



ENDEMOL NEDERLAND B.V.,
Opposer,

-versus-

PORTA COELI INDUSTRIAL CO., INC.,
Respondent-Applicant.

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}
} IPC No. 14-2008-00290
} Opposition to:
} Appln. Serial No. 4-2007-012405
} Date Filed: 09 November 2007
} Trademark: "BIG BROTHER"
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}
}

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2012 - 159 dated August 31, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 31, 2012.

For the Director:


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



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Trademark: "BIG BROTHER"

Decision No. 2012- 159

DECISION

ENDEMOL NEDERLAND B.V. ("Opposer") filed on 10 November 2008 an opposition to Trademark Application Serial No. 4-2007-012405. The application, filed by PORTA COELI INDUSTRIAL CO., INC. ("Respondent-Applicant"), covers the mark "BIG BROTHER", for use on vehicles under Class 12 of the International Classification of goods. The Opposer alleges, among other things, the following:

"1. The Opposer's trademark BIG BROTHER was adopted by Opposer even prior to the filing of respondent-applicant's trademark application for BIG BROTHER in November 9, 2007. Hence, Opposer's marks BIG BROTHER should be protected on the basis of Section 123.1 (d) of R.A. 8293, which states, to wit: x x x

"1.1. Respondent-Applicant's trademark BIG BROTHER adopts the mark BIG BROTHER which is identical to or nearly resembles the duly registered BIG BROTHER mark in classes 9, 25 and 41; BIG BROTHER & DEVICE mark in classes 9, 25 and 41 and the BIG BROTHER OFFICIAL PRODUCT LOGO mark for classes 09, 16, 25, 28 and 41, all of which are owned by the Opposer.

"1.2. as the original creator and owner of the registered trademark BIG BROTHER, the rights of the Opposer are entitled to protection against damage and prejudice, which will be caused by the registration of the trademark BIG BROTHER in the name of the respondent-applicant.

"2. The mark BIG BROTHER is known in numerous countries to be owned by the Opposer. It is registered in the Philippines and in various countries worldwide. The registration of a confusingly similar trademark BIG BROTHER for goods in class 12 will therefore be a breach of the clear provision of section 123.1 (f) of R.A. 8293 on well-known marks. Sec 123.1 (f) of R.A. 8293 provides: x x x

"2.1. The appropriation by respondent-applicant of the well-known mark BIG BROTHER is likely to cause confusion on the part of the public who may think that the respondent-applicant's products in Class 12 are related to or sponsored by the Opposer because of the similarity of both the Opposer's and respondent-applicants marks.

"2.2. Considering the vast expanse of television promotion for BIG BROTHER, and the marketing paraphernalia introduced by the Opposer through its local franchise into the market bearing the mark BIG BROTHER, it is very likely for the public viewers of the hit

television show to associate respondent-applicant's goods such as, 'vehicles' bearing the mark BIG BROTHER with the Opposer as part of the aggressive promotion of the BIG BROTHER reality television show.

"3. The registration or use respondent-applicant's BIG BROTHER will ultimately lead to the dilution of the distinctiveness of the Opposer's BIG BROTHER mark. Hence, registration of respondent-applicant's mark BIG BROTHER should be proscribed. Trademark dilution is the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of: (1) competition between the owner of the famous mark and other parties; or (2) likelihood of confusion, mistake or deception."¹

"3.1. Opposer's mark BIG BROTHER has undoubtedly gained worldwide notoriety and is very distinctive. Respondent-Applicant's confusingly similar trademark BIG BROTHER, on the other hand, only came after BIG BROTHER has become a household name in the Philippines and almost a decade after it had achieved notoriety worldwide.

"3.2. Clearly, the adoption of the mark BIG BROTHER is an attempt on the part of respondent-applicant to ride on the goodwill of Opposer's registered mark BIG BROTHER.

"The Opposer will rely on the following facts in support of the opposition:

"1. Opposer is a global leader in television and audiovisual entertainment.² Active in over 20 countries on five continents, Opposer's products are the content created for media and communication platforms including television, the internet and mobile phones. Opposer is a leading developer and producer of his content. Their range of programming product consists of:

- **Non-scripted:** ranging from game shows to reality TV;
- **Scripted:** includes subgenres such as drama and soap operas;
- **Digital Media:** leveraging television and other brands.³

Exhibits 'A' and 'B' of the Affidavit are printouts from the relevant websites.

"2. Of Opposer's top ten television shows, the BIG BROTHER reality television show is currently their top grosser.⁴ In each series, which lasts for around three months, a group of people (normally fewer than sixteen at any one time) dubbed as 'housemates' live together full-time in the Big Brother House, isolated from the world but under the continuous gaze of television cameras. The Housemates try to win a cash prize by avoiding periodic, usually publicly-voted, evictions from the house.

2.1. The first BIG BROTHER broadcast occurred in the Netherlands on September 16, 1999 on the Veronica TV channel. Since then, it has become a prime-time hit in almost 70 countries.⁵

2.2. The reality show BIG BROTHER is aired in countries such as, Albania, the African continent, Argentina, Australia, Belgium, Brazil, Bulgaria, Canada, Colombia, Croatia, Czech Republic, Denmark, Ecuador, Finland, France, Germany, Hungary, Italy, India, Israel, Mexico, the Middle East, Netherlands, Nigeria, Norway, Pacific Region, Philippines, Poland, Portugal, Romania, Russia, Scandinavian Peninsula, Slovakia, Slovenia, South Africa, Spain, Sweden, Switzerland, Thailand, United Kingdom, United States of America, and the Western Balkans.⁶

Exhibits 'C', 'D' and 'E' of the Affidavit are printouts from the relevant websites.

¹ *Levi Strauss & Co. & Levi Strauss (Phils.), Inc. v. Clinton Apparelle Inc.*, G.R. No. 138900 20 Sept. 2005.

² See <http://www.endemol.com/About%20Endemol/default.aspx?flD=7101>

³ See <http://www.endemol.com/About%20Endemol/Default.aspx?flD=7129&rlD=16>

⁴ See <http://www.endemol.com/Main%20business%20areas/Default.aspx?flD=7103>

⁵ See [http://en.wikipedia.org/wiki/Big_Brother_1999_\(Netherlands\)](http://en.wikipedia.org/wiki/Big_Brother_1999_(Netherlands))

⁶ See [http://en.wikipedia.org/wiki/Big_Brother_\(TV_Series\)](http://en.wikipedia.org/wiki/Big_Brother_(TV_Series))

"3. In late 2004, ABS-CBN Broadcasting Corporation, with authority of the Opposer introduced and aired the Philippine version of the hit reality television show aptly titled Pinoy BIG BROTHER. It aired its maiden episode on August 21, 2005 and has ruled its time slot for the past three years. The show has been described by writers as having millions of fans and a constant top-rater on surveys.⁷ Exhibits 'F-1' and 'F-2' attached hereto are printouts from the relevant websites showing the relevant ratings.

"3.1. Survey ratings since the first run of Pinoy BIG BROTHER in August 21, 2005 will prove that millions of Filipinos watch and are hooked to the hit reality television show. The demographics of the watchers of the show as manifested in the surveys that show that the program's ratings averaged 19.00% to 24.00% also prove that the hit reality television show has reached the awareness of Filipinos regardless of age or sex.

"4. The mark BIG BROTHER is owned by the Opposer. Opposer has various trademark registrations and applications for BIG BROTHER in more than forty eight (48) countries worldwide. Exhibits 'H', 'I-M' of the Affidavit are the list of the worldwide trademark registrations and certified true copies of foreign trademark registrations for BIG BROTHER.

"4.1. One of the earliest registrations for the mark BIG BROTHER was issued on October 26, 1999 in Denmark under Denmark TM Reg. No. 724183.

"4.2. In the Philippines, Opposer is the owner of valid and existing Philippine TM Registrations listed as follows:

- a. Philippine TM No. 4-2004-000842 for BIG BROTHER in class 41 issued on February 26, 2006;
- b. Philippine TM No. 4-2004-012135 for BIG BROTHER in classes 09 and 25 issued on January 22, 2007;
- c. Philippine TM No. 4-2004-000938 for BIG BROTHER & DEVICE in class 41 issued on November 10, 2005;
- d. Philippine TM No. 4-2004-012136 for BIG BROTHER & DEVICE in classes 9 and 25 for May 28, 2007;
- e. Philippine TM No. 4-2006-000957 for BIG BROTHER OFFICAL PRODUCT LOGO in class 41 issued on March 26, 2007;
- f. Philippine TM No. 4-2006-000956 for BIG BROTHER OFFICIAL PRODUCT LOGO in class 28 issued on April 30, 2007;
- g. Philippine TM No. 4-2006-000955 for BIG BROTHER OFFICIAL PRODUCT LOGO in class 25 issued on April 30, 2007;
- h. Philippine TM No. 4-2006-000954 for BIG BROTHER OFFICIAL PRODUCT LOGO in class 16 issued on June 4, 2007;
- i. Philippine TM No. 4-2006-000949 for BIG BROTHER OFFICIAL PRODUCT LOGO for class 09 issued on July 23, 2007

Exhibits 'N-V' of the Affidavit are certified true copies of the Philippine trademark registrations for the various BIG BROTHER marks.

"5. The mark BIG BROTHER are heavily advertised and promoted worldwide not only on television programs and commercials, but also on merchandise or other paraphernalia in classes 9, 16, 25 and 28 such as caps, shirts, jackets, posters, compact discs and billboards. Exhibit 'W' of the Affidavit are photos of the sample merchandise and advertisements showing worldwide promotions for the mark BIG BROTHER.

"5.1. In the Philippines, Opposer, through its local franchisee ABS-CBN Broadcasting Corporation, has significantly promoted the show for the Philippine market. Radio, television, print media and the internet have been utilized by the local franchisee to promote the Pinoy BIG BROTHER show. Mobile phone companies have also been tapped

⁷ See <http://www.abs-cbnnews.com/storypage.aspx?StoryId=24473>. Due to the daily update of the cited website, the information derived from said website may vary per visit. Hence, reference may be made to: See also <http://ricojr.wordpress.com/2008/05/16/tv-ratings-dyesebel-charms-nationwide-audience-but-abs-cbn-still-dominates-nutam-contest/> and http://www.manilastandardtoday.com?page=goodLife02_jan23_2006

to allow watchers to vote for their favorite 'housemates'. Exhibit 'X' of the Affidavit are photos of the sample promotional materials showing the advertisement of Pinoy BIG BROTHER in the Philippines.

"6. The worldwide net revenue derived from the franchising, sale of commercial slots to advertisers for the BIG BROTHER reality television show, and sale paraphernalia bearing the BIG BROTHER and BIG BROTHER & DEVICE marks in the year 2005-2007 were:

REVENUE	BIG BROTHER (\$MM)
2005	€700,000
2006	€1,400,000
2007	€900,000

"7. Articles have also been published detailing the international success achieved by the reality television show bearing the mark BIG BROTHER. Copies of the articles are Exhibit 'Y' of the Affidavit.

"8. On the bases of the foregoing, respondent-applicant's mark BIG BROTHER, which is identical to Opposer's registered and well-known mark BIG BROTHER, should not be allowed to proceed to registration.

The Respondent-Applicant filed on 07 April 2009 its ANSWER alleging, among other things, the following:

"18. On May 27, 2008, the subject trademark application was found to be registrable and allowed to be published for purposes of opposition by the Bureau of Trademarks, which means that it sees no impediment to grant the registration of the subject trademark since it is not confusingly similar with any pending or registered applications.

"19. The findings of the Bureau of Trademark is supported by the following grounds:

1. First, the goods covered by subject applications are not also similar or related as those of the respondent belong to Class 12 while those of the opposer belong to Classes 9, 16, 25, 28 and 41 as per the Opposition. In the case of Esso Standard Eastern, Inc. vs. Court of Appeals, 116 SCRA 336, the Supreme Court had the occasion to clarify what are related goods, to wit: x x x

2. Second, the parties are not engage in similar or competitive business.

3. Third, purchasers of automobiles are not ordinary buyers as they do inquire about the manufacturers and specifications before buying considering its high value, which therefore makes confusion as to origin/ownership absolutely remote inasmuch as the opposer is not a manufacturer or distributor of motor vehicle in the Philippines or in any part of the world as per its Opposition. Hence, dilution is also not a possibility.

4. Fourth, the words 'Big Brother' in trademark of the respondent are color blue, which makes it different from that of the opposer. In the case of Emerald Garment Manufacturing Corporation vs. Court of Appeals, et al. 25 SCRA 600, the Supreme Court adopted the 'holistic test' in determining whether or not confusingly similarity exists between trademark as 'LEE' and 'STYLISTIC MR. LEE', to wit:

"20. Moreover, the opposer's trademarks cannot also be considered 'well-known' having failed to comply with the requirements under Intellectual Property Code.

"21. From the foregoing, the respondent's subject trademark may be registered as opposer has no legal basis to oppose the same considering the fact that (1) their businesses are non-competitive, (2) their goods/products are unrelated, (3) their goods/products are of high value and not ordinary commodity, (4) their customers exercise high degree of care and

prudence and (5) their trademarks are noticeably distinguishable and different from each other.

22. The affidavit of the witness of the respondent is attached herewith as Annex '1' with attachments marked as Annexes '2' - '5'."

The preliminary conference was terminated on 30 July 2009, followed by the submission by the parties of their respective position papers.

Should the Respondent-Applicant be allowed to register the mark BIG BROTHER?

The Opposer anchors its opposition on Sec. 123.1, pars. (d) and (f), of Rep. Act No 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), which state that a mark cannot be registered if it:

(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.

(f) is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known in accordance with the preceding paragraph, which 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 the 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 use.

The issue of whether the Opposer's trademarks are well-known marks or not is relevant to the resolution of this case only if the Respondent-Applicant's use of its mark in relation to the goods indicated in its application would indicate a connection between the goods and the Opposer's, and which likely to cause damage to the latter's interest.

The records and evidence show that at the time the Respondent-Applicant filed its trademark application on 09 November 2007, the Opposer has already been using and applied for registration or registered in many countries including the Philippines, the mark BIG BROTHER. But, is the registration of the mark BIG BROTHER in favor of the Respondent-Applicant proscribed under the aforementioned provisions of law?

This Bureau finds that the registration and use by the Respondent-Applicant of the mark BIG BROTHER is unlikely to deceive or cause confusion, or indicate a connection between the Respondent-Applicant's goods and the Opposer's. This is so because the goods indicated in the Respondent-Applicant's application are so different from the goods or services covered by the Opposer's mark.

Aptly, confusing similarity is to be determined on the basis of visual, aural, connotative comparisons and overall impressions engendered by the marks in controversy as they are encountered in the realities of the marketplace.⁸ In this instance,

⁸ *Societe Des Produits Nestle, S.A. v. Court of Appeals*, G.R. No. 112012, 04 April 2001.

there is no basis to arrive at a conclusion or to form at least an inference that because of the goodwill that may have already earned by the Opposer's mark, consumers will be lured or enticed to buy the Respondent-Applicant's goods believing that these originated or are associated or connected with the Opposer. The Respondent-Applicant's goods or products are automobile or motor vehicles under Class 12. The Opposer does not deal nor is there evidence to show that it intends to deal with automobiles or motor vehicles. Moreover, because of the high costs of purchasing or acquiring automobiles or motor vehicles, prospective buyers tend to be more inquisitive. Hence, while it is possible that a consumer who encounters the Respondent-Applicant's goods bearing the BIG BROTHER mark may be reminded of the Opposer's "reality TV" show, it is nonetheless unlikely for him or her to conclude or assume that the said goods or the Respondent-Applicant itself is connected to or associated with the Opposer.

This Bureau finds untenable the Opposer's argument that the Respondent-Applicant's use and registration of the mark BIG BROTHER will dilute the distinctiveness of the Opposer's mark. The term "Big Brother" is actually not unique nor invented by the Opposer. Certainly, the Opposer is not the first one to coin or use the term "Big Brother". The term has long been in use to connote:

- "1. An older brother.
2. A man who assumes the role of an older brother, as by providing guidance or protection.
3.
 - a. also **Big Brother** An omnipresent, seemingly benevolent figure representing the oppressive control over individual lives exerted by an authoritarian government.
 - b. A state, organization, or leader regarded in this manner.

[Sense 3, after Big Brother, a character in the novel *1984* by George Orwell.]⁹

"Big Brother" is,

" x x x used to negatively describe a situation in which a Big Brother authority figure — in concert with 'thought police' — constantly monitors the population to detect betrayal via 'improper' thoughts. x x x"¹⁰

The "reality TV" show depicting and observing peoples' daily lives is essentially a demonstration of the concept of a "Big Brother" — i.e. "somebody who watches over you". Hence, as a trademark for entertainment services and related services that deal with "reality TV" shows, BIG BROTHER is deemed a suggestive mark. Thus, it is not inconceivable therefore for proprietors other than the Opposer to have thought of the term "Big Brother" for use as a trademark.

It is emphasized that the essence of trademark registration is to give protection to the owners of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is applied; 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 to the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and

⁹ <http://www.thefreedictionary.com/big+brother>

¹⁰ <http://en.wikipedia.org/wiki/Orwellian>

sale of an inferior and different article as his products.¹¹ The Respondent-Applicant's mark sufficiently serves this function.

WHEREFORE, premises considered, the instant opposition is hereby DISMISSED. Let the filewrapper of Trademark Application No. 4-2007-012405 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 August 2012.



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

¹¹ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 115508, 19 Nov. 1999.