



STICHTING BDO,
Opposer,

-versus-

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

X-----X

} **IPC No. 14-2008-00224**
}
} Opposition to:
} Appln. Serial No. 4-2007-003263
} Date filed: 29 March 2007
} **TM: "BDO Asenso Kabayan**
} **and Device"**
}
}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 - 115 dated July 16, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 16, 2012.

For the Director:


Atty. EDWIN DANILO A. DATING
Assistant Director, BLA



STICHTING BDO,	}	IPC No. 14-2008-00224
Opposer,	}	Opposition to:
	}	
- versus -	}	Appln. Serial No. 4-2007-003263
	}	Date Filed: 29 March 2007
	}	
BANCO DE ORO UNIBANK, INC.,	}	Trademark: BDO Asenso Kabayan
Respondent-Applicant.	}	and Device
x-----x		Decision No. 2012 - <u>115</u>

DECISION

STICHTING BDO¹ ("Opposer") filed on 25 September 2008 an opposition to Trademark Application Serial No. 4-2007-003263. The application, filed by BANCO DE ORO UNIBANK, INC.² ("Respondent-Applicant"), covers the mark 'BDO Asenso Kabayan and Device' for use on "*banking and financing services*" under Class 36 of the International Classification of Goods³.

The Opposer alleges, among other things, that the mark BDO Asenso Kabayan and Device 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. 6*Bis* 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.

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

1. Certified copy of Certificate of Registration No. 4-2002-000146 for the mark BDO & Design;
2. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co. dated 01 June 1998;
3. 2007 International Directory of BDO International;
4. Summary of Opposer's BDO's worldwide trademark portfolio;
5. Certificates of Registration for the word mark BDO and the mark BDO & Design in various countries around the world;
6. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries;
7. World Hockey Posters;

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

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

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.

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. Notarized and legalized Affidavit-Testimony of witness Patrik Van Cauter;
10. BDO Corporate Visual Identity Manual;
11. BDO International Essential Facts 2007;
12. Certificates of Registration for the word mark BDO and the mark BDO & Design in various countries around the world;
13. Other Certificates of Registration for the word mark BDO and the mark BDO & Design in various countries around the world;
14. Printout of the BDO International website www.bdointernational.com;
15. Printout of the BDO International website www.bdo.com;
16. Printouts of websites of some of the Member Firms of BDO International;
17. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries;
18. Certificate of Registration No. 4-2002-000146 for the mark BDO & Design;
19. Notarized Affidavit-Testimony of witness Romeo C. Alba;
20. Memorandum of Agreement between BDO Binder B.V. and BDO Alba Ledesma & Co. dated 26 March 1997;
21. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co. dated 01 June 1998;
22. Printouts of BDO Alba Romeo & Co.'s website www.bdoalbaromeo.com;
23. Brochure/pamphlet of BDO Alba Romeo & Co.;
24. Another brochure/pamphlet of BDO Alba Romeo & Co.;
25. Photos of BDO Alba Romeo & Co.'s office lobby and premises; and
26. List of some of BDO Alba Romeo & Co.'s clients.⁴

On 05 March 2009, the Respondent-Applicant filed its Verified Answer. In substance, the 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 registration for BDO & Design is not valid there being no actual use of the mark 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 the Petition for Cancellation it filed against the Opposer's Trademark Reg. No. 4-2002-000146 (IPC No. 14-2008-00017);
2. Copy of its Articles of Incorporation and amended Articles of Incorporation;
3. List of Respondent-Applicant's 664 branches;

⁴ Marked as Exhibits "A" to "WWWWWWWW", inclusive. Originals of Exhibits "B", "C", "D-1" to "D-13", "G" to "R", "T" to "HH", "QQQQQQQQ" to "RRRRRRRR", "TTTTTTT" to "WWWWWWWW" filed or submitted in IPC No. 14-2008-00017.

4. Print-out of Respondent-Applicant's PSE company profile;
5. Certified true copy of the Reply dated 06 June 2008 submitted in IPC No. 14-2008-00017;
6. Print-outs of the updated contents of the Respondent-Applicant's website;
7. Print-outs of the updated Wikipedia article on the Respondent-Applicant;
8. Respondent-Applicant's awards listed in its website, www.bdo.com.ph;
9. Certified true copy of Service Mark Application No. 4-2007-003263;
10. Certified true copy of Paper No. 2 with mailing date of 06 June 2007 citing Opposer's Trademark Registration No. 4-2002-000146 for the mark "BDO & Design";
11. Certified true copy of Respondent-Applicant's Response to paper No. 2 dated 08 November 2007;
12. Certified true copy of the IPO's Notice of Allowance for the mark "BDO Asenso Kabayan and Device";
13. Print-out of the publication of the mark "BDO Asenso Kabayan and Device";
14. Print-out of the page 28 of Opposer's Verified Answer in IPC No. 14-2008-00017;
15. Print-out of the publication page of the Official Gazette with release date of 30 May 2008";
16. Certified true copy of the Articles of Partnership of Alba Romeo;
17. Compact disc containing a copy of the CNN broadcast and other television commercials;
18. Compact disc containing a copy of the BBC broadcasts;⁵

The Opposer filed a Reply dated 13 March 2009, and the Respondent-Applicant in turn submitted a Rejoinder on 23 March 2009.⁶ The preliminary conference was conducted and terminated on 04 May 2009. Consequently, the Opposer filed its position paper on 01 June 2009 while the Respondent-Applicant did so on 29 May 2009. Subsequently, a "Manifestation", dated 02 June 2011, was filed by the Respondent-Applicant stating that the instant case has been rendered moot and academic by the decision rendered by this Bureau in IPC No. 14-2008-00017. This prompted the Opposer to file on 14 June 2011 a "COMMENT/OPPOSITION" stating, among other things, that the aforementioned decision is not final and was brought to the Office of the Director General on appeal.

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.

⁵ Marked as Exhibits "1" to "18", inclusive.

⁶ 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.

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. 4-2007-003263 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