ASAHI KOGAKU KOGYO KABUSHIKI KAISHA Opposer,	}	IPC No. 14-2002-00016 Opposition to: Appln. Ser No. 85707 Date Filed: April 23, 1993
-versus-	}	
PENTAX, S.P.A. of VERONELLA VERONA, ITALY Respondent-Applicant,	}	TM: "PENTAX" Decision No. 2005-04

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DECISION

The instant case is an Opposition filed by Asahi Kogaku Kogyo Kabushiki Kaisha ("Opposer"), a corporation duly organized and existing under the laws of Japan with office address at 36-9 Maeno-Cho, 2 Chome, Itabashi, Tokyo, 174 Japan against Application Serial No. 85707 for the registration of the trademark PENTAX for Centrifugal Pumps, filed by herein Respondent-Applicant, Pentax, S.P.A. of Veronella Verona, Italy.

The application was published in Vol. IV No. 10 of the Official Gazette which was officially released for circulation on January 17, 2002.

On February 15, 2002, as Opposition to Application Serial No. 85707 was filed before this Office by Opposer's Counsel and thereafter, on May 16, 2002 the required Verified Opposition was filed in this Office.

The grounds for Opposition to the registration of the mark are as follows:

"1. The trademark "PENTAX" is identical and confusingly similar with Opposer's coined word mark "PENTAX" being in use not only in the Philippines but also in various countries of the world since1957 up to the present for various photographic, optical, surveying, cinematographic, medical, electrical and electronic machines, equipment, apparatus and instruments, including parts, spare parts, and/or accessories thereof.

"2. The coined trademark "PENTAX" is a registered mark in the name of Opposer in the Philippines having filed with the application for its registration in the country in 1984 with the Certificate of Registration therefore (with No. 40867) having been issued in 1988; in addition the said mark "PENTAX" is likewise registered in various countries of the world.

"3. The trademark "PENTAX" applied for by the respondent-applicant is well-known and has been in use in the Philippines and in various countries spanning all of the continents of the world long before the respondent-applicant's unauthorized use of the said subject word mark "PENTAX" which is identical with Opposer's trademark "PENTAX" for goods mentioned above.

"4. By virtue of the provisions of the Paris Convention for the Protection of Intellectual Property of which the Philippines is a member country, and under the New Intellectual Property Code of the Philippines, the Philippine Government and the IPO is bound to protect Opposer's trademark "PENTAX" by rejecting the application for registration of respondent-applicant.

"5. The registration of Opposer's coined trademark "PENTAX" in the name of Registrant-Applicant will run counter to the provisions of the New Intellectual Property Code of the Philippines as well as the ruling barring the registration of

well-known or world famous trademarks or their derivatives such as the Opposer's trademark, "PENTAX" in the name of the third parties the obvious purpose of which was to ride on the goodwill of such well-known or world famous marks.

"6. The registration of the trademark "PENTAX" in the name of Respondent-Applicant in violation of opposer's propriety rights and interest on the same mark will mislead the general public to believe that Opposer has extended its business into the field of business of respondent-applicant and is now engaging in the manufacture of Centrifugal Pumps, and/or that respondent-applicant's business is in anyway connected with the Opposer's business activities or, that the respondent-applicant is subsidiary of Opposer company.

"7. The registration of the trademark "PENTAX" in the name of respondent-applicant will cause only confusion and/or the likelihood of confusion as to the business itself of respondent-applicant and mostly as to its source and mislead the public, but also would make it more convenient for the respondent-applicant to pass off its business as to those of opposer's or, at the very least, connected or emanating from the authority given by the Opposer which definitely would result in damage and/or prejudice the interest of both the public and the Opposer.

"8. The registration of the trademark "PENTAX" in the name of respondent-applicant will violate the property rights and interest of Opposer over its trademark "PENTAX" that would undoubtedly result and/or cause great and irreparable injury to the Opposer's mark "PENTAX" as well as its right and interest thereon as the general public would not think much of photographic optic, surveying, cinematographic, medical, electrical & electronic machines and equipment, apparatus and instruments and their respective parts of the mark PENTAX use thereon is, in anyway whatsoever, associated with "centrifugal pumps" of respondent-applicant that do not connote quality and accuracy and sophistication for which the mark "PENTAX" has become well-known internationally with respect to products it represent thereby diluting the PENTAX mark's effectivity and strength to the damage and prejudice of the opposer as owner registrant of PENTAX.

"9. Further, the registration of the mark of opposer's "PENTAX" in the name of Respondent-Applicant will not only necessarily result in the weakness of the coined mark "PENTAX" of Opposer as stated above, result in further damage to the proprietary rights and interest of Opposer on its mark but also dilute its effectiveness which under the prevailing laws as well as under the provisions of the Treaty of Paris for the Protection of Industrial Property mentioned above, are supposed to be protected."

To support its Opposition, Opposer relied on the following facts:

"a. Opposer is a manufacturing company that is engaged in the manufacture and sale of photographic, cinematographic, optical, surveying, medical, electrical, and electronic machines, apparatus, and equipment, cameras, etc. including parts, spare parts and accessories thereof;

"b. Opposer has various establishments all over the world, either through its duly authorized licensees or distributors which are licensed not only to use the coined word mark "PENTAX" but which are also authorized and licensed to manufacture and sell promotional products bearing the said mark "PENTAX";

"c. The trademark "PENTAX" of Opposer is a well-known and world famous mark and has worldwide registration and/or applications for registration in various countries of the world;

"d. By and through printed and/or TV and radio advertisements and sponsorships of world events in the field of photography, sports and other fields of interest, and by the reputation that precedes it in any part of the world as a product of excellence when ever the mark is seen attached to or used to identity a product o which product, the mark "PENTAX" is attached was made world-class products and the mark itself a world class mark of good repute;

"e. Opposer's trademark has been in use much earlier than that of respondent-applicant and it continued to be used up to the present that said mark "PENTAX" enjoys a good reputation and goodwill for the high quality which it services and products represent and with which its service and products are usually associated with;

"f. Respondent-applicant's "PENTAX" is but an identical imitation of Opposer's coined mark "PENTAX";

"g. The application for registration of "PENTAX" by respondent-applicant was obviously intended to ride on the goodwill of Opposer's would famous mark "PENTAX" and;

"h. The registration of the mark "PENTAX" of respondent-applicant would diminish the distinctiveness and strength of Opposer's mark which the public has already identified and associated with the opposer's products and services and such registration would work to the Opposer's prejudice and damage not mentioning the violation of Opposer's rights and interest over its mark "PENTAX"

Immediately, a Notice to Answer the Verified Notice of Opposition dated June 6, 2002 was sent to the herein Respondent-Applicant. However, for failure to file the required Answer to the Verified Notice of Opposition despite notice thereof, Respondent-Applicant was declared in DEFAULT per Order No. 2003-171 dated April 28, 2003.

Pursuant to Order of Default, Opposer presented its evidence ex-parte consisting of Exhibits "A" to "E" inclusive of submarkings.

The issues to be resolved in this case are:

a) WHETHER OR NOT CONFUSING SIMILARITY EXISTS BETWEEN OPPOSER'S MARK PENTAX FOR CENTRIFUGAL PUMPS; AND

b) WHETHER OR NOT RESPONDENT-APPLICANT'S MARK TARNISHES THE IMAGE OF OPPOSER'S MARK.

Since the challenged application was filed under the Old Trademark Law or R.A. 166, the instant case shall be decided on the provisions thereof so as not to prejudice the rights vested by said law upon the parties herein. The applicable provisions of R.A. 166 provides:

"Sec. 4. Registration of trademarks, trade names and service marks in the principal register – xxx The owner of a trademark, trade name or service mark to distinguish his goods, business or services of others shall have the right to register the same on the principal register, unless it: xxx

"(d). Consists of or comprises a mark or trade name which so resembles a mark or trade name registered in the Philippines by another and not

abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or deceive purchaser." *(underscoring ours)*

In determining whether the trademarks are confusingly similar, a comparison of the words is not the only determinant factor. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other (FRUIT OF THE LOOM, INC. VS. COURT OF APPEALS AND GENERAL GARMENTS CORPORATION, G.R. NO. L-32747. NOVEMBER 29, 1984.)

Applying the foregoing rule, it appears that both Opposer and Respondent-Applicant uses the dominant word-mark "PENTAX" however, the degree of similarity ends here. A closer examination of Respondent-Applicant's mark "PENTAX" discloses that it gives a different visual and commercial impression when compared to the mark of the Opposer as shown below

PENTAX

OPPOSER'S MARK

RESPONDENT'S MARK

A comparison between the two marks would show the difference between the two marks:

(a) In Respondent-Applicant's "Pentax" only the letter "P" is in upper case while the Opposer's "PENTAX" marks, all the letters are in upper case;

(b) Both trademarks are written in entirely different fonts;

(c) Respondent-Applicant's mark, the word "Pentax" is contained in a rectangle and on one end the letters "P" and "e" is further enclosed by a substantially stylized pentagon whereas Opposer's mark is just a simple word mark.

In this connection, the placement of Respondent-Applicant's mark within other identifying but prominent figures becomes relevant. Here it shows that Respondent-Applicant plans to use the name "Pentax" within a prominent rectangular box. In addition, on one end the word "Pentax" will be contained in a prominently displayed stylized pentagon. Thus, the two marks appear in strikingly different contexts and project wholly different visual displays. Therefore, although the two marks have similar word mark, in all likelihood the appearance and visual context in which Respondent-Applicant's "Pentax" mark appears will distinguish the marks in the consumer's mind.

More importantly, the non-existence of confusingly similarity on the trademark of both parties is further compounded by the fact that the goods or products covered by Respondent-Applicant's trademark differs from those of the Opposer's as they belong to an entirely different class. Respondent-Applicant's centrifugal pumps belong to Class 7 while Opposer's goods namely, physical and chemical, medical, measuring, photographic and educational apparatus and instruments; eye glasses and calculating machines and their parts, belong to Classes 9 and 10, hence, there is no factual basis to hold that Respondent-Applicant's trademark is confusingly similar with Opposer's trademark.

In the case of PHIL. REFINING CO., INC. VS. NG SAM *(115 SCRA 472)*, the Supreme Court stated:

> "The right to a trademark is limited one, in the sense that others may use the same mark on unrelated goods. The mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description."

This was reiterated in the case of FABERGE, INC. VS. IAC *(215 SCRA 316):*

> "One who has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others for products which are of a different description. xxx The certificate of registration issued by the Director of Patents can confer upon the Petitioner the exclusive right to use its own symbol only on those goods specified in the certificate, subject to any condition and limitation stated therein".

Finally in CANON KABUSHIKI KAISHA VS. *(G.R. NO. 120900, 20 JULY 2000)*, the Supreme Court again ruled that the certificate of registration confers upon the trademark owner the exclusive right to use its own symbol only to those goods specified in the certificate.

To bolster the instant Opposition, Opposer claims that Respondent-Applicant mark tarnishes the image of Opposer's mark. We disagree.

A trademark may be tarnished when it is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context with the result that the public will associate the lack of quality of prestige in the defendant's goods with the plaintiff's goods. The mark may also be tarnished if it loses its ability to serve as a "wholesome identifier" of plaintiff's product. *(HORMEL FOODS CORP. vs. JIM HENSON PRODS., 73 F. 3d 497 (2d Cir. 1996)*

The sine qua non of tarnishment is a finding that plaintiff's mark will suffer negative associations through defendant's use. *(HORMEL FOODS CORP. vs. JIM HENSON PRODS., 73 F. 3d 497 (2d Cir. 1996)* However, Opposer's claim are just bare allegations unsupported by clear and convincing evidence that Respondent-Applicant's use of the mark will cause negative associations. Moreover, Respondent-Applicant's goods are non-competing or dissimilar which makes it unlikely that it will gain from the tarnishment of the mark. Therefore, We find that there is no likelihood of tarnishment.

WHEREFORE, in view of the foregoing, the Notice of Opposition filed by the Opposer is, as it is hereby DENIED.

Considering however that, as shown by the records, Respondent-Applicant, despite due notice failed its Answer to the Notice of Opposition nor filed any motion to lift the Order of Default, Respondent-Applicant's act is indicative of its lack of interest in its application, thus, it is deemed to have voluntarily abandoned the same.

Moreover, under Rule 602 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers, the law imposes upon the Respondent-Applicant the duty to look after his own interest in the prosecution of his application. On the contrary, the applicant in this case appears to have no interest in defending his application which is the subject of this Notice of Opposition.

IN VIEW THEREOF, Application Serial No. 85707 for the mark "PENTAX" used for Centrifugal Pumps under class 7 filed on April 23, 1993 by Respondent-Applicant, PENTAX, S.P.A. of VERONELLA VERONA, ITALY is hereby considered VOLUNTARILY ABANDONED/WITHDRAWN for Respondent's lack of interest to prosecute subject application.

Let the filewrapper of PENTAX subject matter of this case be forwarded to the Administrative, Financial and Human Resources Development Services Bureau (AFHRDSB) for

appropriate action in accordance with this decision with a COPY furnished the Bureau of Trademarks (BOT) for information and to update its record.

SO ORDERED.

Makati City, January 31, 2005.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office