



**BAC-MAN GEOTHERMAL, INC.,**  
*Opposer,*

**IPC NO. 14-2011-00266**  
Opposition to:

-versus-

Appln. Serial No. 4-2010-010427  
(Filing Date: 23 September 2010)  
TM: "BGI (Sylized)"

**BGI SHENZHEN CO. LIMITED,**  
*Respondent-Applicant.*

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Decision No. 2014- 265

## DECISION

**BAC-MAN GEOTHERMAL, INC.**<sup>1</sup> ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2010-010427. The application, filed by **BGI SHENZHEN CO. LIMITED**<sup>2</sup> ("Respondent-Applicant"), covers the mark "BGI (Stylized)" under Classes 5, 9, 42, and 44<sup>3</sup>, to wit:

1. Class 5: Pharmaceutical preparations; serums; ointments for pharmaceutical purposes; pills for pharmaceutical purposes; anti-anoxia medicine; diagnostic preparations for medical purposes; diagnostic kits for use in disease testing; haemoglobin; fodder additives for medical purposes; media for bacteriological cultures; enzymes for veterinary purposes; enzymes for medical purposes; pesticides for agricultural use;
2. Class 9: Computers; electronic publications in the nature of journals and newsletter in the field of biology, biochemistry, genomics, proteomics, cloning technology, human health, diagnostics, agriculture, and bioinformatics; computer software and programs for bioinformatics analysis and research; computer software for scientific analysis of genetic sequences; physiological parameters monitors; incubators for bacteria culture; microscopes and parts thereof; optical apparatus and instruments; protection devices against X-rays (Roentgen rays), not for medical purposes; bio-chip readers; bio-chips in the use of scientific research, DNA identification, disease testing, drug screening, and drug development;
3. Class 42: Agricultural research; environmental research; project studies in the field of biochemistry, biology, bacteriology, protein and genomics; biochemical, biological, bacteriological and genomics research and analysis; consulting services in the fields of biotechnology and genetic science; providing information in the field of genetics research

<sup>1</sup> A corporation duly organized under the laws of the Philippines with business address at Energy Center, Merritt Road, Fort Bonifacio, 1200 Taguig City, Metro Manila.

<sup>2</sup> A corporation duly organized under the laws of China with business address at Main Building, Beishan Industrial Zone, Yantian District, Shenzhen 518083, China.

<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.

resources; sequencing services for research purposes, namely, plant and animal genome sequencing, microorganism genome sequencing, RNA sequencing, epigenomics sequencing, Sanger sequencing; sequencing services for complex disease research; designing and updating computer software for scientific analysis of genetic sequences; providing data storage and cloud computing services for bioinformatics analysis; the platform of bioinformatics analysis as a service, namely sequencing large-scale DNA, developing software and pipeline, providing varieties of bioinformatics and computational methods and tools for data analysis, developing and maintaining data management systems, supporting robust computational infrastructure, constructing databases, and also focusing on developing all kinds of applications; and

4. Class 44: Hospitals; pharmaceutical advice; telemedicine services; animal breeding; veterinary specialty services providing advanced medical, diagnostic or surgical services for animals; plant nurseries; plant breeding; aerial and surface spreading of fertilizers and other agricultural chemicals; lawn care; vermin exterminating for agriculture, horticulture and forestry; genetic counselling; genetic testing for medical purposes; clinical treatment; clinical laboratory services.

The Opposer anchors its opposition on Sec. 123.1(d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”). According to the Opposer, it is the purchaser of the 150-megawatt Bacon and Manito (“Bac-Man”) geothermal power plants in the Bicol region from the government-operated Power Sector Assets and Liabilities Management Corporation (“PSALM”). It asserts that it is the first to adopt, use and apply for the registration of the “BGI” mark in the Philippines under Trademark Application No. 4-2010-501272 filed on 26 August 2010 for services under Class 42 (supply of electricity). Thus, there is a likelihood of confusion between its own “BGI” mark and the Respondent-Applicant’s “BGI (Stylized)” mark because the latter mark so resembles the former in terms of appearance, sound, spelling and meaning as to likely cause confusion, mistake and deception on the part of the purchasing public as being a mark owned by the Opposer. To support its Opposition, the Opposer submitted the following as evidence:

1. Exhibit “A”- printout of the Opposer’s “*Online Application*” form for the mark “BGI”;
2. Exhibit “B”- Notice of Allowance from the Bureau of Trademarks permitting the application of Exhibit “A”;
3. Exhibit “C”- Print out of Online Application Form of BGI Shenzhen Co. Limited for the mark “BGI (Stylized)”;
4. Exhibit “D”- Memorandum from Maria Luz L. Caminero, PSALM Officer-In Charge, informing Hon. Zenaida G. Cruz-Ducut, Chairperson of the Energy Regulatory Commission, regarding the transfer of control and ownership of the Bac-Man Geothermal Power Plant to Bac-Man Geothermal, Inc.;
5. Exhibit “E”- Memorandum from Lourdes S. Alzona, PSALM Vice President of Finance, informing Ernesto B. Pantangco, Executive Vice President of Bac-Man Geothermal, Inc. to expedite its registration to the Wholesale Electricity Spot Market;
6. Exhibit “F”- Certification from Robinson P. Descanzo, Vice President of Corporate Planning & Communications of the Philippine Electricity Market Corporation, that it received the application of Bac-Man Geothermal, Inc. to join the Philippine Wholesale Electricity Spot Market;

7. Exhibit "G"- Certification from Ma. Cynthia Y. Manrique, Head of Revenue and Regulatory Affairs of the National Grid Corporation of the Philippines, certifying that Bac-Man Geothermal, Inc. is in the process of securing connection, metering and transmission service agreements from the said government agency;
8. Exhibit "H"- "EDC completes BacMan purchase", news article published in the Manila Times on 04 September 2010;
9. Exhibit "I"- "EDC company completes P1.28-B", news article published in Manila Bulletin on 05 September 2010;
10. Exhibit "J"- "EDC unit completes purchase of Bacman geothermal complex", news article published in The Philippine Star on 04 September 2010;
11. Exhibit "K"- "EDC completes payment for BacMan geothermal facilities" (online news article published in Business Insight Malaya) on 06 Sept. 2010;
12. Exhibit "L"- "EDC unit completes purchase of Bacman geothermal complex" (online news article published in Philippine Star Online) on 04 Sept. 2010;
13. Exhibit "M"- Print out of Exhibit "K" as shared on the SE Asia Energy Yahoo! Group; and
14. Exhibit "N"- "Bacman Geothermal Inc. completes US\$28.7M payment for Bacon-Manito Plants" (online news article published on Think GeoEnergy website on 05 Sept. 2010).

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 03 August 2011. On motion of the Respondent-Applicant, this Bureau extended the period up to 02 October 2011 within which to file the answer. The extension notwithstanding, the Respondent-Applicant failed to or did not to file the answer.

Should the mark **BGI (Stylized)** be registered in the name of the Respondent-Applicant?

It is emphasized that 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.<sup>4</sup> Thus, Sec. 123.1 (d) of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") prohibits the registration of the mark if it:

- (d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
  - (i) The same goods or services, or
  - (ii) Closely related goods or services, or
  - (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

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<sup>4</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 November 1999, citing *Ethepa v. Director of Patents*, supra, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

The mark applied for registration by the Respondent-Applicant is practically identical to the Opposer's mark. In this regard, records show that at the time the Respondent-Applicant filed its trademark application on 23 October 2010, the Opposer already has an existing application for the registration of the mark BGI filed on 26 August 2010. Corollarily, this Bureau takes cognizance via judicial notice of the Intellectual Property Office of the Philippines' Trademark Registry which shows that the Opposer's application has matured into registration on 5 May 2011.

At a glance, the goods and services indicated in the Respondent-Applicant's trademark application appear to be non-competing with the service covered by the Opposer's application. However, Sec. 123.1 (d) IP Code prohibits the registration of the mark if it:

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of :

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion: (underscoring supplied)

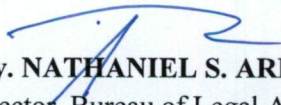
This Bureau noticed that the mark applied for registration by the Respondent-Applicant is composed only of three letters - "BGI" - unaccompanied by any other word much less a device. It is identical to the Opposer's mark "BGI", which is also without any device. Obviously, "BGI" is an acronym, which in essence is an invented word and thus, as a trademark, is highly distinctive. On this score, the parties' respective goods/services are industrial in application or use. Due to the nature of and the diversity of sources or means of producing electric power, a provider or supplier thereof is likely engaged in technological and environmental researches. There is the likelihood therefore that consumers or the public would be of the wrong impression that the parties are connected to each other. The Supreme Court has held:<sup>5</sup>

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application No. 4-2010-010427 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 27 October 2014.

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

<sup>5</sup> *Converse Rubber Corporation v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.