



CITIGROUP INC.,
Opposer,

-versus-

CITIHOMES BUILDER AND
DEVELOPMENT, INC.,
Respondent-Applicant.

} IPC No. 14-2014-00115
}
} Opposition to:
} Appln. Serial No. 4-2013-005784
} Date Filed: 21 May 2013
} TM: "MYCITIHMES"
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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 222 dated October 21, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 21, 2015.

For the Director:


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



CITIGROUP INC.,
Opposer,

IPC NO. 14-2014-00115

-versus-

Opposition to:
Appln. Serial No. 4-2013-005784
Date Filed: 21 May 2013

**CITIHOMES BUILDER AND
DEVELOPMENT, INC.,**
Respondent-Applicant.

Trademark: "MYCITIHHOMES"

x-----x

Decision No. 2015- 222

DECISION

Citigroup Inc.,¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-005784. The application, filed by CitiHomes Builder and Development, Inc. ("Respondent-Applicant")², covers the mark "MYCITIHHOMES" for use on "*real estate affairs, brokerage, real estate agencies/management*" under Class 36 of the International Classification of goods and services³.

The Opposer alleges, among others, that it has made a conscious effort to establish its identity under its "CITI" name and marks which include "CITI and arc design", "CITIBANK", "CITIBANK PAYLINK", "CITIBANKING", "CITICARD", "CITICORP", "CITIDIRECT", "CITIGOLD", "CITIGROUP" and "CITISERVICE". According to the Opposer, it has used and is using its "CITI" family of trademarks in business in many countries including the Philippines and the registration of the Respondent-Applicant's mark "MYCITIHHOMES" will greatly damage and prejudice its rights over its marks. It claims that by virtue of its prior and continued use of its mark in many countries, the large amounts it spent in advertising, promoting, marketing and popularizing the same, and the extensive number of trademark applications and/or registrations, the "CITI" family of marks has become popular and internationally well-known. In support of its opposition, the Opposer submitted the affidavit of Eileen E. Kennedy, its Managing Director, Associate General Counsel and Assistant Secretary, with attachments.⁴

The Respondent-Applicant filed its Answer on 05 August 2014 asserting that with the issuance by the Securities and Exchange Commission (SEC) of a Certificate of Incorporation, the latter is deemed to have passed upon all the rigid requirements of establishing a corporation and did not find that "CitiHomes Builder Development

¹ A public corporation duly organized and existing under the laws of the state of Delaware, USA with principal office at 399 Park Avenue, New York, New York, USA 10043.

² A domestic corporation with business address at 23rd Floor, The World Centre, 30 Sen. Gil Puyat Ave., 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.

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

**Republic of the Philippines
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Inc." is identical or deceptively confusingly similar to an existing corporation or other name protected by law. It also stresses that while the Opposer is a financial services corporation, its company is engaged in real property development. It avers that even granting that the competing marks are confusingly similar, its application should not be denied as the marks will not be used in the same line of business. The Respondent-Applicant submitted a copy of its Articles of Incorporation and Certificates of Filing Amended Articles of Incorporation as evidence.⁵

Pursuant to Office Order No. 154, s. 2010, the case was referred to mediation. The parties, however, refused to mediate. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 28 April 2015. Thereafter, the parties submitted their respective position papers and the case is deemed submitted for decision.

Prefatorily, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. 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.⁶

Records reveal that at the time the Respondent-Applicant filed its application on 21 November 2013, the Opposer has valid and existing registrations of its "CITI" marks including "CITI & ARC DESIGN" issued as early as 08 June 2006.

For comparison, the marks are reproduced as follows:



Opposer's marks

⁵ Marked as Exhibit "1" and "2".

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.



Respondent-Applicant's mark

There is no dispute that the competing marks appropriate the word "CITI", which the Opposer claims to be its well-known mark. It is noteworthy that the "CITI" family of marks has been declared well-known by the Office of the Director General in the latter's decision rendered on 21 April 2008 in the case of "Citigroup Inc. vs. Connaught Center Holdings, Inc." docketed as IPC No. 14-2006-00033⁷, viz:

"To support this contention, the Appellant submitted copies of certificates of registration of its trademarks in the Philippines and in other countries and evidence showing the considerable amount of resources and time in advertising and promotion of its products and services bearing these marks. The Appellant also cites the U.S. case CIT Group, Inc. vs. Citicorp and World Intellectual Property Case Citigroup Inc. vs. Lee Yuki. This Office finds these proofs sufficient to show that the CITI family of marks are internationally well-known."

Accordingly, there is no cogent reason for this Bureau to deviate from this ruling. The Office of the Director General is considered among the competent authorities that may declare a trademark as well-known. Succinctly, Section 123.1 (e) and (f) of the IP Code provides that:

"123.1. A mark cannot be registered if it:

(e) 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 Philippines, 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;

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and

⁷ Appeal No. 14-07-18.

the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use;

xxx"

The declaration of the Opposer's "CITI" marks as well-known notwithstanding, this Bureau finds that the mark "MYCITIHMES" should still be allowed registration absent confusing similarity. The prevalent feature of the Opposer's marks is the word "CITI" while the Respondent-Applicant's mark does not focus on the said word. The beginning word "MY" and the ending word "HOMES" sufficiently lend it the distinctiveness required by law. Noteworthy, the mark "MYCITIHMES" is also accompanied by figure of houses which immediately convey that the same is engaged in real estate.

Even in respect of aural and conceptual projection, confusion or mistake is remote. This is so because "MYCITIHMES" is used for real estate service which is not covered by the Opposer's registration. Therefore, the consumers of one will not be confused, misled and/or deceived that the Opposer's financial and/or banking services are in any way related or connected to the Respondent-Applicant's real estate service. In addition, it is noteworthy that the services involved are the types which are thoughtfully chosen by their target consumers. Cast in this particular controversy, the ordinary purchaser is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved. The definition laid down in *Dy Buncio v. Tan Tiao Bok* is better suited to the present case. There, the "ordinary purchaser" was defined as one "accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."⁸

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. 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.⁹

⁸ *Victorio P. Diaz vs. People of the Philippines*, G.R. No. 180677, 18 February 2013.

⁹ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-005784 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 21 October 2015.



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