



DEXTER YEH TIU doing business  
Under the name and style of DEAN  
AND DELUCA RESTAURANT,  
Opposer,

-versus-

DEAN & DELUCA BRANDS, INC.,  
Respondent –Applicant.

X-----X

} IPC No. 14-2012-00204  
} Opposition to:  
} Appln. Serial No. 4-2011-005522  
} Filing Date: 16 May 2011  
} TM: "DEAN & DELUCA"

### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2014 - 64 dated February 27, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 27, 2014.

For the Director:

  
Atty. EDWIN DANILO A. DATING  
Director III  
Bureau of Legal Affairs



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Decision No. 2014- 64

## DECISION

DEXTER YEH TIU, doing business under the name and style of DEAN AND DELUCA RESTAURANT ("Opposer")<sup>1</sup>, filed an opposition to Trademark Application Serial No. 4-2011-005522. The application, filed by DEAN & DELUCA BRANDS, INC. ("Respondent-Applicant")<sup>2</sup>, covers the mark "DEAN & DELUCA" for use on:

1. various goods under Classes 18, 21, 25, 29, 30, and 32;
2. "on-line retail store and mail order services featuring fine food and kitchenware; retail food store services" under Class 35; and
3. "restaurant and café services" under Class 43.<sup>3</sup>

The Opposer alleges:

"1. Opposer is filing this Notice of Opposition pursuant to Section 34, and in connection with Section 65 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (hereinafter, IP Code for brevity):

"2. x x x

"3. The business name 'DEAN AND DELUCA RESTAURANT' is duly registered in the name of Opposer with the Department of Trade & Industry under Certificate of Business Name Registration No. 01659252 issued on 21 February 2012, a certified copy of which is marked as Exhibit 'A' and made an integral part hereof.

"4. Opposer's 'DEAN & DELUCA RESTAURANT' has been operating at Paruk Siay, Municipality of Siay, Province of Zamboanga Sibugay under Business Permit No. 2012-000000064 dated April 17, 2012, a certified copy of which is marked as Exhibit "B" and made an integral part hereof.

<sup>1</sup> With business and office address at 3F JTKC, 2155 Don Chino Roces Avenue, Pio Del Pilar, Makati City.

<sup>2</sup> A corporation organized and existing under the laws of State of Delaware, United States of America (U.S.A.), and with principal office address at 2420 E. 37<sup>th</sup> St., N. Wichita, Kansas 67219, U.S.A.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

Photographs of Opposer's 'DEAN & DELUCA Restaurant' are collectively marked as Exhibit 'C' and made integral parts hereof.

"5. Opposer's business name 'DEAN AND DELUCA RESTAURANT' is also duly registered with the Bureau of Internal Revenue. Pending release of the BIR Registration Certificate, a copy of the Application Form, together with the Official Receipt is marked as Exhibit "D" and made an integral part hereof.

"6. The trademark/trade name 'DEAN & DELUCA' being applied for registration by Respondent-Applicant is identical and/or confusingly similar to Opposer's business name 'DEAN AND DELUCA RESTAURANT'. A print-out of Respondent-Applicant's trademark/trade name 'DEAN & DELUCA' as published in the e-Gazette is marked as Exhibit 'E' and made an integral part hereof.

"7. The food products included in Respondent-Applicant's application falling under Classes 29, 30, 32, and restaurant and café services falling underclass 43, are identical to the goods and services of Opposer.

The projected use and registration by Respondent-Applicant of the trademark/trade name 'DEAN & DELUCA' will likely cause confusion, mistake, and deception among the consuming public.

"8. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to Opposer. xxx"

In its Verified Answer, the Respondent-Applicant argues that it is the true owner of the DEAN & DELUCA trademark, the Opposer's registration with the DTI was in bad faith. Defending its trademark application, the Respondent-Applicant submitted/presented the following as evidence:

1. Affidavit and Special Power of Attorney executed by Justin Phillips Seamonds, President-International of DEAN & DELUCA Brands, Inc.;
2. A certified true copy of the document showing the legal existence of Respondent-applicant;
3. A printout of the certified document generated by the Delaware Secretary of State certifying the corporate existence of Respondent-applicant;
4. Certified true copies of the documents showing the legal existence of the affiliated entities of Respondent-Applicant;
5. printouts of the certified documents generated by the relevant secretaries of state certifying the corporate existence of representative affiliated entities across the United States;
6. printouts of the [www.deandeluca.com](http://www.deandeluca.com) website;
7. Database printout of all of Respondent-applicant's trademark registrations and applications worldwide for "DEAN & DELUCA" and variations thereof;
8. officially certified copies of Respondent-applicant's eight (8) United States registrations;
9. printouts of the registration details from the Canadian Intellectual Property Office, WIPO, and the Trade Marks and Designs Registration Office of the European Union;
10. certified true copies of some of Respondent-applicant's additional trademark certificates of registrations issued in Malaysia, Mexico,

Qatar, Russian Federation, United Arab Emirates, China, Office of the Harmonization in the Internal Market (OHIM), Netherlands, India, Japan, Jordan, Kuwait, Macau;

11. Catalogs used by Respondent-applicant in marketing and advertising its trademark "DEAN & DELUCA" and variations thereof in different countries worldwide;
12. Affidavit of Diana F. Rabanal;
13. Certification from the barangay office of Paruk, Siay, Zamboanga Sibugay of the non-operation of Dean and Deluca restaurant within their jurisdiction;
14. Affidavit regarding the use and market survey conducted by investigator on Dean and Deluca restaurant located at Paruk, Siay, Zamboanga, Sibugay; and
15. Certified true copy of Trademark Application No. 4-2011-005522.<sup>4</sup>

The parties refused to submit the case for mediation. After the termination of the preliminary conference, the parties submitted their respective position papers. The Respondent-Applicant filed on 11 February 2013 a "MOTION TO EXPUNGE" a document particularly a Bureau of Internal Revenue Certificate of Registration which was attached to the Opposer's Position Paper. This was followed by the Respondent-Applicant's "SUPPLEMENT to the MOTION TOEXPUNGE" filed on 15 February 2013.

Should the Respondent-Applicant be allowed to register the contested mark in its favour?

There is no dispute that the mark DEAN & DELUCA is identical to the business name DEAN AND DELUCA RESTAURANT. Section 134 of the IP Code, provides:

Sec. 134. Opposition. Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2, file with the Office an opposition to the application. xxx

The Opposer has reason to believe that he is a party who may be damaged by the registration of the mark DEAN & DELUCA in favour of the Respondent-Applicant. If the Respondent-Applicant is allowed to register the mark in its name, it would have exclusive rights over the mark or name for similar and/or closely related goods/services. Such exclusion would extend to the Opposer's business.

The Opposer argues that the business name DEAN AND DELUCA RESTAURANT which he registered is protected by Sec. 165 of the IP Code, which provides:

Sec. 165. Trade Names or Business Names.-165.1. A name or designation may not be used a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

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<sup>4</sup> Respondent-Applicant also marked its evidence alphabetically (Exhibits "A" to "K", inclusive).

165.2.(a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful. Xxx

The Opposer may have registered with the DTI and other agency the business name DEAN AND DELUCA RESTAURANT. There is no cogent reason or basis, however, for this Bureau to sustain the opposition. It is emphasized that the protection under the above-quoted provision of law is against any unlawful act committed by third parties. Corollarily, Sec. 165.2(b) of the IP Code states that *"In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful."*

In this regard, records and evidence show that the Respondent-Applicant's use of the mark DEAN & DELUCA is not subsequent to the adoption and use by the Opposer of the business name DEAN AND DELUCA RESTAURANT. The Respondent-Applicant has been using the name, which was derived from the names of its two founders Joel Dean and Giorgio De Luca, since 1977. The Opposer, incorporated on 16 July 1987, registered and applied for registration as a trademark the name DEAN & DELUCA since 1985 in several countries or jurisdictions already, including Malaysia, Mexico, Qatar, Russian Federation, United Arab Emirates, China, Office of the Harmonization in the Internal Market (OHIM), Netherlands, India, Japan, Jordan, Kuwait, and Macau. In fact, the Respondent-Applicant filed the instant trademark application in the Philippines on 16 May 2011. In contrast, the Opposer adopted the name DEAN AND DELUCA RESTAURANT only in 2012.

It is also absurd that the Respondent-Applicant's use of the mark will likely mislead the public. The Respondent-Applicant is seeking registration in the Philippines of a mark it owns for use on its own products and services which it has been offering to the public long before the Opposer sought registration of the business name DEAN AND DELUCA RESTAURANT. As discussed above, the filing of the Respondent-Applicant's trademark application in the Philippines in 2011 even preceded the Opposer's use of the business name DEAN AND DELUCA RESTAURANT in 2012.

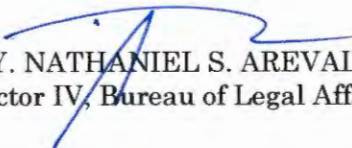
Succinctly, the Opposer's use of the business name DEAN AND DELUCA RESTAURANT is the one that is likely to mislead the public. The Opposer did not give any explanation how he came up with the name DEAN AND DELUCA RESTAURANT. The name and mark DEAN & DELUCA, derived or coined from the surnames of two of the Respondent-Applicant's founders, is highly distinctive and unique. The Respondent-Applicant has been using the name and mark long before the Opposer "used" and registered DEAN AND DELUCA RESTAURANT as a business name. Anyone who is familiar with or had experience engaging the products and services of the Respondent-Applicant or even had the mere chance

to encounter the Respondent-Applicant's mark DEAN & DELUCA, would have the impression that the name DEAN AND DELUCA RESTAURANT is owned by or affiliated with or connected to the Respondent-Applicant.

WHEREFORE, premises considered, the instant opposition is hereby DISMISSED for lack of merit. Let the filewrapper of Trademark Application Serial No. 4-2011-005522 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 27 February 2014.

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