



JACQUELINE ANNE J. LAUDICO,
Opposer,

-versus-

ADVENT MANILA HOSPITALITY,
GROUP, INCORPORATED,
Respondent-Applicant.

X-----X

}
} **IPC No. 14-2011-00363**
} Opposition to:
} Appln. Serial No. 4-2011-001442
} Filing Date: 09 Feb. 2011
} **TM: "XO 46 BISTRO FILIPINO"**
}
}
}
}
}

NOTICE OF DECISION

THE BENGZON LAW FIRM
Counsel for the Opposer
9th Floor, One Global Place
Fifth Avenue, Bonifacio Global City
Taguig City


ADVENT MANILA HOSPITALITY GROUP, INC.
c/o ROSITA B. TINGIN
For Respondent-Applicant
No. 6 Ilang Ilang St., Rosario Heights
New Manila, Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 18 dated January 29, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 29, 2013.

For the Director:


Atty. PAUL U. SAPAK
Hearing Officer
Bureau of Legal Affairs



JACQUELINE ANNE J. LAUDICO,
Opposer,

-versus-

ADVENT MANILA HOSPITALITY,
GROUP, INCORPORATED,
Respondent-Applicant.

X-----X

IPC No. 14-2011-00363
Opposition to:
Appln. Serial No. 4-2011-001442
(Filing Date: 09 Feb. 2011)
TM: "XO 46 BISTRO FILIPINO"

Decision No. 2013-18

DECISION

JACQUELINE ANNE J. LAUDICO ("Opposer")¹ filed on 04 October 2011 an opposition to Trademark Application Serial No. 4-2011-001442. The application, filed by ADVENT MANILA HOSPITALITY, GROUP, INCORPORATED² ("Respondent-Applicant"), covers the mark "XO 46 BISTRO FILIPINO" for use on "restaurant" under Class 43 of the International Classification of Goods and Services³.

The Opposer alleges, among other things, that XO 46 BISTRO FILIPINO is confusingly similar to her trademark "CHEF LAUDICO BISTRO FILIPINO". According to her, she has been using the mark as a business name for restaurant since 2006. To support her opposition, the Opposer submitted as evidence, copy of the December 2007-January 2008 issue of the "Metro Magazine Society", copy of the article "Making the A-list", copy of the article entitled "Not fusion, just modern Filipino food", copy of the Declaration of Actual Use, copy of Certificate of Business Name Registration, copy of her trademark application, the affidavit of Eduardo Ignacio and Tito Castillo, and sales invoices for calling cards⁴.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant 12 October 2011. The Respondent-Applicant, however, did not file an Answer.

The Opposer anchors her case on Sec. 123.1 (e) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), which states that a mark shall not be registered if it 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 Philippine, 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 sector 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.

¹ Filipino, of legal age, with address at CHEF LAUDICO BISTRO FILIPINO, G/F Net Square Bldg., 3rd Avenue, Fort Bonifacio Global City, Taguig City.

² With address at Unit 1, No. 6 Ilang-Ilang St., Rosario Heights, New Manila, Quezon City.

³ 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.

⁴ Marked as Annexes "A" to "G", inclusive.

She also invokes Sec. 165.2 of the IP Code which provides:

Section 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 name or mark, likely to mislead the public, shall be deemed unlawful.

The Opposer has registered with the Department of Trade and Industry CHEF LAUDICO'S BISTRO FILIPINO INC. as a business name since 18 May 2006. However, she has not registered or applied for registration as a trademark the said business name at the time the Respondent-Applicant filed its trademark application.

It must be emphasized that the Opposer's objection to Trademark Application Serial No. 4-2011-001442 is the inclusion in the Respondent-Applicants' trademark of the words "BISTRO FILIPINO", claiming that she has the exclusive right to use them.

In this regard, the Opposer cannot successfully invoke Sec. 123.1 (e) of the IP Code. There is no evidence to prove that CHEF LAUDICO'S BISTRO FILIPINO INC. is a well-known mark internationally and in the Philippines before the filing date of the Respondent-Applicant's trademark application. Also, the Opposer's claim of exclusive use of the words BISTRO FILIPINO has no legal leg to stand on. BISTRO FILIPINO in relation to the parties' businesses or services is generic and/or descriptive. "*Bistro*" is defined as a small restaurant serving wine, bar, tavern or night club.⁵ Hence, BISTRO FILIPINO means a "*bistro*" serving Filipino cuisine, as confirmed by the Opposer herself in the "Opposition" and by the evidence she submitted.⁶

Generic and descriptive words or terms are incapable of being protected as trademarks. In fact, it is explicitly prohibited by Sec. 123.1, pars. (h) to (j), of the IP Code to register a mark that:

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

(i) Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in any bona fide and established trade practice;

(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of services, or other characteristics of the goods or services.

While a composite trademark that includes generic or descriptive words/terms may still be registered, these unregistrable components must be disclaimed. In fact, the Respondent-Applicant disclaimed the words BISTRO FILIPINO in its trademark application.

This Bureau also finds no merit on the Opposer's reliance on Sec. 165.2 of the IP Code. What she using and has registered is the business name CHEF LAUDICO'S BISTRO FILIPINO INC. This is obviously different from XO 46 BISTRO FILIPINO. Moreover, it must

⁵ Ref.: <http://dictionary.reference.com> citing: Dictionary.com Unabridged based on the Random House Dictionary, Random House, Inc. 2013; and Collins English Dictionary-Complete & Unabridged 10th Edition 2009 William Collins Sons & Co., Ltd., 1979, 1986 Harper Collins Publishers 1998, 2000, 2003, 2005, 2006, 2007, 2009.

⁶ See paragraphs 3 to 8 of the Opposition (pp. 1-2), and Annexes "A" to "C".

be emphasized that under Sec. 165.2 of the IP Code, the "...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 name or mark", must be "likely to mislead the public". As discussed above, the only similarity between the Opposer's business name and the Respondent-Applicant's mark are the words or term "BISTRO FILIPINO". The public is not likely to be misled. Since the words or the term "BISTRO FILIPINO" are generic and/or descriptive of the services, it is unlikely for one who encounters the mark XO 46 BISTRO FILIPINO to assume that the establishment and its services are connected with the Opposer. The distinctive feature of the mark that enables the consumer or patron to immediately distinguish it from other "*bistros*" or similar establishments is the coined term "XO 46".

Succinctly, 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.⁷ This Bureau finds the Respondent-Applicant's mark consistent with this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-001442 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 29 January 2013.


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

⁷ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.