

ABS-CBN CORPORATION, STAR RECORDING INC., ABS-CBN FILM PRODUCTION INC., and ABS-CBN PUBLISHING, INC.,
Opposers,

-versus-

ABC DEVELOPMENT CORPORATION,
Respondent- Applicant.

X-----X

IPC No. 14-2011-00246

Opposition to:

Appln. No. 4-2010-008449

Date Filed: 03 August 2010

Trademark : **“STAR FACTOR & LOGO”**

NOTICE OF DECISION

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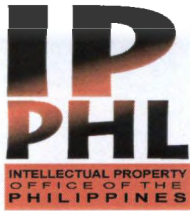
GREETINGS:

Please be informed that Decision No. 2016 - 77 dated March 15, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 15, 2016.

For the Director:


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



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DECISION

ABS-CBN CORPORATION, STAR RECORDING INC., ABS-CBN FILM PRODUCTION INC., and ABS-CBN PUBLISHING, INC., ("Opposers"),¹ filed a verified opposition to Trademark Application Serial No. 4-2010-008449. The application, filed by ABC DEVELOPMENT CORPORATION, ("Respondent-Applicant")², covers the mark "STAR FACTOR & LOGO" for use on goods under the following class³ 41 namely, *entertainment services*.

The Opposer ABS-CBN CORPORATION alleges that it is primarily engaged in television and radio broadcasting since 1946. It is now the largest broadcasting network in the Philippines, with several regional stations throughout the Philippines. It owns the "STAR" mark and other derivative marks featuring the "STAR" word/logo by prior use as early as 1986-1987, when it was re-launched in the aftermath of the historic EDSA Revolution as "THE STAR NETWORK," and began airing programs billed as "STAR ATTRACTIONS". ABS-CBN has also been using the "STAR DRAMA THEATER" mark as early as 1993; "STAR MAGIC," "STAR CIRCLE," "STAR CIRCLE QUEST," and "STAR POWER". ABS-CBN affiliate STAR CINEMA and subsidiary ABS-CBN FILMS have been using the "STAR CINEMA" mark since 1993, while STAR RECORDS has been using the "STAR RECORDS" mark since 1994.

The Opposer further alleged it has the earliest registration and/or applications for registration for the "STAR" mark in the classes pertinent hereto. Opposer ABS-CBN FILMS (as assignee of STAR CINEMA), in particular, has applications for the mark "STAR CINEMA PRODUCTIONS, INC. AND DEVICE" (4-1994-094417 and 4-1994-094418) which were filed in 1994. Opposer STAR CINEMA has an application for the mark "STAR RECORDS AND DEVICE" (4-1995-102605 which was filed in 1995.

¹ A corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines with office at Mother Ignacia St., cor. Sgt. Esguerra Ave., Diliman, Quezon City.
² A corporation duly organized and existing under and by virtue of the laws of the Republic of the Philippines with office at 762 Quirino Highway, San Bartolome, Novaliches, Quezon City.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

The Opposers likewise averred that due to their ownership, extensive use and promotion of the "STAR" marks, they have come to be associated by the public with the "STAR" mark in the field of entertainment and media. The "STAR" mark is distinctive of Opposers and has generated tremendous goodwill for them.

Thus, the following grounds for the instant opposition are interposed: (A) At the time Respondent-Applicant filed the Subject Application, Opposers had already acquired ownership of the "STAR" mark and derivative marks by prior actual use thereof due to its use of the "STAR" mark and derivative marks as early as 1986-1987. (B) Opposers are the earliest applicants/registrants for the "STAR" mark and derivative marks. (C) As the owners of the "STAR" mark and derivative marks, Opposers are entitled to prevent the registration of the "STAR FACTOR & LOGO" mark which is confusingly similar with Opposer's trademarks. (D) The registration of "STAR FACTOR & LOGO" would lead to the dilution of the Opposer's "STAR" marks and derivative marks and would erode their goodwill over said marks.

The Opposers' evidence consist of the following:

1. Certified copy of the Amended Articles of Incorporation;
2. Affidavit of Evangeline Baylon, ABS-CBN employee;
3. Samples of print advertisements and articles in national newspapers enumerated in the Baylon's Affidavit;
4. Certified copies of Manila Bulletin advertisements/articles;
5. Certified copies of PDI advertisements/articles;
6. Affidavit of Catherine Patricia K. Ochoa-Perez, ABS-CBN officer for TV productions;
7. Copy of Application No. 1997-123720 for "STAR DRAMA THEATER";
8. Original printouts of screenshots from the website of STAR MAGIC;
9. Original printouts of screenshots from the website of ABS-CBN's STAR POWER show;
10. Printouts of trademark registration details of Opposers marks;
11. Certified copies of the Articles of Incorporation of STAR CINEMA and ABS-CBN FILMS;
12. Printouts of trademark registration/application details of Opposers marks;
13. Copies of the Deeds of Assignment and letters to IPO for recordal;
14. Affidavits of STAR CINEMA/ABS-CBN FILMS' Mary Angeline Pineda and Roxy Liquigan;
15. Certified copy of the Articles of Incorporation of STAR RECORDS;
16. Printouts of Trademark registration details of STAR RECORDS AND DEVICE;
17. Printouts of Trademark application details of STAR HOME VIDEO, and STAR HOME VIDEO and DESIGN;
18. Affidavit of Annabelle Regalado-Borja, STAR RECORDS' Managing Director;
19. Certified copy of the Articles of Incorporation of ABS-CBN Publishing;
20. Printouts of Trademark registration details of STAR STUDIO;
21. Sample copy of "STAR STUDIO" magazine; and
22. Affidavit of Beverly Sanchez-Fernandez.

On 18 November 2011, Respondent-Applicant filed its Answer alleging among others that its television network "TV5" is the fastest rising network in the Philippines, blazing the trail in Philippine broadcast innovation not only by producing high quality news, public affairs, sports and entertainment programs but also by offering a multi-platform approach in reaching Filipinos across the country and around the world.

Respondent-Applicant claimed that Opposers cannot assert exclusive appropriation and ownership of the word STAR and/or representation of a star in respect of entertainment and related services in Class 41. Accordingly, Respondent-Applicant's mark is not identical or confusingly similar to Opposers' "Star" marks. There are obvious visual, literal and aural distinctions between these marks.

Except for the word "star" or star device, Respondent-Applicant's mark has nothing else in common with any of the Opposers' Star marks. In fact, Respondent-Applicant's mark STAR FACTOR & LOGO is a highly stylized composite mark as opposed to Opposers' plain word marks. Further, the Class 41 services covered by Respondent-Applicant's mark are not similar to the Classes 38, 35 and 16 services and goods covered by some of Opposers' Star marks. There is no sufficient proof that the aforesaid marks of the Opposers are well-known such that to serve as bars to the registration of the Respondent-Applicant's mark.

The Respondent-Applicant further stated that the registration of its mark will not result in the dilution of Opposers' "Star" marks. None of the Opposers' marks, in respect of other marks that also include the word "star" and/or the star device, can be considered as distinctive. The crowding or proliferation of marks that include the word "star" and/or star device in the registry of this Honorable Office negate any claim that Opposers have exclusive use of its mark "STAR" and/or star device in the registry of this Honorable Office negate any claim that Opposers have exclusive use of their "Star" mark and derivative marks. Opposers' marks are not distinctive enough to be eligible for protection from dilution. It cannot be considered well-known marks because in the Philippines alone, the marks are madly diluted with usage by so many persons.

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

1. Original notarized Affidavit of Cristina C. Ona, Head of the Legal Services Department of Opposer;
2. Certified copy of the Amended Articles of Incorporation of ABC Development Corporation;
3. Printout of the home page of TV5's online news patrol, www.interAksyon.com;
4. Pamphlet containing the company profile;
5. Printouts of the home page, site pages for Shows, News and Corporate in the website;
6. Certified copy of Registration Nos. 4201100442 for STAR CONFESSIONS & LOGO; and, 4201001298 for 5 STAR SPECIALS & LOGO;
7. Certified copies of the application and notice of issuance for Registration No. 4201100442;
8. Special Power of Attorney;
9. Secretary's Certificate;
10. Certificate of Registration No. 42004011644 for STAR WITH CROPPED BOX LOGO;
11. Certificate of Registration No. 42004011645 for STAR MOVIES WITH CROPPED BOX LOGO; and,
12. Certificate of Registration No. 42004011646 for STAR WORLD WITH CROPPED BOX LOGO.

The Opposers submitted its Reply 29 November 2011; and, the Respondent-Applicant submitted its Rejoinder on 13 December 2011. Hence, this decision.

Should the Respondent-Applicant be allowed to register the trademark STAR FACTOR & LOGO?

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 out into the market a superior 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.⁴

⁴ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

The competing marks are reproduced below for comparison:

STAR STUDIO **STAR MAGIC** **STAR IN A MILLION** **MORNING STAR**

SEARCH FOR THE STAR IN A MILLION **STAR CIRCLE QUEST** **LITTLE BIG STAR**

Opposer's Trademarks



Respondent-Applicant's Trademark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁵ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The Opposer's mark contain the word "STAR" in simple font, absent any display of device and color. On the other hand, Respondent-Applicant's mark has the word marks "STAR FACTOR" in a stylized red 3D star, with the background consisting of a blue wall and floor with led lights and a reflective floor.⁶ The entirety of the Respondent-Applicant's subject mark has an independent creative concept, easily distinguishable from that of the Opposers' marks. Moreover, the word "star" contemplates among others, the principal member of a theatrical or operatic company who usually plays the chief roles,

⁵ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

⁶ Filewrapper records.

or a highly publicized theatrical or motion-picture performer, or an outstandingly talented performer.⁷ The word "star" has synonymous and/or descriptively related character to the goods/service covered by both parties, and thus, cannot be appropriated and protected as a mark to the exclusion of use by others.

In this regard, the Trademark Registry, the contents of which this Bureau can take cognizance of via judicial notice, consist of registered trademarks which illustrates word marks that contain the word "STAR", the device of star, or combination thereof covering the same classification of goods or related thereto under different registered owners or registered under the Respondent-Applicant such as: "**POP STAR & DEVICE**" (Reg. No. 42003010471 under Joseph O. Yao); "**3 STARS & A SUN LOGO**" (Reg. No. 42007011722); "**LITTLE TWIN STARS**" (Reg. No. 42000006391); "**STAR CONFESSIONS & LOGO**" (Reg. No. 42011004421); "**5 STAR SPECIALS & LOGO**" (Reg. No. 42010012981)⁸; "**STAR WITH CROPPED BOX LOGO**" (Reg. No. 42004011644); "**STAR MOVIES WITH CROPPED BOX LOGO**" (Reg. No. 42004011645); and, "**STAR WORLD WITH CROPPED BOX LOGO**" (Reg. No. 42004011646)⁹. These marks cover the same and/or related classification of goods. Hence, to sustain this opposition solely on the ground that the competing marks both contain the word "**STAR**" would have the unintended effect of giving the Opposer exclusive use of the same, despite the difference or unrelated character of the over-all appearance of the marks.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-008449 is hereby **DISMISSED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 15 March 2016.



Atty. **NATHANIEL S. AREVALO**
Director IV, Bureau of Legal Affairs

⁷ Simple Definition of Star, available at <http://www.merriam-webster.com/dictionary/star> (last access 15 March 2016).

⁸ IPOPHL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/> (last access 15 March 2016).

⁹ Exhibits "A", "B", "C" of Respondent-Applicant's Rejoinder; Also available in IPOPHL Trademarks Database, available at <http://www.wipo.int/branddb/ph/en/> (last access 15 March 2016).