

FASHION TV
PROGRAMMGESELLSCHAFT MBH,
Opposer,

-versus-

FASHION TV LLC,
Respondent- Applicant.

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}
} IPC No. 14-2014-00214
} Opposition to:
} Appln. Serial No. 4-2013-008056
} Date Filed: 10 July 2013
} TM: "FASHION TV
} & WOMAN DEVICE"

NOTICE OF DECISION

A.Q. ANCHETA & PARTNERS

Counsel for Opposer
Suite 1008-1010 Paragon Plaza Bldg.
EDSA corner Reliance Street
Mandaluyong City

**BENZON NEGRE UNTALAN
INTELLECTUAL PROPERTY ATTORNEYS**

Counsel for Respondent- Applicant
2nd Floor, SEDCCO Building
Rada corner Legaspi Streets
Legaspi Village, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 217 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

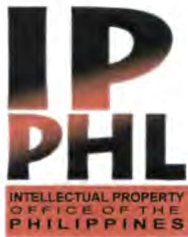
Taguig City, June 30, 2016.

For the Director:

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph



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IPC No. 14-2014-00214
 Opposition to:
 Application No. 4-2013-008056
 Date Filed: 10 July 2013
 Trademark: FASHION TV
 & WOMAN DEVICE
 Decision No. 2016- 217

DECISION

FASHION TV PROGRAMMGESELLSCHAFT MBH¹ (“Opposer”) filed an opposition to Trademark Application Serial No. 4-2013-008056. The application, filed by Fashion TV LLC² (“Respondent-Applicant”), covers the service mark “FASHION TV & WOMAN DEVICE” for use as “broadcast of television programs” under Class 38 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
“ARGUMENTS AND DISCUSSIONS

“25. The ‘FASHION TV’ element in the challenged trademark ‘FASHION TV & WOMAN DEVICE’ is not only the dominant portion, but also the entirety of the trademark ‘FASHION TV’ belonging to, commercially used by, and registered in the home country and other countries of, the Opposer and affiliated companies. Hence, Respondent-Applicant’s Trademark Application Serial No. 4-2013-008056 is a bad faith application for it involves a confusingly similar trademark.

“26. The presence of a device or representation of a woman in the Respondent-Applicant’s trademark ‘FASHION TV & WOMAN DEVICE’ does not eliminate likelihood of confusion. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Neither could it be ruled out even when a design or device is incorporated into the confusingly similar mark. Confusing similarity exists when there is such a close ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other, It has been stated time and again that, ‘the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term’ [See Continental Connector Corp. v. Continental Specialties Corp., 207 USPQ 0.]. It is

¹A corporation duly organized and existing under the laws of Austria, with principal office address at Wasagasse 4, Vienna 1090, Austria.
²With address at 3250 Mary Street, Suite 100, Miami, Florida, 33133, United States of America.
³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

likely that consumers may assume that one mark is just a variation of the other or there is a connection or association between the two marks and/or between the contending parties themselves, when in fact there is none.

"27. With the undeniable and unequivocal prior adoption of the Opposer's trademark 'FASHION TV,' and the extensive commercial use, advertisements and promotions thereof throughout the world, the Opposer has already prior and the Respondent-Applicant has no rights whatsoever to appropriate and register for its exclusive use the trademark 'FASHION TV & WOMAN DEVICE.'

"28. In the Philippines, the channel has been available on SkyCable on Channel 108, Cablelink Channel 66 since January 28, 2008, and selected cable affiliate in the Philippines. Some selected cities and provinces they used two feeds both FashionTV Asia over AsiaSat 3 and FashionTV India & SE Asia over Thaicom 5 feeds including FashionTV HD which already air soon. FashionTV was formerly carried by and Destiny Cable which has since replaced it with another fashion channel. xxx

"29. Respondent-Applicant's bad faith application violates Opposer's prior and superior intellectual property rights to 'FASHION TV' and would enable Respondent-Applicant to unlawfully take an unfair advantage at the expense of Opposer's goodwill, causing grave damage and prejudice to Opposer, in the event that 'FASHION TV & WOMAN DEVICE' would be registered.

"30. 'FASHION TV' could not be appropriated exclusively by, and registered in the name of, the Respondent-Applicant for it is a primary element of Opposer's tradename 'FASHION TV PROGRAMMGESELLSCHAFT MBH,' which has to be protected under Section 165.2 of the IP Code of the Philippines and the provisions of the Paris Convention against infringement and unfair competition even without registration in the Philippines.

"31. The IP Code eliminated the registration requirement for trade names by categorically stating that trade names shall be protected, even prior to or without registration with the IPO, against any unlawful act including any subsequent use of the trade name by a third party, whether as a trade name or a trademark likely to mislead the public.

"32. In Prosource International, Inc. v. Horphag Research Management SA, this Court laid down what constitutes infringement of an unregistered trade name, thus:

x x x

"33. Even under the old Trademark Law (Republic Act No. 166, as amended), protection of tradenames without need of local registration has been recognized. In the case of Fredco Manufacturing Corporation vs. President and Fellows of Harvard College (Harvard University), the Supreme Court pronounced as follows:

x x x

"34. It is material to reiterate at this juncture that Opposer's country of origin or domicile, Austria, is a member-nation of, or signatory to, the Paris Convention and the World Trade Organization and the Agreement on Trade-Related Aspects of Intellectual Property Rights, which grant to nationals or corporate and juristic persons of the Philippines the same right and privilege of bringing similar actions for protection of industrial property rights in Austria.

"35. Without in any way waiving any ounce of weight or force of the Opposer's trademark and service mark 'FASHION TV,' and not intending whatsoever to chip away the prior and superior intellectual property rights of the Opposer, it hereby asserts in the alternative that the registration of Respondent-Applicant's trademark/service mark 'FASHION TV & WOMAN DEVICE' is proscribed under paragraphs (h), (i), (j) and (k) of Section 1231.1 of the IP Code, which clearly state that:

x x x

"36. The truth is, Respondent-Applicant's trademark merely consists of words, symbol and design that describe the intended purpose, function, use, nature or desirable characteristic of the covered broadcasting of television programs services in Class 38. As a matter of fact, said trademark or service mark primarily constitutes words and design or shape that are merely descriptive or generic with respect to the covered broadcasting of television programs services in Class 38. As such, it should never be registered and given protection. The rationale behind refusing registration of merely descriptive or generic words, symbols, shapes, configurations and designs is that such words, symbols, shapes, configurations and designs should remain available for public use, and no one person should be allowed to preclude others from using them. Refusing registration for such words, symbols, shapes, configurations and designs is also consistent and in harmony with the function of trademarks, that is, providing a distinctive identifier of source.

"37. The words, symbol, shape, configuration and design sought to be registered by the Respondent-Applicant has long been used in respect of broadcasting of television programs services involving fashion information, services and products.

"38. The words, symbol, shape, configuration and design employed by the Respondent-Applicant in the subject trademark is already well embedded in the minds of the relevant consuming public throughout the world as one connected with fashion and fashion services and products.

"39. Should the Bureau of Trademarks (BOT) provide protection to Respondent-Applicant's trademark, the BOT would unwittingly allow itself to be a tool for abuse of intellectual Property rights. Article 8 of the TRIPS Agreement entitled 'Principles' recognizes the rights of members to adopt measures for public health and other public interest reasons and to prevent the abuse of intellectual property rights, provided that such measures are consistent with the provisions of the TRIPS Agreement.

"40. The words, symbol, shape, configuration and design used in the Respondent-Applicant's trademark is a commonly occurring words, symbol, shape, configuration and design shape or design used in the broadcasting of television industry featuring information, news, advertisements and promotions of fashion services and products. Accordingly, it lacks inherent adaptability to distinguish. As such, everyone must have the right to use them. To give Respondent-Applicant the trademark/service mark registration it desires through the subject application would give it practically an unending monopoly on the descriptive words, symbol, shape, configuration and design mentioned and discussed above.

"41. Such kind of registration in favor of the Respondent-Applicant would not only violate the provisions of the IP Code, but also run roughshod against the socioeconomic policy in the Philippines, which encourages competition.

"42. Such registration would also impinge upon Section 20 of Article II of the 1987 Philippine Constitution and Article 28 of the New Civil Code of the Philippines.

"43. Mere descriptive shapes, symbols and designs and generic terms are not given protection under the trademark law since they are already recognized as too useful for identifying a particular product. Giving a registration to a single tobacco or cigarette manufacturer, seller or distributor, like the Respondent-Applicant herein, would necessarily allow it to control the use of the registered shape, symbol, design or term already identified with cigarette and tobacco products and articles and consequently provide that manufacturer, seller or distributor a huge competitive advantage that would translate to preventing fair competition in the market. In other words, the registration would be tantamount to restricting free competition in the Philippine market.

"44. The registration of Respondent-Applicant's trademark/service mark 'Fashi8on TV & Woman Device' will undoubtedly cause damage to the Opposer and other persons or entities similarly situated.

"45. Even if the Respondent-Applicant's trademark has already been registered abroad, such registration should not be given any weight and must be disregarded pursuant to Article 6quinquies (B) of the Paris Convention for the Protection of Industrial Property (Paris Convention). The potential negative effects to the Philippine economy in terms of lost revenues, particularly in the tobacco and cigarette industry, that would result from the registration of the trademark/service mark 'Fashion TV & Woman Device' in favor of the Respondent-Applicant could not be precisely gauged.

"46. The allowance of the subject application to proceed to registration would violate not only the provisions of the Intellectual Property (IP) Code, particularly paragraphs (d), (e) and (f) and (g) of Section 123.1 thereof, and in the alternative paragraphs (h), (i), (j) and (k) of Section 123.1, but also the property rights of the Opposer herein under international trade agreements. In addition, such would militate heavily against the commitment of the Philippines to the international community through the accession with the Paris Convention and membership with the World Trade Organization (WTO) and as signatory to the Trade Related Aspects of Intellectual Property Rights Agreement (TRIPS).

"47. Minimum standards for the protection of intellectual property rights, including trademarks, patent law and copyright law, have been set in TRIPS Agreement. A registration of Respondent-Applicant's trademark would undermine the very purposes underlying trademark protection and the reason why trademarks are given protection under the TRIPS Agreement. Like other trademark laws, the IP Code does not merely serve the limited purpose of protecting private property rights. It ultimately supports the broader public interest in affording accurate information to consumers and at the same time must not be used as a tool for restricting fair competition in the Philippine market.

The Opposer's evidence consists of the Affidavit of Mr. Gabriel Lisowski, the CEO of Fashion TV Programmgesellschaft MBH; material and documents describing (a) nature and history of Opposer, (b) list of Fashion TV Operators worldwide, (c) overview of Fashion TV Distribution, advertising/promotion options, and demographics of video views, (d) tourism information/data, (e) You Tube Social Tools,

Facebook Social Tools and promotional locations, (e) information on content advertisement, (f) information on Premium Products Website (www.fashiontv.com), (g) information on promotion clip, promotion options and promotion of events, (h) Fashion TV operation on SmartTVs and Smartphones/pads, (i) BRICS countries overview and Fashion TV channel distribution, (j) Fashion TV channel distribution data in Austria, Germany, Switzerland, United Kingdom, Italy, Poland, Greece, Turkey and Israel, (k) materials on Tourism Promotion Option involving Facebook, You Tube and Google, (l) Fashion TV- Mobile Partners data, (m) Fashion TV advertisements/promotions in hotels, casino and cafes, bars, clubs, shops and films, and (n) information on Fashion TV operations with licensees and designers of lingerie, watches, bags and accessories and beverages; computer print-out from the records of the company showing a list of some of the registrations for 'FASHION TV' trademark, around the world, with registration date, registration number and international class; simple copies of a representative sampling of relevant registration certificates, including registrations in France and the International Registration covering Germany, Spain, Russian Federation, Italy, Monaco, Poland and Switzerland; samples of advertising and promotional material of products bearing the trademark; information about market research studies regarding the trademark in the Philippines and the Special Power of Attorney issued by Opposer in favor of A.Q. Ancheta & Partners.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 26 August 2014. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark FASHION TV & WOMAN DEVICE?

Records show that at the time the Respondent-Applicant filed its trademark application on 17 July 2013 for the mark "FASHION TV & WOMAN DEVICE", the Opposer already owns trademark registrations for the mark "FASHION TV" in France and International Registration covering Germany, Spain, Russian Federation, Italy, Monaco, Poland and Switzerland. This Bureau noticed that the services covered by Respondent-Applicant's trademark application for the mark FASHION TV & WOMAN DEVICE is similar to Opposer's.

A comparison of the competing marks reproduced below:

⁴Marked as Exhibits "A" to "G".

FASHION TV



Opposer's trademark

Respondent-Applicant's mark

shows that confusion is likely to occur. What draws the eyes and the ears with respect to the Respondent-Applicant's mark are the words FASHION TV. FASHION TV is the prominent, in fact, the definitive feature of the Opposer's service mark FASHION TV and the primary element of Opposer's tradename FASHION TV PROGRAMMGESELLSCHAFT MBH. Thus, FASHION TV & WOMAN DEVICE is confusingly similar to Opposer's FASHION TV service mark. Because the Respondent-Applicant's trademark application covers service/s that is similar to the Opposer's, particularly, television programs under Class 38, it is likely that the consumers will have the impression that these services originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of services but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁵

Public interest therefore requires, that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that 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.⁶

⁵Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al., G.R. No. L-27906, 08 Jan. 1987.

⁶*Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepe v. Director of Patents, supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

The Respondent-Applicant's filing of their trademark application in the Philippines may be earlier than the Opposer's, but the latter raises the issues of trademark ownership, fraud and bad faith on the part of the Respondent-Applicant.

In this regard, this Bureau emphasizes that it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right of registration. The Philippines implemented the World Trade Organization Agreement "TRIPS Agreement" when the IP Code took into force and effect on 01 January 1998. Art 16(1) of the TRIPS Agreement states:

1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

Clearly, it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right to registration. While the country's legal regime on trademarks shifted to a registration system, it is not the intention of the legislators not to recognize the preservation of existing rights of trademark owners at the time the IP Code took into effect.⁷ The registration system is not to be used in committing or perpetrating an unjust and unfair claim. A trademark is an industrial property and the owner thereof has property rights over it. The privilege of being issued a registration for its exclusive use, therefore, should be based on the concept of ownership. The IP Code implements the TRIPS Agreement and therefore, the idea of "registered owner" does not mean that ownership is established by mere registration but that registration establishes merely a presumptive right of ownership. That presumption of ownership yields to superior evidence of actual and real ownership of the trademark and to the TRIPS Agreement requirement that no existing prior rights shall be prejudiced. In *Shen Dar Electricity Machinery Co., Ltd.v. E.Y. Industrial Sales Inc., Engracio Yap, et. al.*,⁸, the Director General held:

The IP Code adheres to the existing rationale of trademark registration. That is, certificates of registration should be granted only to the real owners of trademarks. While the 'First-to-File' rule is the general rule for trademark applications filed under and governed by RA 8293, it is not to be applied if there is a determination in appropriate proceedings:

1. That the 'first-filer' is not the owner of the trademark or is not authorized by the owner to procure registration of the trademark in his, her, or its favor; or

⁷See Sec. 236 of the IP Code.

⁸Appeal No. 14-06-09 dated 28 May 2007.

2. That the adoption and/or use by the 'first-filer' of the trademark, even in good faith, is preceded by an actual use by another, also in good faith, prior to the taking into force and effect of RA. 8293.'

In this instance, the Opposer proved that it is the originator and owner of the contested service mark. As stated, "'FASHION TV" as a trademark was first adopted by Mr. Michel Adam Lisowski, President and Founder of the company, in 1997...Trademark "FASHION TV" was registered by Mr. Michel Adam Lisowski in 1998 in France under No. 98/729085 and is also protected by International Registration No. 706 838 in several countries.⁹ In contrast, the Respondent-Applicant despite the opportunity given, did not file an Answer to defend their trademark application and to explain how they arrived at using the mark FASHION TV & WOMAN DEVICE which is identical or closely-resembles that of the Opposer's. In fact, FASHION TV is not only as a service mark but also part of the Opposer's trade name or business name. Trade names or business names are protected under Section 165 of the IP Code. It is incredible for the Respondent-Applicant to have come up with exactly the same mark for use on similar services by pure coincidence.

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2013-008056 is hereby SUSTAINED. 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, 30 JUN 2016.


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

⁹ Exhibit "B".