

CITIGROUP INC.,
Opposer,

-versus-

CITI GLOBAL REALTY AND
DEVELOPMENT, INC.,
Respondent - Applicant.

} IPC No. 14-2013-00346
} Opposition to:
} Appln. No. 4-2013-000915
} Date Filed: 28 January 2013
} TM: "CITIGLOBAL REALTY
} AND DEVELOPMENT, INC."
}
}
}

x-----x

NOTICE OF DECISION

**ROMULO MABANTA BUENAVENTURA
SAYOC & DELOS ANGELES**
Counsel for the Opposer
21st Floor, Philamlife Tower
8767 Paseo de Roxas
Makati City

ATTY. CLAIRE B. CORRAL
Counsel for Respondent- Applicant
Suite 1002-B Fort Legend Tower
3rd Avenue corner 31st Street
Bonifacio Global City
Taguig City

GREETINGS:

Please be informed that Decision No. 2016 - 135 dated May 04, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 04, 2016.

For the Director:

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

CITIGROUP INC.,
Opposer,

-versus-

**CITI GLOBAL REALTY AND
DEVELOPMENT, INC.,**
Respondent-Applicant.

X-----X

IPC NO. 14-2013-00346

Opposition to:
Appln. Serial No. 4-2013-000915
Date Filed: 28 January 2013

Trademark: "**CITIGLOBAL REALTY
AND DEVELOPMENT, INC.**"

Decision No. 2016- 135

DECISION

Citigroup Inc.,¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-000915. The application, filed by Citi Global Realty and Development, Inc. ("Respondent-Applicant")², covers the mark "CITIGLOBAL REALTY AND DEVELOPMENT, INC." for use on "*marketing and selling of real estate*" and "*building construction*" under Classes 35 and 37, respectively, of the International Classification of goods and services³.

The Opposer alleges, among others, that the Respondent-Applicant's mark "CITIGLOBAL REALTY AND DEVELOPMENT, INC." is confusingly similar to its "CITI" family of marks, which it claims to be well-known. It asserts that the Respondent-Applicant uses the same pattern adopted by its "CITI" marks. It explains that the Master File Report listing three thousand one hundred thirty-eight (3,138) "CITI" registrations owned by its company and Citibank, N.A. as of 03 November 2005, when not used alone, the prefix "CITI" may be conjoined with a generic or descriptive term like "CITICARD" or an abbreviated term like "CITICORP". It contends that when pronounced, overheard or spelled, the applied mark may unavoidably be associated with its "CITI" family of marks, to its detriment.

According to the Opposer, its company is internationally-renowned financial services corporation with active presence nationwide, with offices of subsidiaries and affiliates in over one hundred (100) countries, including the Philippines. It traces its history as early as 1800s. In the Philippines, it began operating as early as 1902. Its

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.

Republic of the Philippines

INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,

Taguig City 1634 Philippines • www.ipophil.gov.ph

T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph

global network of companies virtually carries a "CITI" name or branding and offer their products and services using the "CITI" marks. In support of its opposition, the Opposer submitted the affidavit of Anne E. Moses, with annexes.⁴

The Respondent-Applicant filed its Answer on 19 February 2014 alleging, among others, that its company started as a marketing, landholding and leasing company and is now a real estate development company. According to the Respondent-Applicant, its current and upcoming developments are Tagaytay Fontaine Villas, Tagaytay Clifton Resort Suites, high rise developments in Quezon City and first class hotels in Palawan and Tagaytay. It has advertised its projects and services nationwide and has dedicated websites for its projects and developments. It has used its trade name and service mark since 2003.

The Respondent-Applicant denies that its mark is confusing with that of the Opposer's contending that it has a distinctive logo. It avers that its mark is used to indicate real estate development services, hence the terms "REALTY AND DEVT., INC", while the Opposer's mark is used for financial, banking and insurance services. It refutes that the Opposer's "CITI" marks is well-known in the Philippines and cites various other marks incorporating the said term for different classes. The Respondent-Applicant's evidence consists of the affidavit of Elizabeth To, with annexes.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 07 January 2015. Thereafter, the parties submitted their respective position papers. After which, the case is deemed submitted for decision.

Records reveal that at the time the Respondent-Applicant filed its application on 28 January 2013, the Opposer has valid and existing registrations of its "CITI" marks including "CITICORP" issued as early as 20 July 1984.

To determine whether there is confusing similarity, the competing marks are reproduced as follows:

⁴ Marked as Exhibits "A" to "I".

⁵ Marked as Exhibits "3" to "11", inclusive.

Opposer's marks include:

citi **CITI**

CITICORP

CITIBANK

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. 14-2006-00033⁶, 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.

⁶ Appeal No. 14-07-18.

***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. The declaration of the Opposer's "CITI" marks as well-known notwithstanding, this Bureau finds that the mark "CITIGLOBAL REALTY AND DEVELOPMENT, INC." should still be allowed registration absent confusing similarity. Section 123.1 (e) and (f) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("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 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"(Emphasis supplied.)

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 latter's mark consists of the words "CITI" and "GLOBAL" combined and a spiral device, which sufficiently lend the mark the distinctiveness required by law. Noteworthy, the said mark also includes the disclaimed phrase "REALTY & DEVELOPMENT" that immediately conveys that the mark is used in real estate. Even in respect of aural and conceptual projection, confusion or mistake is remote. This is so because "CITIGLOBAL REALTY AND DEVELOPMENT, INC." mark 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.


Moreover, 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."⁷

Furthermore, 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.⁸ The Respondent-Applicant's mark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-000915 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, **04 MAY 2016.**


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

⁷ *Victorio P. Diaz vs. People of the Philippines*, G.R. No. 180677, 18 February 2013.

⁸ *Pribhdas J. Mirpuri vs. Court of Appeals*, G.R. No. 114508, 19 November 1999.