

**REGENT HOSPITALITY  
WORLDWIDE, INC.,**  
Opposer,

**-versus-**

**ORTIGAS & COMPANY  
LIMITED PARTNERSHIP,**  
Respondent- Applicant.

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**IPC No. 14-2012-00458**  
Opposition to:  
Appln. Serial No. 4-2012-004232  
Date Filed: 03 April 2012  
**TM: "THE REGENT AT  
CAPITOL COMMONS"**

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**NOTICE OF DECISION**

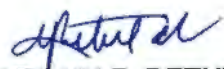
**FEDERIS & ASSOCIATES LAW OFFICES**  
Counsel for the Opposer  
Suite 2004 & 2005, 88 Corporate Center  
141 Valero Sts., Salcedo Village  
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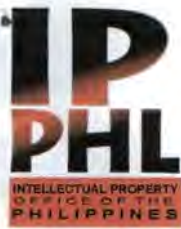
**VILLARAZA CRUZ MARCELO & ANGANGCO**  
Counsel for Respondent- Applicant  
CVCLAW Center  
11<sup>th</sup> Avenue corner 39<sup>th</sup> Street, Bonifacio Triangle  
Bonifacio Global City, Metro Manila

**GREETINGS:**

Please be informed that Decision No. 2016 - 406 dated November 11, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 11, 2016.

  
**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs



**REGENT HOSPITALITY,  
WORLDWIDE, INC.,**  
Opposer

- versus -

**ORTIGAS & COMPANY  
LIMITED PARTNERSHIP,**  
Respondent-Applicant.

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IPC No. 14-2012-00458

Opposition to:

Appln. No. 4-2012-004232

Date Filed: 03 April 2012

Trademark: **"THE REGENT AT  
CAPITOL COMMONS"**

Decision No. 2016 - 406

### DECISION

REGENT HOSPITALITY, WORLDWIDE, INC. ("Opposer")<sup>1</sup> filed a verified opposition to Trademark Application Serial No. 4-2012-004232. The application, filed by ORTIGAS & COMPANY LIMITED PARTNERSHIP ("Respondent-Applicant")<sup>2</sup>, covers the mark "THE REGENT AT CAPITOL COMMONS" for use on goods under classes 36 and 37<sup>3</sup> namely: *"rental of business space, real estate management; real estate leasing; and, real estate development (condominium)."*

The Opposer alleges the following grounds for opposition:

"a. The dominant element of REGENT in the opposed trademark is the dominant part of the corporate name of Opposer, i.e., REGENT HOSPITALITY WORLDWIDE, INC., and thus, it can no longer be used, appropriated and registered as a trademark by another pursuant to Section 165 of the Intellectual Property Code ("IP Code"), Article 6sexeis and 8 of the Paris Convention, and Philips Export B.V. et al., vs. Court of Appeals, et al.

"b. The presence of the dominant element "REGENT" in the opposed trademark renders it confusingly similar to Opposer's well-known, earlier filed (as early as 1993) and earlier registered (as early as 2005) THE REGENT and REGENT formative trademarks, and hence, the subject application must be denied registration under Sections 147.1 and 147.2, 123.1 (d), 123.1 (e), and 123.1 (f) of the IP Code. These THE REGENT trademarks are as follows: THE REGENT (Reg. No. 4-1993-030100), Date Filed: 28 December 1993, Date Registered: 19 December 2005; REGENT (Script) (Reg. No. 4-1996-109660), Date Filed: 10 July 1996, Date Registered: 30 October 2004; OVAL R Logo (Reg. No. 4-2008-001775), Date Filed: 13 February 2008, Date Registered: 28 July 2008.

<sup>1</sup> A foreign corporation organized and existing under the laws of the Cayman Islands, with principal office address at Suite 1408, 14/F, the Centre Mark, 287-299 Queen's Road, Central Hong Kong.

<sup>2</sup> A corporation which may be served summons, orders and processes at its counsel of record with office address at CVCLAW CENTER, 11th Avenue corner 39th Street, Bonifacio Triangle, Bonifacio Global City, Metro Manila.

<sup>3</sup> The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

"c. Opposer is a holder of certificates of registration for these THE REGENT and REGENT formative trademarks issued in other countries and hence, its trademarks are protected under Section 134 as against the infringing opposed trademark.

"d. Opposer has already identified its services in the mind of the public through the said well-known REGENT and REGENT formative trademarks and hence, its trademarks are entitled to protection under Section 168.1 of the IP Code.

"e. Opposer's THE REGENT and REGENT formative trademarks are well-known marks pursuant to Sections 123.1 (e) and (f) of the IP Code, and if allowed to register, the opposed mark will result in trademark dilution as defined by relevant jurisprudence.

"f. The subject application is filed in bad faith because there can be no reasonable explanation for Respondent-Applicant's coinage of the words "THE REGENT" for its opposed trademark, giving rise to the legal inference that Respondent-Applicant chose them deliberately to deceive, and to take advantage of the goodwill of Opposer's well-known THE REGENT trademarks."

The Opposer's evidence consists of the following:

1. Verified Notice of Opposition;
2. Affidavit of Oliver M. Silsby, Director of Regent Hospitality Worldwide, Inc.;
3. Listing of REGENT Formative Applications and Registrations worldwide;
4. Certified true copies (CTCs) of the certificates of trademark registrations for "THE REGENT", "REGENT (Script)" and variations issued in Andorra, Argentina, Benelux, Cambodia, Canada, Cuba, European Community, Guatemala, Israel, Italy, Japan, Mexico, Russia, Saudi Arabia, Singapore and Vietnam;
5. CTCs of the certificates of trademark registrations for "THE REGENT", "REGENT (Script)" and variations thereof issued in the Philippines, Australia, Canada, China, Germany, Hong Kong, Indonesia, India, Korea, Malaysia, Taiwan, Thailand, and USA;
6. Affidavit to show worldwide revenues in the year 1997 to 2009 of the Regent Hotel business;
7. Representative samples of advertising materials brochures, pamphlets for promotions;
8. Awards won by Regent Hotels over the years;
9. Special Power of Attorney with Certification as to authority to sign for corporation;
10. Affidavit of Atty. Diana F. Rabanal;
11. Printout of [www.regenthotels.com](http://www.regenthotels.com);
12. CTCs of Philippine Trademark Registration Nos. 4-1993-090100 (REGENT); 4-1996-109660 (REGENT SCRIPT);
13. Records made with the Intellectual Property Office for Trademark Registration Nos. 4-1993-030100, 4-1996-109660 and 4-2008-001775; and,
14. Articles and advertisement as published in magazines, articles and other publications.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 15 January 2013. Respondent-Applicant failed to file its Answer in accordance to the Amended Rules and Regulations on Inter Partes Proceedings.<sup>4</sup> Thus, it is declared in default and this instant case is deemed submitted for decision.<sup>5</sup>

<sup>4</sup> Rule 2, Secs. 9 (d) and 10, Office Order No. 99 s. 2011.

<sup>5</sup> Order No. 2013-703 dated 06 May 2013.

Should the Respondent-Applicant be allowed to register the trademark THE REGENT AT CAPITOL COMMONS?

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 out into the market a superior 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>6</sup>

Records show that the Opposer has several registrations for the following trademarks: THE REGENT (Registration No. 4-1993-030100 dated 19 December 2005); and, OVAL R LOGO (Registration No. 4-2008-001775 dated 28 July 2008)<sup>7</sup>. The more recent trademark registrations issued include the following: REGENT (Registration No. 4-2015-012636 dated 15 April 2016); REGENT (Registration No. 4-2014-004022 dated 13 November 2014) and, REGENT CLUB (Registration No. 4-2014-004023 dated 05 March 2015).<sup>8</sup> The Opposer has also various foreign registrations for the REGENT trademark and its variants.<sup>9</sup> On the other hand, the Respondent-Applicant filed its application for the registration of the mark THE REGENT AT CAPITOL COMMONS only 03 April 2012.

The competing marks are hereby reproduced for comparison:



Opposer's Trademarks

**THE REGENT  
AT CAPITOL  
COMMONS**

Respondent-Applicant's Trademark

The contending marks contain the identical word REGENT. While Respondent-Applicant's mark has the additional words "AT CAPITOL COMMONS", it appear as descriptive of, or indicator of the

<sup>6</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91

of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

<sup>7</sup> Exhibits "K" and "K-2" of Opposer.

<sup>8</sup> IPPHL Philippine Trademark Database, available at <http://www.wipo.int/branddb/ph/en/> (last accessed 17 November 2016)

<sup>9</sup> Exhibits "B", "C" and "D" of Opposer.

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place or location of "THE REGENT" as a real estate property. As regards the goods or service covered by the competing marks, they are deemed related to each other in function or purpose, and to its nature or character. Both marks relate to real estate property intended for lease and/or purchase for residential and/or commercial purposes. Thus, they are offered for the same service, and to the same sector of consumers. It is likely that said consumers will have the impression that these goods or service originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods or service but on the origin thereof as held by the Supreme Court, to wit:<sup>10</sup>

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

The public interest, therefore, requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that the function of 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>11</sup>

The Opposer has substantially proved that at the time Respondent-Applicant filed its application for the subject trademark 03 April 2012, herein Opposer already has existing registrations for its mentioned trademarks, and has in fact shown its continuous and actual use of its marks in various countries.<sup>12</sup> Thus, Respondent-Applicant's mark should not be allowed registration because it resembles Opposer's mark as to be likely to deceive or cause confusion.<sup>13</sup>

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

A mark cannot be registered if it:

x x x

(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;

In contrast, the Respondent-Applicant despite the opportunity given, failed to explain how it arrived at using the mark "THE REGENT AT CAPITOL COMMONS". The Opposer's mark "REGENT"

<sup>10</sup> Converse Rubber Corporation v. Universal Rubber Products Inc., et al., G.R. No. L-27906, 08 Jan. 1987.

<sup>11</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

<sup>12</sup> Exhibits "D", "F", "G", "J", "M" and "A" of Opposer.

<sup>13</sup> Sec. 123.1 (d), IP Code.

and its variants are unique and highly distinctive with respect to the goods or service it is attached with. It is incredible for the Respondent-Applicant to have come up with the same mark by pure coincidence.

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2012-004232 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City.  NOV 2016



**Atty. GINALYN S. BADIOLA, LL.M.**  
*Adjudication Officer, Bureau of Legal Affairs*