



INTELLECTUAL PROPERTY  
OFFICE OF THE  
PHILIPPINES

**STARBUCKS (HK) LIMITED,**  
*Opposer,*

**-versus-**

**INFORMATION CAPITAL TECHNOLOGY  
VENTURES, INC.,**  
*Respondent-Applicant.*

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**IPC No. 14-2013-00264**  
Opposition to:  
Appln. Serial No. 4-2013-500481  
Date Filed: 20 February 2013

**TM: NOWPLANET.TV**

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**NOTICE OF DECISION**

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**ANCHETA & ASSOCIATES**

*Counsel for Respondent- Applicant*  
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2609 Civic Drive, Filinvest City  
Alabang, Muntinlupa City 1781

**GREETINGS:**

Please be informed that Decision No. 2017 - 04 dated 12 January 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 16 January 2017.

**MARILYN F. RETUAL**

IPRS IV

Bureau of Legal Affairs

**Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE**

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**STARBUCKS (HK) LIMITED,**

Opposer,

-versus-

**INFORMATION CAPITAL TECHNOLOGY  
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IPC No. 14-2013-00264

Opposition to Trademark

Application No. 4-2013-500481

Date Filed: 20 February 2013

**Trademark: "NOWPLANET.TV"**

Decision No. 2017- 04

**DECISION**

Starbucks (HK) Limited<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-500481. The contested application, filed by Information Capital Technology Ventures, Inc.<sup>2</sup> ("Respondent-Applicant"), covers the mark "NOWPLANET.TV" for use on *"telecommunications via the internet", "education; providing of training; entertainment"* and *"social media, scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software"* under Classes 38, 41 and 42, respectively, of the International Classification of Goods<sup>3</sup>.

The Opposer claims to be the lawful owner of the trademark "NOW TV & DEVICE", which has allegedly been subject to various trademark and service mark applications and/or registrations internationally for Classes 09, 16, 35, 38, 41 and 42. In the Philippines, it filed Trademark Application No. 4-2012-010893 on 06 September 2012, with claim of priority based on its earlier filing with the European Union on 23 March 2012. It thus contends that the Respondent-Applicant's mark is identical and visually, phonetically and connotatively confusingly similar to its registered mark. In support of its opposition, the Opposer submitted the following:<sup>4</sup>

1. affidavit of Chan Chi Keung;
2. printed pages of the Opposer's websites;
3. printed pages from website of the Trade Marks and Designs Registration Office of the European Union;
4. letter to the Director of Trademarks of this Office; and,
5. its trademark application for "NOW TV & DEVICE".

<sup>1</sup> A foreign corporation duly organized and existing under the laws of the Hong Kong, with principal office address at PCCW Tower, Taikoo Place, 979 King's Road, Quarry Bay, Hong Kong.

<sup>2</sup> With known address at Unit 5-I 5<sup>th</sup> Floor OPL Building, 100 Palanca Street, Legaspi Village, Makati City.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

<sup>4</sup> Marked as Exhibits "A" to "G", inclusive.

For its part, the Respondent-Applicant avers that it is the registered owner of the mark "NOWPLANET.TV" under Certificate of Registration No. 4-2012-500143 issued on 05 July 2012. It explains that the contested trademark application is merely for design variation of its previously registered mark. It also contends that a search on the WIPO-ROMARIN-International Registration shows that the holder of the registration of "NOWTV" is another entity, not the Opposer. The Respondent-Applicant's evidence consists of the following:<sup>5</sup>

1. copy of its letter dated 10 October 2013 advising the Director of Trademarks of its change of company name;
2. copy of Certificate of Registration No. 4-2012-500143; and,
3. printouts from the search results of WIPO-ROMARIN-International Registration.

Thereafter, the Opposer filed a Reply, which the Respondent-Applicant moved to strike out. The Respondent-Applicant's motion is meritorious as Section 11 of the Amendments to the Rules and Regulation on Inter Partes Proceedings<sup>6</sup> ("IPC Rules") provides that:

***"Section 11. Prohibited pleadings. – No motion to dismiss shall be entertained. Instead, all grounds for dismissal shall be pleaded as affirmative defenses. The resolution of which shall be made in the decision on the merits. Neither shall a motion for bill of particulars, motion for reconsideration of interlocutory orders, and all other pleadings subsequent to the filing of an Answer, shall be allowed."***(Emphasis supplied.)

Pursuant to Office Order No. 154, s. 2010, the case was referred to mediation. The parties, however, refused to mediate. Accordingly, the Hearing Officer conducted a preliminary conference and the same was terminated on 07 May 2015. Thereafter, the parties submitted their respective position papers. After which, the case is deemed submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant's trademark application for "NOWPLANET.TV" should be allowed registration.

Records reveal that at the time Respondent-Applicant filed for an application of registration of its mark "NOWPLANET.TV" on 20 February 2013, the Opposer has previously filed an application for the mark "NOW TV" on 06 September 2012 with claim of priority based on the latter's filing with the European Union on 23 March 2012.

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<sup>5</sup> Marked as Exhibits "1" to "4".

<sup>6</sup> Office Order No. 99, Series of 2011.

Be that as it may, the Respondent-Applicant was able to show that it is the holder of Certificate of Registration No. 4-2012-500143 issued on 20 January 2012. Succinctly, Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code provides") that:

**"123.1. 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**

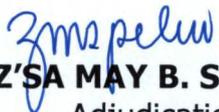
**(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion; xxx."(Emphasis supplied.)**

In this case, it appears that the Respondent-Applicant filed the earlier application and/or registration for the mark "NOWPLANET.TV" even considering the Opposer's application with the European Union for "NOW TV". Applying the above-quoted provision, the Opposer's trademark application for "NOW TV" cannot be used as basis to prevent the Respondent-Applicant from registering a mark that appropriates the words "NOWPLANET.TV" anew for a different presentation and/or logo.

**WHEREFORE**, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-500481 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 12 JAN 2017

  
**ATTY. Z'SA MAY B. SUBEJANO-PE LIM**  
Adjudication Officer  
Bureau of Legal Affairs