



INTELLECTUAL PROPERTY  
OFFICE OF THE PHILIPPINES

**ABS-CBN CORPORATION,**  
*Opposer,*

**-versus-**

**RISINGSTARS ASIA ONLINE OTE. LTD.,**  
*Respondent-Applicant.*

**IPC No. 14-2015-00067**  
Opposition to:  
Appln. Ser. No. 4-2014-006609  
Date Filed: 26 May 2014

**TM: STARSHINE**

X-----X

**NOTICE OF DECISION**

**POBLADOR BAUTISTA & REYES**

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

**ANGARA ABELLO CONCEPCION REGALA & CRUZ**

*Counsel for Respondent-Applicant*  
22<sup>nd</sup> Floor, ACCRALAW Tower  
Second Avenue corner 30<sup>th</sup> Street,  
Crescent Park West, Bonifacio Global City  
Taguig

**GREETINGS:**

Please be informed that Decision No. 2017 - 427 dated 19 December 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, 19 December 2017.

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



INTELLECTUAL PROPERTY  
OFFICE OF THE PHILIPPINES

ABS-CBN CORPORATION	}	IPC No. 14-2015-00067
<i>Opposer,</i>	}	
	}	Opposition to:
-versus-	}	App. Serial No. 4-2014-006609
	}	Date filed: 26 May 2014
RISINGSTARS ASIA ONLINE PTE. LTD.,	}	TM: "STARSHINE"
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2017- <u>427</u>

### DECISION

ABS-CBN CORPORATION,<sup>1</sup> ("Opposer") filed an Opposition to Trademark Application Serial No. 4-2014-006609. The application, filed by RISINGSTARS ASIA ONLINE PTE. LTD.,<sup>2</sup> ("Respondent-Applicant") covers the mark **STARSHINE** for use on "*broadcasting and delivery of audio, video, and/or multimedia content by means of radio, cellular, and wireless communication, television, cable television, closed circuit, electronic communications networks, or computer networks; electronic transmission of data, images and documents via a global computer network; providing access via computer and communication networks to text, data, documents in electronic form, databases, graphics, audiovisual information and web pages; providing access to online facilities to real-time interaction with other computer users concerning topics of general interest and for playing games; providing multiple-user access to computer information on computer networks for the transfer and dissemination of a wide range of information; computer bulletins and message boards in the fields of general interest*" under Class 38 and "*education and entertainment services all relating to television, cinema, radio and theatre; production and presentation of radio and television programmes; films and shows; entertainment by or relating to television and radio; organization of competitions (education or entertainment); interactive telephone competitions; production of cinematographic films, shows, radio programmes and television programmes; provision of education and entertainment by means of radio, television, satellite, cable, telephone, the worldwide web and the internet; organization of shows; radio entertainment; television entertainment; game shows; television entertainment services involving telephonic audience participation; interactive entertainment services for use with a mobile phone; internet based games*" under Class 41 of the International Classification of Goods.<sup>3</sup>

<sup>1</sup> A domestic corporation with principal office address at ABS\_CBN Broadcast Center, Sgt. Esguerra corner Mother Ignacia Street, Quezon City.

<sup>2</sup> A corporation valid and existing under the laws of Singapore with principal office address at 333 North Bridge Road, #08-00 Kh Kea Building, Singapore 188721

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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.

Opposer alleges the following grounds for opposition:

"A. At the time Respondent-Applicant filed the subject Application, Opposer has already acquired ownership of the "STAR" mark and derivative marks by prior and actual adoption and extensive use thereof.

"B. ABS-CBN and its affiliates/subsidiaries are also the prior applicants and registrants of the "STAR" mark and other derivative marks.

"C. As the owner of the "STAR" mark and derivative marks, ABS-CBN is entitled to prevent the registration of the "STARSHINE" mark covered by the subject Application, which is confusingly similar with the trade names and marks of the ABS-CBN Corporation.

"D. Registration of Respondent-Applicant's "Starshine" would lead to the dilution of the ABS-CBN Group's "STAR" trade names/marks and derivative marks and would erode their goodwill over said names and marks."

To support the opposition, Opposer submitted the following evidence:

1. Certified copy of the Articles of Incorporation of ABS-CBN;
2. Certified copy of Assignment of Application for Registration of Trademark between Star Cinema Productions, Inc. and ABS-CBN Film Production, Inc. and Request for Recordal of Assignment filed with the IPO;
3. Certified copy of the Certificate of Filing of Amended Articles of Incorporation of ABS-CBN Film Productions, Inc.;
4. Certified copy of the Certificate of Filing of the Articles and Plan of Merger;
5. Certified copy of the Certificate of Filing of the Amended Articles of Incorporation of ABS-CBN Publishing, Inc.
6. Certified copy of the Amended General Information Sheet of ABS-CBN Corp.;
7. Certified copy of the General Information Sheet of ABS-CBN Film Productions, Inc.;
8. Certified copy of the General Information Sheet of ABS-CBN Publishing, Inc.;
9. Judicial Affidavit of Evangeline Baylon;
10. Copy of the logo of The Star Network;
11. Certified copies of numerous advertisements and articles in the Manila Bulletin and the Philippine Daily Inquirer of Opposer's STAR marks from 1987 - 1990;
12. Certified copy of the Affidavit of Catherine Patrice K. Ochoa-Perez including its Annexes;
13. Printouts of screenshots from the website of Star Magic including its historical background;
14. Judicial Affidavit of Adora Jacila;

15. Judicial Affidavit of Regie Sandel; and
16. Sample copy of Star Studio magazine.

On 15 April 2015, this Bureau issued a Notice to Answer and serve the same to Respondent-Applicant's representative on 21 April 2015. On 21 May 2015, Respondent-Applicant filed its Answer alleging the following:

"1.1. The opposition is based on the Opposer's alleged prior and extensive use of the word "Star" in its company's activities and endeavors, including its Star Records and Star Cinema productions as well as in numerous TV shows. To support its claim, Opposer has provided a list of its registered or pending Trademarks incorporating the word "STAR". However, it is worth noting that in the list provided by Opposer, there is no mark containing any combination of the words "STAR" and "SHINE". Thus, there can be no confusing similarity between Opposer's marks containing the word "STAR" and Respondent-Applicant's "STARSHINE" mark.

"1.2. Opposer does not have a registration or exclusive rights over the word "STAR". In fact, based on our informal search of the online trademark database of this Honorable Office, there are numerous other registrations containing the word "STAR" in the name of third parties, including other local and international television networks, covering similar services and classes as Opposer's marks. Opposer does not have an "exclusive claim over the word "STAR".

"1.3. Based on the records of this Honorable Office, Respondent-Applicant is the registered owner of the RISINGSTARS mark bearing Registration No. 42011009705 in the Philippines, and is currently airing the RisingStars Philippines televised talent show on local channel, TV5 Network. On account of the registered mark, Respondent-Applicant's online presence and currently airing television show, Opposer's claim that it has 'come to be associated by the public with the "Star" mark in the field of entertainment cannot be substantiated.'

"1.4. The word "STAR" is commonly used in the entertainment industry for television shows and other production related activities to suggest that the people being featured in the production are stars or may become stars themselves. Accordingly, no one entity may claim exclusive rights over the word "STAR".

"1.5. Through the filing of its Declaration of Actual Use for its "STARSHINE" mark on 27 August 2014, Respondent-Applicant has demonstrated that it is actively using the "STARSHINE" mark with its online singing competitions. With over 100,000 registered users on its [www.risingstars.ph](http://www.risingstars.ph) website, a large portion of the public was exposed to the use of the "STARSHINE" mark in association with Respondent-Applicant.

"1.6. In view of the foregoing, and considering that Opposer failed to sufficiently establish a valid ground to sustain the opposition to the registration of Respondent-Applicant's mark "STARSHINE", the same must be allowed to proceed to registration."

On 25 May 2015, the case was referred to the Alternative Dispute Resolution (ADR) Services for mediation conference, however, the parties refused to mediate. On 05 October 2015, the preliminary conference was terminated and the parties were directed to submit position papers. On 15 October 2015, Respondent-Applicant filed its Position Paper while Opposer did so on 23 November 2015.

The sole issue to be resolved in this case is: **Whether or not Respondent-Applicant's "STARSHINE" mark should be registered.**

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.<sup>4</sup>

Section 123.1 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code), as amended, provides:

Sec. 123. *Registrability.* - 123.1. A mark cannot be registered if it:

x x x

(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;

It is clear from the above provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, said mark cannot be registered.

Records will show that Opposer started using the "STAR" trademark, trade name and brand way back in 1987 when it was formally re-launched as "The Star Network". Opposer has registered various marks under Class 41 prior to the filing of Respondent-Applicant's trademark application on 26 May 2014. As such, the certificates of registration in its name are *prima facie* evidence of the validity of the registration, the ownership of the mark and the exclusive right to use it in connection with the goods and/or services and those that are related thereto, pursuant to Section 138 of the IP Code. Thus, the Opposer has the right to oppose the application for registration of a mark which is identical or similar to its marks, as in this case.

<sup>4</sup> *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

But are the marks of the parties confusingly similar as to likely cause confusion or mistake on the public? The Opposer and Respondent-Applicant's trademarks are reproduced below for comparison.

MORNING STAR

STAR MAGIC

STAR CIRCLE QUEST

LITTLE BIG STAR

STAR IN A MILLION



Opposer's STAR Marks

**StarShine**

Respondent-Applicant's Mark

In determining the existence of confusing similarity, it becomes imperative for this Bureau to make a careful comparison and scrutiny of the marks involved; to determine the points where these labels as they appear on the goods/services to which they are attached are similar, in spelling, sound and manner of presentation or general appearance. An examination of the competing marks reveal that the manifest similarity between them is the word "STAR". Most of the Opposer's marks and the Respondent-Applicant's mark are word marks using the word "star" in combination with other word or words written in plain font. Although it can be observed that Respondent-Applicant's mark is written in combination of uppercase and lowercase letter, this difference is inconsequential compared to the glaring similarity between them, to evade a finding of confusing similarity.

Confusing similarity exists when there is such a close or 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.<sup>5</sup> 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

<sup>5</sup> Societe Des Produits Nestle, Et. Al. vs. Court of Appeals. G.R. No. 112012. April 4, 2001

5 A handwritten signature in blue ink, consisting of stylized initials, is located in the bottom right corner of the page.

addition of another term."<sup>6</sup>

The finding of confusing similarity based on the reproduction or copying of the dominant feature of a registered mark by the applicant has been dictated by numerous precedents laid down by no less than the highest court of the land. In *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*<sup>7</sup>, the Supreme Court held that "the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof."

What adds more to the likelihood of confusion is the goods or services upon which the contending marks are used. Respondent-Applicant's mark is used on entertainment and mass media services which is already covered by the services offered by Opposer under its "STAR" marks. Further, the services under class 38 which Respondent-Applicant's STARSHINE mark is also being applied for is related to the entertainment services. Since the services which the marks of Opposer and Respondent-Applicant are being used are related, the subsequent user is proscribed from appropriating a service mark which is substantially or confusingly similar to a service mark owned by a prior registrant.

Anent the Respondent-Applicant's contention that the Opposer does not have exclusive right to use the word "STAR" because it is used and registered by third parties in other classes, this Bureau finds the same to be not well-founded. While the IPOPPL's Trademark Database shows that the word "star" is used as a standalone mark or in combination with other words for various classes, nevertheless, if and when Respondent-Applicant's mark will be allowed registration, the likelihood that the public will be confused, mistaken or deceived into believing that Respondent-Applicant's mark is merely a variation of Opposer's STAR marks or that it is associated or affiliated with Opposer is very apparent. Respondent-Applicant failed to establish the contrary as it did not present evidence to prove its claims.

**WHEREFORE**, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2014-

<sup>6</sup> *Continental Connector Corp. vs. Continental Specialties Corp.*, 207 USPQ 60.

<sup>7</sup> *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

006609, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 19 DEC 2017.



**MARLITA V. DAGSA**  
Adjudication Officer  
Bureau of Legal Affairs