



ATE MY HEART INC.,  
Opposer,

-versus-

ABC DEVELOPMENT CORPORATION  
doing business under the name of  
ASSOCIATED BROADCASTING CORP.,  
Respondent-Applicant.

X-----X

} IPC No. 14-2011-00434  
} Opposition to:  
} Appln. Serial No. 4-2011-004422  
} Date Filed: 15 April 2011  
} TM: "LADY DADA & LOGO"

**NOTICE OF DECISION**

**DEL ROSARIO & DEL ROSARIO**  
Counsel for the Opposer  
15<sup>th</sup> Floor, Pacific Star Building  
Makati Avenue cor. Sen. Gil Puyat Avenue  
Makati City

**ABC DEVELOPMENT CORPORATION**  
c/o **CHRISTINE C. ONA**  
For Respondent-Applicant  
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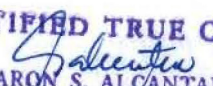
**GREETINGS:**

Please be informed that Decision No. 2013 - 139 dated July 23, 2013 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, July 23, 2013.

For the Director:

  
**Atty. PAUGI U. SAPAK**  
Hearing Officer  
Bureau of Legal Affairs

**CERTIFIED TRUE COPY**  
  
**SHARON S. ALCANTARA**  
Records Officer II  
Bureau of Legal Affairs, IPO



ATE MY HEART INC.,  
*Opposer,*

IPC No. 14-2011-00434  
Case Filed: 18 November 2011

-versus-

Opposition to:  
Appln. Serial No.: 4-2011-004422  
Date Filed: 15 April 2011

ABC DEVELOPMENT CORPORATION  
Doing business under the name of  
ASSOCIATED BROADCASTING CORP.,  
*Respondent-Applicant.*

TM: "LADY DADA & LOGO"

x-----x

Decision No. 2013- 139

## DECISION

ATE MY HEART INC ("Opposer")<sup>1</sup> filed on 18 November 2011 an opposition to Trademark Application Serial No. 4-2011-004422. The application, filed by ABC DEVELOPMENT CORPORATION doing business under the name ASSOCIATED BROADCASTING CORPORATION ("Respondent-Applicant")<sup>2</sup>, covers the mark "LADY DADA & LOGO" for entertainment services under Class 41 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer, alleges among other things the following:

1. The applied trademark "LADY DADA & LOGO" mimics and is confusingly similar with the famous name LADY GAGA earlier used and adopted professionally and artistically by famous lady singer Stefani Joanne Angelina Germanotta, which use dates back to about 01 September 2006.
2. The mark LADY GAGA owned by the Opposer is a well-known mark by almost any music listener.
3. The registration of the trademark LADY DADA & LOGO in the name of the Respondent-Applicant will violate the proprietary rights and interests of the

<sup>1</sup> A corporation duly organized under the laws of the State of California, U.S.A., with principal office at c/o Jeff Gillman, Gelfand, Renner and Feldman, LLP, 1880 Century Park East, Suite 1600, Los Angeles CA 90067.

<sup>2</sup> With address at 762 Quirino Highway, San Bartolome, Novaliches Quezon City, Metro Manila, Philippines.

<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.

Opposer over its well-known mark LADY GAGA and will therefore cause great and irreparable injury to the latter.

4. The registration of the trademark LADY DADA & LOGO in the name of Respondent-Applicant will mislead music listeners and consumers into thinking that the entertainment service or business is under the sponsorship of Opposer or by a subsidiary of Opposer, or is connected or related to Opposer.
5. The registration of the trademark LADY DADA & LOGO in the name of Respondent will run counter to Article 6bis and 8 of The Convention of Paris for the Protection of Industrial Property, otherwise known as the PARIS COVENTION.
6. The registration of the trademark LADY DADA & LOGO in the name of Respondent-Applicant will run counter to the 1999 Joint Recommendation Concerning Provisions on the Protection of Well-known Marks, wherein the World Intellectual Property Organization (WIPO) General Assembly and Paris Union agreed to a non-binding recommendation that a well-known mark should be protected in a country even if the mark is neither registered nor used in that country.

The Opposer's evidence consists of the following:

1. Annex "A" – Consent of Incorporator for Organization Meeting of Ate My Heart, Inc.;
2. Annex "B" – Affidavit of Joseph Germanotta;
3. Annex "Affidavit –A" – List of registrations and pending applications for the mark LADY GAGA in various countries;
4. Annex "Affidavit – B" – Registration No. 5405058 issued on 08 April 2011 for the mark LADY GAGA by the Patent Office of Japan;
5. Annex "Affidavit – B-1" – Registration No. 8634647 issued on 21 September 2011 for the mark LADY GAGA by the Patent Office of China;
6. Annex "Affidavit – B – 2" – Registration No. 3695038 issued on 13 October 2009 for the mark LADY GAGA by the Patent Office of the United States of America;
7. Annex "Affidavit – B – 3" – Registration No. 3960468 issued on 17 May 2011 for the mark LADY GAGA by the Patent Office of the United States of America;
8. Annex "Affidavit – C" – Application No. 2011-021592 filed on 28 March 2011 for the mark LADY GAGA at the Patent Office of Japan;
9. Annex "Affidavit – C – 1" – Application No. 45-201003464 filed on 13 August 2010 for the mark LADY GAGA at the Patent Office of South Korea;
10. Annex "Affidavit – C – 2" – Application No. 40-2011-49695 filed on 09 September 2011 for the mark LADY GAGA at the Patent Office of South Korea;
11. Annex "Affidavit – C – 3" – Application No. 8634649 filed on 03 September 2010 for the mark LADY GAGA at the Patent Office of China;
12. Annex "Affidavit – C – 4" – Application No. 9259022 filed on 25 March 2011 for the mark LADY GAGA at the Patent Office of China;

13. Annex "Affidavit – C – 5" – Application No. 9259021 filed on 25 March 2011 for the mark LADY GAGA at the Patent Office of China;
14. Annex "Affidavit – C – 6" – Application No. 9259020 filed on 25 March 2011 for the mark LADY GAGA at the Patent Office of China;
15. Annex "Affidavit – C – 7" – Application No. 9259019 filed on 25 March 2011 for the mark LADY GAGA at the Patent Office of China;
16. Annex "Affidavit – C – 8" – Application No. 9259018 filed on 25 March 2011 for the mark LADY GAGA at the Patent Office of China;
17. Annex "Affidavit – C – 9" – Application No. 9259017 filed on 25 March 2011 for the mark LADY GAGA at the Patent Office of China;
18. Annex "Affidavit – C – 10" – Application No. 9259016 filed on 25 March 2011 for the mark LADY GAGA at the Patent Office of China;
19. Annex "Affidavit – C – 11" – Application No. 9259015 filed on 25 March 2011 for the mark LADY GAGA at the Patent Office of China;
20. Annex "Affidavit – C – 12" – Application No. 9259037 filed on 25 March 2011 for the mark LADY GAGA at the Patent Office of China; and
21. Annex "Affidavit – D" – Copy of printouts of Opposer's website.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 12 January 2012. However, the Respondent-Applicant did not file the required verified answer, hence Order No. 2012-1587 dated 10 December 2012 was issued declaring Respondent-Applicant in default and the instant opposition is deemed submitted for Decision based on the opposition and evidence submitted by the Opposer.

Should the Respondent-Applicant's trademark application be allowed?

It is 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 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 products<sup>4</sup>.

Records show that at the time the Respondent-Applicant filed its trademark application on 15 April 2011, the Opposer has already registered its mark LADY GAGA and likewise has pending trademark registrations in various countries of the world<sup>5</sup> covering the goods under Classes 3, 9, 14, 16, 18, 25, 35 and 41. In the United States, the Opposer's mark LADY GAGA has been registered under Reg. No. 3,695,038 issued on 13 October 2009 for entertainment services namely, performances and public appearances by a live musical artist and providing non-downloadable prerecorded music on line under Class 41<sup>6</sup>. And, in the Philippines, the Opposer has filed the registration of the mark LADY GAGA FAME on 03 October 2011 under Application Serial No. 4-2011-501466 covering the goods under Class 3.

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<sup>4</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

<sup>5</sup> Annex "Affidavit – A".

<sup>6</sup> Annex "Affidavit – B – 2".



Aptly, the Opposer has established the extent of the protection over its mark through trademark application and registrations in many countries, the international use and promotion thereof in music, digital music, concerts, prints, and internet and other types of media. In this regard, Rule 102 of the Trademark Regulations provides:

Rule 102. *Criteria for determining whether a Mark is Well-known.* In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion, of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is well-known mark.

In this instance, a combination at least of the abovementioned criteria is present or conscious in order for the Opposer's mark to be considered well-known.

In this regard, Sec. 123.1 par (e) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides:

- (e) is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark.*

The competing marks are shown below:

LADY GAGA



Opposer's Mark

Respondent-Applicant's Mark

Jurisprudence says that a practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of the prospective buyer. The trademark complained should be compared and contrasted with the purchaser's memory of the trademark said to be infringed. Some factors such as sound; appearance; form, style, shape, size or format; color, idea connoted by the mark; the meaning, spelling and pronunciation of the words used; and the setting in which the words used; may be considered for indeed, trademark infringement is a form of unfair competition.<sup>7</sup>

This Bureau noticed that the competing marks are both composed of two (2) words. Their first component is the word "LADY" which is exactly the same in composition, spelling, and meaning as well as to sound. Their second component although not exactly identical, however, they are almost exactly the same in sound and appearance. In sum, the two marks are confusingly similar. There is a slight distinction, nevertheless, such variance is insignificant because it will not diminish and/or avoid the likelihood of the occurrence of mistake, confusion or even deception cannot be avoided. The goods or services covered by the Opposer's trademark more particularly entertainment services are practically similar to those indicated in the Respondent-Applicant's trademark application such as entertainment services under Class 41 of the International Classification of Goods and Services. Consumers, particularly, patrons or fans of popular music or entertainment will likely assume, that the Respondent-Applicant's mark is just a variation of or related to the Opposer's and/or the goods or services originate or provided by one party alone or the parties themselves are connected or associated with one another which in fact there is none. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof as held by the Supreme Court<sup>8</sup>:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

<sup>7</sup> Clarke v. Manila Candy Co. 36 Phil. 100, 106; Co Tiong SA v. Director of Patents 95 Phil. 1, 4.

<sup>8</sup> Converse Rubber Corporation v. Universal Rubber Products, Inc. et.al. G.R. No. L-27906, 08 Jan. 1987.

The public interest, therefore, requires that two marks, identical to or closely resembling each other and used on the same and closely related goods or services, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception and even fraud should be prevented.

The mark LADY GAGA consists of a name identifying a particular living individual whose consent is needed for the opposed mark subject of the instant opposition to be registered. The name LADY GAGA has achieved worldwide popularity as belonging to the famous American pop singer and songwriter STEFANI JOANNE ANGELINA GERMANOTTA.

It is inconceivable therefore for the Respondent-Applicant to have come up with the mark "LADY DADA & LOGO" without having been inspired by or motivated by an intention to imitate the Opposer's mark. It is highly improbable for another person to come up with an identical or nearly identical mark for use on the same or related goods purely by coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combinations of letters are available, the Respondent-Applicant had come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.<sup>9</sup>

It is stressed that the Law on Trademarks and Tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster and not to hamper competition, no one especially a trader, is justified in damaging or jeopardizing other business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another.

**WHEREFORE**, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-004422 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 23 July 2013.

  
**ATTY. NATHANIEL S. AREVALO**  
*Director IV*  
*Bureau of Legal Affairs*



/pausi/joanne

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<sup>9</sup> American Wire and Cable Co. v. Director of Patents, et.al. (SCRA 544) G.R. No. L-26557, 18 February 1970.