

FACEBOOK, INC.,
Opposer,

- versus -

LINA PETALVER CELINO,
Respondent-Applicant.

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IPC No. 14-2008-000304
Case Filed on: 17 November 2008

Opposition to:
App. Serial No. 4-2007-013603
Date Filed: 11 December 2007
TM: "FACEBOOK.ASIA"

Decision No. 2010-62

DECISION

FACEBOOK, INC. ("Opposer"), a corporation duly organized and existing under the laws of the State of Delaware, U.S.A., with address at 151 University Avenue, Palo Alto, California 94301, United States of America, filed on 17 November 2008 an opposition to Trademark Application No. 4-2007-013603.¹ The application, filed by LINA PETALVER CELINO ("Respondent-Applicant"), with address at 11 B Sevilla Street, JEM 3, Banlat, Tandang Sora, Quezon City, covers the mark FACEBOOK.ASIA for "use or intended to be used for bringing together, for the benefit of the others, of a variety of goods and/or services by means of the world wide web or internet" under Class 35 of the International Classification of Goods.²

The Opposer alleged the following:

"1. The applied trademark 'FACEBOOK.ASIA' is identical and/or confusingly similar with the trademark 'FACEBOOK', earlier used and adopted by Opposer which dates back to 2004, for which Opposer eventually applied for and was able to secure trademark registrations of its mark 'FACEBOOK'; xxx

"2. x x x

In the Philippines, Opposer has filed its Application No. 4-2008-003293 on 24 March 2008, covering Class 35 as follows, 'providing an online directory information service featuring information regarding, and in the nature of collegiate life, general interests, classifieds, virtual community, social networking, photo sharing and transmission of photographic images; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the internet; providing on-line computer database and on-line searchable database in the field of collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, video sharing and transmission of photographic images; marketing, advertising and promotion services; providing marketing and advertising consultation services; providing market research and information services; providing marketing data; providing marketing tools to provide market information; advertising and information distribution services, namely, providing advertising space via the global computer network; advertising and information distribution services, namely, providing advertising space via the global computer network';

"3. The trademark 'FACEBOOK.ASIA' applied for Respondent-Applicant is identical and confusingly similar to the trademark 'FACEBOOK' owned by Opposer, which is a wellknown mark and used in the whole world, and in the Philippines by

1 The application was published in the Intellectual Property E-Gazette on 18July2008

2 The 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.

almost any internet user, long before Respondent-Applicant's unauthorized use/application of said mark;

"4. The registration of the trademark 'FACEBOOK.ASIA' in the name of Respondent-Applicant will cause confusion and/or the likelihood of confusion as to the services themselves or to their source or origin or will mislead the various internet users in the Philippines, who may associate and connect said mark with Opposer, resulting in possible severe damage and prejudice to both the public and the Opposer;

"5. The registration of the trademark 'FACEBOOK.ASIA' in the name of Respondent-Applicant will violate the proprietary rights and interests of the Opposer over its trademark 'FACEBOOK', and will therefore cause great and irreparable injury to the latter. Opposer has spent a lot of funds for research and development of the products and services bearing the mark 'FACEBOOK', including maintenance thereof, which has extensively been used by world wide users of the internet and likewise, internet users in the Philippines;

"6. The registration of the trademark 'FACEBOOK.ASIA' in the name of Respondent-Applicant will mislead internet users into thinking that Respondent-Applicant is the party responsible for producing and maintaining the services provided by Opposer, or that Respondent-Applicant's use of the 'FACEBOOK.ASIA' mark is sponsored or sanctioned by Opposer. Additionally, Opposer owns and operates the website located at the domain www.facebook.asia. Registration of Respondent-Applicant's mark would also mislead internet users into believing that Respondent-Applicant is the party responsible for producing and maintaining the services provided on Opposer's facebook.asia website;

"7. The registration of the trademark 'FACEBOOK.ASIA' in the name of Respondent-Applicant will run counter to the Memorandum Circulars of the then Minister of Trade and Industry to the Director of Patents on November 20, 1980 and October 25, 1983, directing the Bureau of Patents Trademarks and Technology Transfer to comply with our commitment to the Paris Convention in giving protection to the world famous trademarks, like the Opposer's trademarks, now embodied in Section 123 of the Intellectual Property Code;

"8. The registration of the trademark 'FACEBOOK.ASIA' in the name of Respondent will run counter to Articles 6bis and 8 of The Convention of Paris for the Protection of Industrial Property, otherwise known as the Paris Convention, wherein both the United States and the Philippines are signatories;

x x x

"9. The registration of the trademark 'FACEBOOK.ASIA' in the name of Respondent will run counter to the 1999 Joint Recommendation Concerning Provisions on the Protection of Well-known Marks, wherein the World Intellectual Property Organization (WIPO) General Assembly and the Paris Union agreed to a non-binding recommendation that a well-known mark should be protected in a country even if the mark is neither registered nor used in that country; xxx

x x x

"10. Any use by Respondent-Applicant further of the opposed mark 'FACEBOOK.ASIA' would evidence a bad faith with clear intent to ride on the high reputation of Opposer's mark 'FACEBOOK'. It is obvious that Respondent-Applicant plans to use said opposed mark 'FACEBOOK.ASIA' with fraudulent intent to pass off its goods and services as belonging to Opposer."

"11. Opposer relies on the following facts and circumstances to support this Opposition and reserves its right to present evidence to prove the same and such other facts as may be necessary in the course of the proceedings, depending upon the evidence to be presented by Respondent-Applicant:

"a. Opposer is the owner of the 'FACEBOOK' trademark, having been the first to adopt and use the same in the internet web service worldwide and in the Philippines. The website 'FACEBOOK' has been used in the Philippines at least as early as September 15, 2006. The 'FACEBOOK' trademark which Opposer herein originated is well-known internationally. Its services carried under said trademark has, through time and extensive advertising and web services, earned international acclaim, as well as the distinct reputation of high quality networking services;

"b. Opposer's mark 'FACEBOOK', with worldwide registrations and applications, is well-known internationally and in the Philippines. Opposer has currently over 100 million internet users worldwide, and is the 4th most visited website in the United States. As of November 2007, Opposer has over 200,000 registered users in the Philippines. Opposer's mark has been used and promoted internationally. The 'FACEBOOK' mark has been featured in print, internet and in other types of media. Opposer's services under the 'FACEBOOK' trademark used as a networking tool in the internet, has earned a high degree of reputation and distinction of high quality web networking services;

"c. The mark 'FACEBOOK.ASIA' being applied for by Respondent-Applicant is identical or confusingly similar with the trademark 'FACEBOOK' owned by Opposer and as such, it is likely to deceive the public or cause confusion as internet users will believe that Respondent-Applicant is the source of the services provided by Opposer. Hence, the same cannot be registered pursuant to the provisions of Section 123 of the Intellectual Property Code, including Sections e, f and g of 123.1. Moreover, Opposer currently owns the domain www.facebook.asia and provides services on that site.

"d. By virtue of Opposer's prior and continued use of its trademark 'FACEBOOK' in the Philippines and worldwide, and the large amount spent by Opposer in extensive research and development, web maintenance, said trademark has acquired valuable goodwill among internet users and customers who have identified Opposer's mark as the source of services and products bearing said trademark;

"e. Respondent-Applicant's trademark 'FACEBOOK.ASIA' is but an identical imitation of Opposer's trademark, such that its use in the services of the Respondent-Applicant would infer that the latter's services are connected with the web services maintained by the Opposer as to falsely suggest a connection with existing business of the Opposer (especially in the light of Opposer's ownership of www.facebook.asia domain), and therefore, constitutes an intent to defraud Opposer;

"f. The mark 'FACEBOOK.ASIA' being applied for registration by Respondent-Applicant closely resembles the trademark 'FACEBOOK' of Opposer so as to cause mix-up and confusion between Respondent's and Opposer's goods and services. The confusion is compounded by the fact that Respondent-Applicant intended to ride on the high reputation of the trademark 'FACEBOOK' owned by Opposer as well as its goodwill. Respondent has absolutely no use of the mark 'FACEBOOK.ASIA';

"g. The registration of the trademark 'FACEBOOK.ASIA' diminishes the distinctiveness and strength of Opposer's trademark, which public and internet users and customers have already identified, or associated with Opposer's goods and

services, to the great prejudice and in violation of Opposer's right to said trademark. The interests of the Opposer will definitely be damaged by such unauthorized use."

The Opposer's evidence consists of the following:

1. Exhibit "A" - List of worldwide trademark registrations and applications of Opposer's "FACEBOOK" mark;
2. Exhibit "B" - Copy of the Certificate of Registration of the mark "FACEBOOK" with the African Intellectual Property Organization;
3. Exhibit "C" - Certified copy of the Certificate of Registration of the mark "FACEBOOK" in Australia;
4. Exhibit "D" - Copy of the Certificate of Registration of the mark "FACEBOOK" in Benelux;
5. Exhibit "E" - Copy of the Certificate of Registration of the mark "FACEBOOK" under the Madrid Protocol;
6. Exhibit "F" - Copy of the Certificate of Registration of the mark "FACEBOOK" in European Community;
7. Exhibit "G" - Copy of the Certificate of Registration of the mark "FACEBOOK" in France;
8. Exhibit "H" - Certified copy of the Certificate of Registration of the mark "FACEBOOK" in Greece;
9. Exhibit "I" - Certified copy of the Certificate of Registration of the mark "FACEBOOK" in Hong Kong;
10. Exhibits "J" and "K" - Certified copy of the Certificate of Registration of the mark "FACEBOOK" in Iceland;
11. Exhibits "L", "M", "N" - Certified copy of the Certificate of Registration of the mark "FACEBOOK" in Japan;
12. Exhibits "O" to "S" - Certified copy of the Certificate of Registration of the mark "FACEBOOK" in Mexico;
13. Exhibits "T" and "U" - Certified copy of the Certificate of Registration of the mark "FACEBOOK" in New Zealand;
14. Exhibit "V" - Certified copy of the Certificate of Registration of the mark "FACEBOOK" in Norway;
15. Exhibit "W" - Certified copy of the Certificate of Registration of the mark "FACEBOOK" in Korea;
16. Exhibits "X", "Y", "Z" - Copy of the Certificates of Registration of the mark "FACEBOOK" in Singapore;
17. Exhibits "AA", "BB", "CC" - Certified copy of the Certificates of Registration of the mark "FACEBOOK" in Switzerland;

18. Exhibits "DD" and "EE" -Copy of the Certificate of Registration of the mark "FACEBOOK" in Taiwan;
19. Exhibits "FF", "GG", "HH" -Copy of the Certificates of Registration of the mark "FACEBOOK" in Thailand;
20. Exhibits "II" and "JJ" - Certified copy of the Certificates of Registration of the mark "FACEBOOK" in U.S.A.;
21. Exhibit "KK" - Copy of Opposer's Trademark Application Serial No. 42008-003293 for the mark "FACEBOOK";
22. Authenticated Affidavit of Mr. Richard Nessary;
23. Affidavit of Arturo T. Del Rosario;
24. Affidavit of Maria Luwalhati C. Dorotan;
25. Affidavit of Jerome T. Pampolina;
26. Affidavit of Kristie Anna Pangan;
27. Affidavit of Rachel C. Narvadez;
28. Affidavit of Marcia Munoz Tillman;
29. Affidavit of Jeremiah C. Isip; and
30. Affidavit of Annalee L. Ventura;

This Bureau issued on 08 December 2008 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 15 December 2008. On 13 March 2009, the Respondent-Applicant filed his Verified Answer alleging, to wit:

"1. Respondent-Applicant denies the allegation in paragraph 1 of the Opposition, the truth being that the term 'facebook' has a general usage and meaning such as defined by Boston Law being a 'picture book for freshmen' and under an entry in www.dictionary.com the term refers to a word which means 'a publication for an organization, such as a school or business, which helps members identify each other; also an online version of this, with profiles including a picture, name, birthdate, interests, etc.' and in another entry from the same website, citing Webster's Millennium Dictionary, it means a 'school year book' xxx and in www.wictionary.com it is defined as (a) reference book made or electric directory made up of individual's photographs and names and (b) 'a college publication distributed at the start of the academic year by university administrations with the intention of helping students get to know each other better. x x x

"2. Applicant adopted the term for an intended on-line business directory for goods and services in Asia with member profiles and pictures for their businesses, products and services and added '.asia' to it to identify it as a site with coverage in Asia.

"3. Applicant has come across the term 'facebook' as early as mid to late nineties in her search for a graduate school to attend. While checking out universities, Applicant has seen the name 'facebook'. In thinking of a name for an on-line directory featuring faces of service and goods providers as well as the goods and services they offer, the term came to mind, hence, facebook.asia. xxx

"4. Applicant denies the allegations in paragraph 2 of the Opposition for lack of knowledge as to the truth or falsity of the allegations thereat particularly as to its claim to worldwide trademarks and when they were supposedly acquired.

"5. Opposer applied for the trademark in several classes other than just IC 35 as Applicant's and may not in actual use come into conflict with Applicant's application had the Opposer not usurped on February 14, 2008 the domain name www.facebook.asia in malicious afterthought as there was no actual need for Opposer to acquire that domain name other than to exclude the Applicant from use thereof. xxx

"6. Applicant denies the allegations in paragraphs 3, 4 and 5 of the Opposition, the truth being that the term 'facebook' is a generic term with common usage for decades particularly in schools, colleges and university including that of the Opposer's founder, Mark Zuckerberg's alma mater: Harvard University, which has used the term 'facebook' as early as 1993 (at least) as can be gathered from the university's publication The Harvard Crimson xxx and Philips Exeter Academy where said founder graduated high school xxx; hence, Opposer cannot claim ownership, to the exclusion of others, to the term 'facebook', which by most accounts was derived by Opposer's founder from the term already commonly used by Harvard University and PEA and other academic institutions.

"7. The term 'facebook' is routinely used in various universities and colleges to refer to a picture book or a year book as early as 1978 (at least) by Georgetown Law and Northwestern University, predating even Opposer's founder's birth, and others such as Berkeley Law, Brandeis University, Boston Law xxx;

"8. As early as 1994 there were references in The Crimson to the creation of an on-line facebook, ten (10) years earlier than Opposer's claim, in Harvard University, and there were also such references in 1996, 2003 and 2004 xxx;

"9. In fact, Opposer's trademark registration with the United States Patent and Trademark Office is being challenged on grounds of 'genericness', 'priority of use and confusion' and 'fraud xxx.

"10. Schools that include an on-line facebook include, among others, Georgetown Law, Berkeley Law, Northwestern University, Emory University, Cornell University, Columbia University, Boston College, Yale University, Princeton University, Wharton University, University of Michigan, University of Columbia, Pine Manor College xxx.

"11. Applicant denies the allegation in paragraph 6 of the Opposition, the truth of the matter being that the Opposer usurped the domain name www.facebook.asia only after applicant has filed the registration for the trademark obviously in bad faith upon having knowledge of Applicant's instant application.

"12. Opposer has no exclusive claim to ownership of the term facebook in domain names, there are other websites which include facebook in their domain names such as, among others: www.facebookhaters.coms, www.facebook-cheats.com, www.facebookpresident.com, www.facebookblast.com, www.facebook.fr, www.facebook-boys.com, www.facebook-girls.com, xxx.

"13. Applicant denies the allegations in paragraphs 7, 8 and 9 of the Opposition, the truth of the matter being that the Opposer has no exclusive claim to the term 'facebook' which is a generic term and hence not entitled to protection as exclusive to the Opposer under Philippine Laws, much less under international

conventions or recommendations which require local legislation for their implementation such as the Convention of Paris for the Protection of Industrial Property or the 1999 Joint Recommendation Concerning Provisions on Protection of Well-Known Marks.

“14. In fact it may turn out that even in the country of domicile of Opposer, its trademark may be cancelled either for genericness and/or even fraud in its application and/or prior use thereof by Think Computer Corporation.

“15. Applicant denies the allegations in paragraph 11 of the Opposition for lack of sufficient knowledge to form a conclusion as to the truth or falsity of the allegations thereat.

“16. Applicant denies the allegation that the Opposer’s website has been used in the Philippines as early as September 15, 2006 when its use has been limited or restricted to certain classes of users particularly Ivy Leaguers and students in U.S. schools and went open to the general public only on September 24, 2006 as cited in an article in Wikipedia and others xxx, if ever it may have been an isolated case probably not even by a Filipino national.

“17. Opposer began advertising in the Philippines on or about August 2008 in manifest bad faith since it knows by that time fully well of Applicant’s instant application which by its allegations in its Opposition considers to be in conflict with its own claim to the ‘facebook’ trademark xxx.

“18. Opposer had filed its application for the trademark on March 24, 2008 and Applicant received from Opposer’s counsel a letter dated August 20, 2008 demanding withdrawal of the instant application evidencing Opposer’s prior knowledge thereof.

“19. It is silly and ridiculous in the least and malicious and misleading at its worst Opposer’s allegation that since it owns the www.facebook.asia domain name, which it usurped long after Applicant’s own application for the trademark, Applicant’s prior application was in bad faith .

“20. Opposer’s usurpation of the domain name in bad faith as it has no need for the domain name and has no apparent purpose therefore other than to prevent the Applicant who has prior registration thereof from its use thereby resulting in dislodging of Applicant’s business plans for an on-line business directory and causing irreparable damage and injury to Applicant.”

The Respondent-Applicant submitted the following evidence:

1. Exhibit “1” - printout from the web page of Boston Law;
2. Exhibit “2” and “3” printout from the web page of www.dictionary.com;
3. Exhibit “4” -printout from the web page of www.wiktionary.org;
4. Exhibit “5” and “6” -Affidavit of Lina Petalver Celino and her California LD. No. D5176490;
5. Exhibit “7” - printout of dotasia.org registration information on www.facebook.asia;
6. Exhibits “8” to “12” - printout of relevant articles of The Harvard Crimson;

7. Exhibit "13" -copy of page 1 of a Memorandum from Phillips Exeter Academy Human Resources;
8. Exhibits "14" to "18" - printout of relevant pages from the web page of Georgetown Law and Northwestern University, Berkeley Law, Brandeis University and Boston Law;
9. Exhibits "19" to "24" - printout of relevant articles from the web page of the Harvard Crimson;
10. Exhibit "25" - copy of the Petition for Cancellation filed by Think Computer Corporation against Opposer with the USPTO;
11. Exhibits "26" to "36" - printout of the relevant pages of the web page of Georgetown Law, Berkeley Law, Northwestern University, Emory University, Cornell University, Columbia University, Boston College, Yale University, Princeton University, Wharton University, University of Michigan, Pine Manor College;
12. Exhibits "37" to "43" - printout of the relevant pages from the web pages www.facebookhaters.com,www.facebook-cheats.com,www.facebookpresident.com,www.facebookblast.com,www.facebook.fr,www.facebook-boys.com, www.facebook-girls.com;
13. Exhibit "44" - printout of article downloaded from www.wikipedia.com; and
14. Exhibit "45" -Globe Telecom flyer showing its facebook promo with DTI No. 4206 Series of 2008.

The Opposer filed a Reply on 27 March 2009. On 09 December 2009, the preliminary conference was terminated. Accordingly, this Bureau issued Order No. 2009-195 requiring the parties to submit their respective position papers. Opposer filed its Position Paper on 25 February 2010 while Respondent-Applicant did so on 01 March 2010.

The issues to be resolved in this case are:

1. Whether FACEBOOK is generic or descriptive and therefore, cannot be registered as a trademark;
2. Whether the Opposer's trademark "FACEBOOK" is a well-known mark; and
3. Whether the Respondent-Applicant's trademark "FACEBOOK.ASIA" should be registered.

The Respondent-Applicant raises the issue that the mark "FACEBOOK" is generic or descriptive and therefore cannot be exclusively appropriated and registered. In *Societe Des Produits Nestle, et al. v. Court Of Appeals*³ the Supreme Court explained what constitutes a generic or descriptive mark, to wit:

Generic marks are common words that describe an entire class of goods or services. Generic terms are those which constitute "the common descriptive name of an article or substance," or comprise the "genus of which the particular product is a species," or are "commonly used as the name or description of a kind of goods," or "imply reference to every member of a genus and the exclusion of individuating characters," or "refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular

³ *Societe Des Produits Nestle. et al. vs. Court o f Appeals*. G.R. No. 112012. 4 April 2001.

product,” and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it “forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is,” or “if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods,” or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination.

Also, in *ASIA BREWERY, INC. v. COURT OF APPEALS, ET AL.*⁴, the Supreme Court said:

A word or a combination of words which is merely descriptive of an article of trade, or of its composition, characteristics, or qualities, cannot be appropriated and protected as a trademark to the exclusion of its use by others ... inasmuch as all persons have an equal right to produce and vend similar articles, they also have the right to describe them properly and to use any appropriate language or words for that purpose, and no person can appropriate to himself exclusively any word or expression, properly descriptive of the article, its qualities, ingredients or characteristics, and thus limit other persons in the use of language appropriate to the description of their manufactures, the right to the use of such language being common to all. This rule excluding descriptive terms has also been held to apply to trade-names. As to whether words employed fall within this prohibition, it is said that the true test is not whether they are exhaustively descriptive of the article designated, but whether in themselves, and as they are commonly used by those who understand their meaning, they are reasonably indicative and descriptive of the thing intended. If they are thus descriptive, and not arbitrary, they cannot be appropriated from general use and become the exclusive property of anyone. (52 Am. Jur. 542-543.)

Thus, a generic name of a product can never function as a trademark. It is regarded by law as free for all to use. As such the registration of generic or purely descriptive marks is proscribed because they are the usual way of designating the relevant goods or services or their characteristics. A generic or purely descriptive term is the name of the product or service itself which is the very antithesis of a mark and cannot function as a mark to identify and distinguish the goods or services of one seller.⁵

This Bureau, however, finds that “FACEBOOK” is not generic nor descriptive as a trademark for internet-related services. It is not the common name for internet social networking services. To be descriptive, the true test is not whether they are exhaustively descriptive of the article designated, but whether in themselves, and as they are commonly used by those who understand their meaning, they are reasonably indicative and descriptive of the thing intended. Thus, the difference between the word submitted for registration and the term commonly used or known to relevant consumers to designate the goods and services or their essential characteristics give a distinctive character on the word to make it registrable as a trademark.

While the term “facebook” commonly refers to a “yearbook” or “a publication for an organization, such as a school or business, which helps members identify each other; also an online version of this, with profiles including a picture, name, birthdate, interests”⁶, the use of the same term “facebook”, however, to indicate an internet social networking site is not the familiar or common usage known to consumers or public. It does not denote what goods or services are provided in such a way that the public does not have to exercise powers of perception or imagination. At most, “FACEBOOK” is a suggestive mark. Thus, the term “FACEBOOK” not being generic or descriptive, the same can be registered as a trademark.

Anent the second issue, Opposer claims that its mark “FACEBOOK” is an internationally well-known mark citing Sec. 123.1 (e) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”), which provides:

4 G.R. No. 103543, 05 July 1993, citing *Ong Ai Gui v. Director of Patents*, 96 Phil. 673, 675 [1955].

5 *J. Thomas McCarthy*, Trademarks and Unfair Competition. Vol. I, 1973 Ed.. p. 405

6 See Answer, p. 1.

SEC. 123. *Registrability.* -123.1 A mark cannot 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 section 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;

In this regard, Rule 102 of the Trademark Regulations sets forth the criteria in determining whether a mark is a well-known mark, to wit:

- (a) 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;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) 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 rule requires that the party claiming a mark to be well-known satisfies at least a combination of the above stated criteria. The Opposer submitted certificates of registration of the mark FACEBOOK in numerous countries all over the world. These documents show the extent of the registration of the mark in the world. To show the duration, extent and geographical area of use of the mark in terms of advertising and promotion, the quality image or reputation acquired by the mark, the commercial value attributed thereto, among other things, the Opposer submitted a printout of the relevant portion of Wikipedia on Facebook⁷ internet articles and advertisement of Facebook⁸ and newspaper article⁹. Thus, the Opposer has shown sufficient basis to support its claim that the mark "FACEBOOK" is a well-known mark.

7 See Annex "B", Affidavit of Mr. Arturo T. Del Rosario, Jr

8 See Annex "C" to "F", Affidavit of Mr. Arturo T. Del Rosario, Jr.

9 See Annex "B", Affidavit of Mr. Arturo T. Del Rosario, Jr.

Going now to the issue on whether the Respondent-Applicant's mark "FACEBOOK.ASIA" should be registered, it is emphasized that the fundamental principle and legal basis of trademark registration is that the owner of the mark has the right to register it. The essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into a 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 products.¹⁰

The contending marks are reproduced below for comparison.

FACEBOOK

Opposer's Mark

FACEBOOK.ASIA

Respondent-Applicant's Mark

It is evident that Respondent-Applicant's "FACEBOOK.ASIA" mark is virtually identical to the Opposer's. The only difference is the addition of the word "ASIA". It has been stated time and again that, "the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term."¹¹ As such, the addition of the geographical term "ASIA" on Respondent's mark cannot escape a finding of confusing similarity. In fact, it is likely that the consumers or public would commit mistake in believing that the Opposer has already expanded its services in Asia.

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of the mark would likely cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two marks is such that there is possibility of the older brand mistaking the newer brand for it.¹²

Evidence submitted by the Opposer shows that it has used the mark "FACEBOOK" ahead of the Respondent-Applicant. Certificate of Registration No. 3,041,791¹³ issued by the USPTO on 10 January 2006 shows that the mark "FACEBOOK" was first used in the United States of America on 04 February 2004. The Opposer's evidence¹⁴ also reveals that in the Philippines, many Filipinos have been using "FACEBOOK" as a social networking site where they connect with family, friends, classmates and colleagues, as early as June 2007. Not only that, the Opposer has also registered and/or applied for registration of its mark in various countries all over the world.¹⁵ In the Philippines, the Opposer filed its trademark application for "FACEBOOK" on 24 March 2008 under Application No. 4-2008-003293¹⁶, covering goods under Class 35.¹⁷

10 *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Etepha v. Director of Patents*, 16 SCRA 495

11 *Continental Connector Corp. v. Continental Specialties Corp.* 207 USPQ 60.

12 *Philippine Nut Inc. v. Standard Brands Incorporated et al.* 65 SCRA 575.

13 See Exhibit "II".

14 See Affidavit of Mr. Arturo T. Del Rosario

15 See Exhibit "A" to "JJ"

16 See Exhibit "KK"

17 Providing an online directory information service featuring information regarding, and in the nature of collegiate life, general interests, classifieds, virtual community, social networking, photo sharing and transmission of photographic images; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the internet; providing on-line computer database and on-line searchable database in the

Thus, considering that the Respondent-Applicant's trademark application covers services (under Class 35) similar or closely related to the Opposer's, it is a fair inference that the Respondent-Applicant is in the same line of business with the Opposer's and therefore, is aware of the existence of the mark "FACEBOOK". Aptly, a 'boundless' choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his product from those of others.

When, however, there is no reasonable explanation for the defendant's choice of such a mark though the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive.¹⁸ The ultimate ratio in cases of grave doubt is the rule that as between a newcomer who by the confusion has nothing to lose and everything to gain and one who by honest dealing has already achieved favor with the public, any doubt should be resolved against the newcomer inasmuch as the field from which he can select a desirable trademark to indicate the origin of his product is obviously a large one."¹⁹

Considering therefore, that the Opposer's mark is well-known under Rule 102 of the Trademark Regulations, Trademark Application Serial No. 4-2007-013603 is proscribed by Sec. 123.1 (e) of the IP Code. Moreover, the Opposer having proved its prior use and therefore, ownership of the mark FACEBOOK, for social networking and related services via internet, the Respondent-Applicant cannot claim ownership of an identical mark for use on similar services, and corollarily, the right to register it for exclusive use.

WHEREFORE, premises considered the instant opposition to Trademark Application Serial No. 4-2007-013603 is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2007-013603 be returned together with a copy of this DECISION to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 29 July 2010.

NATHANIEL S. AREVALO
Director, Bureau of Legal Affairs
Intellectual Property Office

field of collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, video sharing and transmission of photographic images; marketing, advertising and promotion services; providing marketing and advertising consultation services; providing marketing and advertising consultation services; providing market research and information services; providing marketing data; providing marketing tools to provide market information; advertising and information distribution services, namely, providing advertising space via the global computer network; advertising and information distribution services, namely, providing advertising space via the global computer network'.