

MONSTER ENERGY COMPANY,
Opposer,

-versus-

MATT IAN J. BARON,
Respondent-Applicant.

X-----X

} **IPC No. 14-2014-00047**
}
} Opposition to:
} Appln. Serial No. 4-2013-502945
} Date Filed: 09 October 2013
}
}
} **TM: MUFFIN MONSTER**
}

NOTICE OF DECISION

CARAG JAMORA SOMERA & VILLAREAL LAW OFFICE

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MATT IAN J. BARON


Respondent- Applicant
143 Luke Wright Street,
Dumaguete 6200

GREETINGS:

Please be informed that Decision No. 2017 - 237 dated 20 June 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, 20 June 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

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Opposer, }
-versus- }
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IPC No. 14-2014-00047
Opposition to:
Application No. 4-2013-502945
Date Filed: 09 October 2013
Trademark: "MUFFIN MONSTER"
Decision No. 2017- 237

DECISION

MONSTER ENERGY COMPANY¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-502945. The application, filed by Matt Ian J. Baron² ("Respondent-Applicant"), covers the mark "MUFFIN MONSTER" for use on "*muffins, bread, pastries, cakes, cupcakes, cookies and other baked goods*" under Class 30 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
"GROUNDS RELIED UPON FOR THIS OPPOSITION

"8. Opposer is the owner of numerous trademark registrations for its MONSTER and MONSTER ENERGY Marks, and is the Registrant in the Philippines of the following Marks with their respective registration details, to wit:

x x x

"9. Opposer is also the owner of numerous trademark registrations for its MONSTER and MONSTER ENERGY Marks, and is the Registrant in various countries of said Marks.

x x x

"10. The Respondent-Applicant's registration of his mark MUFFIN MONSTER, chiefly contravenes Section 123.1 subparagraph (d) of Republic Act No. 8293 ('R.A. No. 8293' or the 'IP Code'), that states, to wit:

x x x

"11. Respondent-Applicant's mark, particularly the term 'MONSTER' appearing as a prominent portion of said composite mark, so resembles the Opposer's Marks, as to be likely when applied to or used in connection with the Respondent-

¹With address at 1 Monster Way, Corona, California 92879, U.S.A.sd

²With address at 143 Luke Wright Street, Dumaguete, 6200, Philippines.

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.

Applicant's goods, to deceive or cause confusion with those of Opposer's goods/lines of business bearing the Opposer's Marks.

"12. The use by Respondent-Applicant of the mark MUFFIN MONSTER on goods that are similar, identical or closely related to the Opposer's goods that are produced by, originate from, offered by, or are under the sponsorship of herein Opposer bearing the latter's Marks, will greatly mislead the purchasing/consumer public into believing that Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer.

"13. Opposer has not abandoned the use in other countries around the world, including here in the Philippines, of its Marks.

"14. By virtue of the prior and continued use of the Opposer's Marks in many countries around the globe made by herein Opposer, said Marks have become popular and internationally well-known ones, including here in the Philippines, and have established valuable goodwill for the Opposer with the purchasing/consumer public, which has identified Opposer as the owner and the source of goods and/or products bearing said Opposer's Marks.

"15. In view of the foregoing, the Respondent's mark may also be considered in contravention of Section 123.1 (f) of our IP Code, which states, to wit:

x x x

"16. In support of this Opposition, Opposer shall prove and rely upon, among others, the following:

"(a) The Opposer is the true owner of the 'MONSTER' and 'MONSTER-formative' Marks for goods and/or products bearing said Marks, which have been registered in the Opposer's name and/or are the subjects of registrations obtained/applications for registration filed, in many jurisdictions around the world, including here in the Philippines. A certified copy of a list of these registrations/applications is marked and attached hereto as Opposer's Collective Exhibit 'VV' to form an integral part hereof.

"Also marked and attached hereto as Opposer's Collective Exhibit 'WW', to form an integral parts hereof, are certified copies of the Affidavit of Opposer's witness, Mr. Rodney Cyril Sacks, Chairman and Chief Executive Office of Monster Beverage Corporation and its subsidiaries including herein Opposer, Monster Energy Company, said Affidavit's complete annexes.

x x x

"(b) Opposer has been commercially using its Marks in the U.S.A, since at least as early as April 18, 2002; and commenced using its Marks elsewhere around the world since 2003, as attested to by Opposer's witness in paragraph 6 of his Affidavit marked as Collective Exhibit 'WW'; which uses all precede the use, if any, made by Respondent-Applicant of his MUFFIN MONSTER mark. Opposer currently sells its MONSTER Energy, MONSTER Khaos, and MONSTER Energy Absolutely Zero products here in the Philippines.

"(c) Apart from Opposer being the originator of the 'MONSTER' and 'MONSTER-formative' Marks used on Opposer's goods and/or products, which

products have been marked, promoted, distributed, offered for sale, and/or sold in many jurisdictions around the world, Opposer manifests that to date, it has sold in the year 2012 alone, more than 2 billion cans of the afore-enumerated products worldwide. Opposer's gross sales for the year ended 31 December 2012 increased to US\$2.37 billion from US\$1.95 billion in 2011, and from US\$1.489 billion in 2010. MONSTER energy drinks have represented 92.3%, 91.2% and 89.9% of total net sales for the years ended December 2012, 2011 and 2010, respectively. Retail sales of Opposer's MONSTER energy drinks outside of the United States in 2012 are estimated to be more than US\$1 billion. Already mentioned as having been marked and attached hereto as Opposer's Collective Exhibit 'WW' to form an integral part hereof, is a duly executed, notarized Affidavit of the Opposer's witness, attesting to the foregoing matters/sales figures as stated in paragraphs 12 and 13 of said Affidavit.

(d) In further support of Opposer's claim that its Marks have gained international fame as ones belonging to the Opposer, the latter manifests that it has undertaken and made extensive publicity and promotion of its Marks in internationally-circulated publications and exposure on television, on the Internet, and at live events, that have attracted a large following. Certified copies of samples of proofs of these promotional/advertising/marketing efforts, are marked and attached hereto collectively as Opposer's documentary Exhibit 'YY'. The latter are identified and attested to by a certified copy of a separate duly signed, notarized and legalized Supplemental Affidavit from Opposer's witness, Mr. Sacks, that is marked and attached hereto as Opposer's documentary Exhibit 'XX', to form an integral part hereof.

x x x

(e) Mr. Sacks executed further Supplemental Affidavits that provide among others, information pertaining to the use in the Philippines of products bearing Opposer's MONSTER line of marks, with the Philippine launch of its products taking place in August 2012, as well as additional information/documents pertaining to the Opposer's use and sales of its MONSTER marks through a host of activities conducted around the world. Thus, marked and attached hereto as Opposer's collective documentary Exhibits 'ZZ', are certified true copies of a duly signed, notarized and legalized Supplemental Affidavit and the latter's complete annexes.

x x x

(f) All of the foregoing together with all of the supporting documents that are marked and attached hereto, prove that Opposer's Marks have gained international fame as ones belonging to herein Opposer, following Rule 102 of this Office's Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Container of Goods that provides for the criteria for determining whether a mark is well-known, as follows:

x x x

The Opposer's evidence consists of a copy of a legalized Certificate of Amendment of Certificate of Incorporation from the Secretary of the State of Delaware, U.S.A.; a copy of a Notice of Recordal issued by the BOT in relation to the Opposer's MONSTER mark with Reg. No. 4-2000-012638; copies of Reg. Nos. 4-2010-011798, 4-2010-011797, 4-2012-009123, 4-2010-011796, 4-2009-012638, 4-2011-007042, 4-2010-012110, 4-2011-013987 and 4-2011-014126 for the marks MONSTER, JAVA MONSTER, MONSTER REHABITUATE, MONSTER ENERGY, MONSTER, MONSTER REHAB, X-

PRESSO MONSTER, MONSTER RECOVERY and MONSTER RECOVERY respectively; copies of selected Registration Certificates abroad featuring Opposer's MONSTER Marks; a list of MONSTER and MONSTER-formative registered marks and those pending applications; the Affidavit of Mr. Rodney Cyril Sacks, Chairman and Chief Executive Officer of the Opposer Company; copies of samples of proofs of promotional/advertising/marketing materials of the Opposer pertaining to its MONSTER/MONSTER-formative marks; copy of a duly signed, notarized and legalized Supplemental Affidavit from Opposer's witness, Mr. Sacks attesting to the authenticity of the samples of promotional/marketing materials; and copies of a signed, notarized and legalized further Supplemental Affidavit of Mr. Sacks and its Annexes 1-5.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 24 March 2014. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark MUFFIN MONSTER?

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

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

x x x

- (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;"
- (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 service 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;

Records show that at the time the Respondent-Applicant filed its trademark application on 9 October 2013, the Opposer has existing trademark registrations for the marks JAVA MONSTER, MONSTER and MONSTER ENERGY under Trademark Reg. Nos. 4-2013-6701, 4-2009-12638 and 4-2010-11796 respectively. These registrations cover

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

beverages. On the other hand, Respondent-Applicant's trademark application for the mark MUFFIN MONSTER covers "muffins, bread, pastries, cakes, cupcakes, cookies and other baked goods" under Class 30.

Hence, the question, does MUFFIN MONSTER resemble Opposer's MONSTER marks such that confusion or deception is likely to occur? The marks are shown below:



Opposer's trademarks

Respondent-Applicant's mark

This Bureau finds that confusion or deception is unlikely to occur at this instance. The products or goods covered by the marks are different. Designated as MUFFIN MONSTER, Respondent-Applicant's products are generally baked goods under Class 30. Opposer's products covered under the MONSTER marks are generally beverages under Classes 30 or 32. While the marks are common as to the use of the word MONSTER, the added first word MUFFIN makes it easier for the consumers to distinguish Respondent's MUFFIN MONSTER from Opposer's MONSTER marks.

Moreover, in the Trademark Registry, the contents of which the Bureau can take cognizance of via judicial notice, there are several trademarks carrying the word MONSTER that are registered under Class 30, such as ICE MONSTER (Reg. No. 4-2008-245), MONSTER CRUNCH (Reg. No. 4-2010-11235), MONSTER SPAGHETTI MEATBALLS! (Reg. No. 4-2010-6201), which are owned by entities other than the Opposer.

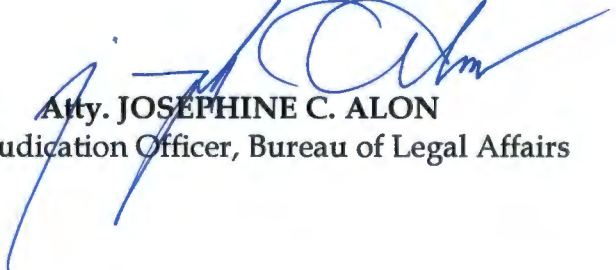
The essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, 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.⁵ This Bureau finds that the Respondent-Applicant's mark sufficiently serves this function.

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

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4/2013/502945 together with a copy of this Decision be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 20 JUN 2017.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs