STICHTING BDO,
Opposer,

-versus-

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

IPC No. 14-2012-00469
Opposition to:
Appln. Serial No. 4-2011-012950
Filing Date: 26 October 2011
TM: "BDO FOUNDATION INC."

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 84 dated March 27, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 27, 2014.

For the Director:

Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

STICHTING BDO,
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-versus-

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

IPC NO. 14-2012-00469

Opposition to:
Appln. Serial No. 4-2011-012950
Date Filed: 26 October 2011
Trademark: **"BDO FOUNDATION INC."**

Decision No. 2014-_84_____

DECISION

STICHTING BDO [1] ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-012950. The application, filed by BANCO DE ORO UNIBANK, INC. ("Respondent")[2], covers the mark "BDO Foundation, Inc." for use on "*foundation rendering humanitarian services*" under Class 45 of the International Classification of goods and services[3].

The Opposer alleges, among other things, that the mark "BDO Foundation, Inc." is confusingly similar to the Opposer's registered "BDO" marks. According to the Opposer, the Respondent-Applicant's trademark application is contrary to Section 123.1, subparagraphs (d), (e) and (f), and Section 131.3 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), and Section 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. 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 2009;

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[1] A foundation duly organized and existing and by virtue of the laws of the Netherlands, with office address at Dr. Holtroplaan 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.

3. a copy of the Omnibus Motion (to Nullify Order and Quash Writ of Executioon with Alternative Motion to Stay Execution with Counterbond) filed with the Office of the Director General dated, 15 January 2010;
4. 2010 International Directory of Member Firms;
5. summary of Opposer's worldwide trademark portfolio;
6. certificates of registration for the word mark BDO and the mark BDO & Design in various countries around the world;
7. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries;
8. BDO International's World Hockey Posters;
9. 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;
10. certified copy of Cert. of Reg. No. 4-2002-000146 for the mark BDO & Design;
11. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co., dated 01 June 1998;
12. notarized and legalized Affidavit-Testimony of witness Robert Stroeve;
13. BDO Corporate Visual Identity Manual;
14. BDO International Essential Facts 2007;
15. 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;
17. printout of websites of some of the Member Firms of BDO international;
18. CD-ROM with selected commercials or advertisements made by Member Firms of BDO International in various countries;
19. notarized and legalized Secretary's Certificate executed by Basile Dura;
20. notarized Affidavit-Testimony of witness Romeo C. Alba;
21. Memorandum of Agreement between BDO Binder B.V. and BDO Alba Ledesma & Co., dated 26 March 1997;
22. Memorandum of Agreement between BDO International and BDO Alba Romeo & Co., dated 01 June 1998;
23. printouts of BDO Alba Romeo & Co.'s website www.bdoalbaromeo.com;
24. brochures/pamphlets 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 21 February 2013, the Respondent-Applicant filed its Verified Answer. In substance, that Respondent-Applicant alleges the following:

1. the opposition consists of mere bare allegations unsupported by any evidence;

[4] Marked as Exhibits "A" to "LLLLLLLLL", inclusive.

2. the decision of this Bureau cancelling the Opposer's Trademark Registration No. 4-2002-000146 was affirmed by the Office of the Director General rendering the instant opposition case without factual and legal basis;
3. it is the true and rightful owner of the trade name and trademark BDO by virtue of its prior use of the same in the Philippines in commerce; hence, it is entitled to the registration of the mark BDO Securities Corporation;
4. as between the parties, it has the better right to the contested mark being the first and prior user of the name and mark BDO;
5. the Opposer's mark BDO & Design cannot prevent the registration of the Respondent-Applicant's mark since the Opposer's registration is not valid there being no actual use thereof in the Philippines which can be attributed to the Opposer; and
6. the Opposer's marks are not internationally well-known and cannot be the basis to oppose the registration of the Respondent-Applicant's mark.

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;
2. certified true copy of this Bureau's Resolution No. 2009-37 (D) in IPC No. 14-2008-00017;
3. certified true copies of Cancellation Order No. 2010-1, dated 26 March 2010, and the list of cancelled registrations including Trademark Reg. No. 4-2002-000146;
4. certified true copy of the Decision dated 11 June 2012;
5. certified true copy of Decision No. 2009-53;
6. faithful print-out of the public index file of Trademark Reg. No. 4-2002-000146 downloaded from the IPOPHL website (trademark search);
7. certified true copy of the Petition for Cancellation in IPC Case No. 14-2008-00017;
8. copy of its Articles of Incorporation and amended Articles of Incorporation;
9. 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);
10. 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);
11. 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;

12. copies of the affidavits of Esther Ng Tycangco, Ester Recio, Peter Lo, Alicia Bautista, Yolanda Pilapil, Danilo Ong, Rosalina Ngo Chua, Josefina Malsi and Nelia Resol, Marie Therese Granada Santos, and Erlinda Duque (originals submitted in IPC No. 14-2008-00017);
13. 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);
14. copy of a Junior Savings Club postcard with mailing date of 04 January 1991 (original submitted in IPC No. 14-2008-00017);
15. advertisements in newspapers starting 03 November 1977 up to 2003 (originals submitted in IPC No. 14-2008-00017);
16. lists of Respondent-Applicant's branches;
17. 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);
18. 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);
19. copy of print out of the Respondent-Applicant's company profile as seen in the Philippine Stock Exchange;
20. copies of application forms for various credit card products;
21. 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;
22. certified true copy of the Reply dated 10 June 2008 in IPC No. 14-2008-00017;
23. copy of television spot report for 2007, showing the date of airing an 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);
24. copies of newspaper articles from 2000 to 2002 citing the Respondent-Applicant's trade name as BDO;
25. copies of the printout of the Respondent-Applicant's website;
26. copy of printouts Wikipedia article;
27. copies of advertisements in 2006 and 2007 in foreign media (originals submitted in IPC No. 14-2008-00017);
28. copies of photographs of the plaques/certificates of awards (originals of the printouts of the photographs submitted in IPC No. 14-2008-00017);

29. 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);
30. faithful printout of the page of the Respondent-Applicant's website showing the list of awards conferred on said party;
31. copy of Trademark Application Form for application No. 4-2011-012948;
32. 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;
33. 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;
34. 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;
35. certified true copy of the Writ of Execution issued by this Bureau on 22 December 2009 in IPC No. 14-2008-00017;
36. Order of the Director General, dated 16 November 2011, January 2010, denying Opposer's motion to nullify Order with motion to stay execution with counterbond and Omnibus Motion
37. certified true copy of the Opposer's Verified Answer in IPC No. 14-2008-00017;
38. certified true copy of the Articles of Partnership of Alba Romeo; and
39. compact discs containing copies of the Cable News Network and British Broadcasting Corporation television commercials;
40. copy of the Order of a court in the United States, dated 11 November 2011, BDO Remit (USA), Inc. v. Stichting BDO, CV 11-04054 MMM (CW);
41. certified true copy of the Director General's Decision, dated 11June 2012, affirming this Bureau of Legal Affairs' Decision No. 2009-53; and
42. certified true copy of the judgement of the Regional Trial Court, dated 28 February 2012, in IP Case MC 09-02 entitled Stichting BDO v. Banco de Oro Unibank, Inc.[5]

Pursuant to Office Order No. 154, s. 2010, the Hearing Officer referred the case to mediation. On 16 April 2013, this Bureau's Alternative Dispute Resolution Services submitted a report that the parties refused to mediate. Accordingly, the Hearing Officer conducted and terminated the preliminary conference on 22 May 2013 wherein the parties were directed to submit their

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5 Marked as Exhibits "1" to "31", inclusive.

respective position papers. On 20 September 2013, the Hearing Officer issued Order No. 2013-1311 declaring the case submitted for decision.

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 *firstly*, at the time the Respondent-Applicant filed the subject trademark application, it already has an existing trademark registration for 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 by this Bureau in its decision in IPC No. 14-2008-00017. The cancellation was upheld by the Director General in his ruling of 11 June 2012 in Appeal No. 14-09-55. Dissatisfied, the Opposer elevated the case to the Court of Appeals (CA-G.R. SP No. 125364). The Court's Special 8th Division rendered a decision on 15 August 2013, to wit:

> **"IN FINE, We do not find any reason to deviate from the general rule, since the factual findings of the IPO are supported by substantial evidence. We simply cannot find ways.**
>
> **"WHEREFORE, the petition is DENIED. The Decision dated June11, 2012, of the Office of the Director General of the Intellectual Property Office in Appeal No. 14-09-55 (IPC No. 4-2008-00017) is AFFIRMED."**

As no appeal or motion for reconsideration was timely filed, the decision of the Court of Appeals became final and executory on 12 September 2013 per Entry of Judgment issued by the Division Clerk of Court. Pursuant thereto, this Bureau issued an "ENTRY OF JUDGMENT/EXECUTION OF DECISION" on 23 January 2014.

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 and the Court of Appeals had 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 case.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-012950 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 27 March 2014.

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