

VANGUARD RADIO NETWORK CO. INC.,

Opposer,

-versus-

MANUELITO LUZON,

Respondent-Applicant.

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IPC No. 14-2012-00071

Opposition to:

Appln. Serial No. 4-2011-012841

Date Filed: 25 October 2011

**TM: 91.5 BIG RADIO BASTA RADIO
BIG RADIO LOGO**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 119 dated 07 April 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, 18 April 2017.

MARILYN F. RETUTAL

IPRS IV

Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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**VANGUARD RADIO
NETWORK CO., INC.,**
Opposer,

-versus-

MANUELITO LUZON
Respondent-Applicant.

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IPC No. 14-2012-00071

Opposition to:

Appln. Serial No. 42011012841

Date Filed: 25 October 2011

**TM: "91.5 BIG RADIO
BASTA RADIO BIG RADIO
LOGO"**

Decision No. 2017- 119

DECISION

VANGUARD RADIO NETWORK CO., INC.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 42011012841. The application, filed by MANUELITO LUZON² ("Respondent-Applicant"), covers the mark "91.5 BIG RADIO BASTA RADIO BIG RADIO LOGO" for goods and services, namely "Broadcasting (radio)" in Class 38 of the Nice Classification.³

The Opposer relies on the following as grounds for its opposition:

"I. SEC. 147 OF RA 8293 ENTITLES OPPOSER THE RIGHT TO PREVENT RESPONDENT-APPLICANT FROM REGISTERING AND/OR USING THE MARK APPLIED FOR BY THE LATTER

"18. As registrant-owner of the mark – "BIG SOUND FM AND DEVICE" – (see Annex "B"), which is currently in full force and effect, Opposer is entitled to the full protection of RA 8293 or the "Intellectual Property Code of the Philippines."

"19. Specifically, Opposer has 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 or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would

¹ A domestic corporation duly organized and existing under the laws of the Philippines, with its principal office at C520 Cityland Pasong Tamo Tower, Don Chino Roces Avenue, Makati City.

² A Filipino, of legal age, and a resident of No. 06 San Ignacio St., Kapitolyo, Pasig City, Metro Manila.

³ The 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.

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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.” (Sec. 147, RA 8293)

“20. Predicated on this “exclusive right”, Opposer appears before this Honorable Office, by way of this Opposition, in order to prevent Respondent-Applicant from registering and/or using the mark – “91.5 BIG RADIO BASTA RADIO, BIG RADIO LOGO” – applied for by him, same being an infringement on the right of Opposer to the sole use of its registered mark – “BIG SOUND FM AND DESIGN”.

“21. The mark applied for by Respondent-Applicant – “91.5 BIG RADIO BASTA RADIO, BIG RADIO LOGO” – is no different from the other (and now *abandoned*) mark applied for by him – “91.5 BIG RADIO LOGO” – the only inconsequential difference being that the mark, subject of and impugned by, this Opposition, contains the additional words – “BASTA RADIO, BIG RADIO”, which appear in small script font under the same logo of the other mark applied for by Respondent-Applicant.

“22. Respondent-Applicant’s mark applied for – “91.5 BIG RADIO BASTA RADIO BIG RADIO LOGO” – rotates around and is focused and centered on the word – “BIG” -, which appears twice on said mark, and is identical with Opposer’s registered mark – “BIG SOUND FM AND DESIGN” – which prominently bears the anchor word – “BIG”. When read on air or used on print, the mark applied for by Respondent-Applicant would result in a likelihood of confusion among the public. Too, it would most likely misinform, mislead, and deceive the public as to the source of the broadcast service, particularly considering that the mark applied for by Respondent-Applicant is intended for use in FM-band radio broadcasting (see Annex “G”), which is exactly the same service (FM-band radio broadcasting) wherein Opposer’s registered mark has been employed as a station brand since 1994, with the onset of its Baguio radio station operations (“95.9 BIG SOUND”).

“23. The fact that Opposer is presently operating only in certain areas of Luzon is of no moment and consequence considering that its registered mark is national in scope and character. Hence, it is entitled to use the same mark when it expands its FM radio broadcast service elsewhere in the country, including Metro Manila. Similarly, the mark applied for by Respondent-Applicant is intended for use nationwide, including the areas already covered by the FM radio service of Opposer.

“24. Opposer is an active member of the Kapisanan Ng Mga Brodcaster Ng Pilipinas or KBP, a national organization of radio and television broadcast station owners and operators. Respondent-Applicant is a veteran broadcast practitioner and a former officer of the KBP. As such, he must have, or should have, known that Opposer has been consistently using its registered mark – “BIG SOUND FM” – as Opposer’s unique brand name in its FM-band radio broadcast service. As such, Respondent-Applicant should have recognized Opposer’s registered mark (see Annex “B”) and thereby restrain himself from filing applications for the registration of identical marks (see Annexes “F” and “G”) which would most likely result in confusion and deception.

“25. Opposer’s seven FM radio stations have now attained a high level of recognition in the broadcast industry and the public as well with the

central word – “BIG” -, being attached to and paired and associated with, either the word – “SOUND” and interchangeably with the word – “RADIO” – the two words (“SOUND” and “RADIO”), being virtual twins and bearing the same or identical meaning, especially to the general public.

“26. The ordinary FM radio listener does not go through the motion or process of finely distinguishing between the words, “SOUND” and “RADIO”. In the public mind, Opposer’s radio stations are either “BIG SOUND” or “BIG RADIO”. Hence, the registration of Respondent-Applicant’s mark – “91.5 BIG RADIO BASTA RADIO, BIG RADIO” – would most likely confuse, mislead, and deceive the public and infringe on the exclusive right of Opposer to its registered mark – “BIG SOUND FM AND DESIGN” (see Annex “B”), particularly considering, as mentioned in paragraph 22 above, that both marks are employed in the same or identical field of FM-band radio broadcasting in the country.

“27. When tested and reckoned against how Respondent-Applicant’s mark sounds and the impact and meaning thereof to the general public in relation to Opposer’s registered mark, the likelihood of confusion and deception graduates to a level of certainty. The application of Respondent-Applicant must be perforce be denied.

“28. Further, to allow the registration of Respondent-Applicant’s mark would unduly benefit Respondent-Applicant as he would profit from the goodwill and brand recognition which Opposer has built through the years (since 1994) with the operation of its FM radio stations. Respondent-Applicant should not be allowed to so profit, at the expense of Opposer.

“II. SEC. 123.1. (d) OF RA 8293 BARS THE REGISTRATION OF THE MARK APPLIED FOR BY RESPONDENT-APPLICANT

“29. Sec. 123 (“Registrability”) of RA 8293 enumerates the instances in which a mark cannot be registered by this Honorable Office. In particular, Sec. 123 (d) thereof provides that a mark cannot be registered if it “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.”

“30. As afore-mentioned, Opposer is the owner-registrant of the mark – “BIG SOUND FM AND DESIGN” – (see Annex “B”), and Respondent-Applicant is the applicant for the registration of the mark – “91.5 BIG RADIO, BASTA RADIO, BIG RADIO LOGO” – (see Annex “G”). As afore-discussed, the mark applied for by Respondent-Applicant is identical, or at the very least, similar to or a variation of, the registered mark of Opposer with a likelihood of confusion and deception resulting therefrom. As such, the mark applied for by Respondent-Applicant is non-registrable, as provided in Sec. 123.1 (d) of RA 8293.

“31. Moreover, and as mentioned in paragraph 9 above, on July 7, 2011, Opposer filed with this Honorable Office an application for the registration of the mark – “BIG RADIO AND DEVICE” – (see Annex “C”), which was thereafter allowed by this Honorable Office under its “Notice of Allowance” dated January 20, 2012 (see Annex “D”). Opposer has paid the fees required under said notice (see Annex “E”).

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“32. Further, and as mentioned in paragraph 10 above, on July 12, 2011, or five days after, Respondent-Applicant filed with this Honorable Office an application for the registration of the mark – “91.5 BIG RADIO LOGO” – (see Annex “F”). The registration of said mark has been *abandoned* by Respondent-Applicant.

“33. However, and as mentioned in paragraph 11 above, on October 25, 2011, or three (3) months after Opposer had filed its application for the registration of the mark – “BIG RADIO AND DEVICE” -, Respondent-Applicant filed with this Honorable Court another application for the registration of the mark – “91.5 BIG RADIO, BASTA RADIO, BIG RADIO” – (see Annex “G”). This is the mark which pends registration with this Honorable Office and now subject of and opposed by, this Opposition.

“34. On the basis of Opposer’s filing date (July 7, 2011) of the mark (“BIG RADIO AND DEVICE”), which is clearly earlier than Respondent-Applicant’s filing date (October 25, 2011, for the mark “91.5 BIG RADIO BASTA RADIO, BIG RADIO LOGO”), Opposer’s application for the registration of its mark is entitled to “priority action” and precedence over that of Respondent-Applicant’s. This is as it should be considering that the mark applied for by Respondent-Applicant is identical with, or at the very least, similar to or a variation of, the mark applied for by Opposer, and would likely deceive or cause confusion, as discussed in the preceding paragraphs, and further considering that the marks applied for registration by Opposer and Respondent-Applicant belong to the same Classification No. 38 (Communications), particularly, FM radio broadcasting.

“35. Sec. 123.1 (d) is unequivocal in granting priority, precedence, or a superior status to a mark applied for earlier than that applied for at a later date, and bars the registration of the latter when coupled with the circumstances explained in the paragraph immediately above.

“36. The application of Respondent-Applicant for the registration of the mark – “91.5 BIG RADIO, BASTA RADIO, BIG RADIO LOGO” – must therefore be denied. The same action must likewise apply if and when Respondent-Applicant attempts to revive his application for the registration of yet another identical, albeit abandoned, mark identified as – “91.5 BIG RADIO LOGO”.

“37. As a final point, this Honorable Office should consider the fact that Respondent-Applicant is, to the knowledge and belief of Opposer, not an owner of a single radio or television station in the country, much less a grantee of a Congressional Franchise to own and operate broadcast stations. Applications for the registration of trademarks under Classification No. 38 (“Communications”) intended by an applicant for use in connection with the operation of radio or television stations should, *as a matter of policy*, be limited by this Honorable Office to those who are duly franchised by Congress, like Opposer, or at least, operators who are authorized as such by the National Telecommunications Commission or NTC.

The Opposer’s evidence consists of a copy of the resolution by Opposer’s Board of Directors authorizing Noel C. Galvez, Corporate Secretary and Vice President for Operations to represent itself regarding this matter; a copy of the

Certificate of Registration No.4-2011-007286 for the trademark "BIG SOUND FM AND DESIGN" with filing date on 22 June 2011; a copy of the particulars of the application of "BIG RADIO AND DEVICE"; a copy of the notice of allowance; a copy of official receipt no. 0377209 dated 20 February 2012; a copy of the particulars of the application of "91.5 BIG RADIO LOGO"; a copy of the particulars of the application of "91.5 BIG RADIO BASTA RADIO, BIG RADIO LOGO"; a copy of the letter written by the Opposer to the Director of Trademarks objecting to the registration of the mark "91.5 BIG RADIO LOGO"; and a copy of the letter written by the Opposer to the Director of Trademarks objecting to the registration of the mark "91.5 BIG RADIO BASTA RADIO, BIG RADIO LOGO".⁴

The Respondent-Applicant filed his Answer on 18 May 2012 alleging among other things:

"6. Opposer Vanguard's Opposition has no factual and legal basis. Consider:

Respondent-Applicant's mark "91.5 BIG RADIO, BASTA RADIO, BIG RADIO" is not identical with, nor nearly resembles, Opposer Vanguard's mark, as to be likely to deceive or cause confusion.

"7. Section 123 (d) of RA 8293 relevantly provides:

"Section 123. *Registrability*. – 123.1. A mark cannot be registered if it:

xxx xxx xxx

(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 xxx xxx"

"8. Here, while respondent-applicant applied for registration of the mark "91.5 BIG RADIO, BASTA RADIO, BIG RADIO"⁵ on 25 October 2011 apparently after Vanguard Radio Network Company, Inc. ("Vanguard") applied for registration of the mark "BIG RADIO"⁶ on 7 July 2011, the two (2) marks, however, are not identical to each other, nor do they "nearly resemble" each other as to be considered likely to deceive or cause confusion.

⁴Marked as Exhibits "A" and "I", inclusive

⁵A Copy of respondent-applicant's Application is attached hereto and made an integral part hereof as Annex "B"

⁶A copy of Vanguard's Application is attached hereto and made an integral part hereof as Annex "C"

“9. Jurisprudence provides two (2) tests that can be used to determine whether there is likelihood of confusion: the Dominancy Test and the Holistic or Totality Test.

“9.1. In *Dermaline, Inc. vs. Myra Pharmaceuticals* (G.R. No. 190065, 16 August 2010), the Supreme Court elucidated that the Dominancy Test involves the comparison of the prevalent features of competing trademarks and their similarity will determine whether it might cause confusion or deception. Applying this test to the 2 subject marks, it can be said that the dominant feature of respondent-applicant’s mark is the number “91.5” which is in big bold numbers and presented in color blue, while the dominant feature of Opposer Vanguard’s mark is the picture of a huge microphone which is featured on the very center of the mark. With very dissimilar dominant features, confusion between the two marks is highly unlikely.

“9.2. The Holistic Test was also discussed in *Dermaline*. The Court said that the Holistic Test requires a consideration of the marks in their entirety as applied to the products to determine whether there is confusing similarity. A thorough comparison of the 2 marks, as clearly illustrated above, would readily show that they are hardly identical with each other; in fact, they are very much different from one another. The first thing that strikes out is the use of colors which are present to respondent-applicant’s mark: “Background is yellow; 91.5 is written in blue; “BIG RADIO” is written in red; Tag line “BASTA RADIO, BIG RADIO, is written in red”. Opposer Vanguard’s mark, on the other hand, is merely in black and white without further use of any other color. Furthermore, respondent-applicant’s mark features the number “91.5” and the tagline “BASTA RADIO, BIG RADIO”, while there are no numbers and taglines in the Opposer’s mark.

“9.3. The only similar features in both marks are the words “BIG” and “RADIO”. But, as will be further discussed hereunder, Opposer Vanguard cannot validly appropriate the exclusive use of these words. Further, the marks differ in the manner in which they are presented. The words in respondent-applicant’s mark is written in straight horizontal lines, parallel to each other, while the words in Opposer Vanguard’s mark are written to form a circle.

“9.4. To illustrate more clearly, below are the 2 marks, placed side by side with each other, to highlight the stark difference between the two marks, for better appreciation of this Honorable Office:

Respondent's mark



Opposer's mark



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“10. Respondent-Applicant’s mark, taken in its entirety, features highlydistinguishable characteristics that totally differentiate itself from the Opposer Vanguard’s mark. Therefore, it is not similar to, nor does it “nearly resemble” the latter’s mark as to be likely to deceive or cause confusion.

The words “BIG RADIO” are mere generic words which may not be appropriated exclusively by Opposer Vanguard.

“11. More importantly, Opposer Vanguard may not appropriate for itself and to the exclusion of others the words “BIG RADIO” and claim exclusive proprietary rights over them. This is because these words are generic. “BIG” is a generic word that connotes size, while “RADIO” is a proper noun referring either to a “system of telecommunication employing electromagnetic waves of a particular frequency range to transmit speech or other sound over long distances without the use of wires” or “an apparatus for receiving or transmitting radio broadcasts” or “a message transmitted by radio”⁷. Certainly, the Opposer Vanguard cannot validly claim to have exclusive right to the use of these two generic words.

“12. In *Asia Brewery vs. Court of Appeals* (G.R. No. 103543, 5 July 1993, 224 SCRA 437, 448), the Supreme Court held that San Miguel Corporation has no proprietary rights over the words “pale pilsen” as to prevent Asia Brewery from using it to describe its beer products. In holding that Asia Brewery did not infringe San Miguel’s trademark, the Supreme Court ruled:

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“13. In the same vein, Opposer Vanguard may not validly arrogate unto itself the exclusive right to the use of the words “BIG RADIO”. Because they are generic words, they may not be appropriated by anyone, including Opposer Vanguard even if it purportedly owns many radio and television stations in Luzon (as it claims in its Opposition).

“14. Respondent-Applicant is fully cognizant of this principle. In fact, in his Application Form filed before this Office (Annex “B”), he expressly stated in his disclaimer that he does not claim the exclusive right to use the words “BIG” and “RADIO”. Similarly, in its own Application, Opposer Vanguard disclaimed any exclusive right use the word “RADIO”. Naturally so, because, being generic words, no one, including Opposer Vanguard, may claim proprietary and exclusive rights to use them.

The law neither requires prior Congressional grant nor proof of ownership of a radio or television station in the country before one can register a trademark.

⁷Random House Webster’s College Dictionary (Revised and Updated), page 1016.

“15. Opposer Vanguard argues that respondent-applicant’s application for registration should be denied because he is not an owner of a radio or television station in the country, nor a grantee of a Congressional Franchise to own and operate broadcast stations. Opposer Vanguard’s argument is devoid of any legal basis.

“16. Rules 300 and 304 of the Rules and Regulations on Trademarks, Service Marks, Trade names and Marked or Stamped Containers relevantly provide:

PART 3

Who May Apply for a Mark

RULE 300. *The Applicant.* – (a) Applicant may be a person or juridical person.

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RULE 304. *Power of attorney or Authorization.* – At the time of filing of an application, no power of attorney or authorization is required. However, the Office may require any attorney or other recognized person to submit within sixty (60) days from notice a power or authorization before he will be allowed to take an initial or further action in any application or registration.

“17. As seen from the quoted provisions, the rules do not prescribe the conditions mentioned by Opposer Vanguard in the Opposition. Even powers of attorney or authorizations which can be required to be produced are generally unnecessary in the processing of the application for registration of a trademark. Neither were they asked from respondent-applicant when he applied for the registration of “91.5 BIG RADIO, BASTA RADIO, BIG RADIO LOGO” mark.

“18. Absent any law imposing additional requirements for registration, respondent-applicant has every right to apply for the registration of the mark, “91.5 BIG RADIO, BASTA RADIO, BIG RADIO LOGO”, and take any further action necessary in the processing thereof. As discussed, he need not be a grantee of a Congressional franchise to own and operate broadcast stations or actually own a radio or television station, to apply for the same.

Respondent-Applicant had been using the mark “91.5 BIG RADIO” for more than one (1) month before Opposer Vanguard caused the registration of the mark “BIG RADIO”.

“19. Not only is Respondent-Applicant’s mark “91.5 BIG RADIO, BASTA RADIO, BIG RADIO” not confusingly identical nor similar to Opposer Vanguard’s “BIG RADIO” mark, moreover, Respondent-Applicant had already been using the said mark for more than one (1) month before Opposer Vanguard caused the registration of its mark.

“19.1. Records would bear that Opposer Vanguard caused the registration of the mark “BIG RADIO” only on 7 July 2011. However, as will be shown, more than 1 month prior to such registration, on 31 May 2011, Respondent-Applicant had already launched its logo and slogan “91.5

BIG RADIO” to the public, as evidenced by pictures thereof attached hereto as Annexes “D” to “D-8”.

“19.2. Verily, Respondent-Applicant had already been using the mark “91.5 BIG RADIO” long before Opposer Vanguard had thought of registering the mark “BIG RADIO”. Respondent-Applicant therefore had prior use of the same. Consequently, it has the better right to the registration thereof.

“19.3. In *Mighty Corporation, et al. vs. E & J Gallo Winery, et al.*,⁸ the Supreme Court gave importance to therein petitioner’s prior use of the subject mark, to wit:

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“19.4. Since Respondent-Applicant had prior use of the mark “91.5 BIG RADIO, BASTA RADIO, BIG RADIO” before Opposer Vanguard caused the registration of the mark “BIG RADIO”, Respondent-Applicant therefore has a better right to the registration thereof.

Opposer Vanguard sought registration of the mark “BIG RADIO” was made in utter bad faith.

“20. Further, Opposer Vanguard’s sought registration of the mark “BIG RADIO” was apparently made in utter bad faith, as shown by the following:

“20.1. First, as demonstrated above, Respondent-Applicant had already been using the mark “91.5 BIG RADIO, BASTA RADIO, BIG RADIO” as early as 31 May 2011, or more than one (1) month before Opposer Vanguard thought of registering the mark “BIG RADIO” on 7 July 2011. Respondent-Applicant therefore had prior use of the same. Obviously, after learning of the launching of Respondent-Applicant’s mark, Opposer Vanguard pre-empted Respondent-Applicant from registering the said mark by hastily causing the registration of the mark “BIG RADIO”, so that it will have a ground to oppose Respondent-Applicant’s eventual registration of its mark.

“20.2. Second, a comparison between Respondent-Applicant’s mark “91.5 BIG RADIO, BASTA RADIO, BIG RADIO” and Opposer Vanguard’s sought mark “BIG RADIO”, would clearly show that the latter was haphazardly and tastelessly conceptualized, as opposed to Respondent-Applicant’s well-thought-of mark. As vividly illustrated above, Respondent-Applicant’s mark is in vibrant and vivid colors, complete with a logo and a tag line. In contrast, Opposer Vanguard’s mark is in plain and bland black and white, without any accompanying tag line. Clearly, it was poorly and tastelessly thought of. This only proves that Opposer Vanguard hastily cause the registration of such mark purposely to pre-empt Respondent-Applicant from registering its mark first.

⁸G.R. No. 154342, July 14, 2004

“20.3. Third, as Opposer Vanguard admitted in paragraphs 5 to 8 of its Opposition, it had been using the brand “BIG SOUND” since 1994. In fact, until now it is still using this brand to identify itself, and NOT “BIG RADIO”. It is thus clear that Opposer Vanguard had thought of the mark “BIG RADIO” for the first time only after it had learned and heard of Respondent-Applicant’s mark “91.5 BIG RADIO, BASTA RADIO, BIG RADIO”, after it was launched on 31 May 2011. And, to pre-empt Respondent-Applicant from registering the said mark first, Opposer Vanguard jumped the gun on Respondent-Applicant and hastily caused the registration of the mark “BIG RADIO” on 7 July 2011, more than 1 month after the launch of Respondent-Applicant’s mark.

“20.4. Hence, it is very clear that Opposer Vanguard caused the registration of the mark “BIG RADIO” only for the purpose of pre-empting Respondent-Applicant from registering its mark “91.5 BIG RADIO, BASTA RADIO, BIG RADIO”. Its sought registration was therefore made in utter bad faith.

Finally, no confusion can result in the registration of Respondent-Applicant’s mark “91.5 BIG RADIO, BASTA RADIO, BIG RADIO” as the two radio stations operate in different areas.

“21. Finally, even assuming for the sake of argument that Respondent-Applicant’s mark “91.5 BIG RADIO, BASTA RADIO, BIG RADIO” may in some way be similar to Opposer Vanguard’s mark “BIG RADIO”, the seeming similarity will not, however, result in confusion among the public. This is so because Respondent-Applicant and Opposer Vanguard operate in different areas, and hence have different audiences.

“21.1. It bears noting that Respondent-Applicant operates a radio station only in Metro Manila. On the other hand, as admitted in its Opposition, Opposer Vanguard operates radio and tv stations only in the provinces, and not in Metro Manila, namely:

- (1) 101.5 BIG SOUND FM in Cabanatuan City;
- (2) 95.9 BIG SOUND FM in Baguio City;
- (3) 105.5 BIG SOUND FM in San Fernando, La Union;
- (4) 97.5 BIG SOUND FM in Lucena City;
- (5) 95.3 BIG SOUND FM in Cauayan City;
- (6) 100.5 BIG SOUND FM in Tuguegarao City;
- (7) 101.3 BIG SOUND FM in Solano, Bayombong;
- (8) 1188 KHZ DZXO AM in Cabanatuan City;
- (9) 819 Khz DWMG in Solano, Bayombong; and
- (10) VRN TV 24 in Baguio City⁹

“22. Verily, Respondent-Applicant and Opposer Vanguard operate their respective radio stations in different places and localities, catering to different audiences and patrons. Hence, there can be no confusion between the two because they do not share the same audience and market. The feared confusion among the public, therefore, does not exist. It is more illusory than real.

⁹Please see paragraph 5, Opposer Vanguard’s Opposition

The Respondent-Applicant's evidence consists of a copy of its letter requesting for revival of its trademark application for "91.5 BIG RADIO"; a copy of its trademark application form for the mark "91.5 BIG RADIO, BASTA RADIO, BIG RADIO"; a copy of Opposer's trademark application form for the mark "BIG RADIO"; and pictures of the launch of Respondent-Applicant's logo and slogan "91.5 BIG RADIO" on 31 May 2011.

Should the Respondent-Applicant be allowed to register the trademark "91.5 BIG RADIO, BASTA RADIO, BIG RADIO"?

The marks of the contending parties are reproduced below, both contain the words BIG and RADIO:

Opposer's mark



Respondent-Applicant's mark



While it is true that Opposer filed the mark "BIG RADIO" earlier than Respondent-Applicant, the Supreme Court has held that:

In other words, the prima facie presumption brought about by the registration of a mark may be challenged and overcome, in an appropriate action, by proof of the nullity of the registration or of non-use of the mark, except when excused. Moreover, the presumption may likewise be defeated by evidence of prior use by another person, i.e., it will controvert a claim of legal appropriation or of ownership based on registration by a subsequent user. This is because a trademark is a creation of use and belongs to one who first used it in trade or commerce.¹⁰

That being said, in order for Respondent-Applicant to claim ownership or actual use over the mark "91.5 BIG RADIO", the same must be proven with sufficient evidence. In this case, however, Respondent-Applicant, in attempting to prove actual usage, merely supplied pictures¹¹ of its staff in their office celebrating the birthday of a certain employee. This is inadequate evidence because the pictures do not prove that Respondent-Applicant has been using the mark "91.5 BIG RADIO" since 31 May 2011 like it alleges.

¹⁰Berris Agricultural Co., Inc. v. Norvy Abyadang, G.R. No. 183404, October 13, 2010

¹¹ Annex "D"- series

The records further show that the Opposer disclaimed the word "RADIO" and the "representation of a microphone" in its trademark application¹² while the Respondent-Applicant disclaimed the words "RADIO" and "BIG" in its trademark application. As a result, the Opposer, unlike the Respondent-Applicant, by registration of the mark "BIG RADIO AND DEVICE" under Certificate of Registration No. 4-2011-007929 issued on 29 March 2012, gains the exclusive proprietary right to use of the word "BIG" with reference to services under class 38, namely telecommunications. The evidence further show that the Opposer previously registered the mark "BIG SOUND FM AND DESIGN" under Certificate of Registration No. 4-2011-007266¹³. The Opposer has shown that it has appropriated and adopted the word BIG, to identify its telecommunication services, as it is in the business of the operation of radio and television broadcast stations. The Respondent-Applicant asserts that the words BIG RADIO are generic. It is observed that the word RADIO was disclaimed in Opposer's trademark application. However, the word "BIG" may be subject of a valid trademark and may be adopted and appropriated by the Opposer in reference to its services, telecommunications when used in an arbitrary manner. In *Mc Donald's Corporation v. L.C. Big Mak Burger, Inc.*¹⁴, the Supreme Court explains:

The contention has no merit. The "Big Mac" mark, which should be treated in its entirety and not dissected word for word, is neither generic nor descriptive. x x x On the contrary, "Big Mac" falls under *the class of* fanciful or arbitrary marks as it bears no logical relation to the *actual* characteristics of the product it represents. *As such*, it is highly distinctive and thus valid. Significantly, the trademark "Little Debbie" for snack cakes was found arbitrary or fanciful.

And since the Respondent-Applicant applies its mark "91.5 BIG RADIO" on the same class 38, particularly "(radio) broadcasting", there is a likelihood of confusion among the public, that the services are affiliated or are under the same sponsorship. By adopting the same word BIG, the listening public may be misinformed or mislead that Respondent-Applicant's radio broadcasting is connected to Opposer's radio station. The mention of the word BIG, even in conjunction with other elements, such as 91.5 or SOUND, or RADIO in radio advertising sounds confusingly similar. The Supreme Court in *Marvex Commercial Co., Inc. v. Petra Hawpia and Co.*¹⁵ held:

Two letters of "SALONPAS" are missing in "LIONPAS"; the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance (*Co Tiong Sa vs. Director of Patents*, 95 Phil. 1 citing *Nims, The Law of Unfair Competition and Trademarks*, 4th ed., vol. 2, pp. 678-679). "The importance of this rule is emphasized by the increase of radio advertising in which we are deprived of help of our eyes and must depend entirely on the ear" (*Operators, Inc. vs. Director of Patents, supra*).

¹² Annex "C"

¹³ Annex "B"

¹⁴ G.R. No. 143993, August 18, 2004


¹⁵ G.R. No. L-192971, December 22, 1966

In conclusion, since Respondent-Applicant has failed to prove with sufficient evidence that it has ownership or actual usage over the mark "91.5 BIG RADIO", the prima facie presumption enjoyed by Opposer as to the ownership of the mark "BIG RADIO" remains.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 14-2012-00071 is hereby SUSTAINED. Let the file wrapper 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, 07 APR 2017.


Atty. ADORACION U. ZARE, LL.M.
Adjudication Officer
Bureau of Legal Affairs