



STICHTING BDO,
Opposer,

-versus-

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

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}
} IPC No. 14-2012-00147
} Opposition to:
} Appln. Serial No. 4-2011-012955
} Date filed: 26 October 2011
} TM: BDO UNIBANK"
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}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012- 230 dated December 27, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 27, 2012.

For the Director:


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



STICHTING BDO,	}	IPC No. 14-2012-00147
Opposer,	}	Opposition to:
	}	
- versus -	}	Appln. Serial No. 4-2011-012955
	}	Date Filed: 26 October 2011
	}	
BANCO DE ORO UNIBANK, INC.,	}	Trademark: BDO UNIBANK
Respondent-Applicant.	}	
x-----x	}	Decision No. 2012- <u>230</u>

DECISION

STICHTING BDO¹ ("Opposer") filed on 04 June 2012 a Verified Notice of Opposition to Trademark Application Serial No. 4-2011-012955. The application, filed by BANCO DE ORO UNIBANK, INC.² ("Respondent-Applicant"), covers the mark 'BDO UNIBANK' for use on "*checkbooks, stationary, and other printed forms and catalogues*" under Class 16 of the International Classification of Goods³.

The Opposer alleges, among other things, that the mark BDO UNIBANK 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. Appeal Memorandum filed with the Office of the Director General dated 22 September 2009;
2. Motion to Nullify Order with Motion to Stay Execution with Counterbond filed with the Office of the Director General dated December 15, 2009;
3. Omnibus Motion (to Nullify Order and Quash Writ of Execution with Alternative Motion to Stay Execution with Counterbond) filed with the Office of the Director General dated January 15, 2010;
4. 2010 BDO International Directory of Member Firms;

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, The Netherlands.

² A corporation duly organized and existing under and by virtue of the laws of the Philippines with given address at BDO Corporate Center, 7899 Makati Avenue, Makati City.

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.

5. Summary of Stitching BDO's worldwide trademark portfolio;
6. Certificates of Registration for the wordmark 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. BDO International's World Hockey Posters;
9. Various materials showing the large presence of BDO International and the active use of its wordmark BDO and the mark BDO & Design in various countries around the world;
10. Certificate of Registration No. 4-2002-000146 for the mark BDO & Design issued by the Intellectual Property Office of the Philippines;
11. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co. dated June 1, 1998;
12. Notarized and legalized Affidavit-Testimony of witness Robert Stroeve;
13. BDO Corporate Visual Identity Manual;
14. BDO International Essential Facts 2007;
15. Certificates of Registration for the wordmark BDO and the mark BDO & Design in various countries around the world;
16. Printout of BDO International website www.bdointernational.com;
17. Printouts of websites of some of the Member Firms of BDO International;
18. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries;
19. Certificate of Registration No. 4-2002-000146 for the mark BDO & Design issued by the Intellectual Property Office of the Philippines;
20. Notarized and legalized Secretary's Certificate executed by Paul Willem Maria van Elten;
21. Notarized Affidavit-Testimony of witness Romeo C. Alba;
22. Memorandum of Agreement between BDO Binder B. V. and BDO Alba Ledesma & Co. dated 26 March 1997;
23. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co. dated 01 June 1998;
24. Printouts of BDO Alba Romeo & Co.'s website www.bdoalbaromeo.com;
25. Brochure/pamphlet of BDO Alba Romeo & Co.;
26. Another brochure/pamphlet of BDO Alba Romeo & Co.;
27. Photos of BDO Alba Romeo & Co.'s office lobby and premises; and
28. List of some of BDO Alba Romeo & Co.'s clients.⁴

On 13 July 2012, the Respondent-Applicant filed its Verified Answer. In substance, the Respondent-Applicant alleges that the instant opposition should be dismissed for lack of factual or legal basis by virtue of the cancellation of Opposer's Certificate of Registration No. 4-2002-000146 for the mark BDO & Device. The Respondent-Applicant claims that its right to the mark BDO has vested under Rep. Act No. 166 (the "old Law on Trademarks") which right cannot be impaired by the IP Code, by virtue of being a prior user of the mark since 1977. 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

⁴ Marked as Exhibits "A" to "LLLLLLLLL", inclusive.

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.

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 in the Philippines attributable to the Opposer. Also, the Respondent-Applicant argues that the Opposer's marks are 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 true copy of Decision No. 2009-53;
2. Certified true copy of Resolution No. 2009-37 (D);
3. Certified true copies of the Cancellation Order No. 2010-1 dated 26 March 2010;
4. Printout of the public index file of Trademark Registration No. 4-2002-000146 downloaded from <http://trademarks.ipophil.gov.ph/tmsearch/>;
5. Certified true copy of the Petition for Cancellation in IPC No. 14-2008-00017;
6. Certified true copy of the Certificate of Filing of Amended Articles of Incorporation;
7. Promotional advertisements in the Bulletin Today and the Philippine Daily Express (certified true copies submitted in IPC No. 14-2008-00017);
8. Copy of 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);
9. 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;
10. Copies of the Affidavits of Esther Ng Tycangco, Ester Recio, Peter Lo, Alicia Bautista, Yolanda Pilapil, Danilo Ong, Rosalina Ngo Chua, Josefina Malsi, Nelia Resol, Marie Therese Granada Santos and Erlinda Duque (originals submitted in IPC No. 14-2008-00017);
11. 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);
12. Copy of a Junior Savings Club postcard with mailing date of 04 January 1991 (original submitted in IPC No. 14-2008-00017);
13. Advertisements in newspapers starting 03 November 1977 up to 2003 (originals submitted in IPC No. 14-2008-00017);
14. Copies of photographs of several branches bearing the Banco de Oro, BDO and BDO Logo in their signages (original printouts submitted in IPC No. 14-2008-00017);
15. 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 submitted in IPC No. 14-2008-00017);
16. 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);
 17. Copies of application forms for various credit card products;
 18. 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;
 19. Certified true copy of the Reply dated 06 June 2008 in IPC No. 14-2008-00017;
 20. Certified true copy of Opposer's Rejoinder dated 23 June 2008 in IPC No. 14-2008-00017;
 21. Copy of television spot report for 2007, showing the date of airing on 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);
 22. Copies of newspaper articles from 2000 to 2002 citing the Respondent-Applicant's trade name as BDO;
 23. Printouts of the updated contents of the Respondent-Applicant's website;
 24. Copy of printouts of Wikipedia article;
 25. Copies of advertisements in 2006 and 2007 in foreign media (originals submitted in IPC No. 14-2008-00017);
 26. Copies of photographs of the plaques/certificates of awards (originals of the printouts of the photographs submitted in IPC No. 14-2008-00017);
 27. 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);
 28. Awards listed in Respondent-Applicant's website www.bdo.com.ph;
 29. Certified true copy of Respondent-Applicant's trademark application form as filed with the IPO;
 30. Certified true copy of the Motion for Execution;
 31. Certified true copy of the Opposition to Motion for Execution Pending Appeal;
 32. Reply (to Respondent-Registrant's Opposition to Motion for Execution Pending Appeal) dated 22 September 2009;
 33. Rejoinder (to Respondent-Applicant's Reply) dated 28 September 2009;
 34. Respondent-Applicant's Sur-Rejoinder dated 07 October 2009;
 35. Opposer's Comment to Sur-Rejoinder dated 09 October 2009;
 36. Certified true copy of Order No. 2009-1773;
 37. Certified true copy of Order No. 2009-1802;
 38. Certified true copy of the Writ of Execution;
 39. Certified true copy of page 28 of Opposer's Verified Answer in IPC No. 14-2008-00017;
 40. Certified true copy of the Articles of Partnership of Alba Romeo;
 41. Compact discs containing copies of the BBC broadcasts and CNN other television commercials;
 42. List of Respondent-Applicant's over 700 branches;
 43. Certified true copy of the Director General's Order dated 16 November 2011;
 44. U. S. Court Order dated 15 November 2011;

45. Certified true copy of Decision dated 11 June 2012; and
46. Copy of the RTC Judgment in IP Case MC 09-02 dated 28 February 2012.⁵

The case was referred to the IPO Mediation Office for mediation conference, however, on 24 August 2012 it was declared a failure of mediation. Then after, the preliminary conference was conducted and terminated on 16 October 2012. The parties submitted their respective position papers on 25 October 2012.

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. 4-2011-012955 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 27 December 2012.


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

⁵ Marked as Exhibits "1" to "31", inclusive.