



DABJAJQ, LLC.,
Opposer,

IPC No. 14-2011-00269
Opposition to:

- versus -

Appln. Serial No. 4-2010-014047
Date Filed: 29 Dec. 2010
TM: 007

FINANSCONSULT EOOD,
Respondent-Applicant.

Decision No. 2012- 62

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DECISION

DABJAJQ, LLC. (“Opposer”)¹ filed on 16 August 2011 an opposition to Trademark Application Serial No. 4-2011-014047. The application, filed by FINANSCONSULT EOOD (“Respondent-Applicant”)², covers the mark “007” for use on “*cigarettes and cigars and products for smokers, namely: ashtrays, lighters, matches*” under Class 34 of the International Classification of Goods or Services.³

In its opposition, the Opposer alleges that the Respondent-Applicant’s mark applied for registration is confusingly similar to the Opposer’s “007” trademarks which has been registered in many countries including the Philippines. According to the Opposer, its “007” marks are well known marks.

The Opposer’s evidence consists of the following:

1. Exh. “A”: Affidavit of the authorized officer of DANJAJQ, LLC;
2. Exh. “A-1”: printout of box office receipts for the last six films in the 007 Series of Films from <http://boxofficemojo.com>;
3. Exh. “A-2”: printout of “non-USA” box office receipts for *Quantum of Solace* and *Casino Royale* in the Philippines from <http://boxofficemojo.com>;
4. Exh. “A-3”: printout of box office receipts for *Quantum of Solace* and *Casino Royale* in the Philippines from <http://boxofficemojo.com>;
5. Exh. “A-4”: printout of worldwide advertising expenses by year and media for the 007 series of films;
6. Exh. “A-5”: printouts samples of movie posters distributed worldwide for the James bond 007 Series of films;
7. Exh. “A-6”: printout from the website <http://www.007.com>;
8. Exh. “A-7”: printout from the website <http://www.jamesbond007store.com>;
9. Exh. “A-8”: printouts of the advertising and various promotional materials used for the

¹ A limited liability company organized under and by virtue of the laws of state of Delaware with address at 2400 Broadway Street, Suite 310, Santa Monica, California 90404, United State of America.

² With address at Altzecco Street, 4000 Plovdiv, Bulgaria.

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

- promotion of 007 in the past;
10. Exh. "A-9": printouts featuring Danjaq's use of the 007 marks in connection with home video;
 11. Exh. "A-10": printout documents with supporting information regarding the use of 007 marks in television;
 12. Exh. "A-11": images of various licensed goods bearing the 007 marks;
 13. Exh. "A-12": printouts of materials featuring 007 in the advertising of various prominent brands;
 14. Exh. "A-13": printouts of materials relating to the use of 007 in licensing programs relating to computer software;
 15. Exh. "A-14": printout from a book on James Bond, *Bond Girls are Forever: The Women of James Bond*;
 16. Exh. "A-15": printout from a book on *James Bond, The Essential James Bond: The Authorized Guide to the World of 007*;
 17. Exh. "A-16": printout from a book on *James Bond, The Incredible World of 007*;
 18. Exh. "A-17": printouts of materials on 007 in relation to goods in class 32;
 19. Exh. "A-18": printouts of campaign brochures from the 007 Series of Films featuring SMIRNOFF vodka;
 20. Exh. "A-19": campaign brochures featuring 007's influence on the habit of drinking alcohol;
 21. Exh. "A-20": advertisement for Finlandia Vodka with the 007 Mark;
 22. Exh. "A-21": Smirnoff advertisement featuring the 007 Marks;
 23. Exh. "A-22": printout of screen captures of Diageo/Smirnoff television and video commercial released in 2008 stating that SMIRNOFF is "JAMES BOND'S" vodka.
 24. Exh. "A-23": printout of advertisements for BOLLINGER champagne featuring 007.
 25. Exh. "A-24": printout of images of other alcohol related merchandise, such as beverage-ware, shirt, and cocktail shakers featuring 007;
 26. Exh. "A-25": printout of Coca Cola advertisements featuring the 007 Marks for *Quantum of Solace*;
 27. Exh. "A-26": printout of articles on the associated of 007 with Heineken;
 28. Exh. "A-27": printout of a merchandising license agreement between Danjaq LLC and Heineken;
 29. Exh. "A-28": printouts of the advertising materials featuring and prominently displaying the 007 trademark with Heineken;
 30. Exh. "A-29": printouts of photos featuring various merchandise, such as playing cards and jackets with the 007 trademark Heineken;
 31. Exh. "A-30": printout of an article on James Bond from magazine Cigar Africionado;
 32. Exh. "A-31": printout of the merchandising license agreement between Danjaq LLC and S.T. Dupont, maker of smoking accessories;
 33. Exh. "A-32": photos featuring cuff links, key chains, and other accessories such as cigar humidor and ashtrays displaying the mark 007;
 34. Exh. "A-33": photos featuring cuff links, key chains, and other accessories such as cigar humidor and for men featuring the 007 mark;
 35. Exh. "A-34": photos of the golden gun, which was actually composed of a pen, a cufflink, a lighter, and a cigarette case with the 007 trademark;
 36. Exh. "A-35": printouts of the royalties statement and information on the production of the golden gun replicas;
 37. Exh. "A-36": photos of Zippo lighters bearing the 007 AND GUN DESIGN mark;
 38. Exh. "A-37": printout of the decision by The Office for Harmonization in the internal Market (OHIM) where the European Community found that the 007 Marks were famous;

39. Exh. "A-38": printout of the decision in the cyber squatting case Danjaq, LLC vs. Conquerer involving the domain name (spy-007.com);
40. Exh. "A-39": printout of the decision by The United States Patent and Trademark Office, Trademark Trial and Appeal Board stating that the 007 marks "*have achieved substantial recognition and fame*";
41. Exh. "A-40": printout of the decision by Chile's Tribunal de Propiedad Industrial, in TPI Case Record No. 752 2007 ruling that the 007 Mark is "*public and common knowledge*";
42. Exh. "A-41": printout of the decision by industrial property office in the Czech Republic rejecting an application for the STAVEBNINY 007;
43. Exh. "A-42": printout of the decision by the Canada patent and trademark office in an opposition against the mark "007", "007 pizza & Subs" and "007 Submarine" in association with a restaurant business, stating that the opposed marks are confusingly similar to the well known mark 007;
44. Exh. "A-43": a list of registrations around the world for 007 and related marks;
45. Exh. "A-43-a": certified true copy of U.S Trademarks Reg. No. 1,739,332 for 007;
46. Exh. "A-43-b": certified true copy of Australian Reg. No. 487018 for 007;
47. Exh. "A-43-c": certified true copy of Community Reg. No. 009141037 for 007;
48. Exh. "A-44": photocopy of Reg. No. 23022 for 007, Andorra;
49. Exh. "A-44-01": photocopy of Reg. No. 23021 for 007, Andorra;
50. Exh. "A-44-02": photocopy of Reg. No. 894822 for 007, Australia;
51. Exh. "A-44-03": photocopy of Reg. No. A487017 for 007, Australia;
52. Exh. "A-44-04": photocopy of Reg. No. KH 24348/06 for 007, Cambodia;
53. Exh. "A-44-05": photocopy of Reg. No. KH 24353/06 for 007, Cambodia;
54. Exh. "A-44-06": photocopy of Reg. No. KH 26015/07 for JAMES BOND 007, Cambodia;
55. Exh. "A-44-07": photocopy of Reg. No. KH 26016/07 for JAMES BOND, Cambodia;
56. Exh. "A-44-08": photocopy of Reg. No. KH 26017/2007 for JAMES BOND 007, Cambodia;
57. Exh. "A-44-09": photocopy of Reg. No. KH 26018/2007 for JAMES BOND 007, Cambodia;
58. Exh. "A-44-10": photocopy of Reg. No. 3040004 for JAMES BOND 007, China;
59. Exh. "A-44-11": photocopy of Reg. No. 3040010 for JAMES BOND 007, China;
60. Exh. "A-44-12": photocopy of Community Reg. No. 002461150 for JAMES BOND 007;
61. Exh. "A-44-13": photocopy of Community Reg. No. 001204882 for JAMES BOND 007;
62. Exh. "A-44-14": photocopy of Community Reg. No. 000251900 for 007;
63. Exh. "A-44-15": photocopy of Community Reg. No. 2277614B for 007, Great Britain and Northern Ireland;
64. Exh. "A-44-16": photocopy of Community Reg. No. 4617719 for JAMES BOND 007, Japan;
65. Exh. "A-44-17": photocopy of Community Reg. No. 1398669 for 007, Japan.
66. Exh. "A-44-18": photocopy of Community Reg. No. 01349561 for 007, China;
67. Exh. "A-44-19": photocopy of Community Reg. No. 01352102 for 007, China;
68. Exh. "A-44-20": photocopy of Community Reg. No. 01136249 for JAMES BOND 007, China;
69. Exh. "A-44-21": photocopy of Community Reg. No. 00173916 for JAMES BOND 007, China;
70. Exh. "A-44-22": Photocopy of Community Reg. No.000316703 for 007;
71. Exh. "A-45": photocopy of Reg. No. 2.128.500 for 007 AND GUN DESIGN, Argentina;
72. Exh. "A-45-01": photocopy of Reg. No. 2.202.861 for 007 AND GUN DESIGN, Argentina;
73. Exh. "A-45-02": photocopy of Reg. No. 895340 for 007 AND GUN DESIGN, Australia;

74. Exh. "A-45-03": photocopy of Reg. No. 462682 for JAMES BOND 007 AND GUN DESIGN, Benelux;
75. Exh. "A-45-04": photocopy of Reg. No. 823505391 for 007 AND GUN DESIGN, Brazil;
76. Exh. "A-45-05": photocopy of Reg. No. 823505383 for 007 AND GUN DESIGN, Brazil;
77. Exh. "A-45-06": photocopy of Reg. No. TMA453,736 for JAMES BOND 007 AND GUN DESIGN, Canada;
78. Exh. "A-45-07": photocopy of Reg. No. 167107 for JAMES BOND 007 AND GUN DESIGN, Iran;
79. Exh. "A-45-08": photocopy of Reg. No. 2455031 for JAMES BOND 007 AND GUN DESIGN, Japan;
80. Exh. "A-45-09": photocopy of Reg. No. 906922 for 007 AND GUN DESIGN, Mexico;
81. Exh. "A-45-10": photocopy of Reg. No. 232952 for JAMES BOND 007 AND GUN DESIGN, Norway;
82. Exh. "A-45-11": photocopy of Reg. No. 4-2003-007594 for 007 AND GUN DESIGN, Philippines;
83. Exh. "A-45-12": photocopy of Reg. No. 241 002 for JAMES BOND 007 AND GUN DESIGN, South Africa;
84. Exh. "A-45-13": photocopy of Reg. No. 01136249 for JAMES BOND 007, China;
85. Exh. "A-45-14": photocopy of Reg. No. 01047711 for JAMES BOND 007, China;
86. Exh. "A-45-15": photocopy of Reg. No. 20967 for JAMES BOND 007 AND GUN DESIGN, Andorra;
87. Exh. "A-45-16": photocopy of Reg. No. 2.034.215 for 007 AND GUN DESIGN, Argentina;
88. Exh. "A-45-17": photocopy of Reg. No. 046283 for 007 AND GUN DESIGN, Benelux;
89. Exh. "A-45-18": photocopy of Reg. No. 3040012 for 007 AND GUN DESIGN, China;
90. Exh. "A-45-19": photocopy of Reg. No. 3040006 for 007 AND GUN DESIGN, China;
91. Exh. "A-45-20": photocopy of Reg. No. 300061965 for 007 AND GUN DESIGN, Hong Kong;
92. Exh. "A-45-21": photocopy of Reg. No. 1298583 for 007 AND GUN DESIGN, India;
93. Exh. "A-45-22": photocopy of Reg. No. IDM000004698 for 007 AND GUN DESIGN, Indonesia;
94. Exh. "A-45-23": photocopy of Reg. No. IDM000004699 for 007 AND GUN DESIGN, Indonesia;
95. Exh. "A-45-24": photocopy of Reg. No. 172115 for 007 AND GUN DESIGN, Israel;
96. Exh. "A-45-25": photocopy of Reg. No. 2536090 for 007 AND GUN DESIGN, Japan;
97. Exh. "A-45-26": photocopy of Reg. No. 3186123 for 007 AND GUN DESIGN, Japan;
98. Exh. "A-45-27": photocopy of Reg. No. 4613923 for 007 AND GUN DESIGN, Japan;
99. Exh. "A-45-28": photocopy of Reg. No. 2455032 for 007 AND GUN DESIGN, Japan;
100. Exh. "A-45-29": photocopy of Reg. No. 04008963 for 007 AND GUN DESIGN, Malaysia.
101. Exh. "A-45-30": photocopy of Reg. No. 04008964 for 007 AND GUN DESIGN, Malaysia;
102. Exh. "A-45-31": photocopy of Reg. No. 04008965 for 007 AND GUN DESIGN, Malaysia;
103. Exh. "A-45-32": photocopy of Reg. No. 835013 for 007 AND GUN DESIGN, Mexico;
104. Exh. "A-45-33": photocopy of Reg. No. 835014 for 007 AND GUN DESIGN, Mexico;
105. Exh. "A-45-34": photocopy of Reg. No. 857485 for 007 AND GUN DESIGN, Mexico;
106. Exh. "A-45-35": photocopy of Reg. No. 684405 for 007 AND GUN DESIGN, New

- Zealand;
107. Exh. "A-45-36": photocopy of Reg. No. 684406 for 007 AND GUN DESIGN, New Zealand;
 108. Exh. "A-45-37": photocopy of Reg. No. 684850 for 007 AND GUN DESIGN, New Zealand;
 109. Exh. "A-45-38": photocopy of Reg. No. T03/12372H for 007 AND GUN DESIGN, Singapore;
 110. Exh. "A-45-39": photocopy of Reg. No. T03/12373F for 007 AND GUN DESIGN, Singapore;
 111. Exh. "A-45-40": photocopy of Reg. No. 632470 for 007 AND GUN DESIGN, South Korea;
 112. Exh. "A-45-41": photocopy of Reg. No. 45-0016151 for 007 AND GUN DESIGN, South Korea;
 113. Exh. "A-45-42": photocopy of Reg. No. 359699 for 007 AND GUN DESIGN, Switzerland;
 114. Exh. "A-45-43": photocopy of Reg. No. 01136250 for 007 AND GUN DESIGN, China;
 115. Exh. "A-45-44": photocopy of Reg. No. 01047712 for 007 AND GUN DESIGN, China;
 116. Exh. "A-45-45": photocopy of Reg. No. 00174761 for 007 AND GUN DESIGN, China;
 117. Exh. "A-45-46": photocopy of Reg. No. TM257947 for 007 AND GUN DESIGN, Thailand;
 118. Exh. "A-45-47": photocopy of Reg. No. SM32599 for 007 AND GUN DESIGN, Thailand;
 119. Exh. "A-45-48": photocopy of Reg. No. 028517 for 007 AND GUN DESIGN, Venezuela;
 120. Exh. "A-45-49": photocopy of Reg. No. 1,739,332 for 007 AND GUN DESIGN, U.S.;
 121. Exh. "A-45-50": photocopy of Reg. No. 3,878,949 for 007 AND GUN DESIGN, U.S.;
 122. Exh. "A-46": printout of the Phil. Reg. No. 4-2003-007594;
 123. Exh. "A-47": printout of the Phil. Reg. No. 4-2003-007592;
 124. Exh. "A-48": printout of the Phil. Reg. No. 4-2007-12634;
 125. Exh. "A-49": printout of the 007 And GUN DESIGN featured by OHIM as a famous number mark;
 126. Exh. "A-50": printout of the Phil. Reg. No. 4- 2010-014047 for 007;
 127. Exh. "B": Affidavit of Mr. Christopher Dolan with copies of decisions upholding the renown of the 007 marks; and
 128. Exh. "C": Affidavit of Mr. Christopher Dolan with copies of the Trademark certificates for the 007 marks.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 19 September 2011. The Respondent-Applicant, however, did not file an answer.

Should the Respondent-Applicant's trademark application be allowed?

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 Thus, Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services of if it nearly resembles such mark as to be likely to deceive or cause confusion.

There is no doubt that the competing marks are practically identical. In this regard, records and evidence show that at the time the Respondent-Applicant filed its trademark application on 29 December 2010, the Opposer already has an existing trademark registration in the Philippines for the mark “007 and Gun Design”, particularly, Reg. No. 4-2003-007594 issued on 15 January 2007, which covers “*scientific, nautical, surveying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life saving and teaching apparatus and instruments; coin or counter-freed apparatus; talking machines cash registers; calculating machines; fire-extinguishing apparatus*” under Class 9 and “*education and entertainment*” under Class 41. The aforementioned goods, however, are not similar to the goods indicated in the Respondent-Applicant’s Trademark Application Serial No. 4-2010-014047. Be that as it may, the registration of the mark “007” in favor of the Respondent-Applicant should not be allowed.

The Opposer submitted evidence to prove that at least a combination of the following criteria for determining whether a mark is a well-known mark, set forth under Rule 102 of the Trademarks Regulations, concurs:

1. 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;
2. the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
3. the degree of the inherent or acquired distinction of the mark;
4. the quality-image or reputation acquired by the mark;
5. the extent to which the mark has been registered in the world;
6. the exclusivity of registration attained by the mark in the world;
7. the extent to which the mark has been used in the world;
8. the exclusivity of use attained by the mark in the world;
9. the commercial value attributed to the mark in the world;
10. the record of successful protection of the rights in the mark;
11. the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and

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

12. 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.

The Opposer's evidence includes proof of the registrations or applications for the registration of its "007" in many countries including the Philippines; the extensive program of the said party's worldwide licensing, merchandising and cross-promotional campaigns featuring the "007" marks on a wide variety of goods and services in nearly every consumer product category; licensing agreements with companies such as S.T. Dupont making smoking accessories, high end lighters and other cigar accessories such as cigar humidor and ashtrays; and decisions or rulings of courts and tribunals in other countries that the "007" marks are famous and deserving of protection across international classes.

Sec. 123.1, pars. (e) and (f) of the IP Code provide that a mark shall not be registered if it:

(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;

Also, this Bureau noticed that the Opposer's mark is derived from the famous fictional British character "secret agent James Bond" whose "code" is "007". In essence, the Opposer's mark is therefore highly distinctive and unique. The mark's ownership could easily be traced to the Opposer or its predecessors-in-interest.

Thus, it is highly improbable that the Respondent-Applicant came up with a mark that is practically identical to the Opposer's by pure chance or coincidence. The Respondent-Applicant did not explain how it arrived at using the same mark.

Corollarily, the field from which a person may select a trademark is practically unlimited. As in all other cases of colourable imitation, the unanswered riddle is why, of the millions of terms and combination 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.⁵

⁵ *American Wire & Cable Company v. Dir. of Patents*, G.R. No. L-26557, 18 Feb, 1970.

Because the Opposer's mark is unique and highly distinctive, just by looking at the Respondent-Applicant's mark would likely create an impression that this is owned by the Opposer and *vice-versa*. The consumers may assume that the Respondent-Applicant's products originate from the Opposer or believe that there is a connection between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:⁶

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily 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 there is some connection between the plaintiff and defendant which, in fact does not exist.

Moreover, it is emphasized that one's right to register a trademark is derived from his or her ownership thereof. The Opposer in this instant has established its ownership of the mark. To allow the Respondent-Applicant to register "007" in its favor would definitely unjustly deprive the Opposer of its ownership of the mark or of its right to exercise acts of ownership thereof.

To conclude, it is stressed that the law on trademarks and tradename is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster, and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another.⁷

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2010-014047 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 April 2012.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

⁶ See *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

⁷ *La Chemise Lacoste v. Judge Oscar C. Fernandez, et al.* (G.R. No. L-63796-97 02 May 1984) and *Sujajani v. Ongpin, et al.* (G.R. No. L-65659 02 May 1984), citing *Baltimore v. Moses*, 182 Md. 229, 34 A (2d) 338.