

RUSSEL G. WEINER,
Opposer,

-versus-

DESTILERIA LIMTUACO & CO., INC.,
Respondent- Applicant.

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}
} IPC No. 14-2013-00457
} Opposition to:
} Appln. Serial No. 4-2013-00004164
} Date Filed: 12 April 2013
} TM: "ROCKSTAR"
}

NOTICE OF DECISION

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DESTILERIA LIMTUACO & CO., INC.
Respondent-Applicant
Destileria Limtuaco & Co. Inc. Building
1830 Epifanio Delos Santos Avenue
Quezon City

GREETINGS:

Please be informed that Decision No. 2017 - 268 dated June 29, 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, June 30, 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

RUSSEL G. WEINER,
Opposer,

IPC NO. 14 – 2013- 00457

Opposition to:

- versus -

Reg. Serial No. 4-2013-004164
TM: "ROCKSTAR"

**DESTILERIA LIMTUACO & CO.,
INC.,**

Respondent-Applicant.

DECISION NO. 2017 - 268

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D E C I S I O N

Mr. Russel G. Weiner (Opposer),¹ filed an Opposition to the Trademark Application No. 42013004164. The subject trademark application filed by Distileria Limtuaco & Co Inc. (Respondent-Applicant),² covers the mark "Rockstar" for "wines, spirits and liquor"³ under Classes 33 of the International Classification of Goods.⁴

The Opposer based its opposition on the following grounds:

1. Opposer is the prior adopter, user and true owner of the trademark ROCKSTAR in the Philippines and elsewhere around the world.
2. Respondent-Applicant's mark ROCKSTAR is identical to Opposer's registered ROCKSTAR trademarks.
3. The registration of Respondent-Applicant's mark ROCKSTAR should not be allowed since said mark is identical to Opposer's registered ROCKSTAR trademark in the Philippines in respect of closely related goods, and is likely to deceive or cause confusion.
4. Opposer's trademark ROCKSTAR and its variations are internationally well-known.

¹A natural person with address at 101 Convention Center Drive, Suite 777, Las Vegas, Nevada 89126

²A corporation with business address at 1830 EDSA, Metro Manila.

³Certificate of Registration with Registration No. _____

⁴The 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 International Classification of Goods and Services for Registration of Marks concluded in 1957.

5. Since Opposer's ROCKSTAR trademarks are internationally well-known, they are entitled to protection against confusingly similar marks covering similar or related goods.
6. The word ROCKSTAR forms part of the corporate name of Opposer's company and as such is protected under the Article 6 and Article 8 of the Paris Convention.

The pertinent portions of Opposition are as follows:

7. The registration of the mark ROCKSTAR in the name of the Respondent-Applicant will violate and contravene the provisions of Sections 123.1 (d), (e), (f), and (g) of the IP Code, as amended, because said mark is identical to Opposer's own internationally well-known ROCKSTAR trademark as to be likely to cause confusion or mistake, or deceive the purchasers thereof as to the origin of the goods.

8. The registration of the mark ROCKSTAR in the name of Respondent-Applicant will cause grave and irreparable injury and damage to the Opposer for which reason he opposes said application based on the grounds set forth hereunder.

10. Opposer, founder of the company Rockstar, Inc., created the famous energy drink ROCKSTAR in 1999, which was manufactured and distributed by said company in 2001. Opposer was born in 1970 to leading herbalists Dr. Michael and Janet Weiner, who authored or co-authored nearly two dozen books on health and nutrition published in more than ten countries. As a child and teenager, he went with his parents to explore the islands of Fiji, Tonga, Samoa, The Cook Islands, Tahiti and Marqueses Islands learning about healing plant remedies and elixirs used by native doctors. After graduating from high-school and college in California and New York, Opposer spent on year in as distributor manager for Country Life Vitamins in Los Angeles, California, where he also created and packaged a number of memorable events for student trips to Cancun, San Felipe and other exotic locations for skiing and snowboarding adventures. With his experiences with his parents and travels, he went into product development for Maurice Kanbar, creator of Sky Vodka and rolled out several consumer ideas, including Vermeer chocolate liquor. Sick of paying US\$2 for an 8.4 ounce can of Red Bull, Kanbar challenged him to do something about it, and with the latter's blessings, started his own company, mortgaging his condominium unit for US\$50,000. For eighteen months, Opposer went into intense product development and vetted 750 variations to finally achieve the perfect product: the ROCKSTAR energy drink. x x x

11. A visual comparison between the parties' marks leaves no doubt that Respondent-Applicant's ROCKSTAR mark is not only confusingly similar but is, in fact, IDENTICAL to Opposer's internationally well-known ROCKSTAR trademarks, for which Opposer has previously obtained registrations in the Philippines and other countries worldwide.

12. The confusing similarity of Respondent-Applicant's ROCKSTAR and Opposer's well-known ROCKSTAR trademarks is highly likely to deceive the purchasers of goods on which the mark is being used as to the origin or source of said goods and as to the nature, character, quality and characteristics of the goods to which it is affixed. Furthermore, the unauthorized use by others of a trademark similar or identical to Opposer's ROCKSTAR trademarks will certainly dilute the distinctiveness of the latter, and adversely affect the function of said trademarks as an indicator of origin, and/ or the quality of the product.

x x x

13. Opposer is the owner of the following trademark registrations in the Philippines, both of which were granted in June/July of 2012:

	Trademark	Registration No.	Date Registered
1	ROCKSTAR	4-2012-500641	July 12, 2012
2	ROCKSTAR (Stylized)	4-2012-500642	June 28, 2012

x x x

15. The goods covered by the Opposer's registrations for his ROCKSTAR marks fall under Class 32, specifically, "*non-alcoholic beverages, namely energy drinks*". Respondent-Applicant's application for the mark ROCKSTAR covers "*wines, spirits, and liquor in Class 33*", and while being in a different class, these goods are nevertheless closely related to Opposer's own goods, as they flow through the same channels of trade. Opposer's ROCKSTAR energy drinks are available in convenience stores, supermarkets, and similar retail stores, where goods like wines, spirits and liquors may also be purchased. In the case of *Esso Standard Eastern, Inc. vs. Court of Appeals*, the Supreme Court held that in determining whether goods are related, several factors come into play, among which are the channels of trade through which the goods flow. This same concept of "*related goods*" was reiterated in the case of *Mighty Corporation, et al., vs. E & J Gallo Winery, et al.* indeed, the goods are so closely related that it might reasonably be assumed that the wines, spirits and liquor manufactured and sold by the Respondent-Applicant originated from Opposer, or that both parties' goods originated from one manufacturer.

x x x

17. Ergo, even assuming the goods specified in Opposer's Philippine registrations of the mark ROCKSTAR are considered non-competing with Respondent-Applicant's goods, to allow the latter to use the mark ROCKSTAR for goods under Class 33 would nevertheless result in unfair trading, as it would not only prevent the natural expansion of Opposer's business but will also have Opposer's business confused with and put at the mercy of Respondent-Applicant's.

18. More importantly, it must be pointed out that Opposer has caused the registration of his trademark ROCKSTAR in other countries to cover goods under Class 33, which include "Alcoholic

beverages (except beers); distilled spirits and alcoholic beverages produced from a brewed malt base with natural flavors.” x x x

22. The confusing similarity between Opposer's own trademark ROCKSTAR and Respondent-Applicant's mark, coupled with the fact that the latter is intended to be used on goods closely related to Opposer's products, further increases likelihood of confusion in the minds of the public as to the origin of Respondent-Applicant's goods.

x x x

23. Opposer owns several registrations and applications for the registration of the mark ROCKSTAR and its variations in many countries worldwide. x x x

26. Quite remarkable is the presence of Opposer's mark ROCKSTAR online and in various social networks. Apart from his official websites, Opposer also maintains accounts on various social media platforms such as Twitter, Facebook, YouTube, Instagram, and Pinterest, all of which serve the purpose of advertising and disseminating news and information about his company's various ROCKSTAR energy drinks as well as of the musical and sporting events sponsored by Rockstar, Inc., among others. x x x

27. Opposer's Rockstar, Inc. has spent considerable amounts in the advertising, promotion and sponsorship of various events by its ROCKSTAR-branded products. x x x

28. By 2007, ROCKSTAR was one of the top three energy drink brands in North America, having enjoyed a 155% growth sale in 2004, reaching US\$48 million, and has sold over a billion cans. By 2008, the ROCKSTAR energy drink had 14% of the US energy drink market. ROCKSTAR was differentiated from the market leader Red Bull by using a 16 oz. can and marketing itself as twice the size of Red Bull for the same price.

29. Rockstar, Inc. is currently one of the largest energy drink companies in the world, and ROCKSTAR is the third most consumed energy drink in the USA, with annual sales far in excess of US\$500 Million, third behind Monster and Red Bull. Rockstar, Inc. produces energy drinks for people with active and exhausting lifestyles, ranging from athletes to rockstars. It offers its products through convenience stores and retail outlets in the United States, Canada, Australia, Austria, Belgium, France, Ireland, New Zealand, Japan, Germany, Switzerland, Finland, Spain, the Netherlands, the United Arab Emirates, and the United Kingdom. Rockstar, Inc. has operations in Australia, Austria, Belgium, Canada, France, Germany, Ireland, Japan, Mexico, the Netherlands, New Zealand, Spain, Switzerland, the United Arab Emirates, the United Kingdom and the United States.

x x x

30. Opposer's trademark ROCKSTAR is internationally well-known, having met the criteria under Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames, and Marked or Stamped Containers. According to Section 123.1 (e) and (f) of the IP

Code, a mark cannot be registered if it is identical with, or confusingly similar to well-known marks x x x

35. The registration of the mark ROCKSTAR in the name of the Respondent-Applicant will violate the exclusive proprietary rights of the Opposer over his own marks and irreparably injure or damage the interest, business reputation and goodwill of said marks.

36. Clearly, the registration of the mark ROCKSTAR in the name of Respondent-Applicant will not only prejudice the Opposer but will also allow the Respondent Applicant to unfairly benefit from and get a free ride on the goodwill of Opposer's well-known ROCKSTAR trademark.

x x x

37. Opposer would like to point out that the **dominant and essential** feature of his company, **ROCKSTAR, INC.**, is the word "ROCKSTAR". Opposer's corporate name is protected under the Paris Convention and the Philippine Trade Name Law without need of registration. The Philippines and the USA are both members-signatory to the Paris Convention. x x x

39. ROCKSTAR is both a trademark and a tradename that has become synonymous with Opposer's energy drink and the active lifestyle his company Rockstar, Inc. espouses. The registration of an identical mark by another proprietor engaged in the manufacture and/or distribution of goods closely related or similar to those of Opposer's will cause grave and irreparable injury to the ROCKSTAR trademark and trade name, dilute said trademark, and give rise to confusion in the mind of the public, and create the utterly false impression that Opposer and Respondent Applicant are affiliated or related entities.

To support its claim, the Petitioner submitted the following evidence:

Exhibit "A" – Special Power of Attorney;

Exhibit "B" – Affidavit of Mr. Ian K. Boyd;

Exhibit "C" – Affidavit of Atty. Chrissie Ann L. Barredo; and

Exhibit "C-4" to "C-5" – Printout from the IPOPHL's
Trademark Search System;

This Bureau issued a Notice to Answer and served to the Respondent-Applicant on 5 March 2014, requiring the Respondent-Applicant to file a Verified Answer. However, the Respondent-Applicant did not file an Answer. Hence, an Order dated 3 June 2014 was issued declaring the Respondent-Applicant in default. Consequently, this case was deemed submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant should be allowed to register the trademark "ROCKSTAR."

The Opposition is anchored on Section 123.1 pars. (d), (e), (f) and (g) of Republic Act No. 8293, also known as, the Intellectual Property Code of the Philippines ("IP Code") which provide, as follows:

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;

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services

x x x

The pertinent trademarks are depicted below for examination and comparison:

ROCKSTAR

ROCKSTAR

ROCKSTAR

Respondent – Applicant’s Mark

Opposer’s Trademark

The competing trademarks as shown above are both composed of identical wordmark “Rockstar.” While it is true that the font types and the font styles are different, the variations are, at best, minor and negligible to the consumers. Thus, this Bureau finds that the two contending marks are confusingly similar.

The above finding of confusing similarity of the marks is strengthened by the fact that the goods subject of the competing marks are closely related goods. The Opposer’s trademark covers “*non-alcoholic beverages, namely energy drinks*” while the Respondent-Applicant goods are “*wines, spirits and liquors.*” Although the two groups of goods are categorized under different Nice Classification, they are both beverages, which can be found side by side in stores and grocery stands. There is very high probability that the public may associate the two groups of goods together or that the goods all came from one source, manufacturer or originator.

Pursuant to the Intellectual Property Code, the prior registration of the wordmark “ROCKSTAR”⁵ would prevent the allowance for registration of an identical or confusingly similar mark. In the instant case, records bear out that the Opposer already had a prior and existing trademark registrations for the mark “ROCKSTAR” when the Respondent – Applicant filed its application for similar wordmark on 12 April 2013.⁶

The Supreme Court has consistently emphasized that a trademark is a distinctive mark of authenticity through which the merchandise of a particular producer or manufacturer may be distinguished from that of others, and its sole function is to designate distinctively the origin of the products to which it is attached.⁷ More importantly, the protection of trademarks as intellectual property is

⁵ Exhibit “C-4” and Exhibit “C-5”

⁶ Respondent-Applicant’s Trademark Application documents

⁷ Arce Sons and Co. vs. Selecta Biscuit et. al., G.R. L-14761, 28 January 1961 citing Reynolds & Reynolds Co. vs. Nordic, et al., 114F 2d, 278

7/11/13


intended not only to preserve the goodwill and reputation of the business established on the goods bearing the mark through actual use over a period of time, but also to safeguard the public as consumers against confusion on these goods.⁸

Following the above discussion, the registration of the Respondent-Applicant's trademark is proscribed under Section 123.1 of the IP Code.

WHEREFORE, the instant Opposition to Trademark Application Serial No. 42013004164 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42013004164 be returned together with a copy of this DECISION to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, **29 JUN 2017**


Atty. Leonardo Oliver Limbo
Adjudication Officer
Bureau of Legal Affairs

⁸ *McDonald's Corporation v. MacJoy Fastfood Corporation* 215 SCRA 316, 320 (1992); and *Chuanchow Soy & Canning Co. v. Dir. of Patents and Villapania*, 108 Phil. 833, 836 (1960).