

MONSTER ENERGY COMPANY,
Opposer,

-versus-

NINTENDO CO., LTD.,
Respondent- Applicant.

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} **IPC No. 14-2014-00497**
} Opposition to:
} Appln. Serial No. 4-2014-000163
} Date Filed: 06 January 2014
} **TM: "POCKET MONSTERS"**
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NOTICE OF DECISION

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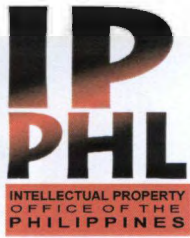
GREETINGS:

Please be informed that Decision No. 2016 - 186 dated June 22, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 22, 2016.

For the Director:

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



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-versus-	}	Opposition to:
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	}	
	}	Decision No. 2016 - <u>186</u>
x-----x		

DECISION

Opposer, MONSTER ENERGY CO. ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2014-000163. The application filed by NINTENDO CO., LTD. ("Respondent-Applicant")² covers the mark "POCKET MONSTERS" for use on goods under Classes 9, 16, 28 and 41 of the International Classification of Goods.³

The Opposer alleges the following grounds:

"a. Opposer is the **prior adopter, user and true owner** of the **MONSTER trademark and its variations**;

"b. Respondent's mark **POCKET MONSTERS** is **confusingly similar** to Opposer's internationally well-known **MONSTER trademark and its variations**.

"c. Opposer's **MONSTER trademark and its variations** are **internationally well-known marks** entitled to protection under the provisions of the IP Code and Article 6bis of the Paris Convention.

"d. The registration and use of the trademark **POCKET MONSTERS** by Respondent will **diminish the distinctiveness and dilute the goodwill** of the Opposer's **MONSTER trademarks**."

Opposer's evidence consists of the following:

1. Exhibit "A" - Legalized Power of Attorney;
2. Exhibit "B" to "B-43" - Authenticated Affidavit Direct Testimony of Rodney Cyril Sacks ;
3. Exhibits "B-44 to "B- 49" - list of Opposer's registered **MONSTER** marks and pending applications;

¹ A corporation organized and existing under the laws of Delaware, U.S.A with address at 1 Monster Way, Corona, California, 92879 U.S.A.
² A corporation organized and existing under the laws of Japan with address at 11-1 Hokotate-Cho, Kamitoba, Minami-Ku, Kyoto, Japan.
³The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

4. Exhibits "B-50" to "B-53" - photographs of Opposer's sponsored athlete bearing the MONSTER mark;
5. Exhibits "B-54" to "B-58" - photos of Opposer's products sold in different establishments;
6. Exhibits "B-63" to "B-68" - photographs showing examples of use of the MONSTER marks by Monster sponsored team;
7. Exhibits "B-69" to "B-162" - photographs showing sponsorship of MONSTER in International Sports;
8. Exhibits "B-218" to "B-222" - photos of Opposer's international events sponsorship;
9. Exhibits "B-223" to "B-260" - printouts of Opposer's website and social media presence;
10. Exhibits "B-261" to "B-270" - photos of apparels and merchandise showing MONSTER marks;
11. Exhibits "B-271" to "B-331" copies of articles featuring MONSTER marks;
12. Exhibits "B-332" to "B-385" - pictures of the point of sale items of Opposer;
13. Exhibit "C" - Affidavit of Joy Marie Gabor-Tolentino with Annexes;

This Bureau issued on 22 January 2013 a Notice to Answer and personally served a copy thereof upon the Respondent-Applicant's counsel on 02 February 2015. On 04 March 2015, Respondent-Applicant filed its Answer alleging the following Special and Affirmative Defenses:

"A. Respondent-Applicant's trademark 'POCKET MONSTERS' is not confusingly similar to Opposer's mark 'MONSTER' and its variants.

"2. Respondent-Applicant has used and registered the mark POCKET MONSTERS in other countries well before Opposer's mark was launched.

Respondent-Applicant's evidence consists of the following:

1. Exhibit "A" - certified copy of Japan Certificate of Registration No. 4302113 for the mark POCKET MONSTERS registered in 06 August 1999 for Class 9;
2. Exhibit "B" - certified copy of Japan Certificate of Registration No. 4373387 for the mark POCKET MONSTERS registered in 07 April 2000 for Classes 12, 18, 20, 24, 29, 35, 38 and 41 ;
3. Exhibit "C" - Printout from IPOPHL's Trademark Database of Respondent's trademark application for the mark POCKET MONSTERS filed on 16 April 1998;
4. Exhibit "D" - List of Respondent's registrations of its POCKET MONSTERS mark in various countries worldwide; and
5. Exhibits "E" to "J" - various clippings/articles about Respondent's POCKET MONSTERS video games.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation on 17 March 2015. On 22 July 2012, the Bureau's ADR Services submitted a report that the parties failed to settle their dispute. During the preliminary conference on 14 September 2015, the same was terminated and the parties were

directed to submit position papers. On 02 October 2015, Respondent-Applicant filed its Position Paper while Opposer did so on 05 October 2015.

Should the Respondent-Applicant's mark **POCKET MONSTERS** be allowed registration?

Section 123.1 (d) of the 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, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

The records show that at the time the Respondent-Applicant filed its application for the mark **POCKET MONSTERS** on 06 January 2014, the Opposer already has an existing registration for the trademark **MONSTER**, **MONSTER ENERGY**, **M MONSTER ENERGY**, among others, covering goods falling under classes 5, 32, 33, 16. Opposer's **MONSTER** marks are used on goods ranging from *dairy based beverages, coffee based beverages, alcoholic, nutritional supplements in liquid form, non-alcoholic beverages, ready to drink tea and iced tea* to name a few. On the other hand, Respondent-Applicant's **POCKET MONSTER** is used on "*downloadable programs for consumer video game machines; paper and cardboard; cards for trading card games; game machines and apparatus; and educational and instruction services relating to arts, crafts, sports or general knowledge*" to name a few under classes 9, 16, 28 and 41. As such, Opposer's and Respondent-Applicant's goods are non-competing or not related.

But are the marks of the parties confusingly similar as to likely cause confusion, mistake or deception among the consumers?



MONSTER ENERGY

MONSTER

Opposer's Marks

POCKET MONSTERS

Respondent-Applicant's Marks

Respondent-Applicant's mark is similar to Opposer's in so far as the word "MONSTER" which is one of Opposer's mark is present in its mark **POCKET MONSTERS**. However, this Bureau finds that the presence of the word "MONSTER" in Respondent-Applicant's marks is inadequate to establish a finding of confusing similarity between the competing marks to sustain the opposition. The word "MONSTER" which means "an imaginary creature that is typically large, ugly, and frightening" is a word commonly used as a trademark. That is why, in

this Office's Trademark Registry there are numerous trademark registrations and applications in various classes bearing the word "MONSTER" such as: "MONSTER TAIL", " MONSTER SQUAD", "COOKIE MONSTER", "MONSTER HUNTER" and "MONSTER STRIKE", among others. This only shows that Opposer has not exclusively appropriated the word "monster" to the exclusion of others. This also underscores the fact that "MONSTER" is widely used as a trademark and taken alone is not very distinctive as to effectively identify the source of goods or services. Hence, what will determine whether the competing trademarks are confusingly similar are the other words or symbols present in the marks. Respondent-Applicant's mark also contains the word "POCKET" to form the mark "POCKET MONSTERS" which Opposer has not adopted. Moreover, as earlier pointed out, the parties goods are non-competing and not related. Similarity in the marks does not automatically prevents one from registering its mark when such mark is used on unrelated, dissimilar or non-competing goods. In *Philippine Refining Co., Inc. vs. Ng Sam and The Director of Patents*⁴, the Court ruled:

A rudimentary precept in trademark protection is that the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods." Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

Section 138 of the R.A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code) provides, to wit:

SECTION 138. Certificates of Registration. — A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.

In this regard, a certificate of registration gives the registrant the right to exclusively use its mark only in connection with the goods/services as specified in the registration and those related thereto. Thus, when the goods or businesses of the parties are non-competitive and their products so unrelated, the use of similar trademarks is not likely to give rise to confusion, mistake or deception the public, much less cause damage to Opposer.

In addition, it is worth to note that Respondent-Applicant's mark has been associated with Respondent's Pokemon video game based media franchise. In Japan, the mark POCKET MONSTERS was registered as early as 1997. In the Philippines, Respondent originally applied for registration of POCKET MONSTERS in 1998. As such, it cannot be said that Respondent-Applicant merely adopted the similar trademark to ride on the popularity of Opposer's mark.

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

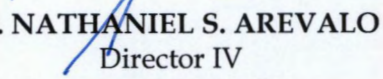
⁴ *G.R. No. L-26676, July 30, 1982*

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.⁵ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby *DISMISSED*. Let the filewrapper of Trademark Application Serial No. 4-2014-000163, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 22 JUN 2016



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

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.