



LINA PETALVER CELINO,  
*Opposer,*

IPC No. 14-2011-000086

- versus -

Opposition to:  
Appln. Serial No. 4-2008-603293B  
(Filing Date: 24 March 2008)  
TM: "FACEBOOK"

FACEBOOK, INC.,  
*Respondent-Applicant.*

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DECISION NO. 2012 - 46

## DECISION

LINA PETALVER CELINO ("Opposer")<sup>1</sup> filed on 11 March 2011 an opposition to Trademark Application Serial No. 4-2008-603293B. The application, filed by FACEBOOK, INC. ("Respondent-Applicant")<sup>2</sup> covers the mark "FACEBOOK" for use on *"providing an online directory information service featuring information regarding, and in the nature of collegiate life, general interest, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images, advertising and information distribution services, namely, providing classified advertisement 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, photosharing, 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"* under Class 35 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges that she has a prior application for the registration of the mark FACEBOOK.ASIA which was filed in December 2007. According to the Opposer, her mark is exactly similar to the Respondent-Applicant's such that the latter's application is barred by Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). She submitted as evidence, printouts from the IPO website of her Trademark Application Serial No. 4-2007-013603 and the Respondent-Applicant's opposed application.

<sup>1</sup> With address at 104 GS Rada St., Unit #1627, Legaspi Village, Makati City.

<sup>2</sup> A corporation duly organized and existing under the laws of the State of Delaware, United States of America, with address at 151, University Avenue, Palo Alto, California 94301, U.S.A.

<sup>3</sup> 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.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 18 April 2011. The Respondent-Applicant filed its Verified Answer on 15 August 2011, wherein it alleges the following:

"2. The Honorable Office, in its Decision dated 29 July 2010 in IPC No. 14-2008-00304, has already ruled that Applicant is the owner of the 'FACEBOOK' mark and has proven prior use thereof. In the said Decision, the Honorable Office held that Applicant's 'FACEBOOK' mark is well-known and is entitled to protection under the relevant laws. With the said Decision of this Honorable Office, Opposer thus cannot lay a claim to ownership of an identical mark 'FACEBOOK.ASIA' and cannot register said identical mark.

"3. Opposer purportedly filed a motion for reconsideration in IPC No. 14-2008-00304. However, herein Applicant was not furnished a copy of the same. Thus, the Decision of this Honorable Office in IPC No. 14-2008-00304 is final and the instant Opposition is barred by res judicata.

"4. Applicant is the owner of the well-known mark 'FACEBOOK' which is registered in the intellectual property registers of several countries worldwide. Moreover, in several other countries, Applicant has pending applications for the registration of the mark. x x x

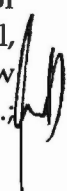
"5. Applicant has prior use of the 'Facebook' trademark for its social networking site. It was first used in the Philippines as early as 15 September 2006. On the other hand, Opposer has never used her 'FACEBOOK.ASIA' mark.

Applicant has over 750 million active internet users worldwide and owns the most visited websites in the Philippines. These figures may be accessed from <http://www.alexa.com>. As of 1 January 2011 more than 20 million active Facebook users located in the Philippines has logged into Applicant's website within the preceding 30 days. Applicant is also the owner of domain name <http://facebook.asia>, which it also uses to provide its social networking services. x x x

"6. 'Facebook' is an internationally well-known mark and is widely used by Filipinos. x x x

"7. Opposer's 'FACEBOOK.ASIA' mark, which falls under the same NICE classification as that of Applicant's mark, is confusingly similar to and may be considered an infringement of Applicant's well-known 'Facebook' mark. Opposer only wishes to ride on the popularity of Applicant's mark and has no genuine intention to operate a business using the 'FACEBOOK.ASIA' mark. In fact, she has not bothered to register said business with the appropriate business registers in the Philippines. x x x

"8. Applicant's 'Facebook' mark is entitled to protection under the Intellectual Property Code of the Philippines and the Convention of Paris for the Protection of Industrial Property otherwise known as the Paris Convention."

The Respondent-Applicant's evidence consists of certified copy of the Decision in IPC No. 14-2008-00304 dated 29 July 2010; list of worldwide registrations and applications of the mark FACEBOOK; certified copy of sample registrations of the mark in several countries like the BENELUX, under the Madrid Protocol, European community, France, Greece, Hong Kong, Iceland, Japan, Mexico, New Zealand, Norway, Korea, Singapore, Switzerland, Taiwan, Thailand, and the U.S.A. 

certified copy of the authenticated Affidavit of Richard Nessary submitted in IPC No. 14-2008-00304; certified copy of the authenticated Affidavit of Mr. Nessary dated 04 November 2010; certified copies of affidavits executed by local users of Facebook submitted in IPC No. 14-2008-00304; certified copy of the Certification from Securities and Exchange Commission that "FACEBOOK.ASIA" is not registered as a corporation or partnership in the Philippines; and certified copy of the Negative Certification from the Department of Trade and Industry that "FACEBOOK.ASIA" is not registered as a business name.<sup>4</sup>

The preliminary conference was terminated on 22 November 2011.

There is no dispute that the Respondent-Applicant's mark is confusingly, nay, identical, to the mark the Opposer applied for registration in 2007. The issue to be resolved, however, is who between the parties is the owner, and therefore, has the right register, the mark. In this regard, this Bureau had already resolved the issue in its Decision, dated 29 July 2010, in IPC No. 14-2008-00304, to wit:

"Evidence submitted by the Opposer shows that it has used the mark 'FACEBOOK' ahead of the Respondent-Applicant. Certificate of Registration No. 3,041,791 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 evidence 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 allover the world. In the Philippines, the Opposer filed its trademark application for 'FACEBOOK' on 24 March 2008 under Application No. 4-2008-003293, covering goods under Class 35.

"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. 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.

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

<sup>4</sup> Marked by Respondent-Applicant as Exhs. "1" to "42".

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."

Even if there is a pending motion for reconsideration, there is no cogent reason for this Bureau to decide the instant case, otherwise. The parties submitted the same evidence they had in IPC No. 14-2008-00304.

WHEREFORE, premises considered, the instant opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2008-60329B be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 February 2012.



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