

HOPEWELL PLASTIC LAMINATES,	}	Inter Partes Case No. 14-2002-00041
<i>Opposer,</i>	}	Opposition to:
	}	
	}	
-versus-	}	App. Ser. No. : 4-1998-009320
	}	Date Filed : 23 December 1998
	}	Trademark : "OMEGA"
NICHIAS CORPORATION	}	
<i>Respondent-Applicant.</i>	}	
x-----x		Decision No. 2009-123

### DECISION

For decision is the Verified Notice of Opposition filed by Hopewell Plastic Laminates Limited (hereinafter referred to as Opposer), a corporation organized and existing under the laws of Hong Kong with address at 3<sup>rd</sup> Floor, Hopewell Logistics Centre, 2-12 Wing Kei Road, Kwai Chung, New Territories, Hong Kong against Application Serial No. 4-1998-09320 filed on 23 December 1998 for the mark "OMEGA" covering goods under class 19 namely: "Floor boards, concrete building elements, floor tiles not of metal, slabs not of metal, surfacing not of metal, for buildings, concrete flooring blocks, concrete panels, non-metallic floor coverings for finishing semi-finished floors, non-metallic fascias, ramps being structures of non-metallic materials" filed by Nichias Corporation (hereinafter referred to as respondent-applicant), a corporation organized and existing under the laws of Japan, with address at 1-26, Shiba-daimon, 1-Chome Minato-Ku, Tokyo, Japan.

The grounds for the opposition are as follows:

4. Opposer believes that it would be damaged by the registration of the mark "OMEGA" in the name of Respondent-Applicant for which reason it opposes said application on the following grounds and facts:
  - 4.1. Opposer is the true owner of the mark OMEGA as it can trace its ownership and its right to use the said mark as early as 1974, or for over twenty-eight (28) years.
  - 4.2. Opposer and the mark OMEGA are internationally well-known by reason of the long use of the mark OMEGA by Opposer, and the worldwide applications and registrations of the said mark.
  - 4.3. Opposer has in its name several applications and registrations for the mark OMEGA in various countries in the world most if not all are members of the Paris Convention and/or World Trade Organization. Among the countries where mark OMEGA is registered in Class 19 under the name of Opposer or its related companies are as follows:

- a. Hong Kong
- b. United States of America
- c. Israel
- d. China
- e. Macau

Most of the above-listed applications and registrations were filed earlier than 23 December 1998, the date of filing of Respondent-Applicant's application. Opposer reserves its right to present copies of the certificates of trademark registrations obtained from, and applications filed in, the countries mentioned above and in other countries during the course of the proceedings.

- 4.4. The mark OMEGA sought to be registered by Respondent-Applicant is identical with the mark owned and being used by the Opposer. The similarity of the two (2) marks is likely to deceive purchasers of goods on which it is to be used to an extent that said goods might be mistaken by the unwary public to be manufactured by the Opposer. It might mislead the public as to the nature, quality, characteristic and origin of the goods on which it is affixed, especially since the goods on which Opposer's mark is being used, which are "plywood plastic laminated sheets, louver door, partition-boards and plastic boards all for use in construction and decoration, high pressure decorative laminate special papers impregnated with resins in the form of sheets for further manufacture into building materials, namely, kitchen cabinets, furnitures, wall panels, counter tops, table tops, desk tops, and work surfaces; and laminate sheets made from special papers impregnated with resins with a wood grain finish to use as a wood substitute in the manufacture of kitchen cabinets, furnitures, wall panels, counter tops, table tops, desk tops and work surfaces", is related to, if not the same as, the goods on which Respondent-Applicant uses its mark.

- “5. Under the Intellectual Property Code and relevant Philippine jurisprudence, the government of the Republic of the Philippines is bound to protect Opposer's trademarks by rejecting the application for registration of an identical mark such as the mark OMEGA sought to be registered by Respondent-Applicant.

5.1. Section 123 (e) and (g) of the Intellectual Property Code provides:

“SEC. 123. *Registrability* – 123.1. A mark cannot be registered if it:

x      x      x

(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 a 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;

x      x      x

(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;”

- “6. Respondent-Applicant’s application for registration of the mark OMEGA is tantamount to fraud as the use of the said mark on the goods described in the application clearly infringes upon the established rights of the Opposer.
- “7. The registration of the mark OMEGA in the name of Respondent-Applicant will violate the proprietary rights/interests, business reputation and goodwill of the Opposer over its trademark, considering that the distinctiveness of the said mark will be diluted, thereby causing irreparable injury to the Opposer.
- “8. Finally, the registration of the mark OMEGA, which is identical with Opposer’s trademark, will not prejudice the Opposer, but will also cause Respondent-Applicant to unfairly benefit from, and get a free ride on, the goodwill of Opposer’s trademark and business reputation.

A Notice to Answer was sent by registered mail on 8 October 2002. In the Answer filed on 27 November 2002, respondent-applicant raised the following special and affirmative defenses, to wit:

“14. The verified Notice of Opposition is defective in form and substance in that Opposer did not attach hereto copies of certificate or registrations or the supporting documents relevant to its claim and allegations, contrary to Section 134 of the Intellectual Property Code of the Philippines (“IPC”) which 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. 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.” (Underscoring supplied)

“15. Section 122 of the IPC provides that “the rights in mark shall be acquired through registration made validly in accordance with the provisions” of the IPC. Opposer has no registration for the mark OMEGA in the Philippines. Its Philippine application for OMEGA was filed only on June 25, 2001, two (2) years and six (6) months after Respondent-Applicant herein has filed the subject application.

“16. Opposer does not qualify as an owner of a well-known mark. Section 123.1 (e) of the IPC clearly prescribes the following elements, absent which will not entitle the claimant to the benefit of the said law, i.e., that the claimant’s mark: (a) must have been considered by a competent authority of the Philippines to be well-known, (b) must be well-known internationally, and (c) must be well-known in the Philippines, and (d) that the offending mark is used for identical or similar goods or services. Section 123.1 (e) provides:

“x x x A mark cannot be registered if it:

x x x

(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 a

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; x x x” (*Underscoring Supplied*).

- “17. The above-quoted Section 123.1 (e) of the IPC clearly requires that claimant’s mark is well-known both internationally and in the Philippines. It further requires that knowledge in the Philippines may be obtained as a result of the promotion of the mark. Allegations as to these minimum qualifying requirements for a well-known status is fatally omitted by Opposer in its Verified Notice of Opposition. In fact, in no part of the pleading mentioned is there a specific allegation made by Opposer that it has used or advertised or that it is using or advertising the mark OMEGA in the Philippines. Neither is there a specific allegation that Opposer’s mark OMEGA is well-known in the Philippines on account of advertising efforts made by the Opposer.
- “18. Opposer admits that not all applications filed in the countries cited, i.e., Hong Kong, U.S.A., Israel, China and Macao have matured to registrations. Mere applications generally do not give rise to legal rights whether in Philippines or in the foreign countries where issued.
- “19. Even assuming *arguendo* that registrations have already issued in the aforementioned countries, Opposer admits that not all of them are issued in its name. Absent the valid execution and recordal of an appropriate document of assignment or license by registrant in favor of Opposer, the latter cannot validly derive the legal rights/interests arising from such registrations.
- “20. Opposer miserably failed to allege in its Verified Notice of Opposition facts that will support its claim for protection under the criteria for well-known mark prescribed by Rule 102 of the Rules and Regulations on Trademarks which provides as follows:

“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 which the Philippines and in other countries, of the goods and/or services to which the mark applies;
- c.) the degree of inherent or acquired distinction of the mark;
- d.) the quality0image 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 a well-known mark.”

“21. Respondent right to the use and registration for the mark OMEGA in the Philippines preceded that of Opposer. Being the first use in good faith of the mark OMEGA in the Philippines and being the first to apply for the same in the Philippines, Respondent’s right is superior to the right claimed by Opposer herein. In fact Respondent has already filed a notarized Declaration of Actual Use for the goods covered by the subject application, a photocopy of which is herewith attached and marked as Annex 1 hereof and made an integral part hereof.

- “22. Being the prior user and the first applicant of the mark OMEGA in the Philippines, Respondent and not Opposer who has established a goodwill for the subject mark in the Philippines and it is Respondent who stands to be damaged and prejudiced if the subject application is disallowed. Having established the requisite goodwill in the consciousness of the Philippine consumers, Respondent has been recognized as the legitimate source and origin of the OMEGA products in connection with the goods covered by the subject application. Therefore, the public stands to be misled, deceive and confused if this opposition is given due course and Opposer given the right to use and register the mark OMEGA in the Philippines at the expenses of the Respondent herein.
- “23. Respondent and not Opposer herein is the rightful owner of the mark OMEGA, its ownership arising from its adoption, use, registration and promotion of the subject mark not only in the Philippines but also in other foreign countries. Respondent reserves the right to present in evidence documents supporting its ownership claims to the subject mark.

Opposer formally offered the following evidence to wit:

Exhibit	Description
“A” to “A-7”	Notarized and legalized Affidavit dated 02 September 2003 executed by Lam Ying Wai Patrick.
“B”	Certified copy of Certificate of Incorporation of Omega Laminates Limited.
“C” to “C-5”	Certified copy of the companies Registry Annual Return dated 13 April 2007 filed by Hopewell Plastic Laminates Limited with the Hong Kong Companies Registry.
“D” to “D-6”	Certified copy of Deed of Assignment dated 20 November 2001 of Hong Kong Trademark Registration Nos. 1131 and 1132 executed by Lam Sia-Yuen, formerly trading as Hopewell Plastic Laminates Limited.
“E” to “E-1”	Certificate of Registration No. 1131 for the mark “OMEGA” issued by the Hong Kong Registrar General’s Department, Trade Marks Registry on 25 June 1981 in favor of Sheng Kee Enterprises Co., Ltd.,
“E-2”	Renewal of Hong Kong Trademark Registration No. 1131 for the mark “OMEGA”
“F” to “F-5”	Certified copy of the Companies Registry Annual Return dated 07 February 2003 filed by the Opposer, Hopewell Plastic Laminates Limited, with the Hong Kong Companies Registry.
	Certified copy of the Companies Registry Annual

"G" to "G-6"	Return dated 13 August 2002 filed by the Opposer, Hopewell Plastic Laminates Limited, with the Hong Kong Companies Registry
"H" to "H-55"	Copy of a page of brochure/ magazine/ catalogue which the Opposer, Hopewell Plastic Laminates Limited, uses to promote its products bearing the mark "OMEGA" in various countries
"H-56"	Certified copy of Hopewell Plastics Limited Invoice No. BB028896 dated 08 August 1996
"H-57", "H-58"	Certified copy of Hopewell Plastics Limited Invoice No. BB028299 dated 06 August 1996 Certified copy of Hopewell Plastics Limited Invoice No. BB025748
"H-59"	Certified copy of Hopewell Plastics Limited Invoice No. 961126 dated 26 November 1996
"H-60", "H-61"	Certified copy of Bill of Lading No. EEL/BKK-0112296 dated 22 November 1996 Certified copy of Application/Collection Order dated 26 November 1996
"H-62"	Certified copy of Hopewell Plastics Limited Packing List dated 26 November 1996
"H-63"	Certified copy of Hopewell Plastics Limited Certificate of Origin dated 26 November 1996
"H-64"	Certified copy of Hopewell Plastics Limited Certificate /List of Weight dated 26 November 1996
"H-65"	Certified copy of Shipping Order No. EEL/BKK-01125 dated 20 November 1996
"H-66"	Certified copy of letter dated 05 November 1996 from Wanlop Arunyakasem to Hopewell Plastics Limited
"H-67"	Page 2 of letter dated 05 November 1996 from Wanlop Arunyakasem to Hopewell Plastics Limited
"H-68"	Certified copy of letter dated 12 November 1996 from Wanlop Arunyakasem to Hopewell Plastics Limited
"H-69"	Certified copy of Application for Opening of a Documentary Credit dated 08 November 1997
"H-70"	Certified copy of Hopewell Plastics Limited Invoice No. 970317 dated 17 March 1997
"H-71"	Certified copy of Bill of Lading No. KEL-006 dated 17 March 1997
"H-72"	Certified copy of Shipping Order No. KEL-006 dated 11 March 1997
"H-73"	Certified copy of Invoice No. 97OS-43 dated 06 March 1997
"H-74"	Certified copy of letter dated 05 March 1997
"H-75"	Certified copy of letter dated 06 March 1997
"H-76"	Certified copy of Invoice No. 970808 dated 08 August



	1997
"H-77"	Certified copy of Hopewell Plastics Limited Packing List dated 08 August 1997
"H-78"	Certified copy of Telegraphic Transfer dated 06 August 1997 in the amount of HKD 16,200.00
"H-79"	Certified copy of House Air Waybill No. HKG-019105 dated 13 August 1997
"H-80"	Certified copy of letter from Sally Teoh to Hopewell Plastics Limited dated 06 August 1997
"H-81"	Certified copy of Hopewell Plastics Limited Invoice No. 960727 dated 27 July 1996
"H-82"	Certified copy of House Air Bill No. 5274 dated 27 July 1996
"H-83"	Certified copy of letter dated 23 July 1996 from Triple K Enterprise to Hopewell Plastics Limited
"H-84"	Certified copy of Hopewell Plastics Limited Invoice No. BB159335 dated 29 June 1998
"H-85"	Certified copy of Hopewell Plastics Limited Invoice No. BB159335 dated 29 June 1998
"H-86"	Certified copy of Hopewell Plastics Limited Invoice No. BB159678 dated 30 June 1998
"H-87"	Certified copy of Hopewell Plastics Limited Invoice No. BB170145 dated 07 September 1998
"H-88"	Certified copy of Multi-Rich Home Decors, Inc., Purchase Order No. 98-0008 dated 22 August 1998
"H-89"	Certified copy of Hopewell Plastics Limited Invoice No. 971222 dated 22 December 1997
"H-90"	Certified copy of Hopewell Plastics Limited Packing List
"H-91"	Certified copy of letter dated 02 December 1997 from PG Bison to Hopewell Plastic Limited
"H-92"	Certified copy of Shipping Order
"H-93"	Certified copy of Hopewell Plastics Limited Invoice No. OSY2000153 dated 13 September 2002
"H-94"	Certified copy of Hopewell Plastics Limited Order Sheet dated 13 September 2002
"H-95"	Certified copy of Bill of Lading No. WK/JKT-7684 dated 13 September 2002
"H-96"	Certified copy of Hopewell Plastics Limited Packing List dated 05 January 2000
"H-97"	Certified copy of Hopewell Plastics Limited Invoice No. DOY0004551 dated 30 November 2000
"H-98"	Certified copy of Air Waybill dated 30 November 2008
"H-99"	Certified copy of Hopewell Plastics Limited Invoice No. 000105 dated 05 January 2000
"H-100"	Certified copy of Certificate of Origin – Re-export No. 0145634

"H-101"	Certified copy of letter from Wylie Chan to Hopewell Plastics Limited dated 24 January 2000
"H-102"	Certified copy of Application for Amendments to Documentary Credit dated 17 December 1999
"H-103"	Certified copy of letter dated 26 January 2000 from Wylie Chan to Hopewell Plastics Limited
"I"	Certified copy of Certification dated September 2003 issued by Ma. Theresa B. Dizon-De Vega, Consul of the Philippine in and for Hong Kong SAR
"I-1"	Certified copy of letter dated 11 June 1994 from Norman Chow to Joseph Ang of Multi Rich Home Decors, Inc.
"I-2"	Certified copy of letter dated 10 June 1994 from Joseph Ang of Multi Rich Home Decors, Inc.
"I-3"	Certified copy of Hopewell Plastics Limited Invoice No. BB159335 dated 29 June 1998
"I-4"	Page 2 of certified copy of Hopewell Plastics Limited Invoice No. BB159335 dated 29 June 1998
"I-5"	Certified copy of Hopewell Plastics Limited Invoice No. BB159678 dated 30 June 1998
"I-6"	Certified copy of Hopewell Plastics Limited Invoice No. BB170145 dated 07 September 1998
"I-7"	Certified copy of Hopewell Plastics Limited Invoice No. BB189515 dated 20 January 1999
"I-8"	Certified copy of Hopewell Plastics Limited Invoice No. OS99000026 dated 02 June 1999
"I-9"	Copy of Multi Rich Home Decors, Inc., Purchase Order dated 12 May 1999
"I-10"	Certified copy of Hopewell Plastics Limited Invoice No. OS99000202 dated 18 November 1999
"I-11"	Certified copy of Hopewell Plastics Limited Invoice No. OS99000090 dated 06 August 1999
"I-12"	Copy of Multi Rich Home Decors, Inc., Purchase Order dated 02 August 1999
"I-13"	Certified copy of Hopewell Plastics Limited Invoice No. OS 99000202 dated 18 November 1999
"I-14"	Copy of letter dated 09 November 1999 from Hopewell Plastics Limited to Multi Rich Home Decors, Inc.
"I-15"	Certified copy of Hopewell Plastics Limited Invoice No. OS99000219 dated 17 December 1999
"I-16"	Page 2 of certified copy of Hopewell Plastics Limited Invoice No. OS99000219 dated 17 December 1999
"I-17"	Page 3 of certified copy of Hopewell Plastics Limited Invoice No. OS99000219 dated 17 December 1999
"I-18"	Copy of Multi Rich Home Decors, Inc Purchase

	Requisition Slip dated 04 December 1999
"I-19"	Certified copy of Hopewell Plastics Limited Invoice No. OS99000290 dated 10 March 2000
"I-20"	Page 2 of certified copy of Hopewell Plastics Limited Invoice No. OS99000290 dated 10 March 2000
"I-21"	Page 3 of certified copy of Hopewell Plastics Limited Invoice No. OS99000290 dated 10 March 2000
"I-22"	Copy of Multi Rich Home Decors, Inc. purchase order signed by Levi S. Ang, Executive Vice-President
"I-23"	Certified copy of Hopewell Plastics Limited Invoice No. OSY0000219 dated 08 September 2000
"I-24"	Page 2 of certified copy of Hopewell Plastics Limited Invoice No. OSY0000219 dated 08 September 2000
"I-25"	Page 3 of certified copy of Hopewell Plastics Limited Invoice No. OSY0000219 dated 08 September 2000
"I-26"	Page 4 of certified copy of Hopewell Plastics Limited Invoice No. OSY0000219 dated 08 September 2000
"I-27"	Page 5 of certified copy of Hopewell Plastics Limited Invoice No. OSY0000219 dated 08 September 2000
"I-28"	Certified copy of Hopewell Plastics Limited Invoice No. OSY0000361 dated 30 December 2000
"I-29"	Page 2 of certified copy of Hopewell Plastics Limited Invoice No. OSY0000361 dated 30 December 2000
"I-30"	Page 3 of certified copy of Hopewell Plastics Limited Invoice No. OSY0000361 dated 30 December 2000
"I-31"	Page 4 of certified copy of Hopewell Plastics Limited Invoice No. OSY0000361 dated 30 December 2000
"I-32"	Page 5 of certified copy of Hopewell Plastics Limited Invoice No. OSY0000361 dated 30 December 2000
"I-33"	Copy of PO No. 209 dated 11 December 2000
"I-34"	Certified copy of Hopewell Plastics Limited Invoice No. OSY0000391 dated 08 February 2001
"I-35"	Copy of Multi Rich Home Decors, Inc., PO No. 2013 dated 06 February 2001
"J" to "J-1"	Photographs showing Hopewell Plastic Laminates Limited's participation in exhibits held in the Philippines
"J-2" to "J-4"	Photographs of business card holders given away during the Worldbex 2000 Exhibit bearing Hopewell Plastic Laminates Limited's "OMEGA" mark
"K"	Copy of the print-out of the website <a href="http://www.hopewellplastics.com">www.hopewellplastics.com</a>
"L" to "L-1"	Copy of the filing letter dated 25 June 2001 for Trademark Application No. 4-2001-004482 for the mark "OMEGA"
"M" to "M-1"	Copy of Trademark Application No. 4-2001-004482 for

	the mark "OMEGA"
"N"	Copy of Special Power of Attorney executed by Hopewell Plastic Laminates Limited in favor of the undersigned counsel
"O" to "O-1"	Copies of drawings and facsimiles of the mark "OMEGA" attached to Trademark Application Serial No. 4-2001-004482
"P" to "P-2"	Certified copy of United States Registration No. 2,145,222
"Q"	Certified copy of Israeli Trademark Registration No. 118184
"R" to "R-3"	Certified copy of Chinese Registration Nos. 944935 and 256143
"S" to "S-2"	Certified copy of Macau Registration No. N/005906
"T"	Certified true copy of Certificate dated September 2003 issued by Ma. Theresa B. Dizon-De Vega, Consul of the Philippines in and for Hong Kong SAR
"T-1"	Certified copy of letter dated 05 October 1998 of Alfred Lam, Keung & Ko to Hopewell Plastics Limited
"T-2" to "T-3"	Certified copy of letter dated 07 October 1998 of Alfred Lam, Keung & Ko to Hi Tak Thermal & Acoustic Insulation Engineering Limited
"T-4"	Certified copy of letter dated 07 October 1998 of Raymond Chan to Alfred Lam, Keung & Ko
"T-5"	Certified copy of letter dated 08 October 1998 of Alfred Lam, Keung & Ko to Hi Tak Thermal & Acoustic Insulation Engineering Limited
"T-6"	Certified copy of letter dated 07 October 1998 of Raymond Chan to Alfred Lam, Keung & Ko
"T-7"	Certified copy of letter dated 14 October 1998 of T. Togasaki to Hi Tak Thermal & Acoustic Insulation Engineering Limited
"T-8"	Certified copy of letter dated 14 October 1998 of Raymond Chan To Alfred Lam, Keung & Ko
"T-9" to "T-10"	Certified copy of letter dated 20 October 1998 of Alfred Lam, Keung & Ko to Hopewell Plastics Limited
"T-11" to "T-12"	Certified copy of letter dated 20 October 1998 of Alfred Lam, Keung & Ko to Hi Tak Thermal & Acoustic Insulation Engineering Limited
"T-13" to "T-14"	Certified copy of letter dated 20 October 1998 of Alfred Lam, Keung & Ko to Nichias Corporation, the Respondent-Applicant
"T-15"	Certified copy of letter dated 04 November 1998 of Alfred Lam, Keung & Ko to Nichias Corporation, the Respondent-Applicant
"T-16"	Certified copy of letter dated 04 November 1998 of

	Alfred Lam, Keung & Ko to Hi Tak Thermal & Acoustic Insulation Engineering Limited
"T-17"	Certified copy of letter dated 04 November 1998 of H. Kubo to Alfred Lam, Keung & Ko
"T-18"	Certified copy of letter dated 04 November 1998 of Raymond Chan to Alfred Lam, Keung & Ko
"T-19"	Certified copy of letter dated 05 November 1998 of Alfred Lam, Keung & Ko to Nichias Corporation, the Respondent-Applicant
"T-20"	Certified copy of letter dated 05 November 1998 of Alfred Lam, Keung & Ko to Hi Tak Thermal & Acoustic Insulation Engineering Limited
"T-21"	Certified copy of letter dated 26 November 1998 of Alfred Lam, Keung & Ko to Hopewell Plastics Limited
"T-22" to "T-23"	Certified copy of letter dated 26 November 1998 of Alfred Lam, Keung & Ko to Nichias Corporation, the Respondent-Applicant
"T-24"	Certified copy of letter dated 09 December 1998 of Nichias Corporation to Alfred Lam, Keung & Ko
"U" to "U-3"	Certified copy of Deed of Assignment dated 16 November 1981 of Hong Kong Trademark Registration Nos. 1131 and 1132 executed by Sheng Kee Enterprises Co. Ltd., in favor of the Lam Sai-Yuen trading as Hopewell Trading Company.
"V" to "V-3"	Certified copy of Deed of Assignment dated 02 September 1985 of Hong Kong Trademark Registration Nos. 1131 and 1132 executed by Omega Laminates Limited in favor of the Lam Sai-Yuen trading as Hopewell Trading Company.
"W" to "W-7"	Translation of Trademark Registration Certificate No. 944935 (China), Trademark Registration Certificate No. N/005906 (Macau) and Trademark Registration No. 256143 (China) from Chinese to English
"X"	Affidavit dated 19 August 2003 executed by Victor Sy
"X-1"	Signature of the Notary Public who notarized the Affidavit dated 19 August 2003 executed by Victor Sy
"X-1-A", "Y" to "Y-11"	Signature of Victor Sy in his Affidavit dated 19 August 2003 Copy of the Articles of Incorporation of Multi-Rich Home Decors, Inc. filed with the Securities and Exchange Commission on 21 January 1993
"Z", "Z-1" to "Z-4"	Cover sheet of the copy of the 1998 General Information Sheet of Multi Rich Home Decors, Inc. filed with the Securities and Exchange Commission Copy of 1998 General Information Sheet of Multi Rich Home Decors, Inc., filed with the Securities and Exchange Commission

"AA" to "AA-3"	Copy of 2000 General Information Sheet of Multi Rich Home Decors, Inc., filed with the Securities and Exchange Commission
"BB" to "BB-3"	Copy of 2001 General Information Sheet of Multi Rich Home Decors, Inc., filed with the Securities and Exchange Commission
"CC"	Copy of Hopewell Plastics Limited Invoice No. BB170145 dated 07 September 1998
"CC-1"	Copy of Hopewell Plastics Limited Invoice No. BB189513 dated 20 January 1999
"CC-2"	Copy of Hopewell Plastics Limited Invoice No. BB189515 dated 20 January 1999
"CC-3"	Copy of Hopewell Plastics Limited Invoice No. OS99000024 dated 02 June 1999
"CC-4"	Copy of Hopewell Plastics Limited Invoice No. OS99000026 dated 02 June 1999
"CC-5"	Copy of Hopewell Plastics Limited Invoice No. OS 99000090 dated 06 August 1999
"CC-6"	Copy of Hopewell Plastics Limited Invoice No. OS99000202 dated 18 November 1999
"CC-7"	Copy of Hopewell Plastics Limited Invoice No. OS99000219 dated 17 December 1999
"CC-8"	Page 2 of copy of Hopewell Plastics Limited Invoice No. OS99000219 dated 17 December 1999
"CC-9"	Page 3 of copy of Hopewell Plastics Limited Invoice No. OS99000219 dated 17 December 1999
"CC-10"	Copy of Hopewell Plastics Limited Invoice No. OS99000290 dated 08 September 2000
"CC-11"	Page 2 of copy of Hopewell Plastics Limited Invoice No. OS99000290 dated 08 September 2000
"CC-12"	Page 3 of copy of Hopewell Plastics Limited Invoice No. OS99000290 dated 08 September 2000
"CC-13"	Copy of Hopewell Plastics Limited Invoice No. OSY99000219 dated 10 March 2000
"CC-14"	Page 2 of copy of Hopewell Plastics Limited Invoice No. OSY99000219 dated 10 March 2000
"CC-15"	Page 3 of copy of Hopewell Plastics Limited Invoice No. OSY99000219 dated 10 March 2000
"CC-16"	Page 4 of copy of Hopewell Plastics Limited Invoice No. OSY99000219 dated 10 March 2000
"CC-17"	Page 5 of copy of Hopewell Plastics Limited Invoice No. OSY99000219 dated 10 March 2000
"CC-18"	Copy of Hopewell Plastics Limited Invoice No. OSY99000361 dated 30 December 2000
"CC-19"	Page 2 of copy of Hopewell Plastics Limited Invoice No. OSY99000361 dated 30 December 2000

"CC-20"	Page 3 of copy of Hopewell Plastics Limited Invoice No. OSY99000361 dated 30 December 2000
"CC-21"	Page 4 of copy of Hopewell Plastics Limited Invoice No. OSY99000361 dated 30 December 2000
"CC-22"	Page 5 of copy of Hopewell Plastics Limited Invoice No. OSY99000361 dated 30 December 2000
"CC-23"	Copy of Hopewell Plastics Limited Invoice No. OSY0000391 dated 08 February 2001
"CC-24"	Copy of Multi Rich Home Decors, Inc., purchase order signed by Levi Ang, Executive Vice President
"CC-25"	Copy of Multi Rich Home Decors, Inc., PO No. 99-0003 dated 12 May 1999
"CC-26"	Copy of letter dated 02 August 1999 from Multi Rich Home Decors, Inc., to Hopewell Trading Company
"CC-27"	Copy of letter dated 09 November 1999 from Hopewell Plastics Limited to Multi Rich Home Decors, Inc.
"CC-28"	Copy of Multi Rich Home Decors, Inc., Purchase Requisition Slip dated 04 December 1999
"CC-29"	Page 2 of copy of Multi Rich Home Decors, Inc., Purchase Requisition slip dated 04 December 1999
"CC-30"	Copy of letter dated 12 November 2000 from Multi Rich Home Decors, Inc., to Lam Kin San
"CC-31"	Copy of PO No. 2009 dated 11 December 2000
"CC-32" "DD" to "DD-3", "DD-3-A"	Copy of PO No. 2013 dated 06 February 2001 Certified Copy of the Supplemental Affidavit dated October 2003 executed by Lam Ying Wai Patrick Signature of Lam ting Wai Patrick in his Supplemental Affidavit dated 31 October 2003

During the course of the proceedings, respondent-applicant submitted the Affidavit-testimony of Osamu Oshima to which the opposer manifested that it will no longer serve written interrogatories. Respondent-applicant also submitted the Affidavit of Tomas C. Kawpeng and formally offered the following documentary evidence, to wit:

Exhibit	Description
"1"	Authentication signed by Consul General Claro S. Cristobal
"1-a"	Signature of Claro S. Cristobal
"1-b" to "1-f"	Affidavit-Testimony of Osamu Oshima
"1-f-a"	Signature of Osamu Oshima
"2"	Certified True copy of Malaysia Certificate of Registration of Trademark for OMEGA, Registration No. 98014014

"3"	Certified true copy of Singapore Certificate of Registration of Trademark for OMEGA, Registration No. T98/11891C
"4"	Certified true copy of China Certificate of Registration of Trademark for OMEGA, Registration No. 878761
"5"	Indonesian Official Excerpt of Certificate of Registration of Trademark for OMEGA Registration No. 452500
"5-b" to "5-c"	Official English translation of Exhibit "5"
"6"	Certified true copy of Japan Certificate of Registration of Trademark for OMEGA, Registration No. 4745174
"6-a"	Facsimile Image of trademark covered in Exhibit "6"
"6-b"	English translation of Exhibit "6"
"6-c"	English translation of Exhibit "6-a"
"7"	Advertisement of OMEGA and Nichias Corporation during the 17 <sup>th</sup> Southeast Asian International Building Exposition held last May 3-6, 2000 in Singapore
"8"	Certified copy of Directory of Certified Products 2000-2001 published by the Singapore Productivity and Standard Board
"9"	Certified copy of Directory of Certified Products 1997 published by the Singapore Productivity and Standard Board
"10"	Certified copy of the advertisement for OMEGA in the Singapore Yellow Pages
"10-a"	Certification of Exhibit "10"
"11"	Facsimile Transmission, November 7, 2002
"11-a"	Certification of Exhibit "11"
"12" to "12-a"	OMEGA Floor Job References for Singapore from 1996 to 2002
"13"	Advertisement in Asian-Architecture Magazine 2001 Spring-Summer 2001 Edition
"14"	Advertisement in Asian-Architecture Magazine, Spring-Summer 2002 Edition ( <a href="http://www.archi.net.tw">www.archi.net.tw</a> )
"15"	Project reference from 1995 to 2001 for Indonesia
"16"	Supply record for the Philippines for OMEGA FLOOR as of June 9, 2001
"17" to "17-b"	Affidavit-Testimony of Tomas Kawpeng
"17-b-1"	Signature of Tomas Kawpeng
	Certified true copy of Certificate of Filing of





"18"	Amended Articles of Incorporation of Kent International Trading Co., Inc.
"18-a" to "18-f"	Amended Articles of Incorporation of Kent International Trading Co., Inc. including Director's Certificate
"19" to "19-f"	General Information sheet for 2007
"20"	Exclusive Distributor Certificate
"21" to "29"	Receipts/Invoices from 1999
"30" to "30-j"	Catalogue of Respondent-Applicant which is used in the Philippines
"31" to "31-b"	List of customers who have purchased flooring products using the trademark OMEGA of Respondent-Applicant
"32" to "32-d"	Supplemental Affidavit of Osamu Ohshima
"32-e"	Signature of Osamu Ohshima Notarial Certificate
"33" to "33-d"	Publication of Trademark Application No. Sho-63-128995 with application date of November 15, 1988 with the Japan Patent Office
"34"	Certificate of authentication of the Manila Economic Cultural Office of Taiwan signed by Resurrecion Fernando
"34-a" to "34-u"	Judgment No. 94-3116 in Hopewell Plastic Laminates Limited vs. Intellectual Property Office of Ministry of Economic Affairs of Taiwan
"35"	Authentication by Sulpicio M. Confiado, consul General of the Republic of the Philippines in and for Tokyo, Japan
"35-a"	Declaration of Osamu Ohshima
"35-a-1"	Signature of Osamu Ohshima
"35-b"	Notarization by Tokyo Legal Affairs Bureau
"35-c" to "35-d"	Notarial Certificate by Toichi Fujiwara
"36" to "36-tttttt"	Invoices / Receipts for the years 1996, 1997, 1998, 1999, 2000, 2001, 2002, 2003, 2004, 2005, 2006 and 2007
"36-uuuuuuu" to "36-zzzzzzz"	Bills of Lading
"36-aaaaaaaa" to "36-bbbbbbbb"	List of construction worksites in Japan which used Respondent-Applicant's OMEGA product
"37"	Actual Catalog of Nichias OMEGA Floor

The Pre-trial Conference was initially set on 10 February 2003 and a mediation conference was set on 8 April 2003, but no amicable settlement was reached by the parties. In the meantime, opposer submitted its pre-trial brief on 21 February 2003 while respondent-applicant submitted its pre-trial brief on 22 February 2003.

The issues as culled from the records which shall be discussed simultaneously are whether the opposer is the prior user and owner of the mark OMEGA and whether OMEGA is a well-known mark. In sum, whether the mark OMEGA can be allowed registration over the opposition.

The contending marks are reproduced below for comparison.

Opposer's mark	Respondent-Applicant's mark
	

As may be seen, it is once apparent that the marks are identical and evidence show that both marks are applied for same class 19. Opposer's mark is taken from an image in (Hong Kong) Certificate of Registration dated 25 June 1981 registered in the name of Shen Kee Enterprises Co., Ltd. (Exhibit "E") and respondent-applicant's mark from filewrapper evidence. Opposer's registration abroad is for goods under class 19, namely "plywood plastic laminated sheets, louver doors, partition-boards and plastic boards for use in construction and decoration. Filewrapper shows that respondent-applicant applied for the registration of the mark OMEGA on goods under class 19 namely "Floor boards, concrete building elements, floor tiles not of metal, slabs not of metal, surfacing not of metal, for buildings, concrete flooring boards, concrete panels, non-metallic floor coverings for finishing semi-finished floors, non-metallic fascias, ramps being structures of non-metallic materials."

The law on the matter of trademark registration is section 123.1 of Republic Act No. 8293, otherwise known as The Intellectual Property Code of the Philippines, which provides:

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

(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;"

In the Philippines, respondent-applicant filed its application for registration of the mark OMEGA for goods under class 19 on 23 December 1998. On the other hand, opposer filed an application for the mark OMEGA for goods under class 19 on 25 June 2001. (Exhibit "M"). As between the two, respondent-applicant has the earlier filing date for the mark OMEGA.

As regard to the issue of prior use, evidence show that in the Philippines, opposer first used the mark in the Philippines through a sale in June 29, 1998 as evidenced by Invoice No. BB159335 (Exhibit "H-84", Exhibit "I-3"). The transaction was between Hopewell Plastics Limited, which opposer claims to be a related company and Multi-Rich Home Decors, Inc., a domestic corporation. (Exhibit "Z"), its authorized importer/distributor in the Philippines. Respondent-applicant's first use in the Philippines is evidenced by an Invoice No. T-26568 dated December 3, 1999. (Exhibit "27"). The transaction is between Kent International Trading, a domestic corporation (Exhibit "19"), respondent-applicant's exclusive distributor in the Philippines and Shimizu Philippines Contractors, Inc., the buyer of OMEGA raised floor system.

Opposer is the prior user of the OMEGA mark in the Philippines. Opposer used the mark one year ahead of the respondent-applicant. Although opposer claims that he has used the mark since 1996, this allegation is not supported by evidence. Moreover, the Bureau noted that Multi Rich Home Décor, Inc. was invited under the sponsorship of the opposer and Hopewell Trading Co. to attend an Exhibition in Hong Kong which showcases their latest products.

Since the parties' first use, both have vigorously used the mark OMEGA in the Philippines. evidence show that various invoices and purchase orders indicating OMEGA brand was sold by opposer in the year 1998 (Exhibit "H-84", "H-85", "H-86", "H-87"), 1999 (Exhibits "I-7" to "I-18"), 2000 (Exhibit "I-19" to "I-33"), 2001 (Exhibit "I-34" to "I-35"). Opposer's participation in an exhibit in the year 2000 is shown by copies of pictures and business cards. (Exhibit "J"). Respondent-applicant's witness Tomas Kawpeng (Exhibit "17") admits that Kent International Trading started marketing OMEGA Raised Floor System in 1999. In the Affidavit-testimony of its witness, Osamu Ohshima (Exhibit "1") expressed that respondent-applicant used the trademark OMEGA in the Philippines in December 11, 1998. However, the Bureau has earlier found that respondent-applicant first used its mark only in December 3, 1999. Thereafter, it is undeniably that it continued the use of the mark as evidenced by various invoices indicating sales, supply and installation of the OMEGA raised floor system in the year 2000 (Exhibit "26"), 2001 (Exhibit "28"), 2002 (Exhibit "29"), 2003 (Exhibit "21") 2004 (exhibit "22"), 2006 (Exhibit "23"), 2007 (Exhibit "24"), 2005 (Exhibit "25"). Catalogues and promotional materials used were submitted. (Exhibits "30A-J"). It also showed a list of its Philippine clients (Exhibit "31") to wit: Shimizu Phil. Contractors, Inc., GTI Bldg., CCT-Fujitsu, Kajima-JAE, Tasei Philippine Construction Corp., PBCOM to name a few.

As regard to use abroad, opposer submitted catalogues and brochures allegedly used in various countries. (Exhibit "H" – "H-55"). Opposer also submitted proof of sales in Hong Kong, since 1996 and other countries like Thailand, China, Malaysia, South Africa (Exhibit "H-56" – "H-83", "H-89" "H-103"). For its part, respondent-applicant presented receipts t show sales in Malaysia, Japan, Singapore, Vietnam, Indonesia, Thailand, Brunei and China since

1998) (Exhibit "36" to "36-tttttt" "36-zzzzzz"). Respondent-applicant's catalogues used in the Philippines (Exhibit "30"), Directory of Certified products dated 1997 published by the Singapore Productivity and Standards Board (Exhibit "9") and advertisements in Building Exposition held in Singapore shows its mark has been advertised and promoted.

As regard to opposer's contention that it is the owner of the OMEGA mark, opposer offered as evidence the Certificate of Registration No. 1131 of the mark OMEGA mark in the Hong Kong registrar in favor of Sheng Kee Enterprises Co. Ltd. On June 25, 1981. (Exhibit "E"). In a series of Deeds of Assignment, the mark was assigned to Omega Laminates Limited, (Exhibits "U"), then to Lam Sai-Yuen as Hopewell Trading Company (Exhibit "V") and finally to opposer, Hopewell Plastic Laminates Limited. (Exhibit "E"). It also obtained registration of its mark in the United States (Exhibit "P"), Israel (Exhibit "Q"), China (Exhibit "R", "W") and Macau (Exhibit "S").

On the other hand, respondent-applicant also obtained foreign registrations for its mark OMEGA. In Malaysia in 1998 (Exhibit "2"), Singapore (Exhibit "3"), China, (Exhibit "4"), Indonesia (Exhibit "5") and in Japan (Exhibit "6"). In the Supplemental Affidavit of Osamu Ohshima (Exhibit "32"), he explained that it was the registered owner of the NICHIAS OMEGA FLOOR, in Japanese character as early as 1988. The document in support of this contention is a page showing matters recorded in the Trademark Register Book (Exhibit "33-C") shows application for an "Association trademark" with an application date of November 15, 1988 and registration date of November 12, 2003 by Nichias Corporation.

The confluence of evidence prove that opposer is the owner and first user of the mark OMEGA for goods under class 19 in the Philippines. It also proved that it obtained registration of its mark abroad, in Hong Kong ahead of respondent-applicant's first registration of the mark in Japan. In fact, respondent-applicant is aware of the existence and ownership of the mark OMEGA because it has negotiated for the use of the mark OMEGA in another jurisdiction. Even if respondent-applicant was the first to file an application for the mark OMEGA in the Philippines, it is not entitled to its registration because it is not the owner of the mark.

In an exchange of correspondence between the law firm Alfred Lam, Keung & Ko and Hi Tak Thermal & Acoustic Insulation Engineering Limited and between the firm and respondent-applicant, Nichias Corporation (Exhibit "T") in Hong Kong, respondent-applicant discounted the use of the mark because no agreement was reached regarding the terms of such use which is in recognition of opposer's ownership of the mark. In the last of the correspondences (Exhibit "T-24") H Kubo, a representative of the respondent-applicant, stated that "we will no longer seek your client to grant a license to us for the use of the subject Trademark xxxx".

In *Shangri-la International Hotel Management, Ltd. V. Developers Group of Companies, Inc.* (G.R. No. 159938. March 31, 2006), the Court held:

"By itself, registration is not a mode of acquiring ownership. When the applicant is not the owner of the trademark being applied for, he has no right to apply for registration of the same."

In *Operators Incorporated v. Director of Patents, et al.*, G.R. No. L-17901, October 29, 1965, the Supreme Court held:

“Where the applicant was not the owner of the trademark being applied for, he had no right to apply for registration of the same. The right to register trademarks, tradenames and service marks is based on ownership. xxx

This Bureau likewise notes the Supreme Court’s pronouncement in *Unno Commercial Enterprises, Incorporated vs. General Milling Corporation*, G.R. No. L-28554. February 28, 1983 held that “Only the owner of the mark has the right to register the same. 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 services from the goods, business or services of others is entitled to register the same.”

As regards to opposer’s contention that it is well known, this deserves scant consideration. The law states:

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

x x x

(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; x x x”

Also, Rule 102 of the Rules and Regulations on Trademarks contain the criteria to be taken into account in determining well-knownness of a trademark. Thus, Rule 102 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”

Opposer’s mark OMEGA cannot be considered well-known. The evidence does not sustain a finding that the geographical extent to which the mark has been used and promoted is limited to a few countries. Proof of the outcome of litigation was not even to its favor. Moreover, the market share in the Philippines and abroad is limited and its use has not been attended with exclusivity.

WHEREFORE, premises considered the OPPOSITION filed by Hopewell Plastic Laminates Limited, is, as it is hereby, SUSTAINED. Accordingly, Application Serial No. 4-1998-009320 by Respondent-Applicant, Nichias Corporation, is as it is hereby, REJECTED.

Let the file wrapper of “OMEGA”, subject matter of this case together with a copy of this DECISION be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 28 September 2009.

ESTRELLITA BELTRAN-ABELARDO  
*Director, Bureau of Legal Affairs*