

ZACARIAS R. TABANIAG, JR.,  
Opposer,

-versus-

DANTE TINGA, JR.,  
Respondent- Applicant.

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}  
} IPC No. 14-2009-00193  
} Opposition to:  
} Appln. Serial No.4-2008-011530  
} Date Filed: 22 September 2008  
} TM: "FILGOLF & DEVICE"

**NOTICE OF DECISION**

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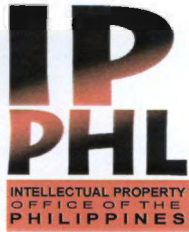
**GREETINGS:**

Please be informed that Decision No. 2016 - 56, dated February 22, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 22, 2016.

For the Director:

*Edwin Q. Dating*  
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Director III  
Bureau of Legal Affairs



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Opposer,

- versus -

**DANTE TINGA, JR.,**  
Respondent-Applicant.

**IPC NO. 14 - 2009 - 00193**  
Case Filed on: 31 July 2009

Opposition to:  
Appln Serial No. 42008011530  
Date filed: 22 September 2008  
**TM: "FILGOLF & DEVICE"**

x-----x

**DECISION NO. 2016 - 56**

## DECISION

ZACARIAS R. TABANIAG, JR. (Opposer),<sup>1</sup> filed an Opposition to Trademark Application Serial No. 4-2008-011530 on 31 July 2009. The application filed by DANTE TINGA, JR. (Respondent-Applicant)<sup>2</sup> covers the mark "FILGOLF & DEVICE" for "*printed matter, newspaper & periodicals, books, bookbinding, materials, photographs, stationery, adhesive materials (Stationery), typewriters*" under Class 16 and for "*publication of printed matter, newspaper & periodicals, books; providing a website that displays various request, reviews, recommendations, rankings, information relating to the products event in the field of entertainment, education and sports*" under Class 41 of the International Classification of Goods.<sup>3</sup>

The pertinent portions of the Opposition are quoted as follows:

"1.3. Opposer is the son of Zacarias 'Taby' Tabaniag ('Mr. Tabaniag Sr.') the true owner of the trademark "Filgolf", subject of this Opposition. Mr. Tabaniag Sr. died on 02 March 2008. Hence, this action is brought by his heirs represented by Opposer.

"1.4. In 1975, Tabaniag, Sr. began publication of 'Filgolf Panorama & All Outdoors', a magazine published in Metro Manila with a nationwide circulation of about 5000 copies. The magazine grew and became a staple for Filipinos playing golf anywhere in the country. By the 1980's, the magazine simply came to be known

<sup>1</sup>Filipino, of legal age, with address at 2575-H M. Dela Cruz St. Pasay City.

<sup>2</sup>Filipino, of legal age with address at 2959 Noel St. United Hills Subd. Paranaque.

<sup>3</sup> 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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as 'Filgolf' Tabaniag, Sr. was thus well known all around the country to be the true owner of the trademark 'Filgolf' as early as 1975.

"1.5. Tabaniag, Sr. continued to use the 'Filgolf' trademark for the magazine he published until he died in 2008. (See Filgolf Magazines published in 1995 until 2007 attached to Opposer's Affidavit and marked as Exhibits 'B' to 'B-18')

"1.6. In order to continue the legacy of Tabaniag, Sr. after his death in 2008, Opposer requested Games We Play Publishers, Inc. ('the Publisher') to continue the publication of the magazine bearing the 'Filgolf' trademark. As such, the publisher issued 'Filgolf: Golf+Travel+Lifestyle' dated October-December 2008, bearing the 'Filgolf' trademark owned by Tabaniag, Sr. x x x

"1.7. The said issue was distributed to the public during the 13<sup>th</sup> Philippine International Golf Show on 19 to 21 September 2009 at the SMX Convention Center in SM Mall of Asia, Pasay City. Around 5,000 copies of the magazines were given to attendees of the golf show.

"1.8. A day after the magazine bearing the 'Filgolf' trademark owned by Tabaniag, Sr. was distributed at the golf show, on 22 September, respondent-applicant filed an application for registration of his alleged "Filgolf & Device" trademark under Class 16 and 42 with this Honorable Office. The application was assigned Application No. 4-2008-011530. The mark applied for was published for opposition in this Honorable Office's IPO E-Gazette on 3 April 2009.

"1.9. Opposer himself filed an application for registration of the 'Filgolf' trademark on 10 November 2008 under Classes 16 and 42. The application was assigned Application No. 4-2008-013721. x x x

"1.10. Although the 'Filgolf' trademark is not yet registered in the name of Opposer or Tabaniag, Sr. in the Philippines, the latter has been selling and distributing his magazine bearing said trademark as early as the year 1975. Opposer continues to distribute the magazine as aforementioned.

"1.11. In fact, the 'Filgolf' trademark is a well known mark especially among the golfing sector in the Philippines. This can be gleaned from the numerous sponsors who placed advertisement on different issues of the magazine x x x It is likewise well-known as belonging to Tabaniag Sr., the rights to which are transmitted to his heirs after his death in 2008. This fact is acknowledged and proven by other noted golf-writing authorities in their articles attached to Opposer's affidavit x x x

"1.12. Despite this, however, respondent-applicant fraudulently filed an application for registration of the 'Filgolf' trademark in the Philippines. In fact, so blatant is the fraud that respondent-applicant did not wait too long and filed his application immediately a day after magazine bearing the 'Filgolf' trademark was launched. Should such application be allowed great prejudiced and injury will result to Opposer and other heirs of Tabaniag Sr. x x x

"2.2. Opposer is entitled to ask that the application for registration of respondent-applicant be refused by this Honorable Office. The 'Filgolf' mark is well known in the Philippines, especially within the golfing sector, to be owned by Tabaniag, Sr. as evidenced by Exhibits. It is only Tabaniag, Sr., and now his heirs (sic) represented by Opposer, who should be allowed to use the 'Filgolf' mark. A registration of the mark in respondent-applicant's favor will result in prejudice and injury to Opposer.

"2.6. Respondent-applicant has no right to appropriate the 'Filgolf' mark for himself, when he knew well that the same is owned by Tabaniag, Sr. and now his heirs. Tabaniag Sr. has spent considerable time and effort and incurred great expense in producing and developing the magazines bearing the 'Filgolf' mark. Respondent-



applicant was not authorized by Tabaniag, Sr. or his heirs to file the application for registration of the mark.

“2.7. Under Section 123.1, paragraph (b), Part III of the IP Code, a mark cannot be registered if it is likely to mislead the public particularly as to the nature, quality, characteristics or geographical origin of the goods or services. Respondent-applicant’s trademark application ‘Filgolf’ is exactly identical to the trademark ‘Filgolf’ of Tabaniag, Sr. and his heirs as to be likely, when applied to or used in connection with the goods of respondent-applicant, to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that respondent-applicant’s goods either come from Tabaniag, Sr. and his heirs or are sponsored or licensed by it.

“2.8. It is, moreover, clear from the facts that respondent-applicant copied the trademark of Tabaniag, Sr. and his heirs. The fact that respondent-applicant filed his application a day after Opposer caused the continued distribution of the magazine bearing the ‘Filgolf’ mark, and perhaps respondent-applicant got hold of a copy of the same, clearly indicates that respondent-applicant did not coin the term or come up with the mark by himself, and is merely claiming ownership of the mark through fraudulent means.

“2.9. Respondent-applicant’s application for registration of the ‘Filgolf’ mark and presumably using it on his own goods, is with the obvious intention of misleading the public into believing that his goods bearing the trademark originate from, or are sponsored or licensed by the heirs of Tabaniag, Sr., which has become identified in the trade and by consumers as the source of goods bearing the trademark ‘Filgolf.’

“2.10. Indeed, respondent-applicant had before him ‘a boundless choice of words, phrases, colors and symbols sufficient to distinguish his marked product from the others.’ And yet, respondent, applicant chose an identical mark. ‘Though the field of his (its) selection was so broad, the inevitable conclusion is that it was done deliberately to deceive.’ (Del Monte Corporation vs. Court of Appeals, 181 SCRA 410, 419-420)

“2.11. If this Honorable Office will allow respondent-applicant to register his mark, it would cause damage to Tabaniag Sr. and his heirs, the real owner of the ‘Filgolf’ trademark. They will be deprived of the royalty payments it rightfully deserves as the trademark owner. In addition, while respondent-applicant would unjustly benefit from the use of the trademark, the ‘Filgolf’ mark would be totally beyond the control of the heirs of Tabaniag Sr., which will have no means of ensuring the quality of the products manufactured by respondent-applicant and consequently no way of preserving the reputation, popularity and distinctiveness of the ‘Filgolf’ trademark. This is clearly prejudicial to Tabaniag Sr. and his heirs and justifies the rejection of respondent-applicant’s Trademark Application.

The Opposer’s evidence consists of the following:

1. Exhibit “A” – Affidavit of Mr. Zacarias R. Tabaniag, Jr.;
2. Exhibit “B” – “B-18” Copies of Filgolf Magazines published from 1995 to 2007;
3. Exhibit “C” - Copy of Filgolf: Golf + Travel + Lifestyle dated October-December 2008 ;

4. Exhibit "D" – Copy of Trademark Application Form filed with the IPO; and

5. Exhibit "E" to "E-2" – articles written on Taby Tabniag Sr and Filgolf

On 26 August 2009, this Bureau issued a Notice to Answer to the Respondent-Applicant. The Respondent-Applicant filed its Answer on 23 November 2009. The pertinent allegations in the Answer are as follows:

"4. The trademark 'Filgolf' was applied by respondent-applicant for use by Empyrean Press, Inc. of which he is a majority stockholder.

"5. Empyrean Press is a duly organized Philippine corporation registered in January 31, 2005, principally engaged in custom publication business. It owns and operates a number of website and print publications including the Filproperty magazine.

"6. Filproperty is a Philippine real estate print catalog that is also found in the internet at [www.filproperty.com](http://www.filproperty.com). It provides a list of useful information about the residential and vacation properties in the Philippines including prices, tips, industry updates, and support services. x x x

"7. Considering the breadth and wide scope of the real property business in the Philippines, respondent-applicant thought of producing a 'Filgolf' website and print publication as a necessary extension of Filproperty.

"8. Thus, on November 10, 2007, following the same steps or process he made in the registration of Filproperty trademark, respondent-applicant first applied and acquired for a valuable consideration [www.filgolf.com](http://www.filgolf.com) domain name in the internet.

"9. After the domain name registration, respondent-applicant and his team which comprise the officers of Empyrean Press, Inc., held a series of meetings and discussions mapping out and planning the objective, format, and 'look' of the website and the print publication of Filgolf.

"10. They came up with the content and layout of the book and website with a tentative title cover: 'The Ultimate Guide to Philippine Golf Courses.' x x x

"11. On September 22, 2008, upon prior search in the IP Office website where the intended trademark does not appear to have been applied or registered by any third party, respondent-applicant proceeded to apply for the trademark registration of 'Filgolf' before this Office.

"12. Contrary to Opposer's allegation which is outrightly misleading and was purely meant to cast bad faith on the part of respondent-applicant, the alleged filgolf magazine dated October-December, 2008 was allegedly distributed only on September 19-21, 2009 during the Philippine International Golf Show at SMX Convention Center in SM Mall of Asia or ONE YEAR AFTER respondent-applicant filed his trademark registration.

x x x

"16. Indeed, our intellectual property law has adopted the 'first to file, first to own' policy with respect to ownership of trademarks.

"17. In the case at bar, respondent-applicant filed for the registration of the Filgolf trademark on September 22, 2008, much earlier than the application of Opposer.

"18. When respondent-applicant filed the subject trademark, he has no knowledge of its alleged prior existence. He coined the mark by joining the two words 'Filipino' and 'golf' to complement with his earlier registered trademark of filproperty which also combined the words 'Filipino' and 'property.'

"19. Opposer was simply negligent in failing to have the trademark registered.

"20. A reading of the documentary exhibit of Opposer would show that its 'Filgolf magazines' are readily classified as news magazines about golf and the personalities / players involved in the sports. Its market are the Filipino golf players and enthusiasts.

"21. This is very much different from the content and format of respondent-applicant "filgolf" book and website, which as earlier stated is a necessary extension of the filproperty magazine. In other words, said book and website are a real estate business book and website that showcase the architectural beauty, features and amenities of the Philippine Golf Courses aimed at luring or inviting the investors, businessmen, tourists, retirees and overseas Filipino workers to invest in golf clubs, enjoying their amenities, or even settle or retire in places within or near these golf courses.

"22. The distinct purpose, content, 'look', and market of respondent-applicant's filgolf book and website with that of the Opposer's magazines shall hardly create the likelihood of confusion.

"23. Moreover, Opposer's claim for said trademark appears to be limited, narrow and hardly popular to create confusion of ownership. From its alleged year of first publication up to the present, its readership has been confined to a small group of golf players, writers and enthusiasts. Its number of print publications have been erratic and inconsistent.

"24. Certainly, the prospects of respondent-applicant's success in its filgolf periodical and website would absolutely not be attributed to Opposer who has not attained any goodwill or reputation on its claimed trademark particularly in the field of real estate business that focus on golf courses in the Philippines.

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

1. Exhibit "1", "1-A" and "1-B" – Copy of the Filproperty print catalogs;
2. Exhibit "2" - Copy of the proof of purchase of domain name [www.filproperty.com](http://www.filproperty.com);
3. Exhibit "3" – Copy of the sample content and layout; and
4. Exhibit "4" - Affidavit of Mr. Dante Tinga, Jr.

On 3 December 2009, the Opposer filed a Reply correcting the year of the "13<sup>th</sup> Philippine International Golf Show" indicated in the Verified Opposition from "2009" to "2008." Opposer also argued that the filing of the trademark application in behalf of Emphyrean Press, Inc. only shows that the Respondent-Applicant is not the true owner of the mark. Furthermore, he reiterated that the trademark used by



Tabaniag Sr. has already become well-known which is an exception to the first-to-file rule under the Intellectual Property Code.

The Preliminary Conference was terminated on 20 May 2010, followed by the parties' submission of their respective position papers.

The issue for resolution is whether the trademark "Filgolf & Device" should be registered in favor of Respondent-Applicant.

The competing trademarks are reproduced below for examination:

**FilGolf**



Opposer's applied mark

Respondent-Applicant's marks

The competing marks are practically identical. The word "Filgolf" is the most prominent feature of both marks. While the mark applied for registration by the Respondent-Applicant has an additional device included, the same impression is being conveyed by the mark to the buying public. The device containing an illustration of a golf course on the Respondent-Applicant's mark is a mere representation of the wordmark itself and has no separate identity apart from the word mark. Undoubtedly, the added image device is not sufficient to distinguish its mark from that of the Opposer.

The confusing similarity in the mark is confounded by the fact that the goods subject of the competing trademarks are also similar or closely related goods. Thus, considering that the two marks are essentially similar and they cover the same goods, there is reasonable probability that confusion on the part of the public will result. In order to determine who between the parties has the right over the trademark, there is a necessity to determine who between the two parties owned the subject trademark.

Records show that "Filgolf" mark was first adopted and used by the Opposer's predecessor-in-interest prior to the Respondent-Applicant's application for registration of the subject trademark.<sup>4</sup> The Opposer submitted copies of the Filgolf magazines published by his late father dating back to November 1977.<sup>5</sup>

In controverting the allegation of the Opposer, the Respondent-Applicant argued that the intellectual property law has adopted the "first to file, first to own" policy with respect to ownership of trademarks and in the present case he filed for registration earlier than the Opposer. Respondent-Applicant added that the magazines

<sup>4</sup> Exhibit "B", "C", and "E"

<sup>5</sup> Exhibit "E-1"

A handwritten signature or set of initials in blue ink, located in the bottom right corner of the page.

presented by the Opposer shows that the market of Opposer is limited to Filipino golf players and enthusiasts. The publication of Respondent-Applicant is different in the content, format and target market, and will hardly create the likelihood of confusion. The Respondent-Applicant submitted documents on the registration of its website and samples of its publications dating back to 2007.<sup>6</sup>

This Bureau finds the arguments of Respondent-Applicant unmeritorious.

The Supreme Court has held that, 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.<sup>7</sup> Trademarks, being a special property, are afforded protection by law. However, for one to enjoy the legal protection, ownership of the trademark should rightly be established.<sup>8</sup> Clearly only the true owner of a trademark should be allowed to apply for its registration.

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 or applicant must then necessarily yield to superior evidence of actual and real ownership of a trademark.<sup>9</sup>

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, is based on the concept of ownership.

In this case, the Opposer has sufficiently proven that he is the owner of the "Filgolf" mark having used the trademark in magazine publications for over thirty (30) years prior to the application of Respondent-Applicant.

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.<sup>10</sup> Allowing 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. 42008011530 is hereby **SUSTAINED**. Let the filewrapper of

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<sup>6</sup> Exhibit "1" and "2"

<sup>7</sup> Birkenstock Orthopaedie GMBH and Co. KG vs. Philippine Shoe Expo Marketing Corporation, G.R. No. 194307, 20 November 2013

<sup>8</sup> *Berris Agricultural Co. Inc. vs. Norvy Abyadang* G.R. 183404, 13 October 2010

<sup>9</sup> *ibid*

<sup>10</sup> Pribhdas J. Marpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999



Trademark Application Serial No. 42008011530 be returned together with a copy of this DECISION to the Bureau of Trademarks (BOT) for appropriate action.

**SO ORDERED.**

Taguig City, 22 February 2016

  
**ATTY. NATHANIEL S. AREVALO**  
Director  
Bureau of Legal Affairs