IP PHL
INTELLECTUAL PROPERTY OFFICE OF THE PHILIPPINES

UNIVERSAL ROBINA CORPORATION, Petitioner,	}	**IPC No. 14-2010-00037**
	}	Cancellation of:
	}	Reg. No. 4-2004-008586
	}	Date Issued: February 12, 2007
-versus-	}	**TM: "COCA-COLA C2"**
	}	
	}	
	}	
THE COCA-COLA COMPANY, Respondent-Registrant.	}	
x----------x		

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 30 dated January 28, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 28, 2016.

For the Director:

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

IP PHL
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OF THE PHILIPPINES

UNIVERSAL ROBINA CORPORATION, *Petitioner,*	**IPC No. 14-2010-00037**
-versus-	**Cancellation of:** **Reg. No. 4-2004-008586** **Date Issued: 12 February 2007** **Trademark: "COCA-COLA C2"**
THE COCA-COLA COMPANY, *Respondent-Registrant.*	
x----------x	*Decision No. 2016-* 30

DECISION

UNIVERSAL ROBINA CORPORATION ("Petitioner") filed a petition to cancel Trademark Registration No. 4-2004-008586. The registration, issued in favor of THE COCA-COLA COMPANY ("Respondent-Registrant"), covers the trademark "COCA-COLA C2" for use as "*non-alcoholic beverages, drinking waters, flavored waters, mineral and aerated waters, soft drinks, energy drinks and sport drinks; fruit drinks and juices; syrups; concentrates and powders for making beverages including flavored waters, mineral and aerated waters, soft drinks, energy drinks, sports drinks, fruit juices and juices*" under Class 32 of the International Classification of Goods and Services.[1]

The Petitioner alleges:

x x x

"FIRST GROUND: FAILURE TO FILE DECLARATION OF ACTUAL USE

"7. Section 124.2 of R.A. 8293 requires the applicant or the registrant to file a declaration of actual use of the mark with evidence to that effect, as prescribed by the Regulations, within three (3) years from the filing date of the application. Otherwise, the applicant shall be refused or the mark shall be removed from the Register by the Director.

"8. Relevantly, Rule 204 of the Rules and Regulations on Trademarks provides that the Office will not require any proof of use in commerce in the processing of trademark applications. However, without any need of any notice from the Office, all applicants or registrants, shall file a declaration of actual use of the mark with evidence to that effect within three years from the filing date of the application, without possibility of extension, from the filing date of application. Otherwise, the application shall be refused or the mark shall be removed from the register by the Director motu propio.

"9. Within three (3) years from the date of its application for trademark registration on 15 September 2004, respondent did not file the required Declaration of Actual Use ('DAU') for the mark 'COCA-COLA C2.'

[1]The 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

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"SECOND GROUND: ABANDONMENT OF MARK

"10. Moreover, respondent has not used the mark 'COCA-COLA C2' in commerce since it filed its application for trademark registration on 15 September 2004. It has neither promoted nor distributed products using the mark 'COCA-COLA C2'. Respondent's failure to file the required Declaration of Actual Use ('DAU') within three (3) years from the date of its application for trademark registration clearly shows that it has effectively abandoned or withdrawn any right of interest in its trademark 'COCA-COLA C2.'

"THIRD GROUND: TRADEMARK INFRINGEMENT

"11. Respondent's trademark 'COCA-COLA C2' is confusingly similar to petitioner's trademark mark 'C2 COOL & CLEAN GREEN TEA AND DEVICE' as to be likely to deceive or cause confusion among the consuming public, to the damage and prejudice of the petitioner.

"12. Petitioner is the earlier applicant for registration of the mark 'C2 COOL & CLEAN GREEN TEA AND DEVICE' on 12 March 2004, which was granted registration on 17 August 2006 under Certificate of Registration NO. 4-2004-002401. Respondent filed its application for the registration of the mark 'COCA-COLA C2' at a later date on 15 September 2004 and was granted registration only on 08 January 2009.

"13. Petitioner has used the mark 'C2 COOL & CLEAN GREEN TEA AND DEVICE' as early as February 2004. Petitioner likewise has sought registration of the said trademark in several countries within the region, including Australia and New Zealand.

"14. Petitioner has developed goodwill and superior reputation for its mark 'C2 COOL & CLEAN GREEN TEA AND DEVICE' through registration, extensive promotion, and actual use in commerce. Through its marketing efforts, petitioner has propelled the subject trademark and its product to top-of-mind status among Filipino consumers.

"15. Respondent has maliciously presented and has given the dominant element of petitioner's mark, i.e. the name 'C2', such general appearance and pronunciation that has given rise to a colorable imitation of petitioner's mark that in turn has given rise to a confusing similarity between the two marks that is likely to cause confusion and even deception among the consuming public as to the origin of the goods, to the prejudice of petitioner. Respondent's use of the mark will likely mislead the buying public into believing that the goods of respondent are produced from, or under the sponsorship of petitioner or vice versa.

"16. Confusion between petitioner's and respondent's products, as well as the source of the same, is very likely, especially considering that both marks cover the same and/or closely related goods. Both petitioner and respondent's mark are for use in connection with goods classified under International Class 32 and moreover, are for products that are essentially ready to drink beverages which will pass through the same channels of commerce. A comparison of the two marks is hereto attached x x x

"17. Even assuming that the goods for which respondent's mark shall be used is not the same or similar to the goods for which petitioner's mark is used, the registration of the mark 'COCA-COLA C2' nonetheless indicates a connection between the goods of petitioner with that of respondent, to the damage and prejudice of petitioner. The cancellation of the registration of respondent's mark under the foregoing circumstances is warranted under Section 123.1 (f).

"18. Respondent's registration of the mark 'COCA-COLA C2' allows respondent to benefit from the superior quality and reputation carefully built by petitioner for its own product, resulting to a loss of distinctiveness of petitioner's trademark, to the detriment and damage of petitioner's interests.

The Petitioner's evidence consists of a copy of the Certificate of Registration No. 4-2004-002401 for the trademark C2 COOL & CLEAN GREEN TEA AND DEVICE; copy of the Declaration of Actual Use dated March 2007 for the trademark C2 COOL & CLEAN GREEN TEA AND DEVICE; copy of the Certificate of Registration No. 4-2004-008586 for the trademark COCA-COLA C2; copy of the Certification issued by the Bureau of Trademarks for Trademark Registration No. 4-2004-008586; and, a picture of the two competing marks or labels.[2]

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Registrant on 17 March 2010. Said Respondent-Registrant, however, did not file an Answer.

Should Trademark Registration No. 4-2004-008586 issued in favor of Respondent-Registrant be cancelled?

Records show that at the time the Respondent-Registrant filed its trademark application on 15 September 2004, the Petitioner already filed trademark application for C2 COOL & CLEAN GREEN TEA AND DEVICE under Application Serial No. 4-2004-002401 on 12 March 2004. The trademark application of Petitioner matured into a registration on 17 August 2006. This Bureau noticed that the goods indicated in the Respondent-Registrant's trademark application for COCA-COLA C2 are similar and/or closely-related to the Petitioner's.

But, are the competing marks, as shown below, resemble each other such that confusion, or even deception is likely to occur?

[2] Marked as Exhibits "A" to "H", inclusive.

COCA-COLA C2

Petitioner's trademark *Respondent-Registrant's mark*

In this regard, what draws the eyes and the ears with respect to the Respondent-Registrant's mark is the word "C2". "C2" is the prominent, in fact, the definitive feature of the Petitioner's trademark C2 COOL & CLEAN GREEN TEA AND DEVICE covered under Trademark Registration No. 4-2004-002401. Trademark Registration No. 4-2004-002401 covers *"ready-to-drink iced tea"* under Class 32, product or goods which the Respondent-Registrant deals in under the COCA-COLA C2 mark which covers *"non-alcoholic beverages, drinking waters, flavored waters, mineral and aerated waters, soft drinks, energy drinks and sport drinks; fruit drinks and juices; syrups; concentrates and powders for making beverages including flavored waters, mineral and aerated waters, soft drinks, energy drinks, sports drinks, fruit juices and juices"* in Class 32. It is likely therefore, that a consumer who wishes to buy beverages or drinks and is confronted with the mark COCA-COLA C2, will think or assume that the mark or brand is just a variation of or is affiliated with the Petitioner's C2 COOL & CLEAN GREEN TEA AND DEVICE trademark.

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.[3]

Moreover, attached to the Petitioner's evidence is a Certification issued by the Bureau of Trademarks on 20 November 2009 stating that no Declaration of Actual Use ("DAU") has been filed for Trademark Registration No. 4-2004-00858 for the mark COCA-COLA C2, which registration was issued to Respondent-Registrant THE COCA-COLA COMPANY on 12 February 2007 . The non-filing of the requisite DAU shall

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

result in the removal of the mark from the Trademark Registry of the Intellectual Property Office. Section 123.2 of R.A. 8293 states:

> Sec. 124. *Requirements of Application*. - x x x 124.2. The applicant or the registrant shall file a declaration of actual use of the mark with evidence to that effect, as prescribed by the Regulations within three (3) years from filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the Register by the Director.

Accordingly, this Bureau finds that the registration of COCA-COLA C2 for goods in Class 32 is proscribed by Sec. 123.1, par. (d) (iii) of the IP Code.

WHEREFORE, premises considered, the Petition for Cancellation is, as it is hereby **GRANTED**. Let the filewrapper of Trademark Registration No. 4-2004-008586 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 January 2016.

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