



STICHTING BDO,
Opposer,

-versus-

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

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}
} IPC No. 14-2011-00190
} Opposition to:
} Appln. Serial No. 4-2010-010214
} Date filed: 17 September 2010
} TM: "BDO Banco De Oro"
}
}
}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 - 128 dated July 16, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 16, 2012.

For the Director:

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

CERTIFIED TRUE COPY
Sharon S. Alcantara
SHARON S. ALCANTARA
Records Officer II
Bureau of Legal Affairs, IPO



STICHTING BDO,	}	IPC No. 14-2011-00190
Opposer,	}	Opposition to:
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	}	Appln. Serial No. 4-2010-010214
- versus -	}	Date Filed: 17 September 2010
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BANCO DE ORO UNIBANK, INC.,	}	Trademark: BDO Banco De Oro
Respondent-Applicant.	}	
x-----x		Decision No. 2012 - <u>128</u>

DECISION

STICHTING BDO¹ ("Opposer") filed on 05 May 2011 an opposition to Trademark Application Serial No. 4-2010-010214. The application, filed by BANCO DE ORO UNIBANK, INC.² ("Respondent-Applicant"), covers the mark 'BDO Banco De Oro' for use on *"banking services; financial affairs/services; monetary services; real estate services, namely consumer loans to finance acquisition of houses and lots, condominium units, or construction of homes, financing offered to individual buyers for the acquisition of property from the various projects of accredited real estate developers or those that have existing tie-ups with the applicant, credit facility offered to client developers to supplement working capital requirements and accelerate project development, consumer loans collateralized by real estate property for purposes of funding investments, working capital requirements, etc., asset management, disposal of foreclosed assets through outright sale, property auctions, or through its broker network and joint venture agreements with leading real estate developers and leasing of properties; insurance services namely, brokerage insurance services through its subsidiary, BDO insurance brokers inc., namely non-life insurance, particularly industrial/commercial all risk, fire and lightning with personal/comprehensive general/product liability, contractors' all motor vehicle, marine cargo insurance/marine hull/aviation, property floater, security bonds, money securities and payroll, fidelity guarantee, bankers' blanket bond, individual/group personal accident, travel personal accident, life insurance, particularly group life, HMO, particularly group health/hospitalization/HMO and bancassurance services and investment services"* under Class 36 of the International Classification of Goods³.

The Opposer alleges, among other things, that the mark BDO Banco De Oro 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.

- 1 A foundation duly organized and existing under 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.

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

1. Copy of the Appeal Memorandum filed with the Office of the Director General;
2. Copy of the Motion to Nullify Order with Motion to Stay Execution with Counterbond filed with the Office of the Director General;
3. Copy of the Omnibus Motion (o Nullify Order with Motion to Stay Execution with Counterbond) filed with the Office of the Director General;
4. 2007 International Directory of BDO International
5. Summary of Opposer's BDO's worldwide trademark portfolio;
6. Certificates of Registration for the word mark BDO and the mark BDO & Design in various countries around the world;
7. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries;
8. World Hockey Posters;
9. 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;
10. Certificate of Registration No. 4-2002-000146 for the mark BDO & Design;
11. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co. dated 01 June 1998;
12. Notarized Affidavit-Testimony of witness Robert Stroeve;
13. BDO Corporate Visual Identity Manual;
14. BDO International Essential Facts 2007;
15. Certificates of Registration for the word mark BDO and the mark BDO & Design in various countries around the world;
16. Other Certificates of Registration for the word mark BDO and the mark BDO & Design in various countries around the world;
17. Printout of the BDO International website www.bdointernational.com;
18. Printout of the BDO International website www.bdo.com;
19. Printouts of websites of some of the Member Firms of BDO International;
20. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries;
21. Certificate of Registration No. 4-2002-000146 for the mark BDO & Design;
22. Notarized and legalized Secretary's Certificate executed by Paul Willem Maria van Ellen;
23. Notarized Affidavit-Testimony of witness Romeo C. Alba;
24. Memorandum of Agreement between BDO Binder B.V. and BDO Alba Ledesma & Co. dated 26 March 1997;
25. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co. dated 01 June 1998;
26. Printouts of BDO Alba Romeo & Co.'s website www.bdoalbaromeo.com;
27. Brochure/pamphlet of BDO Alba Romeo & Co.;
28. Another brochure/pamphlet of BDO Alba Romeo & Co.;
29. Photos of BDO Alba Romeo & Co.'s office lobby and premises; and
30. List of some of BDO Alba Romeo & Co.'s clients.⁴

On 26 July 2011, the Respondent-Applicant filed its Verified Answer. In substance, the 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

⁴ Marked as Exhibits "A" to "AAAAAAAAA", inclusive. Originals of Exhibits "D", "E-1" to "E-13", "G" to "G-2", "H" to "S", "U", "W", "X" to "KK", "UUUUUUUU" to "VVVVVVVV", "XXXXXXXX", "ZZZZZZZZ" to "ZZZZZZZ-3" and "AAAAAAAAA" are filed or submitted in IPC No. 14-2008-00017.

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 registration for BDO & Design is not valid there being no actual use of the mark 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.

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

1. Certified copy of Decision No. 2009-53;
2. Certified copy of resolution No. 2099-37 (D);
3. Certified copy of Cancellation Order No. 2010-1;
4. Print-out of the public index file of Trademark Registration No. 4-2002-00146;
5. 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);
6. Copy of its Articles of Incorporation and amended Articles of Incorporation;
7. Certified copy of the Certificate of Filing of the Articles of and Plan of Merger of BDO Strategic Holdings Inc.;
8. Print-out of Respondent-Applicant's PSE company profile;
9. Certified true copy of the Reply dated 06 June 2008 submitted in IPC No. 14-2008-00017;
10. Print-outs of the updated contents of the Respondent-Applicant's website;
11. Print-outs of the updated Wikipedia article on the Respondent-Applicant;
12. Respondent-Applicant's awards listed in its website, www.bdo.com.ph;
13. Copy of the trademark application form for the mark BDO Banco De Oro;
14. Certified copy of the Respondent-Applicant's Motion for Execution Pending Appeal dated 26 August 2009;
15. Certified copy of the Opposer's Opposition to Motion for Execution Pending Appeal dated 11 September 2009;
16. Copy of Respondent-Applicant's Reply (To Opposer's Opposition to Motion for Execution Pending Appeal dated 11 September 2009);
17. Copy of Opposer's Rejoinder (To Respondent-Applicant's reply dated 28 September 2009);
18. Copy of Respondent-Applicant's Sur-Rejoinder (To Opposer's Rejoinder dated 28 September 2009);
19. Copy of Respondent-Applicant's Comment To Sur-Rejoinder dated 09 October 2009;
20. Certified copy of Order No. 2009-1773;
21. Certified copy of Order No. 2009-1802;
22. Certified copy of the Writ of Execution;
23. Certified copy of page 28 of Opposer's Verified Answer in IPC No. 14-2008-00017;
24. Certified true copy of the Articles of Partnership of Alba Romeo;
25. Compact disc containing a copy of the BBC broadcasts;
26. Compact disc containing a copy of the CNN broadcast and other television commercials;⁵

⁵ Marked as Exhibits "1" to "26", inclusive.

The Opposer filed a Reply dated 29 July 2011, and the Respondent-Applicant in turn submitted a Rejoinder on 08 August 2011.⁶ The preliminary conference was conducted and terminated on 13 October 2011. Consequently, the Opposer filed its position paper on 20 October 2011 while the Respondent-Applicant did so on 21 October 2011.

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.

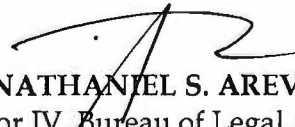
With the cancellation of Trademark Reg. No. 4-2002-000146, the instant opposition case has no more leg to stand on. Moreover, the Director General had also passed upon the issue of ownership of the mark BDO, ruling that the Respondent-Applicant has the better right over the mark BDO on the basis of the 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. 4-2010-010214 be 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

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.