



FREMANTLE MEDIA LIMITED,
Opposer,

-versus-

VISAYAS AMUSEMENT CORPORATION,
Respondent-Applicant.

X-----X

}
} **IPC No. 14-2008-00129**
} Opposition to:
} Appln. Serial No. 4-2007-011329
} Date Filed: 10 Oct. 2007
} Trademark: "VIDEOKE IDOL SINGING
} **COMPETITION & DEVICE**"
}

NOTICE OF DECISION

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Pasig City

GREETINGS:

Please be informed that Decision No. 2012 – 182 dated September 27, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 27, 2012.

For the Director:


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



FREMANTLE MEDIA LIMITED,

Opposer,

- versus -

VISAYA AMUSEMENT CORPORATION,

Respondent-Applicant.

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IPC No. 14-2008-00129

Opposition to:

Appln. Serial No. 4-2007-011329

(Filing Date: 10 Oct. 2007)

**TM: "VIDEOKE IDOL SINGING
COMPETITION & DEVICE"**

Decision No. 2012- 182

DECISION

FREMANTLE MEDIA LIMITED¹ ("Opposer") filed on 17 June 2008 an Opposition to Trademark Application Serial No. 4-2007-011329. The application, filed by VISAYA AMUSEMENT CORPORATION² ("Respondent-Applicant"), covers the mark "VIDEOKE IDOL SINGING COMPETITION & DEVICE" for use on *singing competition* under Class 41 of the International Classification of Goods and Services³. The Opposer alleges the following:

"1. Opposer and 19 TV Limited, a corporation organized and existing under the laws of United Kingdom, with principal office at 100 New Bridge St., London EC4V 6JA (previously 55 Harley Place, Harley St., London W1N 1HB), co-own the mark PHILIPPINE IDOL & DEVICE which is used on goods and/or services in Classes 9, 16, 38, 41, among others. Opposer is also the registrant of the registered mark PHILIPPINE IDOL (under Application Serial No. 4-2004-012172 for goods/services in Classes 9, 16, 25, 28, 38 and 41), and has applied for registration of the mark PINOY IDOL (under Application Serial No. 4-2004-006316, which was re-filed under Application Serial No. 4-2008-01094, for goods and/or services in Classes 9, 16, 38 and 41). Applicant's mark VIDEOKE IDOL SINGING COMPETITION & DEVICE for singing competition in Class 41 so resembles Opposer's marks as to be likely, when applied to or used in connection with the goods and/or services of the Applicant, to create a connection between Applicant's goods and/or services and the Opposer's, and damage the latter's interests as owners of the marks PHILIPPINE IDOL & DEVICE and PHILLIPINE IDOL.

"2. The registration of the mark VIDEOKE IDOL SINGING COMPETITION & DEVICE in the name of the Applicant will violate Section 123.1(f) of the Intellectual Property code, Republic Act No. 8293, Section 6bis of the Paris Convention and Article 16(3) of the Agreement on Trade Related Aspects of Intellectual Property Rights.

"3. The registration of the mark VIDEOKE IDOL SINGING COMPETITION & DEVICE will diminish the distinctiveness and dilute the goodwill of Opposer's marks PHILIPPINE IDOL & DEVICE and PHILIPPINE IDOL.

"4. Applicant's adoption of the confusing similar VIDEOKE IDOL SINGING COMPETITION & DEVICE for its services comprising of singing competition is likely to indicate a connection between Applicant's

¹ A corporation organized and existing under the laws of the United Kingdom with business address at 1StephenSt., London W1T AL, United Kingdom.

² A corporation organized and existing under the laws of the Philippines with business address at 2nd Floor, Reliance House, 205 EDSA corner Rochester St., Greenhills, Mandaluyong City, Metro Manila.

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

services and those of Opposer's goods and/or services, which has been identified as the owner of the well-known marks PHILIPPINE IDOL & DEVICE and PHILIPPINE IDOL. Applicant's unauthorized use of the mark VIDEOKE IDOL SINGING COMPETITION & DEVICE is likely to mislead consumers into believing that Applicant's goods/services are affiliated with or sponsored and licensed by Opposers. Applicant adopted the mark VIDEOKE IDOL SINGING COMPETITION & DEVICE for the purpose of riding on the fame of Opposer's mark and the goodwill they have earned amongst Philippine TV audience.

"5. Applicant's unauthorized appropriation and use of the mark VIDEOKE IDOL SINGING COMPETITION & DEVICE infringe upon Opposer's right to the internationally well-known marks IDOLS, IDOL, POP IDOL, AMERICAN IDOL, AUSTRALIAN IDOL, INDONESIAN IDOL, INDIAN IDOL, SINGAPORE IDOL, MALAYSIAN IDOL, NZ IDOL, CANADIAN IDOL, LATIN AMERICAN IDOL, PHILIPPINE IDOL & DEVICE and PHILIPPINE IDOL and is likely to mislead and deceive the public into believing that Applicant's goods and/or services using the dominant feature of Opposer's marks are licensed, authorized and sponsored by Opposer. The registration of Applicant's VIDEOKE IDOL SINGING COMPETITION & DEVICE is precluded by Section 123.1 (e) and (f) which prohibits the registration of a mark that is confusingly similar to well-known marks as therein defined. Under par. (f), Opposer's registered mark PHILIPPINE IDOL precludes the registration of Applicant's confusingly similar mark VIDEOKE IDOL SINGINGCOMPETITION & DEVICE even with respect to goods and services which are not similar to those with respect to which registration is applied for.

"6. The registration of the mark VIDEOKE IDOL SINGING COMPETITION & DEVICE in the name of the Applicant is contrary to other provisions of the Intellectual Property Code. The dominant feature of Opposer's registered mark PHILIPPINE IDOL as well as its other foreign marks IDOLS, IDOL, POP IDOL, AMERICAN IDOL, AUSTRALIAN IDOL, INDONESIAN IDOL, INDIAN IDOL, SINGAPORE IDOL, MALAYSIAN IDOL, NZ IDOL, CANADIAN IDOL, LATIN AMERICAN IDOL, PHILIPPINE IDOL & DEVICE and PHILIPPINE IDOL is the word IDOL and Applicant's use and appropriation of that dominant feature amounts to trademark infringement under Section 155.1 of the IP Code.

"In support of this opposition, Opposer will prove and rely upon, among other facts, the following:

"1. FremantleMedia Limited and 19 TV Limited are creators, producers and distributors of original and copyright-protected entertainment programs throughout the world and are providers of a wide variety of goods and/or services in Classes 9, 16, 38 and 41, among others. Opposer have applied for the registration for the mark PINOY IDOL in the Philippines for a wide variety of goods and/or services in Classes 9, 16, 38 and 41. Opposer is also the registrant of the mark PHILIPPINE IDOL in Classes 9, 16, 25, 28, 38 and 41. Opposer have jointly applied with 19 TV Limited for the registration for the mark PHILIPPINE IDOL & DEVICE in the Philippines for a wide variety of goods and/or services in Classes 9, 16, 38 and 41.

"2. FremantleMedia Limited and 19 TV Limited are the owners of the marks IDOLS, IDOL, POP IDOL, AMERICAN IDOL, AUSTRALIAN IDOL, INDONESIAN IDOL, INDIAN IDOL, SINGAPORE IDOL, MALAYSIAN IDOL, NZ IDOL CANADIAN IDOL, LATIN AMERICAN IDOL which have been registered and/or applied for registration worldwide for a variety of goods and/or services in Classes 9, 16, 25, 38 and 41. Opposer have also been commercially using their marks IDOLS, IDOL, POP IDOL, AMERICAN IDOL, AUSTRALIAN IDOL, INDONESIAN IDOL, INDIAN IDOL, SINGAPORE IDOL, MALAYSIAN IDOL, NZ IDOL, CANADIAN IDOL, LATIN AMERICAN IDOL internationally. In the countries where Opposer's marks are in commercial use, the dominant feature 'IDOL' is preceded by the name of the country where Opposer's original and copyright-protected entertainment programs are broadcast, including those in the Philippines where Opposer's marks PHILIPPINE IDOL & DEVICE and PHILIPPINE IDOL have been used long before the appropriation and use of the confusingly identical mark VIDEOKE IDOL SINGING COMPETITION & DEVICE by Applicant. Since Applicant's mark carries the dominant feature of Opposer's 'IDOL' mark, its unauthorized and unlawful appropriation is an act of infringement and/or unfair competition, which cannot ripen into lawful trademark ownership.

"3. Opposer's marks IDOLS, IDOL, POP IDOL, AMERICAN IDOL, AUSTRALIAN IDOL, INDONESIAN IDOL, INDIAN IDOL, SINGAPORE IDOL, MALAYSIAN IDOL, NZ IDOL, CANADIAN IDOL, LATIN AMERICAN IDOL as well as PHILIPPINE IDOL & DEVICE and PHILIPPINE IDOL are well-known marks within the meaning of Section 123.1 (f), 147.2 of the Intellectual Property Property Code, section 6bis of the Paris Convention and Article 16(3) of the Agreement on Trade Related Aspects of Intellectual Property Rights and are entitled to broad legal protection against unauthorized users like the Applicant who has unlawfully appropriated it for its own goods and/or services in its attempt to ride upon the

reputation, goodwill and renown of Opposer's marks. Applicant's appropriation and use of the dominant feature of Opposer's marks IDOLS, IDOL, POP IDOL, AMERICAN IDOL, AUSTRALIAN IDOL, INDONESIAN IDOL, INDIAN IDOL, SINGAPORE IDOL, MALAYSIAN IDOL, NZ IDOL, CANADIAN IDOL, LATIN AMERICAN IDOL as well as PHILIPPINE IDOL & DEVICE and PHILIPPINE IDOL for "singing competitions" is identical to the core interest of Opposer's business (ie, the production of a singing competition) in which opposer's right of exclusivity should be recognized.

"4. Opposer are the first users of the marks PHILIPPINE IDOL & DEVICE and PHILIPPINE IDOL on a wide variety of goods and/or services in Classes 9, 16, 38 and 41. Applicant's appropriation of the confusingly similar mark VIDEOKE IDOL SINGING COMPETITION & DEVICE falsely indicates a connection between Applicant's goods and those of Opposer, which has been identified as the owner of the internationally well-known marks IDOLS, IDOL, POP IDOL, AMERICAN IDOL, AUSTRALIAN IDOL, INDONESIAN IDOL, INDIAN IDOL, SINGAPORE IDOL, MALAYSIAN IDOL, NZ IDOL, CANADIAN IDOL, LATIN AMERICAN IDOL as well as PHILIPPINE IDOL & DEVICE and PHILIPPINE IDOL, Applicant's unauthorized appropriation and use of Opposer's internationally well-known marks will damage Opposer's interests as owner and/or prior user of the marks.

"5. The registration and use of a confusingly identical mark for identical services by Applicant will diminish the distinctiveness and dilute the goodwill of Opposer's marks."

The Opposer's evidence consists of the following:

1. Affidavit of Sarah Frances Hamilton Tingay, Director of FremantleMedia Limited;
2. samples of some of the programs and literature distributed by Opposer;
3. printout of a presentation which shows the worldwide recognition of the Idol marks;
4. document entitled "idols around the world";
5. spreadsheet entitled "Idols Production History";
6. production history of Idol programs around the world;
7. document showing the viewing and telephony vote figures for Indonesian, Indian, Singapore and Philippine Idol series;
8. copies of articles published in the internet;
9. ratings chart of PHILIPPINE IDOL television program;
10. samples of articles and advertisements of PHILIPPINE IDOL program and branded products bearing the Opposer's Philippine marks PHILIPPINE IDOL & DEVICE, PHILIPPINE IDOL and PINOY IDOL;
11. selection of Idols merchandise worldwide; and
12. list of sponsorships around the world.⁴

The Respondent-Applicant filed its Answer on 03 October 2008, alleging among other things, the following:

**IV. AFFIRMATIVE ALLEGATIONS &
SPECIAL DEFENSES**

"17. Applicant is engaged in the business of letting out various types of amusement machines such as kiddie rides, video game machines, and other types of redemption and coin operated machines. It is a member of the World of Fun Group of Companies and it is the owner and registrant of the mark WOF WORLD OF FUN & LOGO which is used to identify its and its affiliates goods and services to the general public. Its chain of amusement centers are mainly situated and operated within the different shopping malls and department stores all over the Philippines. The following is a representation of Applicant's duly registered mark WOF WORLD OF FUN & LOGO.

x x x

⁴ Marked as Exhibits "A" to "K".

"18. Sometime in 2005, Applicant and its affiliates introduced videoke machines and KTV Rooms as part of its line of amusement games and other entertainment activities. These videoke machines are con-operated machines much like Applicant's other video game machines regularly offered by the Applicant to its patrons and clientele. In this game, the player chooses a song from the machine and sings through a microphone. Depending upon the ability of the player to follow the tune of the chosen song, the videoke machine will award the player a certain grade.

"19. To create awareness among mall-goers and shoppers of department stores and thereby promote the use of its line of videoke machines and KTV Rooms, Applicant held in June of 2006, singing competitions for those who patronized its line of videoke machines. This marketing event was dubbed the VIDEOKE IDOL SINGING COMPETITION".

"20. The marketing event proved successful in terms of creating patronage for the singing competition itself, as well as increasing the volume of use for its line of videoke machines. Because of the enormous success of this marketing event, Applicant decided to apply for the registration of the trademark VIDEOKE IDOL SINGING COMPETITION & DEVICE under class 41 in order to protect its intellectual property rights to the mark, more particularly in the field of singing competitions. For easy reference, the following is a graphic representation of Applicant's mark VIDEOKE IDOL SINGING COMPETITION & DEVICE.

x x x

"21. In conceptualizing the trademark VIDEOKE IDOL SINGING COMPETITION & DEVICE, and contrary to the claim of Opposer that - Applicant adopted its mark for the purpose of 'riding on the fame' of Opposer's mark - herein Applicant did not take into account that the Opposer was using or had registered certain marks which use the word 'idol', or that the Opposer's mark were allegedly well-known in the world. Rather, Applicant chose the word 'IDOL' because it was a very common word used in the entertainment industry to describe people possessing charisma and extraordinary talent which rightfully described the winners and participants of its singing competition.

"22. In addition to the foregoing, Applicant's mark is both visually and strikingly different and absolutely distinguishable from the Opposer's mark. A quick look at Applicant's mark as shown above, when compared to Opposer's marks as shown below, confirm this undeniable visual fact. To wit:

x x x

"21. As one can see from the above, Applicant's mark is strikingly difference from Opposer's marks not only in terms of the overall shape of the logo/device but also in terms of color, style of lettering, and presentation of dominant features so much so that there can be no likelihood of confusion. There is no resemblance whatsoever between Applicant's mark VIDEOKE IDOL SINGING COMPETITION & DEVICE, and Opposer's marks PHILIPPINE IDOL & DEVICE and PINOY IDOL.

21.1. As depicted above, Opposer's marks appear in stylized letters of neon white enclosed in a blue oval, bordered by a neon white outline. There appears to be no dominant feature to this mark other than the stylized words Philippine Idol/Pinoy Idol appearing in neon white lettering over a blue oval.

"21.2. On the other hand, applicant's mark is not at all oval in shape nor does it employ neon white lettering over a neon blue oval design. Applicant's mark bears the words 'Videoke Idol' which appears in stylized yellow letterings overshadowed by the color blue, behind which is the dominant feature of a vintage style microphone placed over a disc of yellow, red, and orange grooves with the words 'Singing Competition' appearing in small simple styled fonts of light blue.

"21.3 Whether one uses the 'holistic test' or the 'dominancy test' in comparing these marks, it will be impossible to confuse one with the other because the marks in question reveal distinct and striking differences that could never lead to any likelihood of confusion, much less result in deception.

"22. More importantly, Opposer's claim that it has the exclusive right to use the word 'idol' is baseless. The word 'idol' is derived from the English language descriptive of 'a person or a thing greatly loved or adored'. In the entertainment industry, the word 'idol' is usual and appropriate to describe singers or actors who have excelled in their respective fields for which reason familiar phrases such as 'matinee idol', 'teen idol', 'stage idol', 'singing idol', 'pop idol', and 'record idol' have been ascribed to them by the industry since time in memorial.

22.1 Being nothing more than a word descriptive of persons in the performing arts, the word 'idol' cannot be appropriated and protected as a trademark to the exclusion of its use by others inasmuch as all persons who are associated in the entertainment industry or in the performing arts, have an equal right to use such a word merely descriptive of participants of similar events or productions. Herein applicant has the right to use the word 'idol' it being appropriate to describe the participants and winners of its competitions, and Opposer has no right to appropriate for itself the exclusive use of the word 'idol', properly descriptive of the goods/service to which the Applicant's mark is attached, nor limit other persons in the use of such word to describe similar goods or services, since the right to the use of such word or language is common to all.

22.2 The foregoing position is underscored by the fact that there are registered trademarks which use the word 'idol', more particularly the trademarks 'IDOL', 'Campus Idol', 'TV IDOLS', and 'IDOL Remittance'.

22.3 As it is, therefore, Opposer cannot claim that Applicant infringed on Opposer's intellectual property right, whose sole and only basis for opposing this application is the identical use of the word 'idol', which as already stated above is not subject to the exclusive use of anyone.

"23. Moreover, the markets of Applicant and the Opposer are not the same so much so that there can be no likelihood of confusion much less deception. The patrons of applicant's services, in relation to the mark, are limited to patrons of its videoke machines who frequent Shopping Malls and Department Stores; who rely on the use of a videoke machines to aid them when they sing; and who participate in singing competitions held in Shopping Malls without the expectation of appearing in television or even being heard on radio.

23.1 In contrast to the intended market of Opposer. And judging by Opposer's Exhibits, its participants seem to be extremely talented and discriminating singers who do not require any singing aid, such as videoke machines. Furthermore, Opposer's market expect to appear and sing before television shows and big production numbers, with a view to bagging million peso recording contracts if and when they win. This is not the case with Applicant's singing competition, wherein the most exposure they will get are printed media posted within shopping malls, department store, and the occasional by-lines of a newspaper.

23.2 As far as their viewing market goes, Opposer's market are the general public who have access to television sets. Applicant's viewing market are the family members and friends of their participants who watch the actual videoke singing competition held within malls and department store.

23.3 As one will see, there is a marked difference that separates the markets/patrons of both parties and there is no possibility that the use by applicant of its mark VIDEOKE IDOL SINGING COMPETITION & DEVICE will diminish the alleged 'distinctiveness' of Opposer's mark nor dilute the 'goodwill' associated with it.

"24. It should likewise be emphasized that the product being offered by Applicant is not a simple over the counter product which ordinary consumers can just pick from the shelf after a cursory look at its brand, thereby making visual similarities in the brand potential sources of confusion. Rather, applicant's product is a long-drawn event that starts from an invitation to patrons and videoke aficionados to join screening and elimination rounds, supported by various marketing events within the malls and department stores through print media campaigns, and ending with the actual holding of the videoke singing competition finals. At any given stage in this process, the participants will be able to discriminate that the product of Applicant from that of Opposer's in that (1) their trademarks totally look different from one another, (2) Opposer's singing competition will be broadcasted in television, whilst Applicant's will not, (3) Opposer's singing

competition will be judged by famous singers and composers, whilst Applicants will be judged by the Center for Pop, and (4) winners of Opposer's singing competition win million Peso recording contracts, whilst they only win a maximum of 120,000 in cash, gift certificates, and Center for Pop music courses.

24.1 More importantly, all media ads, posters, and other campaign material of Applicant indicate the affiliation of its singing competitions to the Applicant by posting Applicant's trademark WOF WORLD OF FUN & LOGO along with the mark VIDEOKE IDOL SINGING COMPETITION. Moreover, the Applicant has NEVER USED any mark of the Opposer in its media campaigns and there is simply no reason for Applicant's consumers/participants to even think that Applicant's singing competitions are affiliated, sponsored, or licensed by Opposer.

"25. As for the claim of Opposer that its 'Idol Marks' are well-known within the meaning of and for which it can invoke Section 123.1 (f), 147.2 of the IP Code and the extra-territorial application of Section 6bis of the Paris Convention, and Article 16(3) of the Agreement on trade Related Aspects of Intellectual Property Rights for the purpose of preventing Applicant's mark from use and registration, suffice to say that in order for Opposer's mark to successfully exclude herein Applicant's mark from registration, it is a pre-requisite under both treaty and local law that Applicant's mark must be identical with or confusingly similar, or constitutes a translation of Opposer's mark. As heretofore shown and explained, however, herein Applicant's mark is not identical with, nor is it confusingly similar to, nor is it a translation of any of Opposer's marks. That being the case, Section 123.1 (f), 147.2 of the IP Code, Section 6bis of the Paris Convention and Article 16(3) of the Agreement on trade Related Aspects of Intellectual Property Rights does not operate to bar Applicant from registering and using the mark VIDEOKE IDOL SINGING COMPETITION.

25.1. Granted that while both Opposer's and Applicant's marks make use of the same word - 'idol', it must be emphasized that Applicant has no right to appropriate unto itself the use of the word "idol" and thereby exclude others from using such words because it is nothing but a descriptive word, that herein Applicant may properly use to describe the participants of its singing competitions. Given these circumstances, no infringement can be committed by herein Applicant by the mere use of the word 'idol' in its trademark, inasmuch as the use of the word 'idol' is open to all."

The Respondent-Applicant's evidence consists of the following:

1. secretary's certificate;
2. Joint Affidavit of Emmanuel C. Jimenez and Lovelle R. Sy;
3. Joint Affidavit of Jerriane Mae O. Templo, Louie Murphy C. Regala and Carmen Marielli E. Fontanilla;
4. certified copy of Respondent-Applicant's Certificate of Registration No. 4-2004-009543 for the mark WOF WORLD OF FUN AND LOGO issued on 18 June 2007;
5. list of World of Fun branches
6. samples of promotional materials;
7. Mechanics of Videoke Idol Singing Competition;
8. newspaper clippings showing how singers have been described using the word "idol";
9. certified copies of certificates of registration of the trademarks "IDOL", "Campus Idol", "TV IDOLS", and "IDOL remittance" which uses the word "idol" to describe their products and services;
10. pictures of Respondent-Applicant's singing competitions;
11. other newspaper clippings; and
12. printed copies of websites showing various press releases.⁵

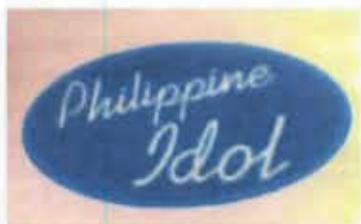
⁵ Marked as Exhibits "1" to "14".

The Opposer filed a Reply on 13 October 2008 and then after the preliminary conference was scheduled and eventually terminated on 11 December 2008. The Opposer filed its Position Paper on 22 January 2009 while the Respondent-Applicant did so on 03 February 2009.

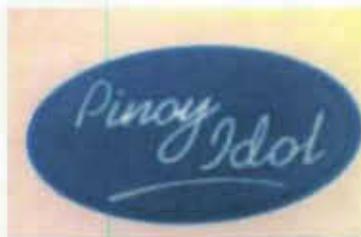
Should the Respondent-Applicant be allowed to register the mark VIDEOKE IDOL SINGING COMPETITION & DEVICE in its favor?

Sec. 123.1 (d) of the IP Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services, or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion. In this regard, the records show that at the time the Respondent-Applicant filed its trademark application on 10 October 2007, the Opposer has existing registration for the mark PHILIPPINE IDOL⁶ and even an earlier applications for the marks PINOY IDOL⁷ and PHILIPPINE IDOL & DEVICE⁸. A scrutiny of these trademark registration and applications shows that these cover goods/services that are similar and/or closely related to the one indicated in the Respondent-Applicant's application. This notwithstanding, this Bureau finds and concludes that the Respondent-Applicant should be allowed to register the mark VIDEOKE IDOL SINGING COMPETITION & DEVICE. The competing marks are depicted below for comparison:

Opposer's marks:



PHILIPPINE IDOL



PINOY IDOL

Respondent-Applicants' mark:



⁶ Cert. of Reg. No. 4-2004-012172, issued on 09 July 2007.

⁷ Appln. Serial No.4-2004-006313, which was re-filed as Appln. Serial No. 4-2008-01094 and ripened into registration on 06 Oct. 2008.

⁸ Appln. Serial No.4-2006-004235, which ripened into registration on 06 Oct. 2008

While the Respondent-Applicant had disclaimed the words "VIDEOKE" and "SINGING COMPETITION" as well as the representation of the microphone, the entirety of the composite mark should still be evaluated for purposes of determining whether it may be registered as a trademark.

The feature that is common to the competing marks is the word "Idol". The word as mark, or a part of a trademark, when used on singing competition and similar or closely related goods, is obviously not unique or highly distinctive. If paired with another word, the mark as a whole may be registered but at any rate is suggestive, and therefore considered a weak mark.

Aptly, it is the word and/or even a device, that is paired with the word "Idol" that would determine whether such mark is distinctive by itself and in relation to other marks, and thus possibly registrable. In the Trademark Registry, the contents of which the Bureau can take cognizance of via judicial notice, there are several trademarks consisting of the word "Idol" or in pair with other word or device that are registered or applied for registration.

With respect to the Opposer's marks, the word "Idol" is combined with the word "Philippine" and "Pinoy". On the other hand, the Respondent-Applicant affixed the words "Videoke Singing Competition" to the word "Idol". Obviously, the appended words in the competing marks are entirely different in spelling, pronunciation and meaning. Further, the general appearance of the competing marks greatly differs from one another such that the overall commercial impression conveyed by the two marks suggests no likelihood of confusion. Apart from the use of the word Idol, there are other essential features composing Respondent-Applicant's mark which included the use of a device consisting of a vintage style microphone placed over what appears to be a disc in yellow, orange and red pattern and the words "Singing Competition" written in small simple fonts in blue color. The word "Videoke Idol" in Respondent-Applicant's mark is written in wider stylized font in yellow color whereas the Opposer's "Philippine Idol" and "Pinoy Idol" marks are written in a peculiar script in white inside a blue background. Thus, the competing marks are similar only in the use of and adoption of the word Idol but they vary substantially in the composition and integration of the other main and essential features, in the general design and their overall appearance. An ordinary consumer's attention would not be drawn on the minute similarity that was noted but on the dissimilarities of the competing marks that are glaring to the eye. 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.⁹

Besides, the goods covered by the marks while they belong to the same class, i.e. Class 41, caters to different market segments or customers such that the Opposer's mark is generally patronized by the general public who have access to television sets because the Opposer's singing competition is broadcast in television whereas the Respondent-Applicant's mark is generally patronized by videoke machine aficionados who frequent Shopping Malls and Department Stores and those who participate in singing competitions held in Shopping Malls.

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.¹⁰ This Bureau finds that the Respondent-Applicant's mark adequately serve these function and purpose.

⁹ See *Societe Des Produits Nestle, S.A. v. Court of Appeals*, G.R.No. 112012, 04 April 2001.

¹⁰ See *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 Nov. 1999.

WHEREFORE, premises considered, the instant Opposition is hereby DISMISSED. Let the filewrapper of Trademark Application Serial No. 4-2007-011329 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 27 September 2012.



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