



**T.C. PHARMACEUTICAL INDUSTRIES
CO., LTD.,**
Opposer,

-versus-

MR. VICHAI KULWUTHIVILAS,
Respondent-Applicant.

x-----x

} **IPC No. 14-2010-00224**
} Opposition to:
} Appln. Serial No. 4-2010-000228
} Date filed: January 7, 2010
} **TM: "RED RAM & DEVICE"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 100 dated May 21, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 21, 2015.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



T.C. PHARMACEUTICAL INDUSTRIES
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IPC No. 14-2010-00224

Opposition to:
Appln. No. 4-2010-000228
Filed on: January 7, 2010
Trademark: "RED RAM
& DEVICE"

Decision No. 2015- 100

DECISION

T.C. PHARMACEUTICAL INDUSTRIES¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-000228. The application, filed by Vichai Kulwuthivilas² ("Respondent-Applicant"), covers the mark "RED RAM & DEVICE" for use on "energy drink (as a non-alcoholic beverage), beer, mineral water, aerated waters, syrups, fruit drinks, fruit juice, other non-alcoholic drinks, other preparations for making beverages" under Class 32 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"1. Opposer is filing the present Opposition under the following laws:

- a. Section 123 (d) of the Intellectual Property Code (Republic Act 8293) - which states that a mark cannot be registered if it:
x x x
- b. Section 123 (e) of the Intellectual Property Code (Republic Act 8293) - which states that a mark cannot be registered if it:
x x x
- c. Section 123 (f) of the Intellectual Property Code (Republic Act 8293) - which states that a mark cannot be registered if it:
x x x
- d. Section 3 and 160, et. seq., of Republic Act 8293, which read:
x x x

"2. Opposer has been previously upheld by this Honorable Office in three (3) similar cases namely: (1) IPC No. 14-2006-00028 T.C. Pharmaceutical Industries Co., Ltd., vs. Osborne Y. Compania S.A.; (2) IPC No. 14-2007-00289 T.C. Pharmaceutical

¹A foreign corporation organized and existing under the laws of Thailand, with principal office at 288 Ekachai Road, Bangbon Sub-District, Bangbon District, Bangkok 10150, Thailand.

²With address at 48/68-70 Village No. 5, Wongwaen Robnok Road, Bang Bon Sub-District, Bang Bon District, Bangkok, Thailand.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

Industries Co., Ltd. vs. Emmanuel L. Libunao; and (3) IPC No. 14-2008-00255 T.C. Pharmaceutical Industries Co., Ltd. vs. Grupo Osborne, S.A.

"2.a. In IPC No. 14-2006-00028 entitled T.C. Pharmaceutical Industries Co., Ltd. vs. Osborne Y Compania S.A., Opposed the application of Respondent for the mark, 'DEVICE OF A BULL,' which is a pictorial representation of a BULL. The device mark involved in the said inter-partes case is similar if not identical to the device of herein Respondent, Mr. Vichai Kulwuthivilas. Finding confusing similarity between Opposer's mark and that of Respondent therein, this Honorable Office ruled that:

"The combination of the word mark RED BULL and DOUBLE BULL device presents a very unique and distinctive choice of word/device combination to arrive at a registrable trademark for an energy drink, this concept of associating a bull for an energy drinks becomes Opposer's source identifier. Consequently, Respondents' use of the same BULL device for beverages or goods falling or belonging to classes 29, 30 & 32 creates or becomes a source of confusion between competing marks because the subject trademark application is identical to or closely resembles Opposer's registered trademarks RED BULL and DOUBLE BULL DEVICE. Anyone is likely to be misled by the adoption of the same BULL device for beverages' (Decision No. 07-49, pp. 5-6).

"Further, this Honorable Office held that:

"What added to the confusion is the use of these competing marks for identical or similar goods: beers, mineral and aerated waters and other non-alcoholic drinks; fruit juices; syrups and other preparations for making beverages (class 32).

"The goods involved, henceforth, flow through the same channels of trade and are of the same as they both constitute beverages. These are commodities that are seen or brought in the market or groceries. The fact that products as such are classified as common day-to-day or household items are marketed similarly would likely result in confusion (Decision No. 07-49, p. 7).

"Finally, this Honorable Office concluded that:

"Being the prior user and registrant of the marks RED BULL and DOUBLE BULL DEVICE in the Philippines and abroad, Opposer is the actual owner thereof. Wherefore, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED (Decision No. 07-49, p.8).

"2.b. In IPC No. 14-2007-00289 entitled T.C. Pharmaceutical Industries Co., Ltd. vs. Emmanuel L. Libunao, this Honorable Office declared that:

"Being the prior user and registrant of the marks RED BULL and DOUBLE BULL DEVICE in the Philippines and abroad, Opposer is the actual owner thereof. Wherefore, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED (Decision No. 07-49, p.8).

"2.c. While in the two aforementioned inter-partes case, this Honorable Office found that Respondents' pictorial representation of a BULL was confusingly similar to that of Opposer's registered marks, this Office went further in IPC No. 14-2008-00255, entitled T.C. Pharmaceutical Industries Co., Ltd. vs. Grupo Osborne S.A. wherein this Honorable Office found that Respondent's DEVICE which consist of the word 'TORO' inside a rectangular device is likewise incapable of registration for being confusingly similar to that of herein Opposer's registered mark.

"This Office held therein that:

"A careful perusal of the competing marks shows that they are not literally the same visually and aurally, but they nevertheless give rise to a likelihood of confusion of goods and confusion of business as the meaning of the words evoke the same aural and visual impressions and connotations. 'Toro' is the Spanish word for 'bull'. Said word is sometimes used as a Filipino colloquialism for the bull. Notwithstanding the literal difference of the words in terms of spelling and saying it, what immediately comes to mind when the competing marks are spoken or read alternately is the image of a bull or bulls. When these image/s are created in the mind and connected to the goods to which they are attached, the likelihood of confusion is heightened: The image/s of a bull/s connote/s vigor, vitality, and/or strength, implying that the alcoholic and non-alcoholic products of either party produce or enhance these qualities or at least are associated with such qualities. The delineation of which products belong to whom is blurred.

"Thus, even a purchaser from the sector who patronizes the products of the parties might likely be induced to believe that the goods of one party are those of the other party and/or that, at the least, there is some connection between opposer and respondent-applicant which, in fact, does not exist. There is likelihood not only of confusion of goods but also confusion of business. Similarity in size, form and color, while relevant, is not conclusive. Neither duplication/imitation, or the fact that the infringing label suggests an effort to emulate is necessary. The competing marks need only contain the main, x x x (Decision No. 2009-110, pp. 11-12).

"3. Opposer is the owner of the marks 'DOUBLE BULL DEVICE' and 'RED BULL', having used, registered and popularized the same in various countries of the world. In the Philippines, Opposer has filed an application for registration of the marks (a) 'DOUBLE BULL DEVICE' and (b) 'RED BULL' for the following goods: beer, mineral and aerated waters and other non-alcoholic drinks; fruit juices; syrups and other preparations for making beverages in Class 32 on July 16, 1993. Opposer's mark 'DOUBLE BULL DEVICE' was registered on March 29, 1995 per Certificate of Registration No. 60093 while Opposer's 'RED BULL' was registered on March 14, 1995, per Certificate of Registration No. 60086.

On the other hand, this application for registration of the mark RED RAM & DEVICE, which clearly bears the same connotation as the mark of herein Opposer as a wild animal with characteristics of being aggressive and wild, was only filed on January 7, 2010 for the same class 32, which are exactly the same goods of Opposer.

"4. Clearly, Opposer's marks 'DOUBLE BULL DEVICE' and 'RED BULL' were filed and registered much earlier than that of Respondent's.

"5. Opposer have been using its marks for 13 years now, having first used and adopted the same as early as 1993. In the Philippines, Opposer has first used the mark 'DOUBLE BULL DEVICE' and 'RED BULL' on June 30, 1993. Opposer's products bearing the marks are currently distributed in the Philippines by Energy Food and Drinks, Inc., of 119-E, West Avenue, Quezon City, the Philippines.

"6. Clearly, Opposer is the rightful owner of the mark 'DOUBLE BULL DEVICE' and 'RED BULL', having used, adopted and registered the same in the Philippines and on several countries in the world much earlier than Respondent.

"Being the owner of the marks, Opposer has sought the registration of the same in Thailand and in various countries of the world, including Philippines, Hongkong, Indonesia, Singapore, China, Cambodia, Myanmar, Vietnam, Taiwan, Korea, Australia, Brunei, Malaysia and Laos.

"7. Through widespread and extensive use by the Opposer in most parts of the world, Opposer's marks have acquired inherent or acquired distinction and notoriety.

"8. Opposer has developed goodwill and reputation for its marks 'DOUBLE BULL DEVICE' and 'RED BULL' through extensive promotion, worldwide registrations and use.

"9. Opposer has built, for its marks 'DOUBLE BULL DEVICE' and 'RED BULL', superior quality-image or reputation through its long use characterized by high standards.

"10. From the foregoing, it is apparent that Opposer's marks satisfy the criteria set by the Rules and Regulations Implementing RA 8297 to be considered as well-known marks, entitled to protection under Section 123 (e) and (f) of R.A. 8293.

"11. Respondent-Applicant's mark 'RED RAM & DEVICE' which has a 'BULL' device and Opposer's marks 'DOUBLE BULL DEVICE' and 'RED BULL' are confusingly similar, and hence, will cause confusion among their prospective market, coupled by the fact that the goods covered are the same or related, sold in the same channels and belonging to the same Class 32.

"12. Considering the above circumstances, registration is proscribed by R.A 8293 Section 123 (d).

"13. If allowed contrary to existing laws and jurisprudence, Respondent's use of the mark 'RED RAM & DEVICE' which means is confusingly similar to Opposer's marks 'DOUBLE BULL DEVICE' and 'RED BULL', will indicate a connection between the latter's goods and those of Respondent's, and will likely mislead the buying public into believing that the goods of Respondent's are produced or originated from or are under the sponsorship of Opposer, to the detriment and damage of Opposer's interests, considering the goods are the same or related.

"14. Opposer hereby alleges that the Respondent-Applicant's adoption of 'RED RAM & DEVICE' trademark which means the same as Opposer's 'DOUBLE BULL DEVICE' and 'RED BULL', was clearly done with the illegal intent of riding on the popularity and goodwill of Opposer's quality-built reputation and will cause great and irreparable damage and injury to the Opposer.

"15. Further, Respondent-Applicant is clearly in bad faith in so using and adopting the subject trademark 'RED RAM & DEVICE', and which is the same as Opposer's 'DOUBLE BULL DEVICE' and 'RED BULL' which Opposer have, because of its prior use and registration, gained worldwide notoriety for said marks.

"16. Attached to this Notice of Opposition are labels of Opposer's marks 'DOUBLE BULL DEVICE' and 'RED BULL'.

"17. Opposer reserves the right to present such other documents as may be necessary to prove its foregoing allegations, in the course of the proceedings.

The Opposer's evidence consists of the legalized and authenticated Verified Notice of Opposition; the Affidavit-Testimony of its witnesses, Ms. Pavana Langthara and Mr. Saravoot Yoovidhya, authorized directors of Opposer; Certificate of Registration No. 60086 for the trademark RED BULL; Certificate of Registration No. 60093 for the trademark DOUBLE BULL DEVICE; copy of Decision No. 2007-49 dated 30 April 2007; copy of Decision No. 2009-110 dated 24 August 2009; and the special power of attorney appointing Saludo Fernandez Aquino & Taleon Law Offices as its true and lawful attorney-in-fact for IPC No. 14-2010-00224.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 05 November 2010. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark RED RAM & DEVICE?

The Opposer anchors its opposition on Sections 123.1, paragraphs (d), (e) and (f), 3 and 160 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

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

x xx

- (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

⁴Marked as Exhibits "A" to "K", inclusive.

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 likely to be damaged by such use”.

Sec. 3. *International Conventions and Reciprocity* - Any person who is a national or who is domiciled or has a real and effective industrial establishment in a country which is a party to any convention, treaty or agreement relating to intellectual property rights or the repression of unfair competition, to which the Philippines is also a party, or extends reciprocal rights to nationals of the Philippines by law, shall be entitled to benefits to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of an intellectual property right is otherwise entitled by this Act.

Sec. 160. *Rights of Foreign Corporation to Sue in Trademark or Service Mark Enforcement Action* - Any foreign national or judicial person who meets the requirements of Section 3 of this Act and does not engage in business in the Philippines may bring a civil or administrative action hereunder for opposition, cancellation, infringement, unfair competition, or false designation of origin and false description, whether or not it is licensed to do business in the Philippines under existing laws.

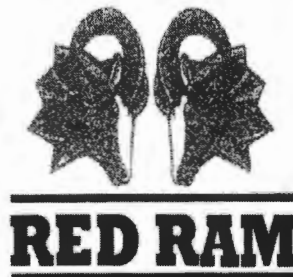
Records show that at the time the Respondent-Applicant filed its trademark application on 07 January 2010, the Opposer already owns trademark registrations for “RED BULL” and “DOUBLE BULL DEVICE”, under Reg. Nos. 60086 and 60093 respectively. The registrations cover “beer, mineral and aerated waters and other non-alcoholic drinks; fruit juices; syrups and other preparations for making beverages” in Class 32.

A comparison of the competing marks reproduced below:

Opposer's trademarks DOUBLE BULL DEVICE AND RED BULL



Respondent-Applicant's mark



shows that confusion is likely to occur. The fact that the Respondent-Applicant's mark depicts "ram" instead of a "bull" is of no moment. The distinctive feature of the Opposer's mark is the mirror image of an animal. In one version or variant of the Opposer's mark, this image is accompanied by the words "RED BULL". The Respondent-Applicant's mark is a colorable imitation of the Opposer's mark is evident in the way it coined it was coined. It also has mirror image of a "ram" and the words "RED RAM". Because the Respondent-Applicant's trademark application covers goods that are similar to the Opposer's, particularly, beer, mineral water, aerated waters, syrups, fruit drinks, fruit juice, other non-alcoholic drinks, other preparations for making under Class 32, it is likely that the consumers will have the impression that these goods originate from a single source or origin or the RED RAM being a variation of the RED BULL marks, as if in launching a new line of products. That consumers will likely to commit such mistake or belief is underscored by the fact that the Opposer's RED BULL trademark has been declared by the Director General of the Intellectual Property Office of the Philippines in Appeal No. 14-07-21 (IPC No. 14-2006-00029 entitled T.C. Pharmaceutical Industries Co., Ltd. vs. Osborne Y Compania S.A.) as well-known. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁵

⁵*Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.

It is emphasized that the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁶ This Bureau finds that the mark applied for registration by the Respondent-Applicant does not meet the function.

Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.⁷ The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-000228 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 21 May 2015.


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

⁶*Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepa v. Director of Patents*, *supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

⁷*American Wire & Cable Company v. Director of Patents*, G.R. No. L-26557, 18 Feb. 1970.