

FUEGO LAND CORPORATION
Opposer,
- versus -

IPC 14-2006-00090

CEBU HOLDING, INC.
Respondent-Applicant.

Opposition to:
TM Application No. 4-2005-004407
(Filing Date: 16 May 2005)

TM: "AMARA STYLIZED"

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Decision No. 2006-135

DECISION

Before this Bureau is an Opposition filed by Fuego Land Corporation, a corporation duly organized and existing under and by virtue of the laws of Republic of the Philippines, with business address at the 3/F Centermall Building, President's Avenue, BF Paranaque, Metro Manila, against the application of registration of the trademark "AMARA STYLIZED" for real estate affairs, insurance, financial affairs, monetary affairs which group of services belong to Class 36 of the Nice Classification, with Application Serial No. 4-2005-004407 and filed on 16 May 2005 in the name of Respondent-Applicant, Cebu Holdings, Inc with business address at 7/F Cebu Holdings Center, Cebu Business Park, 6000 Cebu City.

The grounds for the opposition to the application for registration of the trademark AMARA are as follows:

- "1. Respondent-Applicant has no right to the exclusive use of the word, "Amara", the same being a generic word;
- "2. Respondent-Applicant's use of the generic word, "Amara" has not earned secondary meaning as to allow it to exclusively use the generic word; and
- "3. Respondent-Applicant's trademark "AMARA STYLIZED" is identical and/or confusingly similar to Opposer's trademark, "Amara en Terrazas" as well as Opposer's registered business name, "Amara Condominium";
- "4. The approval of the application is contrary to Section 123.1 (h) of Republic Act No. 8293; and
- "5. The use of the subject mark has caused and the approval and the registration of the application in question will continue to cause great and irreparable damage and injury to herein Opposer.

Opposer relied on the following facts to support its contentions in this Opposition:

- "1. Opposer is the duly registered owner of the business name, "Amara Condominium" and "Amara en Terrazas Condominium" and has been in actual use of these business names prior to the issuance to it of separate certificates of business name registration (Certificate Nos. 00196997 for "Amara Condominium") by the Department of Trade and Industry on 3 August 2010. Attached hereto as Annexes "A" and "B" and made integral parts hereof are copies of each of the Certificate of Business Name Registration (Certificate No. 00196997) for "Amara Condominium" and Certificate of Business Name Registration (Certificate No. 00196975) for "Amara en Terrazas Condominium", both issued in the name of the Opposer.
- "2. Opposer has been using the aforesaid business names for the marketing and sales of condominiums and the conduct of related real estate affairs in Lipa City, Batangas. It is also actually using "Amara en Terrazas Condominium" in the course of its

business. Attached hereto as Annexes "C" to "C-3" are sample published materials bearing the business name, "Amara en Terraza Condominium".

"3. On 21 October 2005, Opposer also filed separate applications with this Honorable Office for the registration of the trademark "AMARA EN TERRAZAS" as follows:

Title of the Mark Sought to be Registered	Application Number
AMARA EN TERRAZAS (STYLIZED)	04-2005-010487
AMARA EN TERRAZAZ	04-2005-010488
AMARA EN TERRAZAZ (LOGO)	04-2005-01489

"4. On 16 May 2005, Respondent-Applicant had filed with the Honorable Office its application for registration of the trademark, "AMARA STYLIZED" which application as earlier alleged, was published for opposition in the trademark Electronic Gazette of this Honorable Office on 25 April 2006.

The Notice to Answer dated 03 July 2006 was sent to Respondent Cebu Holdings, Inc. by registered mail directing it to file its Verified Answer within a prescribed period from receipt. Respondent filed its Verified Answer on 01 September 2006.

Respondent in its Answer and interposed the following ADMISSIONS and DENIALS:

1. "Paragraph 1.01 of the Opposition is denied for lack of knowledge sufficient to form a belief as to the truth thereof.
2. "Paragraph 1.02, 2.01 and 2.02 of the Opposition are admitted.
3. "Paragraph 2.03 and 2.04 of the Opposition are denied for lack of knowledge sufficient to form a belief as to the truth thereof.
4. "The Opposer's reservation at the beginning of its Statement of Facts to adduce evidence in the course of the proceedings is in violation of Office Order No. 79, Series of 2005, which provides that the evidence attached to the Opposition "shall constitute the entire evidence" for the Opposer. Paragraphs 3.01 and 3.02 of the Opposition are denied for lack of knowledge sufficient to form a belief as to the truth thereof.
5. "Paragraph 4.01 and 5.01 of the Opposition are admitted.
6. "The grounds for the opposition stated on page 6 of the Opposition are denied for being mere conclusions of law and fact sans any basis and as stated in the Affirmative Defenses herein.
7. "Paragraph 6.01 of the Opposition is admitted with the qualification that the cases cited therein are not applicable to this case.
8. "Paragraph 6.02 of the Opposition is denied for being a conclusion of law and fact sans any basis and as stated in the Affirmative Defenses herein.
9. "Paragraphs 6.03, 6.04 and 7.01 of the Opposition are denied for being conclusions of law and fact sans any basis and as stated in the Affirmative Defenses herein.

10. "Paragraph 8.01 of the Opposition is admitted with the qualification that the doctrines and cases cited therein are not applicable to this case.
11. "Paragraph 8.02 of the Opposition is admitted for being a conclusion of law and fact sans any basis and as stated in the Affirmative Defenses herein.
12. "Paragraph 8.03 of the Opposition is admitted with the qualification that the doctrine cited therein is not applicable to this case.
13. "Paragraph 9.01 and 9.02 of the Opposition are denied for being conclusions of law and fact sans any basis and as stated in the Affirmative Defenses herein.

and raised in its Answer the following Affirmative Defenses, to wit: (1) The respondent first used the word or mark AMARA [see pars. 23 and 24, Answer]; (2) The word AMARA is not generic, hence, it is registrable [see pars. 25, 26, 27, 28, 41, 42 and 42 Answer]; (3) AMARA is registered for different goods and services worldwide [see pars. 31, 32 and 33, Answer] ; (4) The word AMARA is not descriptive [see pars. 44-54, Answer].

From receipt of the Answer, this Bureau required the parties to attend the Preliminary Conference which took place on 17 October 2006 and on the same day, the parties agreed to terminate the conference and then submitted the case for decision.

Considering that the case was mandatorily covered by the Summary Rules under Office Order No. 79, this Bureau required the parties through their counsels to submit their respective position papers. Opposer filed its position paper on 21 November 2006 while Respondent-Applicant filed their on 14 November 2006.

In support of its prayer for the rejection of Application Serial No. 4-2005-004407 for the mark AMARA, Opposer's evidence consisted, among others, of the DTI Certificate of Business Name Registration for "Amara Condominium" issued to Fuego Land Corporation on 03 August 2005 (Annex "A", Opposer); DTI Certificate of Business Name Registration for "Amara En Terrazas Condominium" issued to Fuego Land Corporation on 03 August 2005 (Annex "B", Opposer); Trademark/Service Mark Application for the mark AMARA EN TERRAZAS (STYLIZED) under Class 36 filed on 21 October 2005 by Fuego Land Corporation, (Annex "D", Opposer); Trademark/Service Mark Application for the mark AMARA EN TERRAZAS LOGO under Class 36 filed on 21 October 2005 by Fuego Land Corporation (Annex "F", Opposer); Some pictures showing the label or marks AMARA EN TERRAZAS LOGO and AMARA EN TERRAZAS (STYLIZED).

Attached as documentary evidence, among others, for the Respondent-Applicant are HLURB Certificate of Registration No. 12656 for Amara Subdivision as project with Cebu Holdings, Inc as project owner covered by DP No. 2005-02-036 dated August 19, 2005 (Exhibit "1-A", Respondent); HLURB License to Sell No. 13699 for the sale of lots/units in Amara Subdivision located at Catarman, Liloan, Cebu with Cebu Holdings, Inc. as project owner issued on 13 September 2005 (Exhibit "1-B", Respondent); Pictures showing groundbreaking ceremonies for the launching of the project AMARA; Advertising materials in local newspapers and other newspaper publications of general circulation; Letter dated August 02, 2006 from the Spanish Embassy in Manila providing the meaning of the word AMARA using as references the Spanish Encyclopedia.

Tersely, the issue for this Bureau's resolution is the propriety of Application Serial No. 4-2005-004407; whether or not Respondent-Applicant is entitled to register the trademark AMARA STYLIZED covering services/business under Class 36

After carefully considering and evaluating the pertinent records at hand, this Office resolved to sustain Applicant's right to use the mark AMARA STYLIZED for its real estate affairs, insurance, financial affairs and monetary affairs.

The issued stems or springs from Respondent-Applicant's appropriation of the word or mark "AMARA", which is the same in sound and spelling vis-à-vis Opposer's trademark, AMARA en Terrazas. Both trademarks are used for real estate affairs and other services under Class 36. There is no issue that the marks involved are identical, not with the style these marks were printed or presented or with the device used thereon but the word or mark AMARA appears both in the labels of the contending parties. Having shown and proven resemblance of the two marks, we now delve on the matter of ownership and priority in application which certainly have decisive effects in the adjudication of the case.

With R.A. 8293 as basis of registrability, this Bureau adheres to the First-to-File Rule and applying specific provisions of R.A. 8293 (Sec. 122 and Sec. 127), records will show that as between the parties, Respondent's application has an earlier filing date. Respondent's mark AMARA was filed on 16 May 2005 while Opposer's application for the same mark AMARA came later on 21 October 2005 (Annexes "D" & "E", Opposer). This fact of an earlier filing was not disputed by Opposer. Opposer's later application for the same mark AMARA was for the same services grouped under Class 36 of the Nice Classification.

The right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano v. Director of Patents, et. al.*, G.R. No. L-20170, August 10, 1965). And where a trademark application is opposed, the Respondent-Applicant has the burden of proving ownership (*Marvex Commercial Co., Inc. v. Peter Hawpia and Co.*, 18 SCRA 1178). In the instant case, Respondent-Applicant presented proof of an earlier application which was not disproved by Opposer Respondent-Applicant, Cebu Holding Inc., on 16 May 2005 filed with the Intellectual Property of the Philippines an application for the registration of the mark AMARA for Class 36 (real estate affairs, insurance, financial affairs, monetary affairs).

Respondent-Applicant has shown likewise proof of its legitimate use when it applied for Certificate of Registration and License to Sell with HLURB on 15 July 2005 to launch the project AMARA (Exhibit "1", Respondent-Applicant); Culled from the records too were several news clipping dated April 2005 which showed a joint venture partnership for (Exhibit "3-B", Respondent-Applicant) and launching of the residential project called AMARA (Exhibit "3-C", Respondent-Applicant) and the groundbreaking ceremonies on October 2005 for the aforementioned 46-hectare subdivision project (Exhibit "3-S", Respondent-Applicant).

Opposer, for its part, showed and presented proofs of its legitimate use the DTI Certificate of Business Name Registration for Amara Condominium (Annex "A", Opposer) and Amara en Terrazas Condominium (Annex "B") both issued on 03 August 2005 to Fuego Land Corporation, Opposer herein. Attached to the Verified Opposition were some newspaper clippings date June 2005 (Annex "C-3", Opposer), dated July 2005 and August 2005 publicly announcing and/or advertising a new resort living called Amara en Terrazas to be developed by Landco Pacific in Batangas. Records do not show any use prior to April 2005 vis-à-vis that of evidence presented by Respondent-Applicant. From the foregoing, being the originator, legitimate user and prior applicant of the mark AMARA, it could be deduced and safely concluded that Respondent-Applicant is the actual owner of the mark AMARA.

Opposer argues that the mark "AMARA" is not registrable for being generic and/or descriptive word pursuant to Section 123.1 (h) of R.A. 8293, to wit:

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

(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;

Worth mentioning at this point is the definition of generic and descriptive terms propounded and /or offered in the case of SOCIETE DES PRODUITS NESTLE vs. COURT OF APPEALS, ET. AL G.R. No. 112012, April 04, 2001, where the court said:

“Generic terms are those which constitute “the common descriptive name of an article or substance” x x x or “refer to the basic nature of the wares or services provide rather than to the more idiosyncratic characteristics of a particular 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, x x x 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 of imagination.

But the word AMARA as used by Respondent-Applicant is neither generic nor a descriptive trademark. The word AMARA is susceptible a various meanings, it may be a Spanish term for a female name, a bug and a name for a place in the northern part of Spain (Exhibit “4”, Respondent-Applicant); Its equivalent in the Webster International Dictionary refers to “a large genus phytophagous ground beetles of oblong-ovate form, medium size, and usually bronze color.” Opposer offered its meaning using the English translation as “love of the sea” (page 5, Opposer’s Position Paper). Given this circumstance, we can not deduce a general meaning of the word AMARA.

Respondent-Applicant is engaged in the business of selling real estate, the mere fact that it is developing a project of condominium living by the sea does not make its mark AMARA generic. The service or business is real estate, AMARA as world does not depict real estate business. It is descriptive if it describes the nature of identify of the goods or services for which it is used. The word “AMARA” may be appropriated by Respondent-Applicant as its own when used on real estate business since it is not descriptive of the goods or the label or mark; a good example would be the word “APPLE” which is a very distinctive trademark for a computer. In the case at bar, the word “AMARA” is used on real estate affairs, specifically condominium living. The case of [G.R. No. L-18289. March 31, 1964.] ANDRES ROMERO, petitioner, vs. MAIDEN FORM BRASSIERE CO., INC. and THE DIRECTOR OF PATENTS, respondent, is one case relevant to and decisive of this particular point when the court ruled:

“The trademark “Adagio” is a musical term, which means slowly or in an easy manner, and when applied to brassieres is used in an arbitrary (fanciful) sense, not being a common descriptive name of a particular style of brassieres, and is therefore registrable”.

This Bureau finds existence of same mark “AMARA” on hoods and/or other services such as in hotels and hotel services, on leather goods or clothing (suits, hats, jackets, belts), for food, flour, coffee, condiments in Classes 29 and 30; and beverages in Class 33. Respondent-Applicant uses in the mark AMARA specifically on real estate business which is not well within those goods or services aforementioned with registered mark AMARA. Believing it can be appropriated as its own, Respondent-Applicant filed for the registration of the mark “AMARA STYLIZED”. The Bureau of Trademarks allowed publication of the mark “AMARA SYLIZED” only after a finding that the subject marks is registrable (see Notice of Allowance).

Based on the foregoing and despite allegation that the mark AMARA is generic, this Bureau resolves to grant protection to Respondent-Applicant’s mark AMARA STYLIZED for use on real estate affairs, insurance, financial affairs and monetary affairs.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby REJECTED. Consequently, application bearing Serial No. 4-2005-004407 filed by Cebu Holding, Inc. on 16 May 2005 for the registration of the mark “AMARA” for use on real estate affairs, insurance, financial affairs and monetary affairs is, as it is hereby GIVEN DUE COURSE.

Let the filewrapper of AMARA, subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Makati City, 29 November 2006.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office