

STAR TELEVISION	}	IPC No. 14-2006-00081
PRODUCTION LIMITED,	}	Case Filed on: May 25, 2006
Opposer,	}	
	}	Opposition to:
-versus-	}	App. Serial No.: 4-1997-123720
	}	Date filed: Aug. 15, 1997
ABS-CBN BROADCASTING CORP.,	}	TM: "STAR DRAMA THEATER"
Respondent-Applicant.	}	
x-----x		DECISION NO. 2009-41

DECISION

Before us is the Verified Notice of Opposition filed against the application for registration of the mark "STAR DRAMA THEATER" used for entertainment services under Class 41 of the international classification of goods bearing Application Serial No. 4-1997-123720 filed by Respondent ABS-CBN Broadcasting Corporation which was published in the Intellectual Property Office Electronic Gazette, released for circulation on 26 January 2006.

Opposer, STAR TELEVISION PRODUCTIONS LIMITED, a corporation organized and existing under the laws of British Virgin Islands, with principal place of business at Craigmuir Chambers, P.O. Box 71, Road Town, Tortola, British Virgin Islands, while respondent-applicant ABS-CBN BROADCASTING CORPORATION, is a domestic corporation, with address at 1 Broadcast Center, Mother Ignacia corner Bohol Avenue, Quezon City.

The grounds for opposition to the registration of the trademark are as follows:

1. Opposer is a satellite television company engaged in broadcasting over fifty (50) services in nine (9) languages, reaching more than three hundred (300) million viewers in fifty three (53) countries including the Philippines.

2. Opposer is the owner and first to register, adopt and use the STAR trademark in connection with a variety of goods and services, including advertising services in international class 35 and entertainment services in class 41. In some instances, the STAR mark of herein Opposer is also used in conjunction with a graphical representation of a star. Opposer has registered and applied for registration of its STAR mark in the Philippines and several countries worldwide and therefore, enjoys the right to exclude others from registering or using, in the Philippines, an identical or confusingly similar mark such as Respondent-Applicant's trademark STAR DRAMA THEATER for services under class 41.

3. There is a likelihood of confusion between Opposer's trademark STAR for goods and services under international classes 9, 16, 35, 38, 41 and 42 and Respondent-Applicant's trademark STAR DRAMA THEATER for entertainment under class 41, because the latter is identical and confusingly similar with Opposer's trademark STAR.

4. The Opposer STAR trademark is well-known internationally, taking into account the public knowledge of the relevant sector of the public, rather than the public at large, as being the trademark owned by the Opposer; hence, the Respondent-Applicant's trademark STAR DRAMA THEATER cannot be registered in the Philippines pursuant to the express provision of Section 147.2 of R.A. 8293. There is no doubt that the use of the Respondent-Applicant's trademark STAR DRAMA THEATER for similar goods/services such as entertainment under international class 41, would indicate a connection between

these goods/services and the Opposer. Likewise, the interests of the Opposer are likely to be damaged by Respondent-Applicant's use of the trademark STAR DRAMA THEATER on the above-enumerated goods/services.

5. The Respondent-Applicant by using STAR DRAMA THEATER as its trademark for its goods/ services has given them the general appearance of the products/services of the Opposer, which would likely influence purchasers to wrongly believe that these products/services originate from the Opposer, thereby deceiving the public and defrauding the Opposer of its legitimate trade hence, Respondent-Applicant is guilty of unfair competition as provided in Section 168.3 of R.A. No. 8293.

6. Respondent-Applicant in adopting the trademark STAR DRAMA THEATER for its product/services is likely to cause confusion, mistake or deception as regards its affiliation, connection, or association with the Opposer, or as to the origin, sponsorship, or approval of its products/services by the Opposer, for which it is liable for false designation of origin, false description or representation under Section 169 of R.A. No. 8293.

Opposer relied on the following facts to support its opposition:

1. The Opposer is the exclusive owner and the first to adopt the STAR trademark for goods falling under classes 9, 16, 35, 38, 41 and 42 in the Philippines. Opposer has prior use, registrations and pending applications for the STAR trademark in the Philippines and in several countries around the world. As a matter of fact, herein Opposer and its affiliates have continuously and uninterruptedly used the well-known STAR mark since 1990 in Hong Kong. In the Philippines, the Opposer STAR mark has been used in commerce as early as 1995.

Opposer was issued a certificate of trademark registration by the IPO as follows:

Mark	Registration No.	Date Issued	Class(es)
STAR TV & STAR DEVICE	4-1992-84265	21 October 2002	38

Furthermore, the following applications in the name of herein Opposer are pending with the IPO:

Mark	Application No.	Filing Date	Class(es)
STAR TV & STAR DEVICE	96170	3 November 1994	16
STAR TV & STAR DEVICE	96171	3 November 1994	35
STAR TV & STAR DEVICE	96172	3 November 1994	41
STAR LOGO	4-2000-10313	18 December 2000	9, 16, 38, 41, 42
STAR & LOGO	4-2000-10314	18 December 2000	9, 16, 38, 41, 42
STAR WITH CROPPED BOX LOGO	4-2004-11644	8 December 2004	9, 16, 38, 41, 42
STAR MOVIES WITH CROPPED BOX	4-2004-11645	8 December 2004	9, 16, 38, 41, 42

LOGO			
STAR WORLD WITH CROPPED BOX LOGO	4-2004-11646	8 December 2004	9, 16, 38, 41, 42

2. Respondent-Applicant's trademark STAR DRAMA THEATER particularly the STAR word appearing therein, is identical with and/or similar to the Opposer's STAR trademark in terms of sound, spelling, syllables and phonetics as well as on the goods/services on which said trademarks are used. Hence, it would likely influence the consumers to believe that the Respondent-Applicant's mark belongs to the Opposer. Among the many classes of goods upon which the Opposer's STAR mark is used, Opposer's STAR mark is used on "entertainment", which falls under international class 41. Said goods/services are obviously identical to the product/services upon which Respondent-Applicant's STAR DRAMA THEATER mark is used. Thus, confusion is much likely.

3. The Opposer's STAR trademark is well-known internationally. The Opposer has obtained registrations and pending applications for its STAR trademark for a variety of goods and services including advertising falling under international class 41 in several countries around the world. Opposer has prior use and registrations for the STAR trademark in many countries worldwide.

The Opposer's STAR trademark has been used, promoted and advertised for a considerable duration of time and over worldwide geographical areas. Opposer has invested tremendous amount of resources in the promotion of its trademark through various media including television commercials, outdoor advertisements, internationally well-known print publications, and sports and other promotional events. Also, the services offered and provided bearing the Opposer's STAR mark are promoted at the internet domain www.startv.com. Thus, there is already a high degree of distinction of the Opposer's STAR trademark. Its products/services carried under the said trademark had, through the years earned a distinct reputation of being high quality products and services.

Furthermore, the well-known status of the Opposer's STAR mark has been confirmed by this Honorable Office in the decision rendered in the case entitled "Star Television Productions Limited vs. Juanito Cardenas" with Inter Partes Case No. 14-2001-00013. Hence, the registration of the Respondent-Applicant's STAR DRAMA THEATER will constitute a violation of Article *6bis* and *10bis* of the Paris Convention as well as Sections 3, 123.1 (e) and 123.1 (f) of Republic Act No. 8293.

4. The use of Respondent-Applicant's trademark STAR DRAMA THEATER for services falling under international class 41 definitely misleads the public into believing that the products/services originate from, or are licensed or sponsored by Opposer or that Respondent-Applicant is associated with or an affiliate of the Opposer.

Respondent-Applicant has appropriated the trademark STAR DRAMA THEATER for the obvious purpose of capitalizing upon or riding on the valuable reputation, goodwill and popularity in the international market for STAR products/services which Opposer gained through tremendous effort and expense over a long period of time. This clearly constitutes an invasion of Opposer's intellectual property rights.

Undoubtedly, the use of the STAR DRAMA THEATER trademark for goods/services falling under international class 41 by the Respondent-Applicant are inflicting considerable damage to the interest of the Opposer. To allow

Respondent-Applicant to register STAR DRAMA THEATER trademark, will constitute a mockery of our laws protecting intellectual property rights as it will legitimize Respondent-Applicant's unfair and unlawful business practice."

Opposer submitted the following pieces of evidence to support the opposition:

Exhibits	Description
"A"	Affidavit of Chan Wai Man
"B"	Samples of the screen shots of the actual television program showing the STAR mark
"C"	Listing of all current registrations for the mark STAR of Opposer all over the world
"D"	Certified true copies of sample foreign registrations covering the STAR mark of Opposer
"E"	Representative samples of invoices for the subscription of STAR services in the Philippines
"F"	Copies of several TV Guides circulated in the Philippines showing use of the Star mark

The Notice to Answer dated 30 May 2006 was served to Respondent-Applicant, through its counsel, Quiason Makalintal Barot Torres & Ibarra on June 2, 2006. On July 25, 2006, Respondent-Applicant filed an Entry of Appearance with Motion for Extension of Time (To File Answer). Said Motion for Extension was denied by this Bureau under Order No. 2006-1155 issued on August 9, 2006 for being filed out of time. On August 31, 2006, Respondent-Applicant filed a Motion to Set Aside Order Dated 9 August 2006 with Motion to Admit Attached Answer. On 18 September 2006, Opposer filed its Opposition to the motion. A Reply was filed on October 25, 2006. On November 22, 2006, Order No. 2006-1663 was issued granting Respondent-Applicant's motion and admitting the Verified Answer. In its Answer, Respondent-Applicant stated, among others, the following defenses:

"1. Opposer's Opposition to the subject applications for the registration of the Star Cinema mark should be denied. Contrary to Opposer's allegations, the registration of the Star Cinema mark is not violative of Sections 123.1 (d), (e) of R.A. 8293, specifically:

a. Opposer has no exclusive right to the use of "Star" for goods and services;

b. The Star Drama mark is not identical to, or similar with, Opposer's Star marks;

c. Opposer's Star TV mark was not internationally and locally famous at the time of ABS-CBN's issue of, and applications for trademark registration for, the Star Drama mark;

d. The registration of the Star Drama will not cause confusion nor lead to deception;

e. The registration of Opposer's STAR TV marks cannot prejudice the right of ABS-CBN to use and register its mark; and

f. ABS-CBN is not liable under Sections 168 (unfair competition) and 169 (false designation of origin) of R.A. No. 8293 in connection with its use of Star Drama for its television show.

2. Opposer's trademark registration for its "STAR TV and DEVICE" mark is not based on actual use of the mark in the Philippines but rather, on its foreign

registration in Israel. Certificate of Registration No. 4-1992-82496 for the mark "STAR TV and DEVICE" was issued for goods covered under class 38 for television and broadcasting services, among others. Based on the records obtained from this Honorable Office, Opposer's registration was made under the provisions of the old Trademark Law, which allowed foreign corporations to register their trademarks on the basis of foreign registration of the marks, and not on the basis of actual commercial use of the mark in the Philippines. It appears that Opposer submitted its Certificate of Registration for the mark issued in Israel for class 38 as basis for the registration of its mark in the Philippines.

3. In order to claim the benefit under the cited provision, the trademark application in the Philippines must have been filed on the same date on which the application was first filed in the foreign country, provided that "[t]he application in the Philippines is filed within six months from the date on which the application was first filed in the foreign country; and within three months from the date of filing or within such time as the Director shall in his discretion grant, the applicant shall furnish a certified true copy of the application for, or registration in the country or origin of the applicant..."

3.1. Based on the records of this Office, Opposer's trademark application was initially filed on 14 September 1992. However, the application was withdrawn on 19 October 1992 because of Opposer's failure to have the application authenticated before the Philippine consular office in Hong Kong. The application appears to have been re-filed only on 16 December 1992.

3.2. Opposer's application was granted based on the registration of the "STAR TV" mark in Israel. However, the application for registration of the mark in Israel appears to have been filed on 15 May 1992, or seven (7) months before Opposer's application for registration of the mark in the Philippines was re-filed. It thus appears that Opposer's trademark registration did not meet the requirements under the old Trademark Law as the application for registration in the Philippines was filed beyond the six-month period prescribed under Section 37, i.e., the Philippine application was re-filed on 16 December 1992 while the application for registration of the mark in Israel was filed on 15 May 1992.

4. Assuming, without conceding, the validity of Opposer's Philippine registration for its Star TV mark, its registration does not affect ABS-CBN's right to use, and register, the Star Drama mark.

5. The registration of the Star Drama mark is not contrary to the provisions of Sections 123.1 (e) and (f) of R.A. No. 8293.

6. Opposer cannot claim exclusive right to the use of the word "Star", either as a stand-alone mark or in conjunction with other words. Based on the allegations on its own opposition, Opposer does not have Philippine trademark registration or application for the stand alone word "Star" or even for the word mark "Star TV". There is likewise no showing that Opposer has continuously and exclusively used the stand-alone word "Star" as a trademark, either in the Philippines or elsewhere, in connection with its services. Further, there is no indication that the word "Star" alone has become distinctive of Opposer's business or services.

7. Assuming arguendo that the mark Star TV might be deemed to be associated with the Opposer, the word "Star" alone may not. On the contrary, the numerous trademarks with the word "Star" in trademarks already registered with this Honorable Office negates exclusive use by Opposer of the word "Star" in

trademarks. It likewise belies the claim that the “star” has become distinctive of its business or services.

8. A search of his Honorable Office’s trademark database will readily show that there are at least fifty-eight (58) trademarks registered and subsisting with this Honorable Office bearing the word “Star”, either as a stand-alone mark or in conjunction with other words.

8.1. Of these trademarks, two-twenty are registered for use on goods and services falling in the same class and/or classes claimed by the herein Opposer as pertaining to the class of goods/services on which it uses its Star marks (i.e. Classes 9, 16, 35, 38, 41 and 42). Seven of these registrations are for the stand-alone mark STAR. More importantly, seven of the trademark registrations, all of which precede Opposer’s Philippine registration for its STAR TV mark, are owned by ABS-CBN and its subsidiaries.

8.2. The above-enumeration still excludes registered trademarks which use STAR as a part of the word, where STAR appears to be the dominant feature of the mark i.e., Starbucks, Starshop, Starnet, Stargazer, Starmedia, etc. If these registered marks were to be included, there would be even more registered trademarks that have STAR as a dominant feature of the mark.

9. The proliferation of the word “STAR” or device in marks registered with this Honorable Office (including those pertaining to marks of the same class as that cited by the opposer) show that Opposer has no exclusive use of the mark. In fact, following the ruling in the Gallo case, these trademark registrations negate the Opposer’s claim that Star has become distinctive of its products. As ruled in a long line of cases of American vintage, “distinctiveness in the marketplace is influenced significantly by the marks of third parties. Third parties’ usage of similar marks, in the same industry, weighs heavily against the finding that a mark is commercially strong.” Elsewhere, it has also been held that “an arbitrary mark may be classified as weak where there has been extensive third party use of similar marks on similar goods.”

10. This implies that in a crowded field of similar marks, “each member of the crowd is relatively ‘weak’ in its ability to prevent use by others in the crowd.” Thus, even assuming that the Opposer has a trademark entitled to protection in this jurisdiction, it cannot prevent Star Drama from using the word “STAR” in its own application.

11. In fact, as between Opposer and ABS-CBN, the latter has a better right to claim exclusivity of use of the word “Star” in the field of entertainment. It bears nothing that apart from its earlier trademark registration for its “Star” marks, ABS-CBN and its subsidiaries likewise have trademark applications for other “Star” marks. Most of these trademarks were used in the Philippines prior to Opposer’s purported local use of its “Star marks”.

12. Opposer likewise anchors its Opposition to the subject Applications on Sections 123.1 (e) and (f) of R.A. No. 8293. The cited sections, however, presuppose that Opposer’s STAR mark was well known internationally and in the Philippines, at the time of filing of the subject Applications. Thus, a mark that is famous internationally (assuming arguendo Opposer’s mark is one), but not locally, cannot claim the benefit of Section 123.1 (e) and (f) of R.A. No. 8293.

13. Opposer further invokes the provisions of the Paris Convention, particularly Articles 6bis and 10bis thereof, in conjunction with Sections 123.1 (e) and (f) of R.A. No. 8293. Opposer overlooks the fact that to avail of the protection

given to well-known marks under the provisions of the Paris Convention, the international and local fame of the mark AT THE TIME of Star Cinema's use and application for its "Star Cinema" mark must be established.

14. Under Article 4 of the Joint Recommendation Concerning Provisions of the Protection of Well-Known Marks, a mark identical to a well-known mark will not be considered a conflicting mark, if such mark was a) used; b) the subject of a trademark application; or c) registered in a Member State before the well-known mark became famous in the Member State.

15. Without conceding that Opposer's "STAR TV" mark is now an internationally and locally famous mark, there is no showing that the mark was internationally AND locally famous at the time of Star Cinema's first use of its mark in 1993, or even at time of filing of the subject Applications in 1994. On the contrary, Opposer's own evidence suggests that, the mark was not even in actual commercial use in the Philippines in 1993.

15.1 The affidavit of Opposer's witness, Chan Mai, states that the STAR mark was first used in commerce in the Philippines only in 1995, which is almost two years after Star Cinema first used its own mark. On the contrary, Star Cinema's mark was already locally famous at the time Opposer used its mark in the Philippines, considering that in 1995, the former had already used its mark in twenty-five (25) movies, all of which were promoted extensively and shown in theaters throughout the Philippines, xxx

15.2. At the time of Opposer's alleged use of the STAR TV mark in 1995, in the field of entertainment, the public at large, (and not only the movie-going public) had already associated STAR in the field of entertainment, with ABS-CBN and its subsidiaries.

16. Opposer attached to its Opposition voluminous documents to demonstrate the supposed international fame of its STAR TV mark. However, not one of the documents attached showed that its Star mark was even famous internationally at the time ABS-CBN first used and adopted its mark in the Philippines in 1993. Further, there is no indication, or even allegation, of efforts undertaken by the Opposer to promote its mark in the Philippines. On the contrary, there is every indication that its mark was, at the very least, not even locally famous at the time of ABS-CBN's applications for the registration of the Star Drama mark in 1997. In this regard, it bears nothing that in *Kabushiki Kaisha Isetan v. Intermediate Appellate Court*, the Supreme Court ruled that a supposed internationally famous mark must also be known "among Filipinos", to claim protection under the Paris Convention. In the cited case, the Supreme Court noted that absence of use in the Philippines by the foreign registrant of the claimed internationally famous mark. Here, Opposer admits that it only used its mark in the Philippines in 1995.

17. Additionally, Sections 123.1 (e) and (f) of R.A. No. 8293 also require that a mark should be well-known internationally and in the Philippines, taking into account "knowledge in the Philippines which has been obtained as a result of the promotion of the mark." There is no showing here of Opposer's prior promotion of the mark in the Philippines which would indicate that the mark was already well-known in the country even before it used the mark here in 1995.

18. Opposer cannot rely on this Honorable Office's declaration in IPC Case No. 14-2001-00013 that its mark is internationally well known, as ABS-CBN was not a party to that case. Additionally, there is nothing in the text of the Decision it invokes which suggests that Opposer's Star mark was internationally

AND locally famous at the time Star Cinema first used its mark in the Philippines in 1993. Further, assuming (without conceding) that Opposer's mark has now become well-known, such fact cannot affect the rights of ABS-CBN, as it used the ABS-CBN mark even before Opposer's mark became well-known. The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization, in their Joint Recommendation on the Protection of Well-Known Marks, likewise recognize that the protection to well-known mark cannot affect the rights of those who used an identical mark before the "well-known" mark has become famous in a member state.

19. Sections 123.1 (d), (e) and (f) all contain a prohibition against the registration of a mark identical to a registered mark or a well-known mark if such registration will cause confusion. As discussed above, Opposer's mark and Star Cinema's mark are not identical. Further, the registration of the Star Cinema mark will not cause confusion or lead to deception.

20. Opposer claims that the Star Drama mark and its Star TV mark are identical. A comparison of the marks however shows that apart from containing the word "Star", the two marks are not identical.

21. The Star Drama mark is composed of the words "Star Drama Theater". Opposer's Star mark consists of just the words STAR TV with the image of a star. The design of the two marks and the fonts used are different. Notably, while Opposer claims that "STAR" is a dominant feature of its mark, the word Star is not given prominence or emphasis in its mark.

22. Since Opposer's mark and ABS-CBN's mark are not identical, it is not likely that the registration of the Star Drama mark will not cause confusion or lead to deception. Further, given the local fame of the Star Drama mark, likelihood of deception is practically inexistent.

23. Moreover, it appears from the documents it attached to its Opposition that Opposer's use of its "Star TV" mark is usually as depicted in its Philippine trademark registration, i.e. as "Star TV" with the image of a star, and not just the word "Star". Assuming, without conceding, that the public may associate "Star TV" exclusively with Opposer, such exclusive association will not occur if only the word "Star" is used. In this case, such association is even remote given the fame of the "Star Drama" mark in the Philippines.

24. ABS-CBN and the Opposer use their marks on goods and services which are distributed in different channels of their respective trade. "Star Drama Theater" movies are shown primarily in local television channels of ABS-CBN for free. ABS-CBN use of its Star Drama mark is therefore notorious and widespread. Opposer's programs are accessible only to those who have cable subscriptions and only in those areas where the cable providers have contracts with the Opposer. Surely, there can be little serious doubt that Opposer's reach cannot even begin to approximate that of ABS-CBN.

25. With the undisputed fame and extensive promotion and use of the Star Drama mark in the Philippines, it is highly unlikely, if not impossible, for the movie-going public, or even the public at large (including those with cable subscriptions), to confuse Star Drama with Star TV. The local fame of the Star Drama mark is such that when it comes to movies, the word STAR is exclusively associated with ABS-CBN and its subsidiaries.

26. Opposer invokes the provisions of R.A. No. 8293 and Article 16 (1) of the Agreement on Trade Related Aspects of Intellectual Property Rights (“TRIPS Agreement”) to prevent the registration of Star Drama mark. However, Opposer ignores the fact that its trademark registrations for the STAR TV mark cannot prejudice the right of ABS-CBN.

27. By its prior adoption and use of the “Star Drama” mark in 1993, ABS-CBN had already acquired ownership over the mark, even without it having secured a registration therefore under the provisions of the old Trademark Law. This right of ownership is protected and preserved notwithstanding the fact that R.A. No. 8293 now provides that ownership over a mark is acquired through registration made validly in accordance with the law. Section 236 of the same law expressly preserves existing prior rights acquired in good faith.

29. The subsequent registration of Opposer’s STAR TV mark cannot prejudice ABS-CBN’s rights. Neither does such subsequent registration give Opposer an exclusive right to use the mark. It bears nothing here that ABS-CBN’s use of its Star Drama precedes Opposer’s claimed actual use of its “STAR TV” mark in the Philippines. ABS-CBN first used its Star mark in the Philippines in 1993 while based on Opposer’s allegations, it first used its “STAR TV” mark in 1995.

30. Opposer’s claim that ABS-CBN is liable under Section 168 and 169 of R.A. No. 8293 has no factual or legal basis. First, unfair competition presupposes that Opposer has established goodwill in the goods and services it offers. There is no showing here of such established goodwill specifically at the time when ABS-CBN first used the “STAR DRAMA” mark in its television show. Considering that Opposer’s claimed first commercial use of its “Star” marks is only in 1995, there was no goodwill to speak of at the time the ABS-CBN first used its own Star mark. Second, the essence of unfair competition is the passing off of the goods for those of the other. Again, critical here is the issue of when Opposer first used its mark in the Philippines. How can ABS-CBN be accused of passing off its television show as a production of the Oppose when at the time the former launched “Star Drama Theater” in 1993, Opposer and its marks are virtually unknown in the Philippines.

31. Neither can ABS-CBN be held liable for false designation of origin. Apart from using the word “Star”, a word over which Opposer cannot claim exclusivity of use, there is no device, symbol, name or representation in ABS-CBN’s “Star Drama” mark that is identical to, or similar with, anyone of the Opposer’s “Star” marks. Moreover, the “Star Drama Theater” show had always been promoted in ABS-CBN’s television network as its own production. The show mainly featured artists which have exclusive contracts or identified with ABS-CBN.

32. Finally, ABS-CBN is cognizant of, and respects, the protection extended to well-known marks under R.A. No. 8293. However, the protection given cannot prejudice the rights of ABS-CBN to use its marks, especially in this case when its use of the mark precedes Opposer’s use and registration of such mark in the Philippines. this is a protection which ABS-CBN is likewise assured of under Section 236 of R.A No. 8293. Section 236 preserves the rights of those who, like ABS-CBN, have acquired over mark prior to the effectivity of R.A. No. 8293.”

Attached to the Verified Answer are the following documentary evidence:

Exhibits	Description
"1"	Affidavit of Catherine Patricia K. Ochoa-Perez
"2"	Summary of artists featured in Star Drama Theater
"3-A" and "3-B"	Copy of two (2) Star Drama Theater episode featuring Manilyn Reynes and Lorna Tolentino contained in VHS tape
"4" to "4-14"	Certified photocopies of samples of Star Drama Theater Press Kits

On December 14, 2006, Opposer filed a Motion for Reconsideration on the Order admitting the answer. A Comment/Opposition thereto was filed on January 15, 2007. On 28 February 2007, the Motion for Reconsideration was denied and at the same time the Preliminary Conference was set on March 29, 2007. On April 30, 2007, the Preliminary Conference was terminated. On August 13, 2007 an Order was issued requiring Respondent-Applicant to submit Position Paper since Opposer has already submitted its Position Paper on August 25, 2006. On September 3, 2007, Respondent-Applicant filed its Position Paper. Hence, the case was submitted for decision.

The sole issue to be resolved in this case is: WHETHER OR NOT RESPONDENT-APPLICANT'S "STAR DRAMA THEATER" SHOULD BE REGISTERED.

Opposer asseverated in its Position Paper that Respondent-Applicant's mark STAR DRAMA THEATER is confusingly similar to Opposer's STAR trademark. In elaborating that Respondent-Applicant's mark is confusingly similar to that of Opposer, it argued that the marks STAR and STAR DRAMA THEATER is similar in meaning, sound and spelling; both contain the word STAR and the word STAR has always been given emphasis in Opposer's business, services and advertisements; and the mark STAR DRAMA THEATER entirely contains Opposer's trademark/service mark STAR and the addition of the words DRAMA THEATER to Opposer's STAR trademark/ service mark does not avoid the probability of confusion among consumers since the other portion of Respondent-Applicant's service mark STAR DRAMA THEATER merely connotes a variant of the STAR trademark/service mark. Also, Opposer alleged that services upon which the marks STAR DRAMA THEATER and STAR are used are identical, related services displayed in same media.

On the other hand, Respondent-Applicant claimed that Opposer has no legal grounds to oppose the subject application as the registration of STAR DRAMA THEATER does not violate the provisions of R.A. 8293 and the Paris Convention. Invoking Article 4 of the Joint Recommendation Concerning Provisions of the Protection of Well-Known Marks, Respondent-Applicant said that Opposer did not present evidence to show that its STAR mark was internationally and locally famous at the time ABS-CBN first used STAR DRAMA in 1993, or even at the time of the filing of the application in 1997 and that as Opposer's own evidence suggests, its mark was not even in actual commercial use in the Philippines in 1993 when Respondent's own STAR DRAMA THEATER was used. Respondent-Applicant also pointed out that in the Affidavit of Chan Mai, Opposer's STAR mark was first used in commerce in the Philippines only in 1995, almost two (2) years after ABS-CBN first used its own mark. Respondent further alleged that ABS-CBN mark was already locally famous at the time the Opposer used its mark in the Philippines, considering that in 1995, the former had already used its mark in numerous episodes which were shown weekly since 1993.

In determining the existence of confusing similarity, it becomes imperative for this Bureau to make a careful comparison and scrutiny of the marks involved; to determine the points where these labels as they appear on the goods to which they are attached are similar, in spelling, sound and manner of presentation or general appearance. For a better appreciation of the

respective claims and arguments of the parties, the two marks are reproduced hereunder exactly as it appears in the application or the facsimile copy of the registration records filed with this Office:



Opposer's STAR mark



Respondent-Applicant's mark

A mere examination and comparison of the competing labels reveal that the dominant word STAR appears in both marks. Although the records disclose that apart from the use of the word STAR, the words "Drama Theater" is added below the word STAR. Unlike the word STAR, the other words, DRAMA THEATER, are descriptive of the service/s Respondent is offering to the public. STAR as word in Opposer as well as Respondent's label is arbitrary, and as word mark it is not generic and may be appropriated by anybody as its own when used on goods/services not descriptive of the label or mark.

With R.A. 166, as amended, as basis of registrability, this Bureau adheres to the rule on prior adoption and use in the Philippines applying specific provisions of R.A. 166 (Sec. 2 and 2-A). Records will show that as between the parties, Respondent's application has an earlier filing date and use in the Philippines of the STAR mark for use on services falling under Classes 35 and 41. But further examination of the claims of Opposer as stated in the opposition, which claim was not disputed by Respondent-Applicant confirms Opposer's earlier application and registration of the STAR mark on services included under Class 38. Between the two contending parties, trademark application of Opposer's STAR mark for Class 38 came earlier by more or less two (2) years or in 1992 vis-à-vis Respondent's application in 1997.

Opposer's communication services (Class 38) and Applicant's entertainment services (Class 41) are admittedly not in actual competition but they are related in that Applicant's entertainment services is carried out and established using communications and/or television as medium. By their being basically in the mass media industry which is rapidly evolving, both services expectedly would cater to the same market targeting as it does, the consuming public. Hence, their services may be marketed similarly. At this juncture, it can logically be inferred that both services flow through the same channels of trade being related to the purpose of existence and their target market. Clearly, their services are related. And when they are related, they subsequent user is proscribed from appropriating a service mark which is substantially or confusingly similar to a service mark owned by a prior registrant.

The right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano v. Director of Patents, et. al.*, G.R. No. L-20170, August 10, 1965). And where a trademark application is opposed, the Respondent-Applicant has the burden of proving ownership (*Marvex Commercial Co., Inc v. Peter Hawpia and Co.*, 18 SCRA 1178). In the instant case, Opposer has an earlier application in 1992 for the STAR mark under Class 38 compared to Respondent-Applicant's application for the subject mark which was in 1997.

Although at first glance, the contending parties do not *directly* move in the same channel of trade and the likelihood of confusion may seem farfetched because the services they offer are not directly related, telecommunication vis-à-vis advertising, there is a probability that Opposer's STAR TV service mark will be used on services similar to that of Respondent-Applicant, i.e., entertainment services, as they are within the normal or zone of potential business expansion of

Opposer. In fact, as stated by Opposer, they have several pending application for registration of their various STAR marks covering Class 41 (the earliest of which was in 1994 for the STAR TV & STAR DEVICE, still a much earlier date than Respondent's filing date for the STAR DRAMA THEATER) the same class upon which the herein subject mark is being applied for registration. The expansion of Opposer's business into these related services were the pattern taken as well in other countries where Opposer's business indeed expanded to these areas. Bolstering this view of potential expansion is the pronouncement of the Supreme Court in the case of Jose P. Sta. Ana vs. Florentino Maliwat, et. al. G.R. No. L-23023, August 31, 1968 which ruled, thus:

"Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade-mark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148 ALR 56 et seq; 53 Am Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business"

It may be well be worthy to note that as early as the years 1990-1991, Opposer's STAR mark was used in Hong Kong through broadcast services via satellite throughout the Asia Pacific Region. Hence, Respondent-Applicant, by any parity of reasoning, cannot be considered an originator, prior registrant nor a prior applicant of the subject or questioned STAR service mark. more so, considering that Respondent is also in the business of broadcasting, it cannot be said that it was oblivious of the existence of the STAR TV.

Anent the Respondent's contention that Opposer's trademark registration did not meet the requirements under the old Trademark Law as the application for registration in the Philippines was filed beyond the six-month period prescribed under Section 37, i.e., the Philippine application was re-filed on 16 December 1992 while the application for registration of the mark in Israel was filed on 15 May 1992, the same is not well-founded. The registration of the STAR TV & STAR DEVICE mark in favor of Opposer constitutes *prima facie* evidence of its ownership of the mark, the date of appropriation and the validity of other pertinent facts stated therein. Indeed, Section 20 of Republic Act 166 provides as follows:

SECTION 20. Certificate of registration prima facie evidence of validity. – A certificate of registration of a mark or trade-name shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark or trade-name, and of the registrant's exclusive right to use the same in connection with the goods, business or services specified in the certificate, subject to any conditions and limitations stated therein.

Clearly, because of the presumption of validity, the burden of proof rests on Respondent to prove that the registration of the mark was invalid and that Opposer is not the owner of the mark. It follows therefore that the claimed dates of respondent's first use of the marks are presumed valid. Furthermore, unless and until a registration is canceled the same is valid and enforceable.

Opposer further argues that STAR marks are well-known citing provision for the protection of well-known marks contained in Article 6*bis* of the Paris Convention. The protection in Article 6*bis* extends only to registration or use in respect of identical or similar goods, contrary to what is obtaining in the instant case which involves services. Opposer further bolstered its argument invoking R.A. 8293 (the Intellectual Property Code of the Philippines) which took effect on January 1, 1998.

In the language of R.A. 8293, more particularly Section 123 (f), it is said that:

“Section 123. Registrability. – 123.1. A mark cannot be registered if it:

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such us.”

It is clear that the foregoing section can not apply to the case at bar because the trademark application was filed when the old trademark law was still effective, it follows that it is R.A. 166, as amended, that must be applied with regard to the determination of whether or not a mark is a well-known. In determining whether a trademark is well-known, we used under the old law as standards an international treaty: the Paris Convention for the Protection of Industrial Property or Article 6bis and as national guidelines, the November 20, 1980 Memorandum issued by the then Minister of Trade and Industry, the Hon. Luis Villafuerte and the October 25, 1983 Memorandum issued by then Minister Roberto V. Ongpin.

Inasmuch as this Bureau finds confusing similarity between the subject service marks in the light of discussions on the evidence adduced and/or presented to this Bureau, the issue of well-knownness of the mark has become unnecessary to resolve.

By appropriating a word which is identical or closely resembles that of a previously registered and widely used trademark, and taking into account the evidence submitted by Opposer, this Bureau holds that indeed there was a deliberate intent by Respondent-Applicant to ride on the popularity of the mark of the Opposer without the Respondent-Applicant having incurred any experience to gain such goodwill and/or reputation.

In the case of American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544, it was observed that:

“Why of the million of terms and combination of letters and designs available the appellee had to choose a mark so closely similar to another’s trademark of there was no intent to take advantage of the goodwill generated by the other mark”

As the rightful owner of the STAR mark, Opposer should be given protection against entities that merely wish to take advantage of the goodwill its marks have generated.

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, Application bearing Serial No. 4-1997-123720 for the mark STAR DRAMA THEATER filed on 15 August 1997 for entertainment services under Class 41 of the International Classification of goods is, as it is hereby REJECTED.

Let the filewrapper of STAR DRAMA THEATER subject matter of the instant case be transmitted to the Bureau of Trademarks for appropriate action in accordance with this DECISION.

SO ORDERED.

Makati City, 13 March 2009

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office