

**STAR TELEVISION PRODUCTIONS LIMITED,**  
*Opposer,*

**-versus-**

**ABS-CBN CORPORATION,**  
*Respondent-Applicant.*

X-----X

**IPC No. 14-2014-00498**  
Opposition to:  
Appl. Serial No. 4-2014-00006856  
Date Filed: 30 May 2014

**TM: STAR STUDIO**

**NOTICE OF DECISION**

**SAPALO VELEZ BUNDANG & BULILAN**

*Counsel for Opposer*  
11<sup>th</sup> Floor, Security Bank Centre  
6776 Ayala Avenue, Makati City

**POBLADOR BAUTISTA & REYES**


*Counsel for Respondent- Applicant*  
5<sup>th</sup> Floor, SEDCCO I Building  
120 Rada corner Legaspi Streets,  
Legaspi Village, Makati City

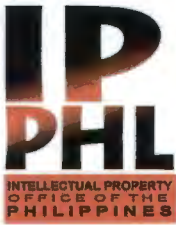
**GREETINGS:**

Please be informed that Decision No. 2017 - 303 dated 28 July 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL 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, 01 August 2017.

  
**MARILYN F. RETUAL**  
IPRS IV  
Bureau of Legal Affairs



STAR TELEVISION  
PRODUCTIONS LIMITED,  
Opposer,

IPC No. 14-2014-00498  
Opposition to:

- versus -

Appln. No. 4-2014-00006856  
Date Filed: 30 May 2014  
Trademark: "STAR STUDIO"

ABS-CBN CORPORATION,  
Respondent-Applicant.  
X ----- X

Decision No. 2017 - 303

**DECISION**

STAR TELEVISION PRODUCTIONS LIMITED ("Opposer"),<sup>1</sup> filed a verified opposition to Trademark Application Serial No. 4-2014-00006856. The application, filed by ABS-CBN CORPORATION ("Respondent-Applicant")<sup>2</sup>, covers the mark "STAR STUDIO" for use on goods under the class<sup>3</sup> 41 namely, *entertainment services*.

The Opposer alleges that it is the first to adopt, use, apply for, and register the "STAR", "STAR TV & STAR DEVICE", "STAR LOGO", "STAR & LOGO" and other derivative trademarks incorporating STAR and/or STAR LOGO including but not limited to "STAR MOVIES", "STAR WORLD", "STAR SPORTS", "STAR PLUS", "STAR ONE", "STAR NEWS" and "STAR GOLD" (collectively referred to as "STAR" trademarks) worldwide, including the Philippines, for goods and services under classes 9, 16, 35, 38, 41 and 42. The Opposer claimed that its "STAR" trademarks are well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public at large, as trademarks expressly and directly referring to and owned by the Opposer.

Further, the Opposer avers that there is a likelihood of confusion between Opposer's "STAR" trademarks and Respondent-Applicant's "STAR STUDIO" mark because the latter's mark is identical in sound, spelling, connotation and appearance to the former's "STAR" trademarks as to likely to cause confusion, mistake and deception to the public. Thus, Respondent-Applicant's "STAR STUDIO" mark for its services, is likely to cause confusion, mistake, or to deceive as to affiliation, connection, or association with the Opposer, or as to origin, sponsorship, supervision, authorization or approval of its products by the Opposer, for

<sup>1</sup> A foreign corporation duly organized and existing under the laws of British Virgin Islands with address at Craigmuir Chambers, P.O. Box 71, Road Town, Tortola, Vritish Virgin.  
<sup>2</sup> A corporation duly organized and existing under Philippine laws, with address at ABS-CBN Broadcast Center, Sgt. Esguerra Avenue corner Mother Ignacia Street, Quezon City.  
<sup>3</sup> 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.

which it is liable under designation of origin, false description or representation under Sec. 169 of R.A. No. 8293.

The Opposer's evidence consists of the following:

1. Affidavit of Director Kate Elizabeth McNamara, inclusive of exhibits;
2. Opposer's Certificate of Registrations for "STAR" trademarks issued by the IPOPhl;
3. Listings of Opposer's all current registrations of the "STAR" trademarks
4. Promotional and advertising materials for products and services carrying STAR trademarks;
5. Certified true copies of Decision in IPC Nos. 14-2001-0013 and 14-2007-00255 declaring and confirming the well-known mark status of the trademark STAR, respectively;

On 11 May 2015, Respondent-Applicant filed an Answer. It states that it is engaged in the business of television and radio network broadcasting. It has several subsidiaries and affiliates engaged in the same or allied businesses, which include: ABS-CBN Film Productions, Inc. (more commonly known as "STAR CINEMA"), which recently absorbed Star Recording, Inc. ("STAR RECORDS"); and (b) ABS-CBN Publishing, Inc. (publisher of "Star Studio Magazine").

According to Respondent-Applicant, it has long acquired the exclusive right to use the mark "STAR" through prior adoption and substantially exclusive use thereof with respect to their goods and services. In the Philippines, it used the "STAR" mark as early as 1986-1987 as "The STAR Network" and thereafter, in its re-launching. Between the years 1987 to 1990, print advertisements and articles made known nationwide the "THE STAR NETWORK". Up to the present, the "STAR" mark, its derivative and variant marks are continuously used. Thus, Opposer is merely a junior user of the "STAR" mark, without right to exclude a senior user from registering a derivative "STAR" mark.

Respondent-Applicant likewise affirmed ownership of the "STAR" mark by registrations and/or applications for registration in the classes pertinent hereto. In fact, it obtained a prior registration for the "STAR STUDIO and DEVICE" mark as early as 30 May 2003. However, the registration of this mark expired on 20 May 2013. Moreover, ABS-CBN Publishing, Inc., is the registered owner of the subsisting "STAR STUDIO" mark, which is a plain word version of the subject mark. ABS-CBN also claimed protection by law regardless of registration over the trade name "STAR".

In consequence, the ABS-CBN Group aggressively protects its ownership of the "STAR" mark, not only through registration, but also by opposing trademark applications for "STAR" marks filed by other applicants. It maintains that the registration of the subject mark will not mislead the public, as Respondent-Applicant's "STAR STUDIO" mark is not identical to or confusingly similar with Opposer's "STAR" marks. Moreover, the public associates "Star" and "Star Studio" with the ABS-CBN Group.

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

1. Amended Articles of Incorporation of ABS-CBN;
2. Amended Articles of Incorporation of ABS-CBN and its Articles and Plan of Merger with STAR Records;
3. Deeds of Assignment and the corresponding letters to the IPO;
4. Amended Articles of Incorporation of ABS-CBN Publishing, Inc.;
5. General Information Sheet of STAR Recording, Inc.;
6. General Information Sheets of ABS-CBN, STAR CINEMA and ABS-CBN Publishing, Inc.;
7. Judicial Affidavit of Ms. Evangeline Baylon;
8. Original printouts of screenshots from the website of STAR MAGIC;
9. Tri-ribbon number 2 with a Star figure referred to Ms. Baylon's Affidavit;
10. List of Print Advertisements and Articles in The Manila Bulletin;
11. Affidavit of Ms. Catherine Patrice K. Ochoa-Perez;
12. Printouts of screenshots from the website of STAR MAGIUC, including its historical background;
13. Judicial Affidavit of Ms. Adora Jacila;
14. Judicial Affidavit of Mr. Regie Sandel;
15. Sample copy of the STAR STUDIO magazine;
16. Printouts of trademark details for various STAR marks from the IPO online trademarks database;
17. Certificate of Registration for the mark STAR STUDIO and DEVICE;
18. Trademark Application Forms, Responses, Notices and Official Receipts;
19. Orders issued by the Bureau of Legal Affairs and the Office of the Director General, and Motion to Dismiss filed by ABS-CBN Group and Star TV; and,
20. Notices of Opposition and Compliances in IPC cases forming part of official records of IPO.

After the termination of the Preliminary Conference, the parties filed their respective position papers<sup>4</sup>. Thereafter, this case is submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark STAR STUDIO?

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.<sup>5</sup>

---

<sup>4</sup> Opposer filed Position Paper on 21 October 2016; Respondent-Applicant filed Position Paper on 04 October 2016 (attached in Motion to Admit Attached Position Paper).

<sup>5</sup> 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:



Opposer's Trademarks



Respondent-Applicant's Trademark

An examination of the above-illustrated competing marks reveal that they contain the word "STAR". The word "STAR" is an arbitrary word. It is not a generic term for its goods and therefore, may be appropriated as its own. Apart from the use of the word "STAR", there are other words present such as "TV" and "MOVIES" in Opposer's trademarks; and "STUDIO" in Respondent-Applicant's trademark. These words are descriptive of the service/s and/or goods it cover and offer to the public. Therefore, it cannot cause to distinguish the marks from one another.

It appears that the contending parties do not directly move in the same channels of trade and the likelihood of confusion may seem farfetched because the services they offer are not identical, telecommunication vis-a-vis advertising. However, there is a probability that Opposer's "STAR TV" mark will be used on services similar to that of Respondent-Applicant i.e., entertainment services, as they are within the normal or zone of potential business expansion of Opposer. In fact, Opposer mentioned several pending application for registration of their various "STAR" marks covering class 41 for "STAR TV & STAR DEVICE" and "STAR DRAMA THEATER. The expansion of Opposer's business into these related services are the pattern taken as well in other countries where Opposer's business indeed expands. In the case of Jose P. Sta. Ana vs. Florentino Maliwat, et al. G.R. No. L-23023, 31 August 1958, it was ruled that:

"Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trademark or trade name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party

has extended his business into the field (see 148 ALR 56 et seq; 53 Am Jur. 576) or is in any way connected with the activities of the infringer; or when it forestalls the normal potential expansion of his business."

The right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration.<sup>6</sup> Where a trademark application is opposed, the Respondent-Applicant has the burden of proving ownership.<sup>7</sup> In the instant case, the Opposer has an earlier trademark application in 1992 for the STAR mark.<sup>8</sup> In fact, as early as 1990's, Opposer's STAR mark was used in the Philippines through various Philippine cable or DTH television companies. Also, 50,000 households in the Philippines received services from the STAR Group.<sup>9</sup> Therefore, Respondent-Applicant by any party of reasoning, cannot be considered an originator, prior registrant nor a prior applicant of the subject or questioned STAR service mark.

Furthermore, it is noteworthy that the mark "STAR" has been declared well-known by the Bureau of Legal Affairs in several decisions.<sup>10</sup> The continuous use, advertising, promotion of the "STAR" trademarks conferred ownership and valuable goodwill to Opposer.

Corollarily, Section 123.1 paragraphs (d), (e) and (f) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), provides 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;

x x x

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is 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 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;"

Hence, the registration of the mark applied for registration by the Respondent-Applicant must not be allowed pursuant to Section 123.1 (d) and (f) of the IP Code.

---

<sup>6</sup> Bert R. Bagano vs. Director of Patents, et al., G.R. No. L-20170, 10 August 1956.

<sup>7</sup> Marvex Commercial Co., Inc. vs. Peter Hawpia and Co., 18 SCRA 1178).

<sup>8</sup> par. 10, Affidavit of Kate Elizabeth McNamara.

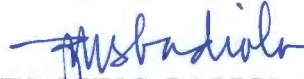
<sup>9</sup> par. 7, Affidavit of Kate Elizabeth McNamara; Annex "G" of Exhibit "A" of Opposer.

<sup>10</sup> Exhibits "J" and "K" of Opposer.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2014-00006856 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. **28 JUL 2017**



**Atty. GINALYN S. BADIOLA, LL.M.**  
*Adjudication Officer, Bureau of Legal Affairs*