

ROBERT B. CATIMBANG
Opposer,

- versus -

MIA DINA M. DIVINAGRACIA,
Respondent-Applicant,
x-----x

IPC No. 14-2009-00199
Case Filed on: 04 August 2009

Opposition to:
App. Serial No. 4-2007-013169
Date Filed: 27 August 2007
TM: "THE GO GIRLS"

Decision No. 2010-44

DECISION

ROBERT B. CATIMBANG ("Opposer"), a Filipino citizen with business address at 55 14th Avenue, Murphy, Quezon City, filed an opposition to Trademark Application Serial No. 4-2007-013169. ¹ The application, filed by MIA DINA M. DIVINAGRACIA ("Respondent-Applicant"), also a Filipino citizen, with residence address at 83 San Pedro 8 Compound Himalayan Road, Pasong Tamo, Tandang Sora, Quezon City, covers the mark "THE GO GIRLS" for use on entertainment service under Class 41 of the International Classification of Goods.²

The Opposer alleges the following:

"II. GROUNDS OF THE OPPOSITION

"3. Opposer is a choreographer-manager of a dance group known as the 'GO GIRLS'. He is the first to adopt, use and appropriate the GO GIRLS trademark for the said dance group.

"4. There is likelihood of confusion between opposer's GO GIRLS trademark covering Class 41 (entertainment services) and respondent's 'THE GO GIRLS' trademark application for the same class because the latter is identical to and closely resembles opposer's trademark in appearance, spelling, sound, meaning and connotation.

"5. The opposer's trademark GO GIRLS is well-known in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being the trademark owned by the opposer. There is no doubt, therefore, that the respondent intends to ride on the popularity and goodwill of opposer's trademark in adopting and using the trademark GO GIRLS, as such use would indicate a connection between such services and those of the opposer's. Thus, the interest of the opposer are likely to be damaged by the respondent's use of the trademark GO GIRLS.

"6. The respondent by using the THEGO GIRLS as her own trademark for services identical to that of the oppose, has given her services the general appearance of the services of the oppose which would likely influence the public to believe that the services of the respondent's THE GO GIRLS are that of the opposer, thereby, deceiving the public and defrauding the opposer of his legitimate trade, hence, respondent is guilty of unfair competition as provided in Sec. 168.3 of KA. No. 8293.

"7. Respondent, in adopting the trademark Go GIRLS for her services is likely to cause confusion, mistake or deception as regards her affiliation, connection or association with the opposer as to the origin, sponsorship or approval of her services by the oppose, for which she is liable for false designation of origin, false description or representation under Sec. 169 of KA. No. 8293.

¹ The application was published in the Intellectual Property E-Gazette on 08 April 2009

² The Nice Classification is a classification of goods and services for the purpose of registering trademarks and servicemarks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

“Opposer relies on the following facts to support its opposition xxx.

“8. The opposer is the first to adopt, use and appropriate the Go GIRLS trademark in the Philippines for Class 41.

“9. There is a likelihood of confusing similarity between the respondent’s trademark THE GO GIRLS and opposer’s GO GIRLS trademark.

“10. Respondent’s THE GO GIRLS trademark is exactly identical and/or similar to opposer’s GO GIRLS trademark in appearance, spelling, meaning, connotation and sound, as would likely influence the public to believe that it belongs to the opposer.

“11. The opposer’s GO GIRLS trademark is well-known in the Philippine show business industry.

“12. Opposer’s GO GIRLS trademark have been used, promoted and advertised for a considerable duration of time and over wide nationwide areas. Opposer has invested tremendous amount of resources in the promotion of its trademark, i.e., magazines, newspapers, albums, videos, etc. The opposer’s GO GIRLS trademark has a considerable share in the market in the Philippine show business dance industry. There is already a high degree of distinction of the opposer’s Go GIRLS trademark.

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“8. The opposer is the first to adopt, use and appropriate the Go GIRLS trademark in the Philippines for Class 41.

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“12. Opposer’s GO GIRLS trademark have been used, promoted and advertised for a considerable duration of time and over wide nationwide areas. Opposer has invested tremendous amount of resources in the promotion of its trademark, i.e., magazines, newspapers, albums, videos, etc. The opposer’s GO GIRLS trademark has a considerable share in the market in the Philippine show business dance industry. There is already a high degree of distinction of the opposer’s Go GIRLS trademark.

“13. Respondent’s use of the GO GIRLS trademark would indicate a connection to the services of the opposer, thus, the interests of the opposer are likely to be damaged.

“14. The use of the respondent of the GO GIRLS trademark for services under Class 41 (entertainment services) definitely misleads the public into believing that the services originate from or are licensed or sponsored by the oppose or that respondent is associated with or an affiliate of the oppose.

“15. Respondent has appropriated the trademark GO GIRLS for the obvious purpose of capitalizing upon or riding on the valuable goodwill and popularity in the local show business dance industry which oppose gained through tremendous effort and expense over a long period of time. This clearly constitutes an invasion of opposer’s intellectual property rights.

“16. Undoubtedly, the use of the GO GIRLS trademark and the offering of services falling under Class 41 (entertainment services) by the respondent are inflicting considerable damage to the interests of the opposer. x x x”

The Opposer’s evidence consists of the following:

1. Affidavit of Robert B. Catimbang;
2. Exhibit “B” and “C” - original photographs of the double platinum award for the song and the GO GIRLS dance group with Mr. Bayani Agbayani and Mr. Lito Camo;
3. Exhibit “D” - photos of the CD sleeve of the Gasolina album;
4. Exhibit “E” - photos of the CD sleeve of the Go-Girls album
5. Exhibit “F” - photos of the Go Girls performing in Unang Hirit show;
6. Exhibit “G” - photos of the Go Girls performing in Win! Win! Win! TV game;
7. Exhibit “H” - photos of the Go Girls performing Chow Time Na show;
8. Exhibit “I” - photos of Go Girls attending different events;
9. Exhibit “J” - photos of promotional materials of provincial events attended by the Go Girls;
10. Exhibit “K” - printouts from the webpage www.gogirlsdancers.com; and
11. Exhibit “L” to “V” - Certifications from the producer of Unang Hirit show evidencing the various performances of the Go Girls in the show.

This Bureau issued on 26 August 2009 a Notice to Answer and served a copy thereof to the Respondent-Applicant’s representative, Mr. Deo M. Divinagracia, on 07 October 2009. The Respondent-Applicant, however, failed to file an Answer. Accordingly, this Bureau issued on 18 February 2010 Order No. 2010-263 stating that the Respondent-Applicant had waived her right to file answer and that the case is submitted for decision.

Should the Respondent-Applicant be allowed to register the mark THE GO GIRLS in her favor?

The contending marks are reproduced below:

The

Go Girls

Opposer’s Mark

The Go Girls

Respondent-Applicant’s Mark

Obviously, the competing marks are identical. Also, the marks are used by both parties on entertainment. There is no doubt therefore, that confusion or deception is likely to occur. The public will assume that the two (2) dancing/entertainment groups using the same or identical marks, are one and the same, or at least, are connected to or with each other.

In this regard, it is emphasized that an opposition is basically a review of the trademark application in question, succinctly, whether the requirements for registration under the law are met. Anybody who believes he will be damaged by the registration of the mark may oppose the application, even if the opposer has not yet applied for the registration of the identical or confusingly similar mark in the Philippines. Sec. 134 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines (“IP Code”) provides:

“Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2, file with the Office an opposition to the application. Such opposition shall be in writing and verified by the oppositor or by any person on his behalf who knows the facts, and shall specify the grounds on which it

is based and include a statement of the facts relied upon. Such opposition shall be in writing and verified by the oppositor or by any person on his behalf who knows the facts, and shall specify the grounds on which it is based and include a statement of the facts relied upon. Copies of certificates of registration of marks registered in other countries or other supporting documents mentioned in the opposition shall be filed therewith, together with the translation in English, if not in the English language. For good cause shown and upon payment of the required surcharge, the time for filing an opposition may be extended by the Director of Legal Affairs, who shall notify the applicant of such extension. The Regulations shall fix the maximum period of time within which to file the opposition. (Sec. 8, R.A. No. 165a)” [Emphasis supplied.]

The Opposer anchors his opposition on the ground that the Respondent-Applicant cannot register the mark in her favor because the latter is not the owner thereof and therefore has no right to registration. The Opposer also alleges that he is the true owner and prior user of the mark used for entertainment, such that he stands to lose and incur damage if the Respondent-Applicant is allowed to register the identical mark. The Opposer, thus, has cause of action and legal standing to oppose the Respondent-Applicant’s application.

It must be emphasized that the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into a 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 products.³

In this regard, the Philippines implemented the TRIPS Agreement when the IP Code took into force and effect on 01 January 1998. Art. 15 of TRIPS Agreement reads:

Section 2: Trademarks

Article 15

Protectable Subject Matter

1. Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.
2. Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provisions of the Paris Convention (1967).
3. Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.

³ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R.No. 114508, 19 November 1999, citing *Etepha v. Director of Patents*, 16 SCRA 495.

4. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.
5. Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.

Also, Art. 16 (1) of the TRIPS Agreement states:

Article 16

Rights Conferred

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.
2. Notably, the IP Code adopted the definition of the mark under R.A. 166, to wit:

121.1. "Mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods; (Sec. 38, RA. No. 166a)

Corollary thereto, Sec. 122 of the IP Code states:

Sec. 122. How Marks are Acquired.-The rights in a mark shall be acquired through registration made validly in accordance with the provisions of this law. (Sec. 2-A, RA. No. 166a)

Sec. 122 makes reference to Sec. 2-A of R.A. 166, as amended, the old Law on Trademarks, which states:

Sec. 2-A. Ownership of trademarks, tradenames and service marks; how acquired. -Anyone who lawfully produces or deals in merchandise of any kind or who engages in any -lawful business, or who renders any lawful service in commerce, by actual use thereof in manufacture or trade, in business, and in the service rendered, may appropriate to his exclusive use a trade-mark, a trade-name, or a service-mark not so appropriated by another, to distinguish his merchandise, business or service from the merchandise, business or services of others. The ownership or possession of a trade-mark, trade-name, service-mark, heretofore or hereafter appropriated, as in this section provided, shall be recognized and protected in the same manner and to the same extent as are other property rights known to the law."

In *Shangri-La International Hotel Management, Ltd., et al. v. Developers Group of Companies, Inc.*⁴ the Supreme Court defined the scope of Sec. 2-A of RA 166, thus:

x x x For, while Section 2 provides for what is registrable, Section 2-A, on the other hand, sets out how ownership is acquired. These are two distinct concepts.

Under Section 2, in order to register a trademark, one must be the owner thereof and must have actually used the mark in commerce in the Philippines for 2 months prior to the application for registration. Since 'ownership' of the trademark is required for registration, Section 2-A of the same law sets out to define how one goes about acquiring ownership thereof. Under Section 2-A, it is clear that actual use in commerce is also the test of ownership but the provision went further by saying that the mark must not have been so appropriated by another. Additionally, it is significant to note that Section 2-A does not require that the actual use of a trademark must be within the Philippines. Hence, under R.A. No. 166, as amended, one may be an owner of a mark due to actual use thereof, but not yet have the right to register such ownership here due to failure to use it within the Philippines for two months. (Underscoring supplied)

From this legal background it is clear that the right to register trademarks, trade names and service marks by any person, corporation, partnership or association domiciled in the Philippines or in any foreign country, is based on ownership, and the burden is upon the applicant to prove such ownership.⁵

In *Unno Commercial Enterprises, Inc. v. General Milling Corporation, et al.*⁶ the Supreme Court held that:

“The right to register trademark is based on ownership. When the applicant is not the owner of the trademark being applied for, he has no right to apply for the registration of the same. Under the Trademark Law only the owner of the trademark, trade name or service mark used to distinguish his goods, business or service from the goods, business or service of others is entitled to register the same.”

In this instance, the Opposer submitted evidence that it has appropriated and used the mark THE GO GIRLS earlier than Respondent-Applicant. In his Affidavit⁷, the Opposer explained that he is the dance choreographer/founder/manager of the dance group known as “THE GO GIRLS” and that he formed the dance group around July of 2003. To corroborate his claim of prior adoption of the mark since 2003, the Opposer presented photographs of the awards received by the GO GIRLS dance groups.⁸ CD sleeves of the music albums, photographs of the group’s performances, photographs of promotional materials for their provincial performances and certificates issued by the show Unang Hirit Show⁹ dated as early as December of 2003 to August of 2007. The printouts from The Go Girls website¹⁰ also show that the Opposer is the manager of the dance group.

With the evidence submitted by Opposer, the burden of evidence is shifted to the Respondent-Applicant. This Bureau notes however, that the Respondent-Applicant did not even file an Answer thereby, failed to rebut or contradict the Opposer’s evidence. The Respondent-Applicant failed to explain how she was able to come up with a similar mark for identical services. In fact, considering that she was a former co-manager of the GO GIRLS dance group, she was aware that the mark THE GO GIRLS has already been appropriated and used by the Opposer. As held by the Supreme Court in *American Wire & Cable Company v. Director of Patents*:¹¹

“Of course, as in all other cases of colorable imitations, the unanswered riddle is why, of the millions of terms and combinations of letters and designs available, the appellee had to choose those so closely similar to another’s trademark if there was no intent to take advantage of the goodwill generated by the other mark.”

5 *Marvex Commercial Co., Inc. v. Petra Hawpia*, G.R. No. L-19297, 22 December 1966 citing *Operators, Inc. vs. Director of Patents*

6 G.R. No. L-28554, 28 February 1993.

7 See Affidavit of Robert Catimbang

8 See Exhibits "8", "C" and "D-4".

9 See Exhibits "D" to "J" and "L" to "V".

10 See Exhibit "K".

11 G.R.No. L-26557, 18 Feb.1970

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. The intellectual property system is not a haven for people who would take advantage of the intellectual creation of others, whether a local resident or a foreigner.¹²

WHEREFORE, premises considered the instant opposition to Trademark Application Serial No. 4-2007-013169 is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2007-013169 be returned/together with a copy of this DECISION, to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.
Makati City, 30 July 2010.

NATHANIEL S. AREVALO
Director, Bureau of Legal Affairs
Intellectual Property Office