



RAYMUND LUTHER B. AQUINO, VICTOR RAFAEL }
 AGBAYANI, HENEDINA SHANICE A. GARCIA, }
 JOSEPH BERNARD P. CAPINPIN, MATEO TOMAS }
 L. ESCUETA, ALEXANDRA MARIA P. SANTIAGO, }
 PAOLO MARTIN M. TARUC, MICHELLE B. }
 SALANGSANG and MARIA JANINA B. DE LEON, }
Opposers, }

-versus-

RAMON MIGUEL C. SAMSON, }
Respondent-Applicant. }

X-----X

IPC No. 14-2013-00071
 Opposition to:

Appln. Serial No. 4-2012-007233
 Date Filed: 15 June 2012

TM: KATIPUNAN

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 534 dated 23 December 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 06 January 2017.


MARILYN F. RETUAL
 IPRS IV
 Bureau of Legal Affairs

RAYMUND LUTHER B. AQUINO,	} IPC NO. 14-2013-00071
VICTOR RAFAEL AGBAYANI,	} Opposition to:
HENEDINA SHANICE A. GARCIA,	}
JOSEPH BERNARD P. CAPINPIN,	}
MATEO TOMAS L. ESCUETA,	} Appln. Ser. No. 4-2012-007233
ALEXANDRA MARIA P. SANTIAGO,	} Date Filed: 15 June 2012
PAOLO MARTIN M. TARUC,	}
MICHELLE B. SALANGSANG, and	} Trademark: "KATIPUNAN"
MARIA JANINA B. DE LEON,	}
Opposers,	}
	}
-versus-	}
	}
RAMON MIGUEL C. SAMSON,	}
Respondent-Applicant.	}
x-----x	} Decision No. 2016- 534

DECISION

RAYMUND LUTHER B. AQUINO, VICTOR RAFAEL AGBAYANI, HENEDINA SHANICE A. GARCIA, JOSEPH BERNARD P. CAPINPIN, MATEO TOMAS L. ESCUETA, ALEXANDRA MARIA P. SANTIAGO, PAOLO MARTIN M. TARUC, MICHELLE B. SALANGSANG, and MARIA JANINA B. DE LEON, (Opposers)¹ filed an opposition to Trademark Application Serial No. 4-2012-007233. The application, filed by RAMON MIGUEL C. SAMSON (Respondent-Applicant)², covers the mark "KATIPUNAN", for use on "magazines " under Class 16 and "media and news services" under Class 35 of the International Classification of Goods³.

The Opposers anchors their opposition on the following grounds:

"8. Specifically, Opposers assert that the Application should be denied for the following reasons:

8.1.1. The mark KATIPUNAN cannot be registered as a trademark because it is descriptive of the geographical origin of the good. Further, it has not acquired a secondary meaning through the respondent-applicant's use of the mark on his publication.

¹ Represented by Attorney-in-Fact Victor Rafael M. Agbayani with address at 48 Mangyan Road, La Vista Subdivision, Quezon City

² A domestic corporation with address at 4 Dominga St. Mendez Rd., Baesa, Quezon 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.

8.1.2. The mark KATIPUNAN cannot be registered as a trademark because it is misleading.

The Opposers allege, among other things, that:

“11. The mark KATIPUNAN is a term, which describes the geographical origin of the publication to which it attaches. As a mere designation of the geographic origin of the publication, the respondent-applicant cannot monopolize the word ‘KATIPUNAN’ as a trademark. Respondent-Applicant’s use of the mark if registered, to the exclusion of others, who have an equal right to use the description will certainly result in injustice. This is especially so because several other academic institutions which publish magazines and academic works are in the Katipunan area in Quezon City. The mark KATIPUNAN certainly contains a quality or characteristic, which everyone else has an equal right to appropriate for goods originating from or pertaining to said place.
xxx

“16. To begin with, it is worth mentioning that there have been other magazines bearing the name ‘Katipunan’ as evidenced by a letter dated 6 June 2012 from the alumni of the old Katipunan Magazine to the Ateneo de Manila University Director of the Office of Student Activities. Therein a letter from Bienvenido Lumera to respondent-applicant was appended permitting them to use the name Katipunan Magazine detailing the history of that magazine in the 1970’s. In addition there is currently another magazine called Katipunan created by the Department of Filipino in Ateneo de Manila University. All these factors combine such that the mark KATIPUNAN could not be solely associated with respondent-applicant’s magazine. As such, it cannot be claimed that the mark KATIPUNAN has gained notoriety in relation to respondent-applicant’s publication. Much less could it be claimed that secondary meaning with respect to the magazine publication has been attained.

“17. Further to date, a cursory internet search of the words ‘Katipunan Magazine’ will reveal nothing of the respondent-applicant’s publication. If one would claim a right to the mark KATIPUNAN, how can it do so when the publication to which it is supposed to attach is not even accessible, much less widely available, to establish secondary meaning?

“18. All told, in addition to being descriptive and generic, the Application should be denied because the mark KATIPUNAN has attained no secondary meaning in relation to the good which is sought to be registered. xxx

“23. On the whole, granting the application will in effect allow the word ‘KATIPUNAN’ to be exclusively stamped on respondent-applicant’s publication. The problem with this situation is that the word ‘KATIPUNAN’ is commonly used as it is a place, particularly a

university area which connotes the quality of academic output, a lifestyle and even a set of activities. To appropriate KATIPUNAN gives the respondent-applicant the exclusive right to countenance his publication, nothing else without his consent, with this brand of academic excellence and way of living, which has been built over the years in the said place. This would evidently and utterly be unfair and misleading. xxx”

To support their opposition, the Opposers submitted as evidence the following:

1. Special Power of Attorney;
2. Copy of letter addressed to Mr. Victor Rafael Agbayani dated 13 December 2012; and
3. Copy of a letter addressed to Mr. Cristopher Castillo dated 6 June 2012.⁴

The Respondent-Applicant filed his Answer on 1 July 2013, alleges, among other things, the following:

“4. Respondent-Applicant first adopted and used the trademark KATIPUNAN in 2005. xxx

“5. It was established as a response to the way things were managed in The Guidon. At the time, because of the unethical behavior of the outgoing senior editors and the objections to the process and results of the editorial selection, many students, including Respondent-Applicant, resigned from The Guidon’s editorial board.

“6. The publication of the magazine stopped in 2007 due to lack of funds. Respondent-Applicant, however, seeks to revive it by re-launching it as an online news and feature publication. This time, the magazine will no longer be just a student project but an honest to goodness media portal. In preparation thereof, he filed a trademark application for KATIPUNAN with the IPO, which is now subject of this opposition case.

“7. Despite knowing Respondent-Applicant’s prior use of the mark KATIPUNAN, Opposer in 2012 launched their own online magazine also entitled KATIPUNAN.xxx

The Respondent-Applicant’s mark is reproduced below:

KATIPUNAN

⁴ Annexes “A” to “C” inclusive of submarkings



The records show that Opposers used the mark “KATIPUNAN”/ “KATIPUNAN MAGAZINE”, “KATIPUNAN BEAT” in a publication pertaining to The Guidon’s online magazine.⁵ This precipitated Respondent-Applicant, through counsel, to send a cease and desist letter to Opposer, Victor Rafael M. Agbayani, urging the opposers to desist from the alleged unauthorized use of the word “KATIPUNAN” in their publications. The Respondent-Applicant claims to be the prior user of the mark KATIPUNAN having used the same since 2005.

The Opposers contend that the word “KATIPUNAN” may not be registered because it is geographically descriptive of the mark and is a generic mark. The Supreme Court in *Societe des Produits Nestle, S.A. v. Court of Appeals*⁶, defines generic and descriptive terms, to wit:

Generic terms are those which constitute "the common descriptive name of an article or substance," or comprise the "genus of which the particular product is a species," or are "commonly used as the name or description of a kind of goods," or "imply reference to every member of a genus and the exclusion of individuating characters," or "refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product," and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it "forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is," or "if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods," or if it clearly denotes what goods or services are provided in such a way that the consumer does not have to exercise powers of perception or imagination.

The word “KATIPUNAN” is neither generic nor a descriptive word for the goods/services “magazines and media and news services” under class 16 and 35. “KATIPUNAN” does not convey the nature, characteristics or descriptive properties of a newspaper, publication or online media. In fact, the word, KATIPUNAN (usually abbreviated to KKK) was a Philippine revolutionary society founded by anti-Spanish Filipinos in Manila in 1892, whose primary aim was to gain independence from Spain through revolution. The Tagalog word "katipunan", literally meaning 'association', comes from the root word "tipon," a Tagalog word meaning "gather".⁷ When used in an arbitrary sense, bearing no relation to the goods/services it seeks to identify, “KATIPUNAN” may be appropriated and adopted as a valid trademark. According to the Opposers, the mark brings to mind academic excellence or a university lifestyle due to the fact that prestigious academic institutions are located in the area of Katipunan Avenue. Following this line of reasoning, “KATIPUNAN” may be considered a suggestive term. Suggestive terms are valid and registrable marks. Suggestive terms are those which, in the phraseology of one court, require "imagination, thought and perception to reach a conclusion as to the nature of the goods." Such terms, "which subtly connote something about the product," are eligible for protection in the absence of secondary meaning. While suggestive marks are capable of shedding "some light" upon certain characteristics of the goods or services in dispute, they nevertheless

⁵ Paragraph 15 of Verified Notice of Opposition

⁶ G.R. No. 112012, 4 April 2011

⁷ <https://en.wikipedia.org/wiki/Katipunan>

involve "an element of incongruity," "figurativeness," or "imaginative effort on the part of the observer."⁸

The Opposers further contend that "KATIPUNAN" is geographically descriptive. Geographic terms are acceptable trademarks are not *per se* unregistrable and may be appropriated as trademarks if used arbitrarily or in a suggestive way. However, if a mark is geographically descriptive, it is not registrable under Section 123 (f) of Republic Act 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). Sec. 123 (f) states:

SEC. 123. Registrability. – 123.1 A mark cannot be registered if it:

x x x x

(j) Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services;

In this regard, the Supreme Court laid the criteria for this determination: Is the mark the name of the place or region from which the goods actually come from? We disagree. There is no evidence that the public associate the goods/service (magazines and media and news services) to Katipunan Ave. To elaborate, the Supreme Court in *Shang Properties Realty Corporation v. St. Francis Development Corporation*⁹ is instructive on the matter. It held:

As deftly explained in the U.S. case of *Great Southern Bank v. First Southern Bank*: "[d]escriptive geographical terms are in the 'public domain' in the sense that every seller should have the right to inform customers of the geographical origin of his goods. A 'geographically descriptive term' is any noun or adjective that designates geographical location and would tend to be regarded by buyers as descriptive of the geographic location of origin of the goods or services. A geographically descriptive term can indicate any geographic location on earth, such as continents, nations, regions, states, cities, streets and addresses, areas of cities, rivers, and any other location referred to by a recognized name. In order to determine whether or not the geographic term in question is descriptively used, the following question is relevant: (1) Is the mark the name of the place or region from which the goods actually come? If the answer is yes, then the geographic term is probably used in a descriptive sense, and secondary meaning is required for protection.

⁸ Ibid note 6

⁹ G.R. No. 190706, 21 July 2014

In the instant case, “Katipunan” is not used to describe establishments located along the Katipunan street or the place where the magazines and news service come from. There is no need to belabor the issue, of whether the word “KATIPUNAN” has not acquired secondary meaning because it is not a geographically descriptive term in the manner it is being used.

However, what is objectionable, if the registration is allowed, is that the application is being made by the person who does not own the mark. Based on the evidence submitted by the Opposers, it appears that KATIPUNAN magazine is an independent publication in the Guidon’s “katipunan” website, supposedly under supervision from the Office of Student Affairs, Ateneo de Manila University. From the letter dated 6 June 2012¹⁰, some former editors and members of the Katipunan magazine, aired their grievance to the Guidon launch of the website (http://the.guidon.com/katipunan/2012/06/05/finding_katipunan), particularly the use of the name and its history. Seemingly, the grievance letter was aimed at new editors at the Guidon. In the letter, the senders acknowledged not holding any legal right to the name “katipunan” (which is in fact used by all sorts of shops and establishments).¹¹ The letter reads:

“xxx When we used the name in 2006, we were aware that a ‘Katipunan’ folio was previously published by Prof. Bienvenido Lumbera some decades back, and with due courtesy, KATIPUNAN sought his permission first in using the name. Prof. Lumbera agreed through a letter correspondence (of which text appears as Appendix A to this letter), and we sued the name since.xxx”

In turn, the text of the letter of Prof. Bienvenido Lumbera¹² which was addressed to Mr. Ramon Miguel C. Samson, Respondent-Applicant, gave a historical account of Katipunan, it reads:

Katipunan was a journal in Pilipino established under the Department of Philippine Studies in 1970 when the department was set up by the Academic Vice President Fr. John Doherty, S.J., in response to the growing militancy of activism in the Ateneo. As originally conceptualized, it was supposed to have been a quarterly publication under the editorship of Nicanor G. Tiongson.

Katipunan ceased publication in 1972 when the three-man faculty of the department found it necessary to disappear in view of the imposition of Martial Law. By the way, ‘Kamao’ was a special feature consisting of translations of progressive/revolutionary poetry from the Third World countries in the third volume of Katipunan which came out as a double issue, so is not true that Katipunan was ever renamed.

You are hereby given permission to use the name KATIPUNAN for your magazine, and as Founding Chair of the defunct Department of Philippine Studies of the Ateneo de Manila University, I am one with you in hoping for the success of your project in idealistic journalism.

¹⁰ Annex “C”

¹¹ Annex “C” page 1

¹² page 15

Preceding therefrom, to dismiss the opposition, therefore, is in effect to give the Respondent-Applicant exclusive right over the word "KATIPUNAN" which is owned by, originated or was conceptualized by a group of writers in The Guidon, or as stated in the letter, the now defunct, three-man faculty of the Department of Philippine Studies in 1970 which ceased operations in view of the imposition of martial law. If this is so, then it results in the consequence of the Opposer having the exclusive right to prevent the use KATIPUNAN by the present editors of The Guidon, when in fact, Respondent-Registrant secured the consent of another to use the mark, KATIPUNAN.

While the Bureau, does not find any objection to the use of the word, "KATIPUNAN" for a publication, being used in its arbitrary sense, that bears no relation to the product it seeks to represent, we cannot ignore the fact that the mark originated and was conceptualized by another person or persons. Hence, this Bureau will not sustain the opposition solely on the grounds set forth by the Opposers, that Respondent-Applicant's mark is geographically descriptive or generic. The Opposers have the right to oppose the subject trademark application under Sec. 134 of the IP Code which provides:

Sec. 134. Opposition. Any person who believes that he will be damaged by the registration for a may upon payment of the required fee and within thirty (30) days after the publication referred to in Sec. 133.2 file with the Office an opposition to the application xxx

This Bureau emphasizes that it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right to registration. The Philippines implemented the World Trade Organization Agreement "TRIPS Agreement" when the IP Code took into force and effect on 1 January 1998.¹³

The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

Significantly, Sec. 121.1 of the IP Code adopted the definition of the mark under the old law on Trademarks (Rep. Act. No. 166), to wit:

121.1 "Mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods; (Sec. 38, R.A. No. 166a)

Sec. 122 of the IP Code also states:

¹³ See Sec. 2: Trademarks, Art. 15 (Protectable Subject Matter)

Sec.122. How Marks Are acquired.- The rights in a mark shall be acquired through registration made validly in accordance with the provision of this law. (Sec. 2-A, R. A. No. 166a)

There is nothing in Sec.122 which says that registration confers ownership of the mark. What the provision speaks of is that the rights in the mark shall be acquired through registration, which must be made validly in accordance with the provision of the law.

A trademark is an industrial property and the owner thereof has property rights over it. The privilege of being issued a registration for its exclusive use, therefore, should be based on the concept of ownership. The IP Code implements the TRIPS Agreement and, therefore, the idea of “registered owner” does not mean that ownership is established by mere registration but that registration establishes merely a presumptive right of ownership. That presumption of ownership yields to superior evidence of actual and real ownership of the trademark and to the TRIPS Agreement requirement that no existing prior rights shall be prejudiced. In *Berris v. Norvy Abyadang*¹⁴, the Supreme Court held:

“The ownership of a trademark is acquired by its registration and its actual use by the manufacturer or distributor of the goods made available to the purchasing public. Xxx In other words, the *prima facie* presumption brought about by the registration of a mark may be challenged and overcome, in an appropriate action, by proof of the nullity of the registration or of non-use of the mark, except when excused. Moreover, the presumption may likewise be defeated by evidence of prior use by another person, *i.e.* it will controvert a claim of legal appropriation or of ownership based on registration by a subsequent user. This is because a trademark is a creation of use and belongs to the one who first used it in trade.”

Clearly, it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right to registration. While the country's legal regime on trademarks shifted to a registration system, thereby adopting the policy of “First-to-File” rule, there are indications that it is not the intention of the legislators not to recognize the preservation of existing rights of trademark owners at the time the IP Code took into effect.¹⁵ The “First-to-File” rule could not have been intended to justify the approval of a trademark application just because it was the first application to be filed regardless of another's better or superior right to the mark applied for. The rule cannot be used to commit or perpetrate an unjust and unfair claim. A trademark is an industrial property and the owner thereof has property rights over it. The privilege of being issued a registration for its exclusive use, therefore, should be based on the concept of ownership. RA 8293 implements the TRIPS Agreement and therefore, the idea of “registered owner” does not mean that ownership is established by mere registration but that registration establishes merely a presumptive right of ownership. That presumption of ownership yields to superior evidence of actual and real ownership of the trademark and to the TRIPS Agreement requirement that no existing prior rights shall be prejudiced.

¹⁴ G.R. No. 183404, 13 October 2010.

¹⁵See Section 236 of the IP Code.

In the instant case, while it is true that the Respondent-Applicant has prior application in the Philippines, it does not mean that he acquired a superior right over the subject mark.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-007233 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 DEC 2016



ATTY. ADORACION U. ZARE, LL.M.

Adjudication Officer
Bureau of Legal Affairs