



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

FORMULA ONE LICENSING B.V.,
Opposer,

-versus-

YOKO ALLOY WHEELS CO., LTD.,
Respondent- Applicant.

X-----X

IPC No. 14-2016-00009
Opposition to:
Appln. Serial No. 4-2015-005874
Date Filed: 01 June 2015
TM: "GRANDPRIX"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 361 dated October 23, 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, October 24, 2017.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

FORMULA LICENSING B.V.,
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- versus -

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IPC No. 14-2016-00009

Opposition to:

Application Serial No. 4-2015-005874

Date Filed: 01 June 2015

Trademark: GRANDPRIX

Decision No. 2017 - 361

DECISION

FORMULA LICENSING B.V.,¹ ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2015-005874. The application, filed by YOKO ALLOY WHEELS CO., LTD.² ("Respondent-Applicant") covers the mark **GRANDPRIX** for use on goods such as "*lubricants, lubricating grease, lubricating oil, grease for arms (weapons), industrial oil, cutting fluids, motor oil*" under Class 4 of the International Classification of Goods.³

Opposer alleges the following grounds to oppose the subject application:

"RESPONDENT'S 'GRANDPRIX' MARK IS IDENTICAL TO FOL'S INTERNATIONALLY WELL-KNOWN 'GRAND PRIX;' AND

"RESPONDENT'S USE OF A MARK IDENTICAL TO FOL'S FAMOUS AND DISTINCTIVE MARK DILUTES, DEFAMES OR OTHERWISE BLURS THE DISTINCTIVENESS OF 'GRAND PRIX'."

Opposer's evidence consists of the following:

1. A copy of the extract from The Netherlands commercial register showing the incorporation of FOL;
2. A copy of the Power of Attorney;
3. A printout of the brief history of Formula One from <http://en.espnf1.com>;
4. Printout of definition of "Grand Prix" from online dictionaries;
5. Printout of the article "Formula One stars to race at world heritage site" from <http://edition.cnn.com>;
6. Printout of the article "65 years of F1" from <https://www.formula1.com>;
7. Print out of Rules and Regulations of F1 from <https://www.formula1.com>;
8. Various printouts of relevant pages about F1 races and events from various websites;

¹ A corporation valid and existing under the laws of The Netherlands with office address at Beursplein 37, 3011 AA Rotterdam, The Netherlands.

² A corporation valid and existing under the laws of Thailand with principal office address at 168/1-2 Moo 5 Pantai-Norasingh, Muang District, Samutsakorn 74000, Thailand.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.



9. Copy of Europe Grand Prix (1950) Race Programme Cover;
10. Copy of a list of trademark registrations of the GRAND PRIX mark;
11. Copies of the certificates of registrations of the GRAND PRIX mark in various classes in Japan, the European Union, Malaysia, Mexico, Russia, Singapore, South Korea, United Arab Emirates and the United Kingdom;
12. Copies of the certificates of registrations of the combined F1 and GRAND PRIX marks in various classes in the United States of America and the European Union;
13. Printout of World Bank 2014 GDP Ranking from <http://databank.worldbank.org>;
14. Printout of World Bank 2014 Population Ranking <http://databank.worldbank.org>;
15. Printout of World Bank Data on the EU from <http://data.worldbank.org>;
16. A copy of the Official Decision of the Spanish Patent and Trademark Office on Application No. 2664489/4 and its accompanying official English translation;
17. A copy of Official Decision No. B.14.1.TPE.0.07.02.00 - 2006/21969;
18. A copy of Official Decision No. B.14.1.TPE.0.07.02.00-2007/43820;
20. Copies of photographs of official GRAND PRIX merchandise;
21. Printouts of photographs of various GRAND PRIX video games;
22. Printout of Motor Racing Programme Covers from <http://www.progcovers.com>;
23. Printouts of Grand Prix Race Programme Covers in 1954, 1959, 1961, 1970, 1980, 1982, 1993, 2008 and 2015 from various websites;
24. Printout of the article "Sponsorship: Brands beat a path to F1's door despite drop in TV viewers" from <http://www.ft.com>;
25. Printout of the article "Infiniti Clear Winner of Visibility Race in Formula One 2013 Season' from <http://repucom.net>;
26. Printout of article " Formula 1 2016: All you need to know about the teams" from <http://www.bbc.com>;
27. Copies of promotional materials showing the use of F1 Marks on road cars;
28. A copy of an excerpt of The Power of Title Sponsorship by Dato 'Shamsul Azhar Abbas;
29. Printout of List of items on sale in DataBlitz Philippines from <http://datablitz.com.ph>;
30. Printout of Grand Prix Event Calendar in 2016 from <http://www.redrocktravel.net>;
31. Printouts of articles about F1 found in websites in the Philippines;
32. A copy of the letter dated January 21, 2016;
33. Judicial Affidavit of Mr. Sean Corbett; and
34. Judicial Affidavit of Ms. Lauren Angelic J. Toledo.

This Bureau issued on 18 May 2016 a Notice to Answer and served a copy thereof to the Respondent-Applicant's trademark agent on 06 June 2016. However, Respondent-Applicant failed to file the answer. On 14 March 2017, this Bureau issued an order declaring Respondent-Applicant in default. Hence, this case is deemed submitted for decision on the basis of the opposition, affidavits of witnesses and documentary evidence of the Opposer.

Should Respondent-Applicant's mark "GRANDPRIX" be allowed registration?

Section 123.1 (d), (e) and (f) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), as amended, provides:

Section 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;

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

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

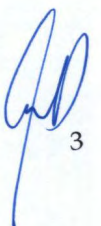
Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, or resembles a well-known mark, said mark cannot be registered.

Indubitably, both Opposer and Respondent-Applicant use the words GRAND PRIX as their mark. However, records will show that at the time Respondent-Applicant applied for registration of its mark GRANDPRIX on 01 June 2015, Opposer has no existing or pending application for registration of a similar trademark with this Office. As such, at that time of the application, there is no bar to the registration of Respondent-Applicant's mark.

However, Opposer further claims that the mark of Respondent-Applicant is confusingly similar to its well-known mark GRAND PRIX registered in various countries abroad. In order to be considered well-known mark, any combination of the criteria set forth in Rule 102 of the Trademark Regulations should be present, to wit:

RULE 102. *Criteria for determining whether a mark is well-known.* - In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;



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- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is a well-known mark.

After going through the evidence submitted by Opposer, this Bureau is not convinced that Opposer's GRAND PRIX mark is a well-known mark. Opposer failed to adduce evidence that its mark GRAND PRIX has attained exclusivity of registration and use in the world. In fact, in the Philippines alone, marks with the words GRAND PRIX as a standalone mark or as a mark in combination with other word or words have been registered in various class to different registrants. The search result for GRAND PRIX in the IPOPHL Trademark Database would show that the marks GRAND PRIX, INSIDE RACING GRAND PRIX, DNA GP GRAND PRIX, RUGBY EXCEL GRAND PRIX AND DEVICE are just some of the marks registered. Further, the extent of the geographical area of the use of the mark is not that wide or expansive.

In addition, while both marks are similar because of the use of the words GRAND PRIX, the similarity in the mark to another mark does not automatically bar its registration. A similar mark may be registered when the goods, upon which the applied mark will be used, is different or non-competing to the goods of another such that it cannot be said that the goods of the latter is manufactured or sourced from the former or that there is a connection between them.

In *Philippine Refining Co., Inc. vs. Ng Sam and The Director of Patents*⁴, the Court ruled:

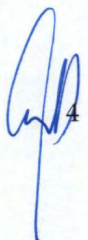
A rudimentary precept in trademark protection is that "the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods." Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

Such restricted right over a trademark is likewise reflected in our Trademark Law. Under Section 4(d) of the law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, as in this case, registration of a similar or even identical mark may be allowed.

In this case, the goods or services upon which the GRAND PRIX mark are used by the contending parties are different that it is unlikely that it will cause confusion, mistake or deception on the part of the public into believing that the goods of Respondent-Applicant comes from or is manufactured or sourced from Opposer.

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

⁴ G.R. No. L-26676, July 30, 1982



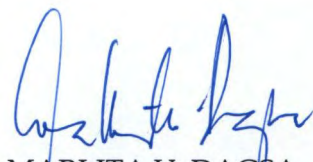
merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product. The mark of Respondent-Applicant meets this function.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is not prohibited by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2015-005874 together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 OCT 2017.


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs