



STICHTING BDO,  
Opposer,

-versus-

BANCO DE-ORO UNIBANK, INC.,  
Respondent-Applicant.

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IPC NO. 14-2010-00297

Opposition to:

Appln. Serial No. 4-2010-000788

(Filing Date: 22 January 2010)

TM: "BDO (Stylized and in Color)"

Decision No. 2012- 125

## DECISION

STICHTING BDO<sup>1</sup> ("Opposer") filed on 01 December 2010 an opposition to Trademark Application Serial No. 4-2010-000788. The application, filed by BANCO DE ORO UNIBANK, INC. ("Respondent")<sup>2</sup>, covers the mark "BDO (Stylized and in color)" for use on various banking, financial, monetary, and real estate services under Class 36 of the International Classification of goods<sup>3</sup>.

The Opposer alleges, among other things, that the mark BDO (Stylized and in color) is confusingly similar to the Opposer's registered BDO marks. According to the Opposer, the Respondent-Applicant's trademark application is contrary to Sec. 123.1, subparagraphs (d), (e) and (f), and Sec. 131.3 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") and Sec. 6bis of the Paris Convention for the Protection of Industrial Property. The Opposer also claims that the registration of the Respondent-Applicant's mark will diminish the distinctiveness and dilute the goodwill of the Opposer's marks covering goods and services under Classes 35, 36 and 42.

The Opposer likewise mentions that the Decision No. 2009-536 promulgated by this Bureau on IPC No. 14-2008-00017, which cancelled the Opposer's Trademark Registration No. 4-2002-000146 for BDO was appealed to the Director General. Hence, the trademark registration is still valid.

To support its opposition to the subject trademark application, the Opposer submitted the following as evidence:

1. a copy of the Appeal Memorandum filed with the Office of the Director General, dated 22 September 2009;
2. a copy of the Motion to Nullify Order with Motion to Stay Execution with Counterbond filed with the Office of the Director General, dated 15 December 2010;

<sup>1</sup> A foundation duly organized and existing and by virtue of the laws of the Netherlands, with office address at Dr. Holtropaan 27, 5652 XR Eindhoven.

<sup>2</sup> With office address at BDO Corporate Center, 7899 Makati Avenue, Makati City, 0726, Metro Manila.

<sup>3</sup> 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.

3. a copy of the Omnibus Motion (to Nullify Order and Quash Writ of Execution with Alternative Motion to Stay Execution with Counterbond) filed with the Office of the Director General dated, 15 January 2010;
4. 2007 International Directory of BDO International;
5. summary of Opposer's BDO's worldwide trademark portfolio;
6. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries;
7. World Hockey Posters;
8. various materials showing the large presence of BDO international and the active use of BDO and the BDO & Design in various countries around the world;
9. certified copy of Cert. of Reg. No. 4-2002-000146 for the mark BDO & Design;
10. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co., dated 01 June 1998;
11. notarized and legalized Affidavit-Testimony of witness Robert Stroeve;
12. BDO Corporate Visual Identity Manual;
13. BDO International Essential Facts 2007;
14. certificates of registration for the wordmark BDO and the mark BDO & Design in various countries around the world;
15. other certificates of registration for the wordmark BDO and the mark BDO & Design in various countries around the world;
16. printout of the BDO international website [www.bdointernational.com](http://www.bdointernational.com);
17. printout of the BDO international website [www.bdo.com](http://www.bdo.com);
18. printout of websites of some of the Member Firms of BDO international;
19. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries; and
20. notarized Affidavit-Testimony of witness Paul Willem Maria van Elten.<sup>4</sup>

On 10 February 2009, the Respondent-Applicant filed its Verified Answer. In substance, that Respondent-Applicant alleges that its right to the mark BDO has vested under Rep. Act No. 166 (the "old Law on Trademarks") which cannot be impaired by the IP Code, by virtue of being a prior user of the mark since 1977. Its right, says the Respondent-Applicant, is even protected under Sections 165 and 236 of the IP Code. According to the Respondent-Applicant, the Opposer's certificate of registration is only *prima facie* evidence of ownership which it sufficiently disputed through voluminous evidence of being the first and prior user of the mark BDO in the Philippines. It also contends that the use of Banco de Oro's initials "BDO" as its trade name is a common banking practice, and that no less than the Bureau of Trademarks has allowed its trademark application.

The Respondent-Applicant likewise claims that the Opposer's registrations for BDO and BDO & Design are not valid there being no actual use of the marks attributable to the Opposer. Also, the Respondent-Applicant argues that the Opposer's mark is not internationally well-known the latter having failed to show or to support the claim of extensive international registration, advertisement and use thereof. Furthermore, according to the Respondent-Applicant, the Opposer's marks are not locally well-known.

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

1. certified true copy of this Bureau's Decision No. 2009-53 in Inter Partes Case ("IPC") No. 14-2008-00017;

<sup>4</sup> Marked as Exhibits "A" to "SSSSSSSS", inclusive. Originals of the following were submitted or filed in IPC No. 14-2008-00017: Exhibits "D", "E-1" to "E-13", "G" to "G-2", "H" to "S", "U", "W" to "KK", and "RRRRRRRR" (certified true copy).

2. certified true copy of this Bureau's Resolution No. 2009-37 (D) in IPC No. 14-2008-00017;
3. certified true copy of Cancellation Order No. 2010-1 issued by the Bureau of Trademarks cancelling Cert. of Reg. No. 4-2002-000146;
4. faithful print-out of the public index file of Trademark Reg. No. 4-2002-000146 downloaded from the IPOPHL website (trademark search);
5. certified true copy of the Petition for Cancellation it filed against the Opposer's Trademark Reg. No. 4-2002-000146 (IPC No. 14-2008-00017);
6. copy of its Articles of Incorporation and amended Articles of Incorporation;
7. promotional advertisements in the Bulletin Today and Daily Express, showing the change of name from "ACME Savings Bank" to "Banco de Oro Savings Bank" (certified true copies submitted in IPC No. 14-2008-00017);
8. copy of its 1977 Annual Report that explains the adoption of the BDO logo and the subsequent annual reports from 1979 to 1981, 1983, 1985 to 1999 and 2001 to 2006 (originals were submitted in IPC No. 14-2008-00017);
9. samples of cashier checks, managers checks, and gift checks issued for more than 20 years, and passbook Savings Account No. 3001-003488-4 with 06 May 1991 as earliest date of deposit (original submitted in IPC No. 14-2008-00017), bearing the trademark and trade names Banco de Oro and BDO logo;
10. copies of the affidavits of Esther Ng Tycangco, Ester Recio, Peter Lo, Alicia Bautista, Yolanda Pilapil, Danilo Ong, Rosalia Ngo Chua, Josefina Malsi and Nelia Resol (originals submitted in IPC No. 14-2008-00017);
11. copies of internal memorandum dated 28 February 1990 for an employee's appointment, and a "Loan Release Advice" form dated 21 November 1991 for an employee's salary loan (originals submitted in IPC No. 14-2008-00017);
12. copy of a Junior Savings Club postcard with mailing date of 04 January 1991 (original submitted in IPC No. 14-2008-00017);
13. advertisements in newspapers starting 03 November 1977 up to 2003 (originals submitted in IPC No. 14-2008-00017);
14. lists of Respondent-Applicant's branches;
15. copies of photographs of several branches bearing the Banco De Oro, BDO and BDO logo in the signages (original printouts submitted in IPC No. 14-2008-00017);
16. Articles of Incorporation and 2007 General Information Sheets of BDO Financial Services, Inc., BDO Insurance Brokers, Inc., BDO Capital and Investment Corporation, BDO Savings Bank, Inc., BDO Realty Corporation, BDO Securities Corporation, and BDO Private Bank, Inc. (originals submitted in IPC No. 14-2008-00017);
17. copy of print out of the Respondent-Applicant's company profile as seen in the Philippine Stock Exchange;
18. copies of application forms for various credit card products;
19. copy of Certificate of Change of Name of "Hatid Yaman Remittance Company, Ltd." to "BDO Remittance Limited" issued by the Registrar of Companies of Hongkong;
20. certified true copy of the Reply dated 10 June 2008 in IPC No. 14-2008-00017;
21. copy of television spot report for 2007, showing the date of airing and the frequency of the Respondent-Applicant's television advertisements in prime time and popular television shows and the costs thereof (original submitted in IPC No. 14-2008-00017);
22. copies of newspaper articles from 2000 to 2002 citing the Respondent-Applicant's trade name as BDO;
23. copies of the printout of the Respondent-Applicant's website;
24. copy of printouts Wikipedia article;
25. copies of advertisements in 2006 and 2007 in foreign media (originals submitted in IPC No. 14-2008-00017);
26. copies of photographs of the plaques/certificates of awards (originals of the printouts of the photographs submitted in IPC No. 14-2008-00017);

27. copies of the 2007 July issues of Alpha Southeast Asia Magazine and 2006 Edition of the Business World's Top 1000 corporations in the Philippines (originals submitted in IPC No. 14-2008-00017);
28. faithful printout of the page of the Respondent-Applicant's website showing the list of awards conferred on said party;
29. copy of Trademark Application Form for application No. 4-2010-000788;
30. certified true copies of the Respondent-Applicant's Motion for Execution Pending Appeal dated 26 August 2009, and the Opposer's Opposition to the Motion for Execution Pending Appeal dated 11 September 2009, the Respondent-Applicant's Reply to the Opposition to the Motion for Execution Pending Appeal, the Opposer's subsequent Rejoinder dated 28 September 2009, the Respondent-Applicant's Sur-Rejoinder dated 07 October 2009, and the Opposer's Comment to the Sur-Rejoinder dated 09 October 2009, all in respect of IPC No. 14-2008-00017;
31. certified copy of this Bureau's Order No. 2009-1773 dated 09 December 2009 granting the Respondent-Applicant's Motion for Execution Pending Appeal in IPC No. 14-2008-00017;
32. certified true copy of this Bureau's Order No. 2009-1802 ordering the issuance of the Writ of Execution in IPC No. 14-2008-00017;
33. certified true copy of the Writ of Execution issued by this Bureau on 22 December 2009 in IPC No. 14-2008-00017;
34. certified true copy of the Opposer's Verified Answer in IPC No. 14-2008-00017;
35. certified true copy of the Articles of Partnership of Alba Romeo; and
36. compact discs containing copies of the Cable News Network and British Broadcasting Corporation television commercials.<sup>5</sup>

The Opposer filed a REPLY on 19 April 2011 and the Respondent-Applicant in turn submitted a REJOINDER on 29 April 2011.<sup>6</sup> The Hearing Officer issued Order No. 2011-1366 on 12 September 2011 setting the case for the preliminary conference. Then after, the preliminary conference was conducted and terminated on 13 October 2011. Consequently, the Opposer filed its position paper on 20 October 2011 while the Respondent-Applicant did so on 21 October 2011.

There is no dispute that the competing marks are identical or at least confusingly similar. The goods or services indicated in the Respondent-Applicant's trademark application are also similar and/or closely related to the Opposer's. The issue to be resolved in this case is whether the Respondent-Applicant's trademark application should be rejected on the grounds laid down by the Opposer.

In this regard, this Bureau noticed that the Opposer's case is anchored on its arguments that *first*, at the time the Respondent-Applicant filed the subject trademark application, it already has an existing trademark registration for the BDO (Reg. No. 4-2002-000146), and *secondly*, it is the owner of the mark by virtue of prior use thereof.

Trademark Reg. No. 4-2002-000146, however, was ordered cancelled in this Bureau's decision on IPC No. 14-2008-00017. The cancellation was upheld by the Director General in his Decision of 11 June 2012 on Appeal No. 14-09-55.

<sup>5</sup> Marked as Exhibits "1" to "26", inclusive.

<sup>6</sup> The case was referred to mediation pursuant to Office Order No. 154, s. 2010 (Rules of Procedure for IPO Mediation Proceedings) and Office Order No. 197, s. 2010 (Mechanics for IPO Mediation and Settlement Period). The mediation, however, was unsuccessful and



With the cancellation of Trademark Reg. No. 4-2002-000146, the instant opposition case has no more leg to stand on. Moreover, the Director General had also passed upon the issue of ownership of the mark BDO, ruling that the Respondent-Applicant has the better right over the mark BDO on the basis of the same facts, records and evidence attendant to this case.

Accordingly, there is no cogent reason for this Bureau to rule otherwise in this instance.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-000788 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 16 July 2012.

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