

**BENTA BIRADA NEW DAILY/
PHELAN A. TAYLARAN,**
Opposer,

-versus-

**BRIGADA NEWS PHILIPPINES
ELMER V. CATULPOS,**
Respondent- Applicant.

IPC No. 14-2010-00294
Opposition to:
Appln. Serial No. 4-2010-740084
Date Filed: 16 July 2010
TM: "BIRADA"

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NOTICE OF DECISION

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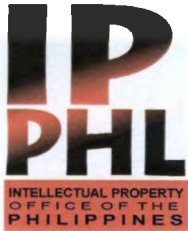
GREETINGS:

Please be informed that Decision No. 2016 - 44 dated February 11, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 11, 2016.

For the Director:

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



**BENTA BIRADA NEWS DAILY /
PHELAN A. TAYLARAN,**
Opposer,

IPC NO. 14 – 2010- 00294
Case Filed on: 1 December 2010

- versus -

Opposition to:

Appln Serial No. 42010740084
Date filed: 16 July 2010
TM: "BIRADA"

**BRIGADA NEWS PHILIPPINES
ELMER V. CATULPOS,**
Respondent-Applicant.

DECISION NO. 2016 - 44

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DECISION

MR. PHELAN A. TAYLARAN (Opposer),¹ owner and proprietor of Benta Birada News Daily, filed an Opposition to Trademark Application No. 4-2010-740084 on 16 July 2010. The application filed by MR. ELMER V. CATULPOS (Respondent-Applicant),² owner and proprietor of Brigada News Philippines, covers the mark "BIRADA" for "Newspaper" under Class 16 of the International Classification of Goods.³

The pertinent allegations in the Opposition are quoted as follows:

- "3.1. That the applied Trademark "BIRADA" for Letterhead, Signage, Employee's Uniform, Dry / Wet Seal by the Respondent-Applicant has been used and appropriated as his own by the Opposer, Phelan A. Taylaran, for his local newspaper tabloid publishing business under a duly registered Trade name Benta Birada News Daily. Since November 13, 2009, Benta Birada News Daily and/or Phelan A. Taylaran has been using and/or appropriating the word "BIRADA" in the masthead of his local daily newspaper tabloid published and circulated in Cagayan de Oro City and in the neighboring cities municipalities and provinces in the Islands of Mindanao and Visayas;
- "3.2. So that, the applied trademark "BIRADA" is identical with, or confusingly similar to, or constitutes a translation of a mark already long appropriated and/or used by the Opposer, whereby although not registered, has already been well-known locally in Mindanao and the Visayas Islands and which has already established goodwill to the reading public. Albeit not registered, Opposer's use

¹Filipino, of legal age, married and resident of PPA Road Agora Lapasan, Cagayan de Oro City .

²Filipino, of legal age, married and resident of Roxas Ave., Brgy. East, General Santos City.

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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and/or appropriation as his own of the mark "BIRADA" is entitled to protection. x
x x

- "3.3. That Respondent-Applicant has not been using and/or appropriating the mark "BIRADA" in his local newspaper tabloids at the time he applied for the registration of the said mark on July 16, 2010, for a period of at least three (3) years as required by law. It was only in the last week of August 2010 when the Respondent-Applicant started using and appropriating the word "BIRADA" in the masthead of his local tabloids circulated and sold in Mindanao. Respondent-Applicant, however, actually used a yellow background, not the red color he applied for, with words Daily Newspaper in blue bold italics below the word "BIRADA" which is printed in bold red italics, not in bold yellow text as applied for;
- "3.4. Otherwise put, Respondent-Applicant has not been using and/or appropriating as his own, the word "BIRADA" exactly in the color and design that he applied for registration. What the Respondent-Applicant has been using and/or appropriating, but only beginning the last week of August 2010, is the word "BIRADA" in bold red letters, with a yellow background;
- "3.5. Nevertheless, the mark applied for registration with IPO is no doubt, identical, or confusingly similar to or constitutes a translation of the mark already in use and appropriated by the Opposer, daily in the masthead of his local daily newspaper tabloid Benta Birada News Daily;
- "3.6. Ergo, the applied trade mark cannot be registered based on the provisions of Section 123(e) and Section 124.2 of Republic Act 8293;
- "3.7. Opposer attaches herewith a sample issue of the local tabloid published by Respondent-Applicant for August 23, 2010 wherein the word "BIRADA" was used x x x Applicant's August 23 2010 issue was yet his 6th issue. This means that Respondent-Applicant first issue using the word "BIRADA" was only on August 17, 2010;
- "3.8. On the hand, Opposer has been using and/or appropriating the mark with the word "BIRADA" therein as the dominant word in the masthead of his publication since November 13, 2009 and continuously every day until at present;
- "3.9. At present, Opposer / Benta Birada News Daily has a sales of over Seven Thousand copies of tabloids daily in Northern Mindanao. Its newspaper tabloid "BIRADA" News Daily, with slogan "Gamay pero Yayay" has already established a distinctive mark of the reading public as the Official publications of the Opposer and not of the Applicant albeit it started only in November of 2009. Considering, that it is catered everyday, it has swiftly established a distinctive mark in the minds of the reading public;"

This Bureau issued a Notice to Answer to the Respondent-Applicant. Subsequently, the Respondent-Applicant filed its Answer on 20 January 2011. The pertinent portion of the Answer are as follows:

- "1. The subject Verified Notice of Opposition has been the offshoot of the Complaint for Violation of R.A. No. 8293, The Intellectual Property Code, to wit: Infringement of Trademark and Unfair Competition filed by the herein respondent/application before the City Prosecution Office of Cagayan de Oro against the herein Opposer Phelan A. Taylaran, et. al. under NPS Docket No. X06-INV-10K-02501, anchored on their act of publishing a tabloid known as Benta Birada News Daily, which is named as an alternative opposer herein, and of a Complaint for Libel against them before the General Santos City Prosecution Office embraced under NPS Docket No. XII-30-INV-10J-00585 premised on certain libelous articles which were written and published in the said tabloid. Ergo, this Verified Notice of Opposition serves as an act of unlawful retaliation by the opposer and his personnel/staff members who were made respondents in the aforesaid cases.
- "2. The averment of the opposer in paragraph 3.1 of the Verified Notice of Opposition that he has appropriated as his own the trademark "BIRADA" applied for by

respondent since November 13, 2009 is hereby specifically denied, on account of the fact that such an act cannot and should not be given protection as it is glaringly unlawful, for it has been copied, imitated or patterned from that of the IPO-registered trademark BRIGADA NEWS PHILIPPINES. The same constitutes an Infringement of Trademark and Unfair Competition as clearly established in the Complaint for Violation of R.A. No. 8293 cited in the immediately preceding paragraph x x x

- "3. Given the foregoing, the allegations of the Opposer in paragraphs 3.2, 3.5, 3.6, 3.8 and 3.9 of the subject Opposition should not be given due consideration because the same are bereft of legal basis, and should in fact be treated as explicit admissions on the part of the opposer and his personnel / staff members of the violations of the Intellectual Property Code they have committed, the aggrieved party of which is the herein respondent/applicant;
- "4. The opposer made an erroneous interpretation of Section 124.2 of the Intellectual Property Code x x x This similar provision is likewise indicated in Section 151.1 (c) of R.A. 8293 and in Section 2(c), Rule 8 of Rules and Regulation on Inter Partes Proceedings (Petitions for Cancellation of Patent, Trademark, Utility Model, Industrial Design, Compulsory Licensing and Opposition to Trademark Registration) x x x The said provision actually means that a registered mark can be cancelled or a mark can be denied registration, if the owner of the registered mark or the applicant, failed to use the same, without legitimate reason, for an uninterrupted period of at least three (3) years, to be reckoned from the time of registration or application, and NOT PRIOR OR BEFORE THAT TIME, as the case may be, of the trademark. Thus the averment in paragraph 3.7 of the subject document will not hold water and is immaterial;
- "5. Moreover, the contention in the last paragraph 3.3 and 3.4 of the Notice of Opposition are of no moment and should be simply disregarded because the same is easily defeated by what is enshrined in Section 152.2 of the Intellectual Property Code, which states that: "The use of the mark in a form different from the form in which it is registered, which does not alter its distinctive character, shall not be a ground for cancellation or removal of the mark and shall not diminish the protection granted to the mark";
- "6. The respondent's act of filing a Complaint for Violations of R.A. No. 8293 (Intellectual Property Code) to enforce the rights to a registered mark, BRIGADA NEWS PHILIPPINES, and of a similar or closely-related mark thereto, BIRADA, which is the subject matter of the herein Opposition, (as cited in paragraph 2 of the Answer) divest this Honorable Tribunal of jurisdiction over the herein Notice of Opposition, pursuant to Section 151.2 of the said law, which states: "Notwithstanding the foregoing provisions, the court or the administrative agency vested with jurisdiction to hear and adjudicate any action to enforce the rights to a registered mark shall likewise exercise jurisdiction to determine whether the registration of said mark may be cancelled in accordance with this Act. The filing of a suit to enforce the registered mark with the proper court or agency shall exclude any other court or agency from assuming jurisdiction over a subsequently filed petition to cancel the same mark";
- "7. Lastly, the Opposer should have come before this Honorable Tribunal with clean hands. Well settled is the rule in equity jurisprudence, that he who comes to equity must come with clean hands. Accordingly, where a person is guilty of bad faith, fraud of unconscionable act in the transaction which forms the basis of his claim he is entitled to no equitable relief on account of the transaction x x x."

The Opposer submitted the following evidence:

- Annex "A" – Certified True Copy of the Certificate of Business Name Registration for BENTA BIRADA NEWS DAILY
- Annex "B" – Certified True Copy of the Business Permit granted to Opposer for BENTA BIRADA NEWS DAILY.

- Annex "C" – A copy of the Opposer's BIRADA NEWS DAILY Vol.1 Issue No.089 dated 9 February 2010
- Annex "C-1" – A copy of the Opposer's BIRADA NEWS DAILY Vol.1 Issue No.094 dated 14 February 2010
- Annex "C-2" – A copy of the Opposer's BIRADA NEWS DAILY Vol. 1 Issue No. 145 dated 10 April 2010
- Annex "C-3" – A copy of the Opposer's BIRADA NEWS DAILY Vol.1 Issue No.146 dated 11 April 2010
- Annex "C-4" – A copy of the Opposer's BIRADA NEWS DAILY Vol.1 Issue No.152 dated 17 April 2010
- Annex "C-5" – A copy of the Opposer's BIRADA NEWS DAILY Vol.1 Issue No.153 dated 18 April 2010
- Annex "C-6" – A copy of the Opposer's BIRADA NEWS DAILY Vol.1 Issue No.154 dated 19 April 2010
- Annex "C-7" – A copy of the Opposer's BIRADA NEWS DAILY Vol.1 Issue No.172 dated 8 May 2010
- Annex "C-8" – A copy of the Opposer's BIRADA NEWS DAILY Vol.1 Issue No.174 dated 10 May 2010
- Annex "C-9" – A copy of the Opposer's BENTA BIRADA NEWS DAILY Vol.1 Issue No.363 dated 15 November 2010
- Annex "D" – A copy of the Respondent-Applicant's The Original BIRADA NEWS DAILY Vol. 1 Issue No. 006 dated 23 August 2010
- Annex "D-1" – A copy of the Respondent-Applicant's The Original BIRADA NEWS DAILY Vol. 1 Issue No. 048 dated 5 October 2010
- Annex "E" – Affidavit of Mr. Melbert B. Munsad dated 19 November 2010
- Annex "E-1" – Affidavit of Mr. Rafy T. Dagcuta dated 19 November 2010
- Annex "E-2" – Affidavit of Mr. Romeo C. Monterola dated 19 November 2010
- Annex "E-3" – Affidavit of Mr. Jose A. Reyes dated 19 November 2010

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

- Annex "1" – Copy of the Complaint-Affidavit of Mr. Elmer Catulpos filed with the City Prosecution Office for the I.S. Case No. INV-10K-2501 dated 3 November 2010 including attachments.
- Annex "2" - Copy of the Petition for Review filed with Department of Justice for NPS No. X-06-INV-10K-2501 dated 3 July 2011
- Annex "3" – Copy of the Complaint Affidavit of Mr. Elmer V. Catulpos dated 13 October 2010 for NPS Case No. XII-INV-10J-00585 including attachments
- Annex "4" - Copy of the Verified Answer to the Opposition to the instant case dated 13 January 2011

During the Preliminary Conference scheduled on 3 August 2011, only the Opposer appeared and was ordered to submit his Position Paper. On 24 August 2011, the Opposer filed his Memorandum. Subsequently, the Respondent-Applicant manifested that he received the Notice of Preliminary Conference only on 9 September 2011. Thus, in an Order dated 30 March 2012, Respondent-Applicant was allowed to submit his Position Paper which he filed on 18 June 2012.

At the outset, it is imperative to clarify that the provision on mandatory divestment of jurisdiction by this Office, as argued by the Respondent-Applicant citing Section 151.2 of the Intellectual Property Code, does not apply in the instant case. The said section provides:

151.2 Notwithstanding the foregoing provisions, the court or the administrative agency vested with jurisdiction to hear and adjudicate any action to enforce the rights to a registered mark shall likewise exercise jurisdiction to determine whether the registration of said mark may be cancelled in accordance with this Act. The filing of a suit to enforce the registered mark with the proper court or agency shall exclude any other court or agency from assuming jurisdiction over a subsequently filed petition to cancel the same mark.

The above provision pertains to the action for enforcing an already registered trademark and a subsequent filing of a separate petition for cancellation with respect to the same registered mark. The instant case is merely an Opposition against a still to be registered trademark and not a cancellation case as contemplated by the provision. Moreover, the cases contemplated in the above provision must pertain to a single mark that is being enforced by the registered owner and the same time being asked to be cancelled by the other party. The initial case cited by respondent-applicant involves a different "BRIGADA" mark and not the subject "BIRADA" mark in this case.

It is noteworthy to clarify that the instant case being an inter partes case will only resolve whether to allow the registration of Respondent-Applicant's BIRADA trademark. This proceeding has nothing to do with the presence or absence of infringement or unfair competition by any party as those are not proper subject of an inter-partes case.

Based on the records, the competing marks of the parties are as follows:



Mark as actually used by Opposer⁴



Mark⁵ as shown in the Respondent's application

⁴ Opposer's Annex C

⁵ Respondent's Trademark Application Form



Mark as actually used by Opposer⁶
(Opposer's marks)



Mark as actually used by Respondent⁷
(Respondent-Applicant's marks)

A simple comparison of the above marks as used by the parties will support this Office's conclusion that they are practically similar and closely resemble one other. Clearly, all the contending marks consist of the dominant word "BIRADA" as reflected in the masthead of their respective newspapers. The small differences in the color combinations or layout arrangements are minimal and negligible. There is definitely a very high probability that confusion on the part of the public will result. Hence, there is a need to determine who between the two parties own the subject mark.

Records reveal that the "BIRADA" mark was first adopted and used by the Opposer even prior to the Respondent-Applicant's application for registration of the subject trademark.⁸ The Opposer submitted evidence that he has been using the mark BIRADA and its variations as of the 9 February 2010 for tabloid newspaper.⁹ The Opposer also registered its business name Benta Birada News Daily as early as 13 November 2009¹⁰ In controverting the allegation of the Opposer, the Respondent-Applicant merely argued that such prior use should not be given protection as the "BIRADA" mark was copied, imitated, or patterned from that of the IPO registered trademark "BRIGADA" mark.¹¹ However, it does not negate the fact that the "BIRADA" mark was first used by the Opposer as masthead in a newspaper and still being used when Respondent-Applicant applied for the registration of the mark. The Respondent-Applicant's contention that the used of BIRADA mark by the Opposer infringes on Respondent-Applicant's prior registered BRIGADA mark should have been properly address in an action enforcing his intellectual property right than in filing for a registration of similar trademark to that of the Opposer's.

The Supreme Court has held that, "a trademark, being a special property, is afforded protection by law. But for one to enjoy this legal protection, ownership of the trademark should rightly be established."¹² Corollarily, only the true owner of a trademark should be allowed to apply for its registration.

⁶ Opposer's Annex C-1

⁷ Opposer's Annex D

⁸ Annex C, C-1 to C-9 of the Opposer

⁹ See Annex "C"

¹⁰ See Annex "A"

¹¹ par. 2 of the Respondent-Applicant's Answer to Verified Notice of Opposition

¹² *Berris Agricultural Co. Inc. vs. Norvy Abyadang* G.R. 183404, 13 October 2010

Succinctly, it is not the application or the registration that confers ownership of a mark but it is the ownership of the mark that confers the right to register the same.¹³

The Supreme Court further emphasized that a trademark is an industrial property over which its owner is entitled to property rights which cannot be appropriated by unscrupulous entities that, in one way or another, happen to register such trademark ahead of its true and lawful owner. The presumption of ownership accorded to a registrant must then necessarily yield to superior evidence of actual and real ownership of a trademark.¹⁴

Verily, while the country's legal regime on trademarks shifted to a registration system, it is not the intention of the legislators that the law be used in committing or perpetrating an unjust and unfair claim. The privilege of being issued a registration for its exclusive use, therefore, should be based on the concept of ownership.

The essence of trademark 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.¹⁵ To allow the registration of the Respondent-Applicant's mark would be contrary to the very concept of a trademark.

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 42010740084 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42010740084 be returned together with a copy of this **DECISION** to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 11 February 2016


ATTY. NATHANIEL S. AREVALO
Director
Bureau of Legal Affairs

¹³ Birkenstock Orthopaedie GMBH and Co. KG vs. Philippine Shoe Expo Marketing Corporation, G.R. No. 194307, 20 November 2013

¹⁴ *ibid*

¹⁵ Pribhdas J. Marpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999