER ENERGY AND DEVICE", for use on "Motorcycle parts and accessories such as chain and sprocket sets, swing arm, piston ring, axle, handle bar, handle grip, seat cover, shock absorber, rearsset" under Class 12 of the International Classification of Goods³.

The Opposer relies, among other things, on the following grounds in support of the opposition:

"8. Opposer is the owner of numerous trademark registrations for its MONSTER and MONSTER ENERGY marks and is a registrant in the Philippines of the following marks xxx

MARK	REG. NO	REG. DATE	CLASS	VALIDITY
MONSTER ENERGY	4-2010-011796	7/28/11	5,32,33	July 28,2016
M MONSTER ENERGY DESIGN	4-2010-010159	3/31/11	16, 25	March 31, 2016
MONSTER	4-2009-012368	7/01/10	5,32	July 1, 2015

"9. The Respondent-Applicant's registration of his mark 'MONSTER ENERGY AND DEVICE' chiefly contravenes Sec. 123.1 sub paragraph (d) of Republic Act No. 8293, (RA 8293 or the "IP Code") that states, to wit:

¹ A company duly organized under the laws of the State of Delaware, U.S.A. with address at 550 Monica Circle, Suite 201, Corona, California

² Filipino citizen, with address at 80 T. Concepcion St. Marulas, Valenzuela City

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.



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;

“10. Respondent-Applicant’s Mark so resembles the Opposer’s marks, as to be likely when applied to or used in connection with Respondent-Applicant’s goods, to deceive or cause confusion with those of Opposer’s goods /line of business because MONSTER ENERGY AND DEVICE mark is a replica of the stylized MONSTER ENERGY portion of Opposer’s M MONSTER ENERGY (design) mark. It is obvious that the Respondent merely copied Opposer’s mark because the font proportions and colors are identical to, substantially indistinguishable from the stylized MONSTER ENERGY portion of Opposer’s M MONSTER ENERGY (design) mark. Moreover, Respondent has applied to register its mark on Class 12 for motorcycle parts and accessories and Opposer extensively markets and promotes its MONSTER ENERGY beverages through motorcycle related events and athletes. Xxx as shown in www.supercrossonline.com and www.monsterenergy.com websites. Xxx”

The Opposer submitted as evidence the following:

1. Legalized copy of certificate of Amendment;
2. Certified true copies of the Opposer’s Philippine trademark registrations;
3. Request for records;
4. List of registrations;
5. Original Certified true copies of registrations abroad;
6. Promotional materials, press releases, photographs of Motorcross and Supercross competition, pages of magazines press releases about M MONSTER ENERGY AND DESIGN; AND
7. Pages from the website www.monsterenergy.com⁴

This Bureau served upon the Respondent-Applicant a “Notice to Answer” on 20 April 2012. The Respondent-Applicant, however, did not file an Answer. Thus, the Adjudication Officer issued on 20 July 2012 Order No. 2012-986 declaring the Respondent-Applicant in default.

⁴ Exhibits “A” to “PP”

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

Records show that at the time the Respondent-Applicant filed an application for the mark MONSTER ENERGY AND DEVICE, the Opposer has registered the marks MONSTER ENERGY with Reg. No. 4-2010-011796⁵ issued on 28 July 2011 and M MONSTER ENERGY with Reg. No. 4-2010-010159⁶ issued on 3 March 2011

The competing marks, depicted below, are identical :

Opposer's mark



Respondent-Applicant's mark



Scrutinizing the composition of the marks, both marks use the words MONSTER ENERGY written in a stylized form with the letter "O" transected in the middle by a vertical line. It is apparent that the way, style, lettering, manner of presentation of the words MONSTER ENERGY are identical. The identity of the marks' commercial impression can only signify Respondent-Applicant's intention to ride on Opposer's goodwill, being that the Opposer has conducted marketing, promotional activities, which include but are not limited to, sponsorship of sporting events and athletes in motorcycle racing events. Visually and aurally these marks as regards to the word component are exactly the same, which may result to a likelihood of confusion among the public that the products they represent originate from the same source or have the same affiliation or sponsorship.

Succinctly, because the Respondent-Applicant uses its mark on goods that are used in the promotional and advertising activities of the Opposer, it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only 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

⁵ Exhibit "B"

⁶ Exhibit "C"

there is some connection between the plaintiff and defendant which, in fact does not exist.⁷

The public interest, therefore, requires that 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. It is emphasized that 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.⁸

In the instant case, the Opposer established that he is the originator and owner of the contested mark. The records show that at the time Respondent-Applicant applied for registration of the mark "MONSTER ENERGY", the Opposer already has existing registrations for the mark in different countries and have advertised and promoted the same.


Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁹

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. 4-2011-014020 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, 15 MAR 2017


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

⁷*Converse Rubber Corp. v. Universal Rubber Products, Inc., et. al.*, G. R. No. L-27906, 08 January 1987.

⁸*Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

⁹*American Wire & Cable Company v. Director of Patents*, G. R. No. L-26557, 18 February 1970.