



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

RED BULL AG,
Opposer,

-versus-

GRUPO OSBORNE, S.A.,
Respondent-Applicant.

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IPC No. 14-2015-00183
Opposition to:
Appln. Serial No. 4-2014-011142
Date Filed: 05 September 2014

TM: TORO

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 412 dated 12 December 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, 13 December 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

RED BULL AG.,
Opposer,

- versus -

GRUPO OSBORNE, S.A.,
Respondent-Applicant.

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IPC No. 14-2015-00183

Opposition to:

Application Serial No. 4-2014-011142

Date Filed: 05 September 2014

Trademark: TORO

Decision No. 2017 - 412

DECISION

RED BULL A.G.,¹ ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2014-011142. The application, filed by GRUPO OSBORNE, S.A.² ("Respondent-Applicant") covers the mark **TORO** for use on goods such as "*jackets, t-shirts, sweaters, hats, caps, boots, shoes and slippers*" under Class 25; "*beers, minerals and aerated waters and other non-alcoholic drinks, fruits drinks and fruit juices, syrups and other preparations for making beverages*" under Class 32 and "*alcoholic beverages (except beers)*" under Class 33 of the International Classification of Goods.³

Opposer alleges the following grounds for opposition:

"13. The Respondent-Applicant's application for the registration of the mark TORO should not be accepted by this Honorable Office since to do so would be contrary to Section 123.1 (d) and Section 123.1 (f) of the Intellectual Property Code, which prohibits the registration of a mark that :

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"14. The act of the Respondent-Applicant in adopting the mark TORO for its products in International Classes 25, 32 and 33 is clearly an attempt to trade unfairly on the goodwill, reputation, consumer awareness and ride on the notoriety of the Opposer's internationally well-known Red Bull Marks. Such act of the Respondent-Applicant results in the diminution and degradation of the value of the Opposer's internationally well-known Red Bull marks and usurpation of the property rights that rightfully belong to the Opposer.

"15. The Opposer's internationally well-known Red Bull Marks are with prior application and are currently used in the Philippines. The Respondent-Applicant's mark TORO seeks the registration in International Classes 25, 32, and 33 despite the fact that the same is undoubtedly identical, similar and/or closely related to the Opposer's internationally well-known Red Bull Marks. As the Opposer's marks are internationally well-known, the marks are highly likely to be associated with the Opposer, leading to the consumer confusion as to the origin of the Respondent-Applicant's products which may gravely endanger the reputation of the Opposer.

1 A corporation valid and existing under the laws of Switzerland with principal office at Poststrasse 3, 6341 Baar, Switzerland.

2 A corporation valid and existing under the laws of Spain with principal office address at Fernan Caballero, 7, 11.500 Puerto De Santa Maria, Cadiz.

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.



"16. The Respondent-Applicant's mark is aurally and conceptually similar to the Opposer's internationally well-known Red Bull Marks that was previously applied for in the Philippines and previously registered elsewhere in the world. The Red Bull Marks are considered to be the distinct brand name for the Opposer's products that led to its recognition as the leading brand in energy drinks around the world including the Philippines.

"17. The trademark RED BULL and the Respondent-Applicant's mark TORO are identical and/or similar because of the following:

17.1 Both marks are composed of only word marks which undoubtedly heighten the visual, aural, conceptual and phonetic similarity between the marks.

17.2. Both marks present the word 'BULL'. The word element 'TORO' is the Spanish translation of the word 'BULL'. The word 'BULL' and the word 'TORO' are featured as a word of both marks heightening the immediate visual, phonetic and conceptual similarity between the two marks. Further, it is established law in many jurisdictions, including the Philippines, that consumers pay attention to the dominant feature of marks when making quick assessments of the origin of the goods. It follows, therefore, that consumers may be confused when confronted with the two marks RED BULL and TORO.

17.3 Both marks incorporate the name of an animal, more particularly, the bull. Filipino consumers are undoubtedly to be confused when confronted with the two marks RED BULL and TORO as the Spanish translation of the 'BULL' animal.

17.4 It cannot be gainsaid that the concept used by the Opposer for its mark, the BULL animal, has attained sufficient notoriety as an internationally well-known mark and that the same has become distinctive for the Opposer's goods. The Opposer is undoubtedly the source of this novelty and is the first to use the same to identify its goods.

17.5 The BULL concept to identify the Opposer's goods in the marketplace has been the core of its business. It is undeniable that the Opposer has extensively used the same concept for some time and that the Opposer has expended enormous sum of money to make the RED + BULL concept distinctive of its goods. It is without question that the Opposer's internationally well-known RED BULL mark is a distinct mark worldwide and nationwide. The BULL animal is a dominant element of the Opposer's internationally well-known mark. Allowing the same animal to be used by the Respondent-Applicant would inevitably lead to the diluting and diminishing the distinctiveness of the well-known mark, more so when the BULL animal mark is used on products in International Class 32 also.

"18. The Respondent-Applicant's TORO mark very closely resembles and is very similar to the Opposer's internationally well-known Red Bull Marks that was previously registered in the Philippines and all over the world. The resemblance of the Opposer's and Respondent-Applicant's respective marks is most evident upon a juxtaposition of the said marks.

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The Honorable Office can take notice of the fact that Filipino consumers are well-versed in Spanish language, having been a colony of Spain for hundred years. It cannot be gainsaid that an ordinary consumer will see the Respondent-Applicant's mark as a 'new variant' of the Opposer's mark RED BULL, by virtue of the fact that the word 'TORO' is a mere translation of the word 'BULL', thus, further prejudicing the Opposer. xxx

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"19. Goods bearing the Opposer's Red Bull Marks and the Respondent-Applicant's mark TORO are commercially available to the public through the same channels of trade such that an indiscriminating buyer may confuse the products bearing the Respondent-Applicant's mark TORO for goods bearing the Opposer's internationally well-known Red Bull Marks. It is worthy to mention that



the relevant consumers affected herein will be the buyer of drinks and/or refreshments. Naturally, consumers would merely rely on recollecting the dominant and distinct wording of the marks. There is a great similarity between the Opposer's Red Bull Marks and the Respondent-Applicant's TORO mark. Thus, confusion will likely arise and would necessarily cause the interchanging of one product with the other.

"20. Considering the fact that the goods involved are intimately related to the industries where the Opposer is very visible, having used the same to actively promote its products, the possibility of confusion is more likely to occur in light of the fact that ordinary consumers may be prone to believe that the goods of the Respondent-Applicant is equivalent to or affiliated with, or are sponsored by, or are the Opposer's goods. xxx

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"21. The intent to take advantage of the goodwill and reputation of the Opposer's Red Bull Marks is highlighted by the fact that the Respondent-Applicant appears to be circumventing the protection granted to trademark owners when it filed the present application for its mark 'TORO' despite the fact that this Honorable Office has already decided against the registration of the same mark in IPC No. 14-2008-00255 in the case entitled "T.C. Pharmaceutical Industries Co., Ltd. v. Grupo Osborne, S.A.

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"22. If the same BULL animal concept is used by the Respondent-Applicant on products that are associated with the drink/refreshment industry, it will undoubtedly create a false business relationship and/or association to the detriment of the Opposer. Thus, if allowed, the Respondent-Applicant will definitely 'ride on' the popularity and exposure of the Opposer's mark in the field of energy drink.

"23. Wrongful intent can be inferred where the junior user, (the Respondent-Applicant) knew of the senior user's closely similar mark used on similar goods or services, had the freedom to choose any mark, and 'just happened' to choose a mark confusingly similar to plaintiff's mark. It is highly unlikely that the Respondent-Applicant's TORO word mark was independently thought of and was a product of pure coincidence. The Respondent-Applicant's wrongful intent is made more evident by the fact that it has already been denied registration for the same mark in the above-mentioned case, and is attempting to have the same mark registered once again despite the finding of this Honorable Office that the said trademark is confusingly similar to the Opposer's Red Bull Marks.

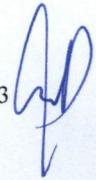
"24. All over the world, the Opposer has successfully opposed numerous marks that make use of the BULL animal concept, arguing on the basis of likelihood of confusion as well as associative effects of the BULL marks. The Commercial Court of Kanto Aargau of Switzerland in an opposition cases against the mark 'BULLFIGHTER' ruled that there was likelihood of confusion.

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"26. The Respondent-Applicant's TORO mark so closely resembles the Opposer's internationally well-known Red Bull Marks that the Filipino public will no doubt confuse one for the other and/or believe that goods bearing the Respondent-Applicant's mark originate from or are sponsored by the Opposer, or, at least, originate from economically linked undertakings creating an inappropriate trade connection or association.

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"30. Of all the possible combinations of the letters of the alphabet and words, the Respondent-Applicant chose to use the mark TORO to identify its goods in International Classes 25, 32 and 33. The Respondent-Applicant also chosen to associate its goods with a translation of the BULL animal word mark. No conclusion can be drawn surrounding the case other than the fact that the Respondent-Applicant is deliberately attempting to trade on the valuable goodwill and to 'ride on' the notoriety of

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the Opposer's internationally well-known Red Bull marks that has been used throughout the world for several decades placing the Opposer in a disadvantageous position.

"31. Clearly, the registration and use of the mark TORO by the Respondent-Applicant is a usurpation of the internationally well-known mark RED BULL, a mark legally owned by the Opposer as well as the goodwill associated therewith.

"32. The registration of the Respondent-Applicant's mark TORO will lead the purchasing public to believe that the goods of the Respondent-Applicant emanate from the 'same source' or from the Opposer. If the products of the Respondent-Applicant are inferior in quality, there will be grave and irreparable injury to the Opposer's valuable goodwill and to its internationally well-known Red Bull Marks. Furthermore, the use and registration of the mark TORO by the Respondent-Applicant will dilute and degrade the distinctive character of the Opposer's internationally well-known Red Bull Marks.

"33. That the Respondent-Applicant seeks to register the mark TORO which is confusingly similar to the Opposer's internationally well-known Red Bull Marks, as to be likely, when applied to the goods of Respondent-Applicant, to cause confusion, mistake or deception to the public as to source of goods, and will inevitably falsely suggest a trade connection between the Opposer and the Respondent-Applicant, is simply violative of the Intellectual Property Code of the Philippines.

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"35. Moreover, in the case of McDonald's Corporation v. L.C. Big Mak Burger, Inc. et. al, the Supreme Court had the occasion to rule that 'while proof of actual confusion is the best evidence of infringement, its absence is inconsequential.' Thus, it follows that the very fact that consumer confusion has been found in other jurisdictions for numerous BULL animal concept trademarks leads to the conclusion that such confusion is likely between the Opposer's RED BULL marks and the Respondent-Applicant's TORO mark.

"36. Thus, the denial of the registration of Trademark Application No. 4-2014-011142 for the mark TORO by this Honorable Office is authorized and warranted under the provisions of the Intellectual Property Code of the Philippines."

Opposer's evidence consist of the following:

1. Special Power of Attorney;
2. Legalized and authenticated Affidavit of Jennifer A. Powers;
3. DVD and printed overview with RED BULL commercials;
4. Samples of promotional materials;
5. DVD with short video clip showing overview of Red Bull's activities;
6. Eurobrand and BrandZ brand value rankings;
7. Trial and awareness study overview 2014;
8. Excerpts from Red Bull website;
9. List of Decisions declaring Red Bull as well-known;
10. RED BULL Collection catalogue;
11. Excepts related to Red Bull's international sports and cultural events;
12. DVD about Red Bull Stratos;
13. Information about Red Bull's national event and sponsorship; and
14. Copy of decisions on Red Bull cases in various jurisdictions.

On 25 June 2015, this Bureau issued a Notice to Answer and served the same to Respondent-Applicant's counsel on 03 July 2015. After several motions for extension, Respondent-Applicant filed the Answer on 01 October 2015 alleging the following Defenses, among others:

"A. RESPONDENT'S mark TORO originated from its famous mark OSBORNE BULL DEVICE and is not confusingly similar to the mark RED BULL.

"1. The RESPONDENT successfully cooperated with OPPOSER over a long period of time. It acted as distribution partner for the OPPOSER in Spain including the enclaves in North Africa, as well as in Andorra and Gibraltar for more than a decade. Due to its excellent distribution network in the region the RESPONDENT helped OPPOSER to establish their energy drink on the market in Spain.

"2. In the year 2006 OPPOSER terminated the distribution agreement with the RESPONDENT regarding the energy drink RED BULL and ended a successful cooperation of over ten years. In light of the fact that the termination of this long lasting distributorship led to a loss of important revenues, the RESPONDENT decided to bring an own energy drink on the market. For this energy drink the RESPONDENT deliberately selected two of its trademarks already perfectly positioned on the market: the famous OSBORNE BULL device and the word trademark TORO .

"B. RESPONDENT WAS ABLE TO REGISTER THE MARK "TORO" IN EUROPE IN SPITE OF OPPOSITION FROM OPPOSER.

"3. The RESPONDENT applied for registration for the mark TORO and was granted trademark certificates for class 32 and 33, among other classes, such as CTM number 001500917 for TORO and BULL device, CTM number 001319185 for TORO and CTM number 002844264 for TORO.

"4. The OPPOSER filed several cases against the RESPONDENT for the cancellation of these trademarks. CTM 1.319.185 TORO even became subject of two revocation actions and of two invalidity actions filed by Red Bull before OHIM. They failed.

"5. As an example, in a second invalidity action filed in 2012 based on an alleged incompatibility with prior famous word and word & device trademarks for RED BULL of the OPPOSER, the Nullity Division of OHIM did not consider the famous trademarks RED BULL and to be similar with TORO and therefore rejected the purported claim that the TORO trademark would unduly exploit the reputation of the RED BULL trademarks. The decision rejecting this second invalidity action of the OPPOSER was rendered in December 2013 and already became final.

"6. The OPPOSER also tried to prevent CTM 1.500.917 "TORO & DEVICE" from issuing to registration in classes 32, 33 and 43 based on its whole battery of trademarks, including its prior Austrian trademark registrations for the signs TORO ROSSO and TORO ROJO filed in the year 1998 for goods in classes 32 and 33. OHIM granted the opposition for certain goods in classes 32 and 33 only because of the presence of TORO ROSSO and TORO ROJO trademarks at that time.

"7. The opposition proceeding and the ensuing appeal proceeding before OHIM were even followed by another appeal to the CFI filed by OPPOSER in the year 2007 in order to further delay the proceedings. However, since OPPOSER had never used the TORO ROSSO and TORO ROJO trademarks for beverages, the trademarks became voluntarily cancelled by OPPOSER in light of an imminent revocation due to lack of use.

"8. Both parties have since been involved in several trademark law conflicts in various jurisdictions over the years, OPPOSER citing confusing similarity and alleging damage to its reputation. It was not successful.

"C. THE MARKS CAN COEXIST IN THE MARKET FOR GOODS IN CLASS 32.

"9. It was therefore surprising that OPPOSER had proposed to tolerate use of the trademark TORO XL for energy drinks in Spain and Portugal under the condition that RESPONDENT would limit distribution of the product to these two countries only (letter from OPPOSER'S counsel dated May 16,2007 addressed to RESPONDENT). Spain was, at that time, about the fifth most important market for Red Bull worldwide in terms of turnover.

10. This proves that even the OPPOSER agrees that the marks were not incompatible and that the marks can coexist in the market for goods in class 32 and that there will be no dilution of the mark.

"11. The ordinary consumer will not be confused when the marks are both sold in the marketplace. TORO is a translation of the word BULL and not RED BULL. Even the commercial impression leaves no doubt that TORO is clearly distinct from RED BULL.

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"12. The OPPOSER has no monopoly of the trademark BULL. Trademark Law was not devised to protect concepts as proven by the many trademarks worldwide on these classes with bull devices or the term TORO. There are many instances in jurisdictions all over the world of trademarks containing the same concept but represented so differently that there are no similarities between the trademarks and they can thus coexist since there is no risk of confusion.

"13. The foreign judgments in RESPONDENT'S favor also clearly prove this point.

"D. THE APPLICATION CAN PROCEED FOR GOODS IN CLASSES 25 AND 33.

"14. The OPPOSER'S goods are in class 32. It does not have use for goods in classes 25 and 33. There is no connection between the OPPOSER'S goods in class 32 and that of the RESPONDENT'S goods in classes 25 and 33.

"15. As earlier stated, RESPONDENT'S OSBORNE BULL DEVICE is a well-known mark for goods in class 33. The TORO mark will also be used for goods in class 33.

"16. There will be no likelihood of confusion between the marks TORO and RED BULL for goods in class 25, such as clothing.

"E. RESPONDENT IS RELYING ON THE STRENGTH OF ITS BRANDS AND NOT RIDING ON THE POPULARITY OF OPPOSER.

"17. RESPONDENT is a company that does not need to trade on the goodwill, reputation or notoriety of OPPOSER'S marks. It has been in existence since 1772, way before the OPPOSER was established.

"18. The RESPONDENT can stand on its own repute. It has a vast trademark portfolio that includes a Spanish trademark for "TORO" in class 33.

"19. It is wrong to impute malice or bad faith and state that the mark TORO is a usurpation of the mark RED BULL."

Respondent-Applicant's evidence consists of the following:

1. Legalized and authenticated Special Power of Attorney;
2. Printout of article entitled "The Osborne Bull dominating the Spanish Landscape" dated 08 September 2011 from the website www.spainholiday.com;
3. Printout of article entitled "The Black Bulls of Spain: The Truth" dated 31 May 2012 from the website www.ulookubook.com;
4. Printout of relevant pages from the Osborne webpage;
5. Copy of trademark registration for the mark TORO with a BULL Device issued by OHIM;
6. Copy of Trademark Registration No. 002844264 for the mark TORO issued by OHIM;
7. Copy of Trademark Registration No. 001319185 for the mark TORO issued by OHIM;
8. Copy of a letter dated 16 May 2007 addressed to Respondent from Opposer's counsel.

9. Legalized and authenticated Affidavit of Adela Larios Rivas;
10. List of license agreements between Grupo Osborne SA and several companies and the list of web pages;
11. Copy of Catalogue for Osborne Bull Device and TORO products sold under license.
12. Chart on the various proceedings initiated by Respondent-Applicant against the Austrian mark Red Bull before Austrian Patent Office;
13. Copy of the Writ of Summons in Summary Injunction Proceedings of the District Court of The Hague;
14. Copy of Trademark Registration No. 004769279 for the mark TORO XL issued by OHIM;
15. Catalogue of Osborne alcoholic and beverage products;
16. Catalogue of TORO clothing products of Respondent-Applicant; and
17. Catalogue of other TORO products of Respondent-Applicant.

On 11 February 2016, the case was referred to the Alternative Dispute Resolution (ADR) Services for mediation conference, however, the parties failed to settle their dispute. On 15 September 2016, the preliminary conference was terminated and the parties were directed to submit position papers. On 10 October 2016, Respondent-Applicant filed its Position Paper while Opposer did so on 21 October 2016.

Should the Respondent-Applicant's mark **TORO** be registered?

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 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.⁴

Records will show that at the time Respondent-Applicant filed its application for registration of the mark TORO on 05 September 2014, Opposer already has an existing registration for the mark RED BULL. As such, the certificate of registration in its name is a prima facie evidence of the validity of its registration, its ownership of the mark and its exclusive right to use it in connection with the goods and/or services and those that are related thereto, pursuant to Section 138 of the IP Code. Thus, the Opposer has the right to oppose the application for registration of a mark which is identical or similar to its marks, as in this case.

Incidentally, it is worth to note that the RED BULL mark has been declared as a well-known mark for Class 32. In *T.C. Pharmaceutical Industries, Inc. v. Osborne Y Compania S.A.*⁵, the Director General ruled to wit:

A scrutiny of the records shows that the Appellant submitted substantial evidence to prove the international reputation of its goods under Class 32 bearing the marks DOUBLE BULL DEVICE and RED BULL, particularly, its energy-drink products. It presented evidence of the registration of its marks not only here in the Philippines but also in other countries such as Thailand, Hong Kong, Indonesia, Singapore, China, Cambodia, Myanmar, Vietnam, Taiwan, Korea, Australia, Brunei, Malaysia and Laos. It also submitted copies of promotional materials and leaflets used in Australia, the United States of America, and the countries in

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

⁵ Appeal No. 14-07-21 (IPC No. 14-2006-00029, 16 September 2010).

Europe and Asia like the United Kingdom and India, respectively. It also claims that, in Thailand alone, it has spent more than \$28 Million on advertisement and promotion for the years, 2003 and 2004 and presented sales invoices from this country.

Apropos is the case of *Sehwani, Incorporated VS. IN-N-OUT Burger, Inc.* wherein the Supreme Court concurred with the findings and conclusions of the Bureau of Legal Affairs that the mark "IN-N-OUT" was an internationally well-known mark. The Director based her findings on the evidence presented by the complainant consisting of worldwide registration of the mark, almost all of which were issued earlier than the respondent's date of filing of its application. Considered together with the evidence of advertisements of such mark by the complainant, "IN-N-OUT" was found to be an internationally well-known mark pursuant to paragraphs (a) and (d) of Rule 102 of the Trademark Regulations.

Accordingly, considering that at least a combination of any of the criteria set forth under the Trademark Regulations were met, RED BULL is deemed a well-known mark.

Again, in *Red Bull A.G. v. Wilson Dy Go*⁶, the Director of the Bureau of Legal Affairs declared the mark RED BULL mark also as well-known, to wit:

The Opposer has obtained trademark registrations worldwide for its mark RED BULL (Exhibit "4" to the Affidavit of Dr. Volker Viechtbauer which is marked as Exhibit "B"). Likewise Opposer's products has been extensively sold in more than 157 countries worldwide and promoted through television, cinemas and radio as well as print media. xxx

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Obviously, the Opposer has sufficiently established the presence or concurrence of the criteria or at least a combination thereof for the mark RED BULL to be considered as a well-known mark under the aforesaid rule.

Accordingly, the Respondent-Applicant's trademark application shall be evaluated on the basis of paragraphs (e) and (f) of Sec. 123.1 of the IP Code, to wit:

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

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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.

⁶ Decision No. 13-141 IPC No. 14-2012-00169

Pursuant to the above-cited provisions, a mark cannot be registered if it is identical with, or confusingly similar to, or constitutes a translation of a mark, which is considered to be well-known. The proscription applies if the applicant's goods or services are identical or similar with those covered by the well-known mark, regardless whether the well-known mark is registered here in the Philippines. The prohibition also applies even if the goods or services are not similar provided that the well-known mark is registered in the Philippines and that the use of the mark applied for registration in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered well-known mark and that the interests of the owner of the well-known registered mark are likely to be damaged by such use.⁷

The Opposer and Respondent-Applicant's trademarks are reproduced below for comparison.



Opposer's Marks



Respondent-Applicant's Mark

A comparison of the competing marks would show that Respondent-Applicant's mark consist of the word "TORO" which although not similar to Opposer's RED BULL mark, connotes and conveys the same meaning or idea, which is a "bull" or cattle. The Director General has also held that:

Obviously, the marks are neither identical nor similar. However, the words and the pictorial representations connote the same idea or concept, which is the male cow or cattle. "Toro" is the Spanish word or term for "bull". Significantly, paragraphs (e) and (f) of Sec. 123.1 of the IP Code mention not only identical or confusingly similar mark, but also a mark which constitutes a translation of well-known mark.

Thus, the translation or meaning of the word mark also provides a basis for claiming that it is or is not confusingly similar to another mark. Especially, in a country like the Philippines which has a rich multilingual history, the remnants of which are evident in the vernacular language, in making the necessary comparison between marks in different languages, regard must be accorded to the concept or idea conveyed by a mark. In one case in the United States, it was held that "closeness in meaning can itself substantiate a claim of similarity of trademarks." Our own Supreme Court held in *The George .W Luft Company, Inc. vs. Ngo Guan and Director of Patents* that:

Moreover, the word 'Tango' has a well established meaning, for it describes a particular dance that is well known in the Philippines. In fact, respondent's label includes the picture of a man and a woman dancing.⁸

Thus, this Bureau cannot allow the registration of the mark TORO for goods under Class 32.

However, Respondent- Applicant also applied for the registration of the mark TORO in Classes 25 and 33. In this regard, Section 123.1 (f) prohibits the registration of a mark for dissimilar goods if it would indicate a connection between those goods, and the owner of the registered well-

⁷ Supra, note 5.

⁸ Supra.

known mark and that the interests of the owner of the well-known registered mark are likely to be damaged by such use.

In *246 Corporation, doing business under the name and style of Rolex Music Lounge v. Hon. Reynaldo B. Daway*⁹, the Court said:

A junior user of a well-known mark on goods or services which are not similar to the goods or services, and are therefore unrelated, to those specified in the certificate of registration of the well-known mark is precluded from using the same on the entirely unrelated goods or services, subject to the following requisites, to wit:

1. The mark is well-known internationally and in the Philippines. Under Rule 102 of the Rules and Regulations on Trademarks; Service Marks, Trade Names and Marked or Stamped Containers, in determining whether a mark is well known, the following criteria or any combination thereof may be taken into account:

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2. The use of the well-known mark on the entirely unrelated goods or services would indicate a connection between such unrelated goods or services and those goods or services specified in the certificate of registration in the well known mark. This requirement refers to the likelihood of confusion of origin or business or some business connection or relationship between the registrant and the user of the mark.

3. The interests of the owner of the well-known mark are likely to be damaged. For instance, if the registrant will be precluded from expanding its business to those unrelated good, or services, or if the interests of the registrant of the well-known mark will be damaged because of the inferior quality of the good or services of the user.

As already discussed, the mark RED BULL is a well-known mark. However, as to the second requirement, this Bureau finds that the use of the mark TORO for goods other than Class 32, would not indicate a connection to the goods where the well-known mark RED BULL is used. Again, this issue has been ruled upon by the Director General, to wit:

As to the second requisite of indicating a connection between the unrelated goods and the goods and services of the registered trademark owner, this Office opines that unlike where confusion exists because of the resemblance or similarity in the visual and aural components of competing marks, associating one mark with another through the translation or the meaning of the words or phrases or device comprising the marks, requires a higher level of mental exercise. Illiterates and those who do not speak Spanish or English, or at least understand those words, would not be able to tell that BULL and TORO may have meant the same thing, idea or concept.

People who see the mark TORO on a label or package of a product would not think of the Appellant's mark or connect it with the Appellant unless the goods on which the mark TORO is used are the same goods for which the RED BULL or BULL marks are already

⁹ G.R. No. 157216. November 20, 2003

identified with. The likelihood of association is remote with respect to goods which the Appellant does not deal in or to goods which do not bear the RED BULL and BULL marks.

Consequently, since no connection is likely to be made by the ordinary purchaser between the Appellant's goods under Class 32 and that of the Appellee under the other classes, there is likewise no likelihood that the interests of the Appellant would be damaged so as to preclude it from expanding its business to those unrelated goods.¹⁰

While Opposer has registered the mark RED BULL for class 25, there is no indication that Opposer has expanded its business to include sale of apparels or clothing as to create a confusion between Respondent-Applicant's goods under class 25 and its goods under the same class.

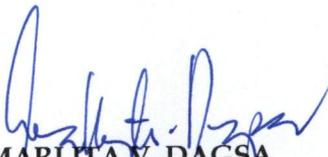
Further, records will show that Respondent has been engaged in the business of alcoholic beverages such as spirits and wines under class 33. Through its continued use of the mark, it has gained considerable goodwill and reputation for its products. Its products have certain class of purchasers or consumers that will not be confused that Respondent-Applicant's alcoholic beverages is anyway related to the Red Bull energy drinks of the Opposer.

Hence, this Bureau finds that the competing marks are confusingly similar for goods under Class 32 but not for the others. Without the likelihood of confusion with goods belonging to classes other than Class 32, there can be no damage to the interests of the Opposer.

WHEREFORE, premises considered, the instant opposition is hereby *SUSTAINED* only with respect to goods falling under Class 32 while the opposition against the registration of the subject mark with respect to goods under Classes 25 and 33 is hereby *DENIED*. Consequently, the trademark application for the registration of the mark "TORO" bearing Application Serial No. 4-2014-011142 for Classes 25 and 33 of the International Classification of goods is, as it is hereby, GIVEN DUE COURSE. Let the filewrapper of Trademark Application Serial No. 4-2014-011142, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 12 DEC 2017.


MARLITA V. DAGOSA
Adjudication Officer
Bureau of Legal Affairs

¹⁰ Supra, note 5.