

BORACAY ENTERTAINMENT RESOURCES, INC.,
Opposer,

-versus-

CITYCENTER LAND, LLC,
Respondent-Applicant.

X-----X

IPC No. 14-2008-00296

Opposition to:

Appln. Serial No. 4-2008-005501

Date Filed: 09 May 2008

TM: ARIA

NOTICE OF DECISION

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GREETINGS:

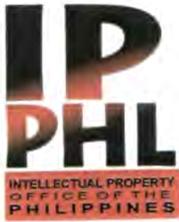
Please be informed that Decision No. 2016 - 313 dated 20 September 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, 20 September 2016.

Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

**Republic of the Philippines
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Date Filed: 09 May 2008

Trademark: "ARIA"

x-----x

Decision No. 2016- 313

DECISION

Boracay Entertainment Resources, Inc.,¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2008-005501. The application, filed by Citycenter Land, LLC ("Respondent-Applicant")², covers the mark "ARIA" for use on *clothing, namely t-shirts; shirts; tank tops; collared golf shirts; sweaters; jackets; jogging suits; sweat shirts; sweat pants; short pants; swim wear; dress shirts; skirts; pants; robes; sleepwear; rompers; scarves; blouses; dress pants; caps; hats; bandannas; headwear, namely bonnets, head bands, sun visors; shoes; socks; slippers*, "casino services; entertainment services; educational services; conducting and providing facilities for special events featuring casino and gaming contests and tournaments; providing facilities for sports and recreation; art exhibitions; photography services; botanical gardens; health club services; booking of theatre tickets; special event planning; cabarets; night clubs; amusement arcades; beach and pool clubs, namely, providing fitness and exercise facilities featuring pools and bathing and showering facilities; providing information in the field of gaming and entertainment via the internet" and "restaurant services; hotel and resort services; bar and lounge services; providing convention facilities; arena services; providing banquet and social function facilities for special occasions; catering; providing information in the field of travel and special events via the internet; travel agency services, namely, making reservations and booking for temporary lodging, restaurants and meals" under Classes 25, 41 and 43, respectively, of the International Classification of goods and services³.

The Opposer anchors its opposition on Section 123.1 subparagraphs (d), (e), (f) and (g) of R.A. No. 8293, also known as the Intellectual Property Code of the

¹ A corporation duly organized and existing under the laws of the Philippines with principal place of business at Boracay Island, Malay, Aklan.

² With business address at 3950 Las Vegas, Boulevard South, Las Vegas, Nevada 89119, United States of America.

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.

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Philippines ("IP Code"). It alleges, among others, that its company was established in 2003 with a main business purpose to own, operate and manage hotels, restaurants, cafes, places of amusements and entertainment and related businesses and activities thereto. Pursuant to said purposes, it set up "ARIA" restaurant and Café del Sol in Boracay. It adopted the name "ARIA" because of the open-air concept of the restaurant and the beachfront location.

According to the Opposer, "ARIA" is an Italian-inspired restaurant with a menu of seventy-seven (77) dishes, seventeen (17) cooks, sixteen (16) servers, four bartenders, thirteen (13) maintenance, four stocks and purchasing personnel, six accounting personnel, two human resource personnel and one general manager in the person of Mr. Gene dela Cruz. It claims to be the most popular restaurant in Boracay that serves one hundred twenty (120) to one hundred fifty (150) customers during off peak season and two hundred fifty (250) to three hundred fifty (350) customers during peak seasons. It contends that the Respondent-Applicant's mark should not be allowed registration for being confusingly similar to its own mark, which it registered on 05 March 2007. In support of its opposition, the Opposer submitted the following as evidence:⁴

1. copy of Certificate of Registration No. 4-2005-011918 for "ARIA";
2. affidavit of Gene Ledesma dela Cruz, with annexes;
3. certification of Atty. Maricris E. Oronea, with annexes;
4. white shirt containing the mark "ARIA";
5. keychain containing the mark "ARIA"; and
6. compact disc containing advertisements of "ARIA" restaurant in YES Boracay radio station.

The Respondent-Applicant filed its Answer alleging, among others, that it owns the marks "ARIA" and "CITYCENTER", which will be used by Citycenter development, a joint venture between MGM Mirage and Infinity World Development Group, a subsidiary of Dubai World. It is the company behind the creation of the Citycenter real estate development, an urban center metropolis to open in 2009 at the Las Vegas Strip. One of the primary elements of its complex is the "ARIA" Resort and Casino, which is located in a four thousand (4,000)-room steel and glass structure, serving as the centrepiece of the Citycenter development.

The Respondent-Applicant maintains that its mark is not confusingly similar to the Opposer's registered mark "ARIA". It explains that its services in Class 43 are broader in scope and not related to *"providing food and drinks"*. Moreover, it points out that the Opposer's restaurant business is limited to the Boracay area, making it impossible to be mistaken or confused with its own "ARIA" casino and resort. It

⁴ Marked as Exhibits "B" to "G", inclusive.

bewails that no evidence was presented to suggest that actual or potential customers of the Opposer were misled into thinking that the Opposer's business is related to its own. Furthermore, asserts that its goods and/or services in Classes 25 and 41 are not within the Opposer's normal expansion of business. The Respondent-Applicant's evidence consists of:⁵

1. witness statement of John M. McManus, its authorized representative;
2. certified copies of its trademark registrations in United Kingdom, Colombia and Peru;
3. certified copies of its trademark applications in various countries;
4. certified copies of advertisements for "CITYCENTER";
5. print and online media publications featuring "CITYCENTER" and "ARIA";
6. database list of all trademark and service mark registrations and applications for "ARIA";
7. affidavit of Amando S. Aumento, Jr.;
8. printed pages of websites of MGM Mirage, Citycenter and Aria;
9. printed pages of "Google" showing search results for the search key "CITYCENTER ARIA";
10. printed pages from the website of United States Patent Office ("USPTO") showing search results for marks containing "ARIA"; and,
11. printed pages from the websites featuring different "ARIA" restaurant all over the world.

The Opposer thereafter filed its Reply. On 10 September 2009, the Preliminary Conference was terminated. The Hearing Officer then issued Order No. 2009-1449 on 30 September 2009 requiring the parties to submit their respective position papers from receipt thereof. After the filing of the position papers and/or the lapse of the said period, the case is deemed submitted for decision.

The issue to be resolved is whether the Respondent-Applicant's mark "ARIA" should be allowed registration.

Section 123.1 (d) of the IP Code provides that:

"123.1. A mark cannot be registered 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; xxx"

⁵ Marked as Exhibits "1" to "16".

Records reveal that at the time the Respondent-Applicant filed its application on 09 May 2008, the Opposer has a valid and existing registration of its "ARIA" mark issued on 05 March 2007 under Certificate of Registration No. 4-2005-011918.

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



Opposer's mark

ARIA

Respondent-Applicant's mark

Unquestionably, the two marks are identical both in spelling and pronunciation notwithstanding the stylized presentation of the Opposer's mark. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.⁶ Corollarily, the Supreme Court in the case of Del Monte Corporation vs. Court of Appeals⁷ held that:

"The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone."

Succinctly, the Respondent-Applicant will use or uses the mark "ARIA" to restaurant, bar and lounge services, among others, under Class 43. These services are similar and/or closely related to "services for providing food and drink", which the Opposer registered its mark. As such, there is likelihood that the consumers of the Opposer will be confused, mistaken or deceived that its services is in any way connected to the Respondent-Applicant, and vice-versa. That the Opposer's evidence shows that its "ARIA" restaurant is being operated only in Boracay is of no moment.

⁶ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁷ G.R. No. L-78325, 25 January 1990.

Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade-mark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business.⁸ Moreover, Section 138 of the IP Code provides that:

"Sec. 138. Certificates of Registration. – A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate." (Emphasis supplied)

Furthermore, 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁹

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.¹⁰ The Respondent-Applicant's mark failed to meet this function.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

⁸ Dermaline, Inc. vs. Myra Pharmaceuticals, Inc., G.R. No. 190065, 16 August 2010.

⁹ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.

¹⁰ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2008-005501 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 20 SEP 2016


ATTY. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs