



DIGITEL MOBILE PHILIPPINES, INC.,
Opposer,

-versus-

GLOBE TELECOM,
Respondent-Applicant.

} **IPC No. 14-2010-00169**
} Opposition to:
} Appln. Serial No.4-2009-012078
} Date filed: 26 November 2009
} **TM: "TODO TAWAG"**
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NOTICE OF DECISION

ATTY. JOEL D. PENEYRA
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GREETINGS:

Please be informed that Decision No. 2015 - 97 dated May 19, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 19, 2015.

For the Director:

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



DIGITEL MOBILE PHILIPPINES, INC.,

Opposer,

IPC No. 14-2010-00169

Opposition to Trademark

Application No. 4-2009-012078

Date Filed: 26 November 2009

Trademark: **"TODO TAWAG"**

-versus-

GLOBE TELECOM,

Respondent-Applicant.

Decision No. 2015- 97

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DECISION

Digitel Mobile Philippines, Inc.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2009-012078. The contested application, filed by Globe Telecom² ("Respondent-Applicant"), covers the mark "TODO TAWAG" for use on "telecommunication services" under Class 38 of the International Classification of Goods³.

The Opposer anchors its opposition on the provisions of Section 123.1 paragraphs (h), (i) and (j).⁴ It asserts that the Respondent-Applicant's mark "TODO TAWAG" should be refused registration for being generic Filipino words and descriptive of the service. According to the Opposer, the word "TODO" translates to "all", "whole" or "everything" in the English language while "TAWAG" means "call" or "communication through voice"; therefore, "TODO TAWAG" will be "all call/call all" or "everything call/call everything". It explains that "TODO TAWAG" is likewise a commonly used phrase in everyday local vernacular when people simply want to stress or highlight the urgency or importance of a call, as in the following phrases: "late siya kaya todo tawag siya sa girlfriend niya"; "miss niya kaya todo tawag sa pamilya"; "todo tawag ako to complain about my..."; "yung katabi niya, todo tawag naman sa phone", etc. It avers that the said phrase is invariably interchanged with the longer version "tawag ng tawag".

¹ A corporation duly organized and existing under the laws of the Philippines with business address at 29th Floor Galleria Corporate Center, EDSA corner Ortigas Avenue, Quezon City.

² A corporation duly organized and existing under and by virtue of Philippine laws, with address at 5th Floor, Globe Telecom Plaza, Pioneer corner Madison Streets, Mandaluyong City 1552.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the 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.

⁴Section 123.1. A mark cannot be registered if it:

x x x

- (h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;
- (i) Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;
- (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; x x x."

In support of its Opposition, the Opposer submitted the following:

1. copy of the Opposer's Certificate of Filing of Amended Articles of Incorporation;
2. copy of R.A. No. 9180; and
3. copy of the Certificate of Public Convenience and Necessity issued by the National Telecommunications Commission (NTC).

The Respondent-Applicant filed its Answer alleging that its company was founded in 1959 and that it markets and offers services relating to telecommunications. According to the Respondent-Applicant, it started offering "TODO TAWAG TEXT" service on 08 March 2005 through Touch Mobile, one of its cellular service brands, to address the clamor of its subscribers for unlimited call and texting services at affordable rates. Due to the overwhelming demand for continued offering of the "TODO TAWAG TEXT" service, Touch Mobile launched the "TODO TAWAG 15/15" service. Then on 14 November 2008, the "TODO TAWAG MAGDAMAG" was launched.

The Respondent-Applicant states that its "TODO TAWAG" trademark has become popular and has acquired immense goodwill through merchandising efforts. It claims to have spent at least Two Hundred Fourteen Million Pesos (Php214M) for marketing, promoting and advertising the various "TODO TAWAG" services. It claims that through extensive, exclusive and substantial use in commerce in the Philippines, "TODO TAWAG" has become distinctive of its products and services as shown in a survey conducted by Taylor Nelson Sofres from 13 to 31 January 2010. It alleges that in October 2009, the Opposer started using "TODO TAWAG IDD" marks and filed for applications for registration thereof as well as the other "TODO TAWAG" trademarks. It avers that the Opposer abandoned the applications due to confusing similarity to its own "TODO TAWAG" mark.

The Respondent-Applicant denies that "TODO TAWAG" is generic but distinctive when in used in conjunction with telecommunication services. It asserts that the terms "TODO" and "TAWAG" may be translated in several ways and have different connotations depending on the translation used while "TODO TAWAG" has no dictionary entry as it is a composite mark, a coined term to suggest the idea of "calling as much you want." It stresses that the Office recognized the registrability of marks bearing "TODO" by granting the same without requiring disclaimer of the said term including its own registered marks, "TODO TEXT" and "TODO BIGAY HABAMBUHAY". It believes "TODO" to be fanciful and that it is only when "TAWAG" was added that the mark becomes suggestive for telecommunications.

The Respondent-Applicant's evidences consist of the following:

1. certified copy of the Amended Articles of Incorporation;
2. original of the advertisement which appeared in the 31 March 2005 issue of Manila Bulletin;
3. original of the advertisement which appeared in the 19 August 2005 issue of Manila Bulletin;
4. copies of the billing statements issued by Universal McCann;
5. copies of some of the Certificates of Performances issued by the GMA network;
6. certification issued by the Universal McCann dated 24 November 2010;
7. activities and materials used by it to market, promote and advertise its mark;
8. printout of republikatm.ph;
9. certification issued by Taylor Nelson Sofres on the survey result;
10. certified copy of Trademark Application No. 4-2009-012078;
11. printouts of the details of the Opposer's applications;
12. copy of page 318 of Webster's Spanish-English English-Spanish dictionary 2004 edition showing the translation of "TODO";
13. copy of page 1447 of Tagalog-English dictionary of L. English showing the translation of "TODO"; and
14. copy of page 1394 of of Tagalog-English dictionary of L. English showing the translation of "TAWAG"; and
15. copies of the registration details of "TODO TEXT" and "TODO BIGAY HABAMBUHAY".

The Preliminary Conference was conducted and terminated on 30 June 2011 wherein the parties were directed to submit their respective position papers.

The sole issue to be resolved is whether the trademark application by Respondent-Applicant for "TODO TAWAG" should be allowed.

A trademark is any distinctive word, name, symbol, emblem, sign, or device, or any combination thereof, adopted and used by a manufacturer or merchant on his goods to identify and distinguish them from those manufactured, sold, or dealt by others. Inarguably, it is an intellectual property deserving protection by law.⁵

As stated in the above definition, a trademark must, first and foremost, be capable of distinguishing one's goods apart from the other. It is the Opposer's contention that the Respondent-Applicant's mark "TODO TAWAG" should not be allowed registration for being generic and/or descriptive. In this regard, Section 123.1 of R.A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), provides that a mark cannot be registered if it:

⁵ Dermaline Inc. vs. Myra Pharmaceuticals Inc., G.R. No. 190065, August 16, 2010.

"xxx

(h) Consists exclusively of signs that are generic for the goods or services that they seek to identify;

(i) Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in bona fide and established trade practice;

(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;

xxx"

Is the mark "TODO TAWAG" generic and/or descriptive for telecommunications services?

In **Societe des Produits Nestle vs. Court of Appeals**⁶, the Supreme Court held:

"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 Respondent-Applicant's mark is composed of two Tagalog words "TODO" and "TAWAG". In English, "TODO" can mean "all", "everything" or "maximum" while "TAWAG" means "call". Therefore, "TAWAG" can be considered generic of the service the mark covers as it gives away to the consumers the idea that the brand is for telecommunications services. However, taken together with the word "TODO", the same is considered distinctive and therefore, registrable within the purview of the law. Instead, the said mark is considered suggestive as it connotes something about the Respondent-Applicant's unlimited call service.

In the cited case, the Supreme Court explained that suggestive terms are those which, in the phraseology of one court, require "imagination, thought and

⁶ G.R. No. 112012, April 4, 2001.

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. While suggestive marks are capable of shedding "some light" upon certain characteristics of the goods or services in dispute, they nevertheless involve "an element of incongruity," "figurativeness," or "imaginative effort on the part of the observer."⁷ The Respondent-Applicant's choice to market its unlimited services by adding the word "TODO" before the generic words such as "TAWAG" and "TEXT", among others, requires imagination on its part to arrive at a fanciful trademark.

The Trademark Registry reveals that there are other trademarks issued to different entities compounding the word "TODO" with a generic or descriptive word/s such as "KALAMANSI TODO PACK" and "TODO SERBISYO AND LOGO". In fact, even the Opposer appears to have applied for the marks "TODO IDD", "TODO IDD TAWAG CARD", "TODO TAWAG IDD" and "TODO TAWAG ABROAD" although these marks appear to have been abandoned with finality.

Finally, it is emphasized that 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.⁸ Based on the above discussion, Respondent-Applicant's trademark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2009-012078 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 May 2015.


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

⁷ Ibid.

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.