

CEFERINO ANACLETO
FRANCISCO, JR.,
Opposer,

IPC No. 14-2009-00145
Opposition to:

- versus-

App. Serial No. 4-2008-014674
Date Filed: 04 December 2008

SONNY EMMANUEL V. FRANCISCO
Respondent-Applicant.

Trademark: "SF FERINO'S"

x-----x

Decision No. 2010-29

DECISION

CEFERINO ANACLETO FRANCISCO, JR. ("Opposer"), Filipino, of legal age, with business address at 58 Visayas Avenue, Quezon City, filed on 02 June 2009 an opposition to Trademark Application Serial No. 4-2008-014674. The application, filed by SONNY EMMANUEL V. FRANCISCO (Respondent-Applicant), with address at 35-C Malinis Street, UP Village, Diliman, Quezon City, on 04 December 2008, covers the trademark "SF FERINO'S" for use on goods under Classes 30, 35 and 43¹: "rice cakes, bibingka, poto-bumbong, liquid bibingka mixture (galapong), powdered bibingka mix, frozen/microwaveable bibingka, retail delicatessen (specialty food) services, restaurant service: carry-out and take-out restaurant services".²

The Opposer alleges the following:

"1. The approval of the application in question is contrary to Section 165 of the IP Code (Republic Act No. 8293);

"2. As the prior user and owner of the business name/trademark/ trade name 'FERINO'S BIBINGKKA', the approval of the application in question will violate Opposer's right to the exclusive use of his business name/trademark/ trade name 'FERINO'S BIBINGKKA' and cause great and irreparable damage and injury to him and his on-going business.

"Opposer will rely on-the following facts established by the annexed affidavit and exhibits to support his opposition, reserving the right to present evidence to prove other facts which may be necessary in the course of the proceedings, depending upon the evidence which may be introduced by Respondent-Applicant:

"1. Opposer is the legitimate son of spouses Ceferino F. Francisco, Sr. and Cristina Anacleto Francisco. A copy of Opposer's Marriage Contract is hereto attached as Exhibit 'A' and made an integral part hereof, with the reservation to submit a certified copy of his Birth Certificate upon release thereof by the National Census and Statistics office, the same to be marked as Exhibit 'A-1'.

"2. In 1983, Opposer's parents started their business of making and selling rice cakes (bibingka and puto burnbong) under the business name/trade name 'FERINO'S BIBINGKKA' at their residence at Ricafort Street, Tondo, Manila, and later on, at 1666 Juan Luna Street, Tondo, Manila.

"3. As soon as he was old enough, Opposer helped his parents in the business of making and selling bibingka and puto bumbong under the business name/ trade name 'FERINO'S BIBINGKKA'.

¹ 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.

² The Application was published for opposition in the Intellectual Property Office Official Gazette, officially released for circulation on 01 June 2009.

A photograph of the 'FERINO'S BIBINGKA' store opened by Opposer's parents in the Manila Hotel Arcade in August 1956 is hereto attached as Exhibit 'B' and made an integral part hereof.

"4. In November 1970, Opposer's parents opened a 'FERINO'S BIBINGKA' store at Fiesta Carnival, Cubao, Quezon City.

"5. On August 21, 1975, Opposer's father, Ceferino F. Francisco, Sr. died. A certified copy of his death certificate is hereto attached as Exhibit 'C' and made an integral part hereof.

After the death of Opposer's father, his mother and siblings, including Opposer, continued with 'FERINO'S BIBINGKA' at Fiesta Carnival, Cubao, Quezon City.

"6. On March 23, 1993, upon insistence of his mother and with the conformity of his siblings and to continue with and perpetuate the 'FERINO'S BIBINGKA' left by Ceferino F. Francisco, Sr., Opposer opened up his first 'FERINO'S BIBINGKA' a store at No. 58 Visayas Avenue, Quezon City.

A certified copy of DTI Certificate of Registration No. 0124405 for the business name 'FERINO'S BIBINGKA' issued on March 23, 1993 in favor of Opposer, is hereto attached as Exhibit 'D' and made an integral part hereof.

"7. Opposer likewise registered with the Bureau of Internal Revenue his business name/trade name 'FERINO'S BIBINGKA'. A copy of the BIR Certificate of Registration No. 94-380-002811 issued on June 28, 1994 is hereto attached as Exhibit 'E' and made an integral part hereof.

"8. On May 2, 1994, Opposer opened two 'FERINO'S BIBINGKA' stores, one at 12 President Avenue, Teoville Subdivision, Paranaque City, and another at Unit 1 Winston Street, Fairview Park, Quezon City. Copies of the BOT Certificates of Registration No. 0177803 and No. 0177802 for the business name 'FERINO'S BIBINGKA' for use in said stores are hereto attached as Exhibits 'F' and 'G' and made integral parts hereof.

"9. Aside from using 'FERINO'S BIBINGKA' as his business name, Opposer has been using also 'FERINO'S BIBINGKA' as his trademark, as well as his trade name.

"10. On August 6, 1998, January 16, 2004, and January 19, 2009, Opposer renewed his business name registration with the OTT.

- a) On August 6, 1998, he was issued OTT Certificate of Registration No. 546705 for the business name 'FERINO'S BIBINGKA', a certified copy of which is hereto attached as Exhibit 'H' and made an integral part hereof.
- b) On January 16, 2004, Opposer was issued OTT Certificate of Registration No. 00262182 for the business name 'FERINO'S BIBINGKA', a certified copy of which is hereto attached as Exhibit 'I' and made an integral part hereof.
- c) Last January 19, 2009, Opposer was issued OTT Certificate of Registration No. 00610717 for the business name 'FERINO'S BIBINGKA', a certified copy of which is hereto attached as Exhibit 'J' and made an integral part hereof.

"11. Last February 28, 2002, Opposer's mother, Cristina Anacleto Francisco died at the age of 88 years old. A certified copy of her death certificate is hereto attached as Exhibit 'K' and made an integral part hereof.

“12. From 1993 up to the present, Opposer has been using ‘FERINO’S BIBINGKA’ as his business name and trade name in his stores, and as his trademark for his rice cake (bibingka), puto bumbong and other native delicacies. Representative copies of his cash invoices are hereto attached as Exhibits ‘L’ to ‘L-39’, and made integral parts hereof, the originals of which will be made available during the preliminary conference for comparison.

“13. The dominant feature of the trademark/trade name ‘SF FERINO’S’ being applied for registration by Respondent-Applicant is the word ‘FERINO’S’, which is identical and/or confusingly similar to the dominant feature of Opposer’s business name/trademark/trade name ‘FERINO’S BIBINGKA’.

A print-out of Respondent-Applicant’s mark ‘SF FERINO’S’ as published in the e-Gazette is marked as Exhibit ‘M’ and made an integral part hereof, while a copy of Opposer’s Application Serial No. 4-2009-003017 for the registration of his trade mark/tradename ‘FERINO’S BIBINGKA and DEVICE’ is hereto attached as Exhibit ‘N’ and made an integral part hereof.

“14. The food products and services covered by Respondent-Applicant’s application, namely, rice cakes, bibingka, puto-bumbong, liquid bibingka mixture (galapong, powdered bibingka mix, frozen/microwaveable bibingka, retail delicatessen (specialty food) services, restaurant service; carry-out and take-out restaurant services falling under Classes 30, 35, and 43, are identical to the goods and services of Opposer.

“15. The approval of the application in question is contrary to Section 165 of Republic Act 1”0. 8293 (IP Code), which provides: x x x

“16. The application in question was filed by Respondent-Applicant in bad faith and fraudulently. Respondent-Applicant has known all along that Opposer has been using and is entitled to the exclusive use of his business name/trademark/trade name ‘FERINO’S BIBINGKA’.

“17. The use and registration by Respondent-Applicant of the trade name/trademark ‘SF FERINO’S’ will likely cause confusion, mistake, and deception, as the consuming public will likely think that Respondent-Applicant’s business is an extension of Opposer’s business and his (Respondent-Applicant’s) goods come from, and/or are authorized and licensed by, Opposer.

“18. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to Opposer. Respondent-Applicant is not entitled to the registration of the mark ‘SF FERINO’S in his favor.”

The Opposer’s evidence consists of the following:

1. Exhibit “A” - Opposer’s Marriage Contract
2. Exhibit “A-1” - Opposer’s Birth Certificate
3. Exhibit “B” - Photograph “FERINO’S BIBIGKA” located at Manila Hotel Arcade;
4. Exhibit “C” - Death Certificate of Ceferino F. Francisco Sr.;
5. Exhibit “D” - DTI Certificate of Registration No. 0124405 for the Business Name “FERINO’S BIBINGKA”, located at Visayas Ave., Quezon City;
6. Exhibit “E” - BIR Certificate of Registration No. 94-380-
7. Exhibit “F” - DTI Certificate of Registration No. 0177803 for the

- Business Name "FERINO'S BIBINGKA", located at Paranaque City;
8. Exhibit "G" - DTI Certificate of Registration No. 0177802 for the Business Name "FERINO'S BIBINGKA", located at Fairview Park, Quezon City;
 9. Exhibit "H" - DTI Certificate of Registration (Renewal) No. 546705 for the Business Name "FERINO'S BIBINGKA" issued 06 August 1998;
 10. Exhibit "I" - DTI Certificate of Registration (Renewal) No. 00262182 for the Business Name "FERINO'S BIBINGKA" issued 16 January 2004;
 11. Exhibit "J" - DTI Certificate of Registration (Renewal) No. 00610717 for the Business Name "FERINO'S BIBINGKA" issued 09 January 2009;
 12. Exhibit "K" - Death Certificate of Cristina Anacleto Francisco;
 13. Exhibit "L" to L-39 - Representative Cash Invoices of Opposer with Trademark "FERINO'S BIBINGKA";
 14. Exhibit "M" - Respondent-Applicant's mark "SF FERINO'S" as Published in IPO's e-Gazette; and
 15. Exhibit "N" - Copy of Opposer's Application Serial No. 4-2009003017 for the mark "FERINO'S BIBINGKA and DEVICE".

This Bureau issued a Notice to Answer on 09 June 2009 and served a copy thereof upon the Respondent-Applicant on 22 June 2009. The Respondent-Applicant, however, did not file an Answer. Thus, the instant opposition case was deemed submitted for decision on the basis of the opposition, the affidavits of witnesses and the documentary evidence submitted by the Opposer.³

Should the Respondent-Applicant be allowed to register the mark "SF FERINO'S" in its favor?

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.⁴

The competing marks are shown below for comparison:

³ Rule 2, Sec. II of the Regulations on Inter Partes Proceedings, as amended.

⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999, citing *Etepha v. Dir. of Patents, supra, Gabriel v. Perez*, 55SCRA406(1974). See also Article 15, par. (1), Art.16, par 91), of the Trade related Aspect of Intellectual Property (TRIPS Agreement).



FERINO'S *Bibingka*

SF FERINO'S

Opposers Trademark

Respondent-Applicants Trademark

One would not miss the word "FERINO'S", whether in the Opposer's mark or in the Respondent-Applicant's mark. That word is what immediately catches the eyes, and even the ears, of the consumers. The addition of the word "*Bibingka*" in the Opposer's mark, on one hand and the letters "5" and "F" in the Respondent-Applicant's mark, on the other, create no unique impression on the marks. The word "*bibingka*" refers to the product itself and thus, not registrable, while the letters "5" and "F" in the Respondent-Applicant's mark are merely "add-ons", and which do not render a distinctive character on the mark apart from that of the Opposer's.

Considering that the competing marks are used on the same good or product - "*bibingka*" - these marks, therefore, are confusingly similar. Consumers will likely be confused or deceived as to the origin or source, the nature, character, quality and characteristics of the goods, to which these marks are affixed.

Section 134 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides:

"Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2, file with the Office an opposition to application. Such opposition shall be in writing and verified by the oppositor or by any person on his behalf who knows the facts, and shall specify the ground on which it is based and include a statement of the facts relied upon. Copies of certificates of registration of marks registered in other countries or other supporting documents mentioned in the opposition shall be filed therewith, together with the translation in English, if not in the English language. For good cause shown and upon payment of the required surcharge, the time for filing an opposition may be extended by the Director of Legal Affairs, who shall notify the applicant of such extension. The Regulations shall fix the maximum period of time within which to file the opposition."

In this regard, it is emphasized that an opposition is basically a review of the trademark application in question, succinctly, whether the requirements for registration under the law are met. It is not necessarily a contest between the opposer and the applicant as to who, between them, has the better right to register the mark. In fact, anybody who believes he will be damaged by the registration of the mark may oppose the application, even if the opposer himself does not apply for the registration of the identical or confusingly similar mark in the Philippines.

Because the competing marks are confusingly similar, the Opposer, as the records show, will be damaged by the registration of the mark "SF FERINO'S". The Opposer submitted evidence of use and ownership of the business name, trade name and the later-applied mark "FERINO'S" since 1993 when he was issued a Certificate of Registration of Business Name by the Department of Trade and Industry, for "FERINO'S BIBINGKA". The Opposer continuously used the mark or name in several branches opened in Quezon City and Paranaque for which he was also issued certificates of Registration of Business Name. This is further corroborated by documentary evidence, particularly, cash invoices indicating the trade name "Ferino's Bibingka" with the Opposer as the Proprietor. These documents bear dates from 2000 to 2008.

The long, continued and exclusive use from the year 2000 has made the business name/trade name of “FERINO’S BIBINGKA” and its unregistered trademark/service mark distinctive of the business, products and services of the Opposer. The Supreme Court ruled that, “the substantial and exclusive use of a trade name for five (5) years is accepted as prima facie proof that the trade name has become distinctive; and thus by such long and continued use acquire a proprietary connotation, such that, to the purchasing public, the name becomes associated with the products or services of the business, as so is entitled to protection.”⁵

Section 168.1 of the IP Code provides:

“168.1. A person who has identified in the mind of the public the goods he manufactures or deals in, his business or service from those of others, whether or not a registered mark is employed, has a property right in the goodwill of said goods, business or services so identified, which will be protected in the same manner as other property rights.”

Corollarily, Section 165.2, paragraphs (a) and (b) of the IP Code, provides:

“Trade names or business names shall be protected, even prior to or without registration, against any unlawful act committed by third parties, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.”

A corporation’s right to use its corporate name and trade name is a property right *in rem* which it may assert and protect against the whole world in the same manner as it may protect its tangible property, real or personal against trespass or conversion. A corporation has the exclusive right to the use of its name which may be protected by injunction upon a principle similar to that upon which persons are protected by injunction upon a trademarks and trade names. It is a fraud on the corporation which has acquired a right to the name and perhaps carried on a business thereunder, and another should attempt to use the same name, or the same name with a slight variation, in such a way to induce others to deal with it in the belief that they are dealing with the corporation which has given reputation to the name. The right to the exclusive use of a corporate name with freedom from infringement by similarity is determined by priority of adoption.⁶

To allow the registration of the Respondent-Applicant’s mark will give the said party an unfair benefit and a free ride on the goodwill of Opposer’s mark. The registration is likely to have an adverse affect on the Opposer’s sales and reputation. The fact that the Respondent-Applicant has filed a Trademark Application ahead of the Opposer is of no moment. The Opposer’s right to its trademark, trade name or business name is protected under Sec. 165 of the IP Code and the Respondent-Applicant’s filing of its application is deemed an unlawful act under the said provision. Hence, the application should not be allowed. Moreover, it is a fundamental principle of the trademark registration system that the owner of the mark has the right to register it. The Respondent-Applicant is obviously not the owner of the mark “FERINO’5”. Neither can he claim good faith in coining the mark. “FERINO’5” is not an ordinary word. It is derived from the name of the Opposer, “CEFERINO”. It is unbelievable that the Respondent-Applicant could have concocted such a mark on his own, and worse used it on a product which is the same as the Opposer’s. The Respondent-Applicant did not even bother to explain how he was able to come up with the mark. He was given his day in court so to speak, yet he chose not to file an Answer that would explain his side.

⁵ *De La Rama Steamship Co. vs. National Development Co.*, 35 SCRA 367

⁶ *Philips Exports B.V. vs. Court of Appeals*, 206 SCRA 457

WHEREFORE, premises considered, the instant OPPOSITION is hereby SUSTAINED. Let the file wrapper of Trademark Application No. 4-2008-014674, together with a copy of this Decision, be returned to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 22 June 2010.

NATHANIEL S. AREVALO
Director, Bureau of Legal Affairs
Intellectual Property Office