

STAR TELEVISION PRODUCTIONS LIMITED,	}	Inter Partes Case No. 14-2001-00013
	}	Opposition to:
Opposer,	}	
	}	Serial No. : 110793
	}	Date Filed : 22 August 1996
-versus-	}	Trademark : "STAR & STAR DEVICE"
	}	
JUANITO Y. CARDENAS,	}	
Respondent-Applicant.	}	
x-----x	}	Decision No. 200-32

DECISION

This pertains to the Opposition filed by STAR TELEVISION PRODUCTIONS, LTD., a corporation organized and existing under the laws of British Virgin Islands, with principal place of business at Carigmuir Chambers P.O. Box 71 Road Town, Tortola, British Virgin Islands, against the registration of the trademark "STAR & STAR DEVICE" for goods covered in Class 9 specifically for use on home audio and video equipment file under Application Serial No. 110793 on 22 August 1996 in the name of JUANITO Y. CARDENAS on No. 7 11th Street, New Manila, Quezon City.

The subject application was published on page 21, Volume III, No. 5, of the Official Gazette, which was officially released for circulation on 26 March 2001. Opposer filed the Verified Notice of Opposition on July 24, 2001.

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

- "1. The registration of the mark subject of this opposition is contrary to the provisions of Section 123.1 (d), of Republic Act No. 8293, as amended, which prohibits the registration of a mark which is : "(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of : (i) The same goods or services, or (ii) Closely related goods or services, or (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;
- "2. Opposer is the owner of the mark STAR TV and STAR DEVICE which has been applied for registration with he Intellectual Property Office in classes 16, 35, 38 and 41. The following are the filing particulars of the applications for registration of the opposer's mark: Serial No. 96170 filed on 3 November 1994 for goods under Class 16; Serial No.96170 filed on 3 November 1994 for goods under Class 35; Serial No. 82496 filed on 14 September 1992 for goods under Class 38 and Serial No. 96170 filed on 3 November 1994 for goods under Class 41;
- "3. The registration of the mark STAR and STRA DEVICE in favor of Respondent-Applicant is contrary to the provisions of Section 3, Republic Act 8293 which grants persons who are nationals of a foreign country, which is a party to any international convention or treaty relating to marks or the repression of unfair competition to which the Philippines is a party, the benefits of the treaty or convention;
- "4. The Opposer is domiciled in the British Virgin Islands, an overseas territory of the United Kingdom. Both the Philippines and the United Kingdom are members of the Paris Convention for the protection of Industrial Property (the Paris Convention);

- “5. Opposer’s STAR TV and STAR DEVICE mark is a well-known or world famous mark. Hence, the registration of Respondent-Applicant’s mark will constitute a violation of Articles 6bis of the Paris Convention in conjunction with Section 123 (f) of Republic Act 8293;
- “6. The use by Respondent-Applicant of the STAR and STRA DEVICE mark on goods that are similar, identical or closely related to goods that are produced by, originating from, or are under the sponsorship of Opposer will mislead the purchasing public into believing that such goods are produced by, originate from, or under the sponsorship of Opposer.
- “7. The denial of the application subject of this opposition is authorized under the provisions of the IP Code.

Opposer relied on the following facts to support its contentions on this Opposition:

- “1. Opposer is the owner of the mark STAR TV and STAR DEVICE, which has been applied for registration in the name of Opposer with the Intellectual Property Office;
- “2. The mark STAR TV and STAR DEVICE has been registered and applied for registration by the Opposer in other countries;
- “3. Opposer has been commercially using its mark STAR TV and STAR DEVICE in the Philippines and internationally prior to the alleged date of first use of the STAR and STAR DEVICE mark by Respondent-Applicant;
- “4. By reason of appearance, the STAR and STAR DEVICE mark sought to be registered in Respondent-Applicant’s name is confusingly similar to the Opposer’s STAR TV and STAR DEVICE mark;
- “5. Opposer has not abandoned its STAR TV and STAR DEVICE mark;
- “6. Opposer continues to use the mark STAR TV and STAR DEVICE in commerce in the Philippines and in other countries;
- “7. By virtue of the prior and continued use by Opposer of its STAR TV and STAR DEVICE in other parts of the world, the mark has become popular and internationally well-known and has established valuable goodwill for the Opposer with the public which has identified the Opposer as the source of goods and services bearing said mark.”

For failure of Respondent-Applicant to answer this instant Opposition, this Office declared Respondent-Applicant in default on this score per Order No. 2002-48, and evidence ex-parte was presented on the Opposition.

In support of its prayer for the rejection of Application Serial No. 110793, Opposer presented and afterwards formally offered its documentary and testimonial evidences. Admitted by this Office as evidence for the Opposer based on the records are Exhibits “A” to “C” inclusive of submarkings which consisted, among others, of the uncontradicted testimony in an affidavit form of Chan Wai Man, Legal Counsel for Star Television Productions Ltd., certified copies of registration and pending applications in the Philippines and abroad for the marks, STAR TV and STAR DEVICE, STAR DEVICE and STAR and STAR DEVICE and various promotional materials used to promote STAR marks.

For evaluation of this Office in particular is the propriety of Application Serial No. 110793. The issue delves on the determination of whether or not Respondent-Applicant is entitled to register the trademark STAR and STAR DEVICE on goods under Class 9 specifically home audio and video equipment which include among others karaoke, radio, radio cassette, television, VHS, components and CD player.

In this connection, it should be noted the Republic Act No. 166, as amended was the law in force at the time the subject trademark application was filed, hence, this Office shall resolve this instant Opposition under said law so as not to adversely affect rights already acquired prior to the effectivity of the new Intellectual Property Code, R.A. 8293.

In the language of R.A. 166, as amended, more particularly Section 4 (d), it is said that:

“Section 4. Registration of trademarks, trade-names and service-marks on the principal register. There is hereby established a register of trademarks, trade names and service marks which shall be known as the principal register. the owner of a trademark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or service of others shall have a right to register the same on the Principal Register, unless it:

“(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers.”

After a close scrutiny and careful evaluation of the records and evidence presented, this Office finds substantiation to the grounds relied upon to sustain this instant Opposition.

It is clear from a reading of the preceding section that the purpose of the Trademark Law is to provide protection not only to the owner of the trademark, likewise, and more importantly, to the unwary public that they may not be confused, mistaken or deceived by goods they buy.

In the instant case, the mark STAR and STAR DEVICE of Respondent-Applicant, not only is similar in spelling, pronunciation and the style of lettering. In fact, it is obviously identical to the mark STAR TV and STAR DEVICE used and not abandoned by Opposer. The subject mark applied for and Opposer's mark are identical in their overall presentation. Likewise, one can readily observe the glaring similarities of the letters S, T, and R in the two marks as they appear on the goods or services of the contending parties.

Opposer had adopted and has been using their STAR marks since December 1990 in Hongkong as can be gleaned in the evidence offered (Exhibit “A-14”) under Class 38 and in Indonesia (Exhibit “A-15”) as early as the year 1992 for goods belonging to Class 9.

From the evidence presented, Opposer has sufficiently corroborated its claim that it had been in the business and was using the STAR marks under Class 9 since 1992 or two (2) years earlier than Respondent-Applicant's stated date of first use. As held in the case of [Unno Commercial Enterprises, Inc. vs. General Milling Corporation] *“prior use by one will controvert a claim of legal appropriation by subsequent users”*. It may be concluded inevitably that Respondent-Applicant's use of identical mark results in an unlawful appropriation of mark previously used by Opposer and not abandoned, thereby contravening the explicit provision of Section 4(d) of Republic Act No. 166, as amended, which is the applicable law that controls the present controversy.

Viewed in the light of the principles above-stated, the issue now hinges or is narrowed down to the question of whether or not Opposer's trademark is internationally well-known and as such is entitled to protection under our law.

As the records eloquently show, Opposer's mark is well-known. The marks STAR TV and STAR DEVICE, STAR DEVICE and STAR and STAR DEVICE have registrations and pending applications in the name of the Opposer in many countries around the world and more than ever almost covered the Asian Region which set them off to tie links with Satellite Television Asian Region Limited. Opposer likewise has enjoyed international reputation and goodwill bearing their trademarks. Over the years, Opposer's services like satellite network and broadcast operations bearing the STAR marks have been produced and distributed by the Company, Opposer herein and/or its world renowned group of companies referred as the STAR Group Limited to cable operators in many Asian countries and in at least thirty-four (34) countries worldwide, including the Philippines. In fact, Opposer has registrations in United Kingdom, Russia and Japan for their trademarks used on goods belonging to Class 9 shown in the attached Exhibits "A-17, A-22 & A-28". To enhance its international reputation and to further promote goodwill over its name, marks and products, the Company has extensively advertised its products and services (Exhibit "A-158 to A-424"), trademarks and name in various publications which are circulated in many countries around the world, including the Philippines.

Under Republic Act 166, as amended, a mark can be considered well-known when any one of the following conditions or criteria or any combination thereof mentioned in the Ongpin Memorandum is met:

" x x x

- "a. a declaration by the Minister of Trade and Industry that the trademark being considered is already well known in the Philippines such that permission for its use by other than its original owner will constitute a reproduction, imitation, translation or other infringement*
- "b. That the trademark is used in commerce internationally, supported by proof that goods bearing the trademark are sold on an international scale, advertisements, the establishment of factories, sales offices, distributorships and the like, in different countries, including volume or other measure of international trade and commerce;*
- "c. That the trademark is duly registered in the industrial property office(s) of another country of countries, taking into consideration the dates of such registration;*
- "d. That the trademark has been long established and obtained goodwill and general international consumer recognition as belonging to one owner or source;*
- "e. That the trademark actually belongs to a party claiming ownership and has the right to registration under the provisions of the aforestated Paris Convention.*

x x x"

Having met the foregoing requirements substantially as well as the home registration, United Kingdom, being a member country of the Paris Convention, it is an inevitable conclusion that Opposer's marks are internationally well-known.

Given the established goodwill and international reputation for its services bearing Opposer's marks and notwithstanding the dissimilarity of the products of herein parties, the trademark owner is entitled to protection when the use of the junior user, a Philippine applicant, "forestalls the normal expansion of their business". It is but apropos that the Court made the following pronouncement in *Sta. Ana vs. Maliwat*, 24 SCRA 1018, where it held that "*the law (Republic Act No. 166, Section 4, par. D, as amended) does not require that the articles of*

manufacture of the previous user and the late user of the mark should possess the same descriptive properties or should fall into the same categories xxx The meat of the matter is the likelihood of confusion, mistake or deception upon purchasers xxx.” Clearly etched in *Converse Rubber Corp. vs. Universal Rubber Products, Inc.* is the concept of likelihood of confusion where it said “The similarity in the general appearance of respondent’s trademark and that of petitioner would evidently create a likelihood of confusion among the purchasing public. xxx The risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the public could reasonably assume that the goods of the parties originated from the same source.”

Opposer’s business and services and Applicant’s goods are admittedly not in actual competition but they have somehow direct relations in that Opposer’s goods and Respondent’s fall in the category of commercial communication equipment. In the same token that television and radio are compatible or logically related to satellite and broadcast services, the likelihoods that prospective buyers may perceive that Respondent’s goods are manufactured by or is associated or connected with Opposer is inevitable.

The court in a long line of cases ruled thus:

“Those who desire to distinguish their goods from the good of another have a broad field from which to select a trademark for their wares and there is no such poverty in the English language or paucity of signs, symbols, numerals etc. as to justify one who really wishes to distinguish his product from the other entering the twilight zone of or field already appropriated by another (*Weco Products Co., Milton Ray Co., 143 F. 2d. 985, 32 C.C.P.A. Patents 1214*).

“why of the millions of terms and combinations of letters and designs available, the respondent had to choose those so closely similar to another’s trademark if there was no intent to take advantage of the goodwill generated by the other mark” (*American Wire & Cable Co. Co., vs. Dir. Of Patents 331 SCRA 544*)

“xxx why, with all the birds in the air, and all the fishes in the sea, and all the animals on the face of the earth to choose from, the defendant company (*Manila Candy Co.*) elected two roosters as its trademark. Although its directors and managers must have been well aware of the long continued use of a rooster by the plaintiff with the sale and achievement of its goods? x x x a cat, a dog, a carabao, a shark, or an eagle stamped upon the container in which candies are sold would serve as well as rooster for the product of defendant’s factory. Why did defendant select two roosters as its trademark? (*Clarke vs. Manila Candy Co., 36 Phil 100*).”

The Opposer having sufficiently corroborated its claim, there being evidence enough to convince this Office that Opposer first adopted the subject mark. Necessarily therefore, the inevitable conclusion, given all the foregoing, is that Respondent-Applicant application Serial No. 110793 can not have any right superior to that of the Opposer.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, application bearing Serial No. 110793 filed by Juanito Y. Cardenas for the registration of the mark “STAR and STAR DEVICE” on goods belonging to Class 9 is hereby REJECTED.

Let the records of this case be forwarded to the Administrative, Financial Human Resource Development Service Bureau for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks for information and to update its record.

SO ORDERED.

Makati City, 05 December 2002.

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