



STICHTING BDO,
Opposer,

-versus-

BANCO DE ORO UNIBANK, INC.,
Respondent-Applicant.

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} IPC No. 14-2008-00220
} Opposition to:
} Appln. Serial No. 4-2007-003266
} Date filed: 29 March 2007
} TM: "BDO Remit and Device"

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 - 111 dated July 16, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 16, 2012.

For the Director:

Edwin A. Dating
Atty. EDWIN DANILO A. DATING
Assistant Director, BLA

CERTIFIED TRUE COPY
Sharon S. Alcantara
SHARON S. ALCANTARA
Records Officer II
Department of Trade and Industry, IPO



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Decision No. 2012- 111

DECISION

STICHTING BDO¹ ("Opposer") filed on 25 September 2008 an opposition to Trademark Application Serial No. 4-2007-003266. The application, filed by BANCO DE ORO UNIBANK, INC. ("Respondent")², covers the mark "BDO Remit and Device" for use on "*banking and financing services*" under Class 36 of the International Classification of goods³.

The Opposer alleges, among other things, that the mark BDO Remit and Device is confusingly similar to the Opposer's registered BDO marks, According to the Opposer, the Respondent-Applicant's trademark application is contrary to Sec. 123.1, subparagraphs (d), (e) and (f), and Sec. 131.3 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") and Sec. 6bis of the Paris Convention for the Protection of Industrial Property. The Opposer also claims that the registration of the Respondent-Applicant's mark will diminish the distinctiveness and dilute the goodwill of the Opposer's marks covering goods and services under Classes 35, 36 and 42.

To support its opposition to the subject trademark application, the Opposer submitted the following as evidence:

1. certified copy of Cert. of Reg. No. 4-2002-000146 for the mark BDO & Design;
2. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co., dated 01 June 1998;
3. 2007 International Directory of BDO International;
4. summary of Opposer's BDO's worldwide trademark portfolio;
5. certificates of registration for the word mark BDO and the mark BDO & Design in various countries around the world;

¹ A foundation duly organized and existing and by virtue of the laws of the Netherlands, with office address at Dr. Holtropaan 27, 5652 XR Eindhoven.

² With office address at BDO Corporate Center, 7899 Makati Avenue, Makati City, 0726, Metro Manila.

³ 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. 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.

6. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries;
7. World Hockey Posters;
8. various materials showing the large presence of BDO international and the active use of BDO and the BDO & Design in various countries around the world; and
9. notarized and legalized Affidavit-Testimony of witness Patrik Van Cauter;
10. BDO Corporate Visual Identity Manual;
11. BDO International Essential Facts 2007;
12. certificates of registration for the wordmark BDO and the mark BDO & Design in various countries around the world;
13. other certificates of registration for the wordmark BDO and the mark BDO & Design in various countries around the world;
14. printout of the BDO international website www.bdointernational.com;
15. printout of the BDO international website www.bdo.com;
16. printout of websites of some of the Member Firms of BDO international;
17. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries;
18. Cert. of Reg. No. 4-2002-000146 for the mark BDO & Design ;
19. notarized Affidavit-Testimony of witness Romeo C. Alba;
20. Memorandum of Agreement between BDO Binder B.V. and BDO Alba Ledesma & Co., dated 26 March 1997;
21. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co., dated 01 June 1998;
22. printouts of BDO Alba Romeo & Co.'s website www.bdoalbaromeo.com;
23. Brochure/Pamphlet of BDO Alba Romeo & Co.;
24. another brochure/pamphlet of BDO Alba Romeo & Co.;
25. photos of BDO Alba Romeo & Co.'s office lobby and premises; and
26. list of some of BDO Alba Romeo & Co.'s clients.⁴

On 26 February 2009, the Respondent-Applicant filed its Verified Answer. In substance, that Respondent-Applicant alleges that its right to the mark BDO has vested under Rep. Act No. 166 (the "old Law on Trademarks") which cannot be impaired by the IP Code, by virtue of being a prior user of the mark since 1977. Its right, says the Respondent-Applicant, is even protected under Sections 165 and 236 of the IP Code. According to the Respondent-Applicant, the Opposer's certificate of registration is only *prima facie* evidence of ownership which it sufficiently disputed through voluminous evidence of being the first and prior user of the mark BDO in the Philippines. It also contends that the use of Banco de Oro's initials "BDO" as its trade name is a common banking practice, and that no less than the Bureau of Trademarks has allowed its trademark application.

The Respondent-Applicant likewise claims that the Opposer's registrations for BDO and BDO & Design are not valid there being no actual use of the marks attributable to the Opposer. Also, the Respondent-Applicant argues that the Opposer's mark is not internationally well-known the latter having failed to show or to support the claim of extensive international registration, advertisement and use thereof. Furthermore, according to the Respondent-Applicant, the Opposer's marks are not locally well-known.

⁴ Marked as Exhibits "A" to "WWWWWWWW", inclusive. Originals of Exhibits "B", "C", "D-1" to "D-13", "G" to "R", "T" to "HH", "QQQQQQQQ" to "RRRRRRRRR", "TTTTTTT" to "WWWWWWWW" filed or submitted in IPC No. 14-2008-00017.

The Respondent-Applicant's evidence consists of the following:

1. certified true copy of the Petition for Cancellation it filed against the Opposer's Trademark Reg. No. 4-2002-000146 (IPC No. 14-2008-00017);
2. copy of its Articles of Incorporation and amended Articles of Incorporation;
3. promotional advertisements in the Bulletin Today and Daily Express (certified true copies submitted in IPC No. 14-2008-00017);
4. copy of its 1977 Annual Report that explains the adoption of the BDO logo and the subsequent annual reports from 1979 to 1981, 1983, 1985 to 1999 and 2001 to 2006 (originals were submitted in IPC No. 14-2008-00017);
5. samples of cashier checks, managers checks, and gift checks issued for more than 20 years, and passbook Savings Account No. 3001-003488-4 with 06 May 1991 as earliest date of deposit (original submitted in IPC No. 14-2008-00017), bearing the trademark and trade names Banco de Oro and BDO logo;
6. copies of the affidavits of Esther Ng Tycangco, Ester Recio, Peter Lo, Alicia Bautista, Yolanda Pilapil, Danilo Ong, Rosalia Ngo Chua, Josefina Malsi and Nelia Resol (originals submitted in IPC No. 14-2008-00017);
7. copies of internal memorandum dated 28 February 1990 for an employee's appointment, and a "Loan Release Advice" form dated 21 November 1991 for an employee's salary loan (originals submitted in IPC No. 14-2008-00017);
8. copy of a Junior Savings Club postcard with mailing date of 04 January 1991 (original submitted in IPC No. 14-2008-00017);
9. advertisements in newspapers starting 03 November 1977 up to 2003 (some of the originals or certified true copies were submitted in IPC No. 14-2008-00017);
10. lists of Respondent-Applicant's branches;
11. copies of photographs of several branches bearing the Banco De Oro, BDO and BDO logo in the signages (original printouts submitted in IPC No. 14-2008-00017);
12. Articles of Incorporation and 2007 General Information Sheets of BDO Financial Services, Inc., BDO Insurance Brokers, Inc., BDO Capital and Investment Corporation, BDO Savings Bank, Inc., BDO Realty Corporation, BDO Securities Corporation, and BDO Private Bank, Inc. (originals or certified true copies were submitted in IPC No. 14-2008-00017);
13. copy of the print out of the Respondent-Applicant's company profile as seen in the Philippine Stock Exchange (original submitted in IPC No. 14-2008-00017);
14. copies of application forms for various credit card products;
15. copy of Certificate of Change of Name of "Hatid Yaman Remittance Company, Ltd." to "BDO Remittance Limited" issued by the Registrar of Companies of Hongkong;
16. copy of television spot report for 2007, showing the date of airing and the frequency of the Respondent-Applicant's television advertisements in prime time and popular television shows and the costs thereof (original submitted in IPC No. 14-2008-00017);
17. copies of newspaper articles from 2000 to 2002 citing the Respondent-Applicant's trade name as BDO;
18. copies of the printout of the Respondent-Applicant's website;
19. copy of printouts Wikipedia article;
20. copies of advertisements in 2006 and 2007 in foreign media (originals submitted in IPC No. 14-2008-00017);
21. copies of photographs of the plaques/certificates of awards (originals of the printouts of the photographs submitted in IPC No. 14-2008-00017);
22. copies of the 2007 July issues of Alpha Southeast Asia Magazine and 2006 Edition of the Business World's Top 1000 corporations in the Philippines (originals submitted in IPC No. 14-2008-00017);
23. copy of Trademark Application Form for application No. 4-2007-003266;
24. certified true copy of "Paper No. 2" issued by the Trademark Examiner in relation to Respondent-Applicant's trademark application.

25. certified true copy of the Opposer's trademark application for the mark BDO & Design, and Declaration of Actual Use ("DAU");
26. certified true copies of the Respondent-Applicant's Response to Paper No. 2, Notice of Allowance and a print out of the corresponding publication of the mark BDO Remit and Device;
27. copy of Opposer's Verified Answer in IPC No. 14-2008-00017;
28. certified true copy of the Articles of Partnership of Alba Romeo; and
29. certified true copy of the Opposer's Rejoinder, dated 23 June 2008, in IPC No. 14-2008-00017.⁵

The Opposer filed a REPLY, dated 06 March 2009, and the Respondent-Applicant in turn submitted a REJOINDER on 19 March 2009.⁶ The preliminary conference was conducted and terminated on 04 May 2009. Consequently, the Respondent-Applicant filed its Position Paper on 29 May 2009 while the Opposer did so on 01 June 2009. Subsequently, a "Manifestation" dated 01 June 2011, was filed by the Respondent-Applicant stating that the instant case has been rendered moot and academic by the decision rendered by this Bureau in IPC No. 14-2008-00017. This prompted the Opposer to file on 14 June 2011 a "COMMENT/OPPOSITION" stating, among other things, that the aforementioned decision is not final and was brought to the Office of the Director General on appeal.

There is no dispute that the competing marks are identical or at least confusingly similar. The goods or services indicated in the Respondent-Applicant's trademark application are also similar and/or closely related to the Opposer's. The issue to be resolved in this case is whether the Respondent-Applicant's trademark application should be rejected on the grounds laid down by the Opposer.

In this regard, this Bureau noticed that the Opposer's case is anchored on its arguments that *first*, at the time the Respondent-Applicant filed the subject trademark application, it already has an existing trademark registration for the BDO (Reg. No. 4-2002-000146), and *secondly*, it is the owner of the mark by virtue of prior use thereof.

Trademark Reg. No. 4-2002-000146, however, was ordered cancelled in this Bureau's decision on IPC No. 14-2008-00017. The cancellation was upheld by the Director General in his Decision of 11 June 2012 on Appeal No. 14-09-55.

With the cancellation of Trademark Reg. No. 4-2002-000146, the instant opposition case has no more leg to stand on. Moreover, the Director General had also passed upon the issue of ownership of the mark BDO, ruling that the Respondent-Applicant has the better right over the mark BDO on the basis of the same facts, records and evidence attendant to this case.

Accordingly, there is no cogent reason for this Bureau to rule otherwise in this instance.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2007-003266 be

⁵ Marked as Exhibits "1" to "17", inclusive.

⁶ The case was referred to mediation pursuant to Office Order No. 154, s. 2010 (Rules of procedure for IPO Mediation Proceedings) and Office Order No. 197, s. 2010 (Mechanics for IPO Mediation and Settlement Period). The mediation, however, was unsuccessful. Accordingly,

returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 16 July 2012.


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