

NIKON CORPORATION, <i>Opposer,</i>	}	INTER PARTES CASE NO. 4006
	}	Opposition to:
-versus-	}	Appln. Serial No. : 82736
	}	Date Filed : 28 September 1992
	}	Trademark: "NIKON & Device"
NIKOLITE INDUSTRIAL CORP., <i>Respondent-Applicant .</i>	}	
x-----x		
NIKON CORPORATION, <i>Opposer,</i>	}	INTER PARTES CASE NO. 4054
	}	Opposition to:
-versus-	}	Appln. Serial No. : 83781
	}	Date Filed : 14 December 1992
	}	Trademark: "NIKON & Device"
NIKOLITE INDUSTRIAL CORP., <i>Respondent-Applicant.</i>	}	
x-----x		
NIKON CORPORATION, <i>Opposer,</i>	}	INTER PARTES CASE NO. 4183
	}	Opposition to:
-versus-	}	Appln. Serial No. : 89763
	}	Date Filed : 08 December 1993
	}	Trademark: "NIKON & Device"
NIKOLITE INDUSTRIAL CORP., <i>Respondent-Applicant.</i>	}	
x-----x		
		Decision No. 2006-90

## DECISION

These pertains to the Notices of Opposition to the application for registration of the mark "NIKON" bearing Serial No. 82736 filed on September 28, 1992, which application was published on page 17 of Volume VI, No. 6 issue of the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) Official Gazette, officially released for circulation on January 27, 1994, application Serial No. 83781 filed on 04 December 1992 and application Serial No. 89763 filed on 08 December 1993, for goods falling under classes 9, 11 and 21.

Pursuant to *Order No. 96-99* dated 9 February 1996, Inter Partes Case Nos. 4006 and 4054 were consolidated with Inter Partes Case No. 4183.

The Opposer in these consolidated cases is "Nikon Corporation", a corporation duly organized and existing under the laws of Japan and with office address at 2-3, Marunouchi 3-Chrome, Chiyoda-ku, Tokyo, Japan.

On the other hand, the Respondent-Applicant in these consolidated cases is "Nikolite Industrial Corporation" Manila, Philippines with address at Narciso St., Canumay, Valenzuela, Metro-Manila.

The grounds for the opposition are the following:

- "1. The trademark "NIKON" is confusingly similar with, if not identical to, the trademark "NIKON", earlier adopted and registered in the Philippines by the Opposer, per Certificate of Registration No. 29680, issued on August 4, 1981;

- “2. The trademark “NIKON” applied for by the Respondent-Applicant is the dominant feature of the corporate name or trade-name of the Opposer, which is known or use in the Philippines long prior to Respondent-Applicant’s unauthorized use of NIKON. Thus, by virtue of the Paris Convention for the Protection of Intellectual Property, of which the Philippines is a member, the Philippine Government is bound to protect Opposer’s corporate name/tradename by rejecting the application for registration of Respondent-Applicant;
- “3. The registration of the trademark “NIKON” in the name of the Respondent-Applicant will run counter to the Memorandum-Circular issued by the then Minister of Trade and Industry to the Director of Patents on November 20, 1980 and October 25, 1983, directing the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) to comply with our commitment to the Paris Convention in giving protection to signature and other world famous trademarks, like the Opposer’s trademark.
- “4. The registration of the trademark “NIKON” in the name of the Respondent-Applicant will forestall the normal expansion of Opposer’s business, or it will mislead the prospective purchasers into thinking that Opposer has extended its business into the field of Respondent-Applicant, or is in any way connected with the latter’s activities or Respondent-Applicant is a subsidiary of Opposer;
- “5. The registration of the trademark “NIKON” in the name of Respondent-Applicant will violate the proprietary rights and interests of Opposer over its corporate name/trade-name as well as its trademark “NIKON” and will therefore, cause great and irreparable injury to the latter;
- “6. The registration of the trademark “NIKON” in the name of Respondent-Applicant will cause confusion and/or the likelihood of confusion as to the goods themselves or their source or origin, or will mislead the purchasing public and make it convenient for Respondent-Applicant to pass-off the goods as those of the Opposer, resulting in damage to both the public and the Opposer.

Opposer relied on the following facts to support its oppositions:

- “a. Opposer is a manufacturer/seller of a wide-range products bearing the trademark “NIKON”, which have been marketed and sold in the Philippines earlier than that of Respondent-Applicant, and in other parts of the world;
- “b. On February 21, 1977, which is very much earlier than Respondent-Applicant’s alleged date of first use of the mark “NIKON” on December 10, 1985, Opposer filed an application for registration of the mark “NION” with the Bureau of Patents, Trademarks and Technology Transfer (BPTTT) and was issued Certificate of Registration No. 29680 on August 4, 1981, for the following goods to wit: physical and chemical apparatus and instruments (excluding those belonging to applied electronic machinery and instruments), motion pictures apparatus and instruments, measuring apparatus and instruments (excluding those belonging to applied electronic machinery and instruments), medical instruments, their parts and accessories (excluding those belonging to other classes), photographic materials, in classes 9 and 10. On the other hand, Respondent-Applicant’s goods cover the following: water jugs, blenders,

oven toasters, gas stoves, flat irons, desk lamps, cassette racks, rechargeable lanterns, rice dispensers, rice cookers, vacuum flask, water purifiers, bread box, water tanks, airpots and juicers, under class 9, 11 and 21, which accentuate confusion or likelihood of confusion;

- “c. The trademark “NIKON” of Opposer is a well-known trademark worldwide shown, among others, by its worldwide use and/or the registration in other countries.
- “d. Since then, Opposer’s trademark and its corporate name had been in use and continued to be used in the Philippines and in other parts of the world, much earlier than that of Respondent-Applicant, and enjoys a good reputation among consumers for high quality which its products represents;
- “e. By virtue of the Opposer’s prior and continued use of its corporate name/trade-name and its trademark in the Philippines and other parts of the world, and the large amount spent by the Opposer in popularizing the same, said trade-name and trademark have become internationally well-known and has established valuable goodwill for Opposer among consumers who have identified Opposer as the source of the products bearing the trademark;
- “f. Respondent-Applicant’s trademark “NIKON” is but an identical imitation of Opposer’s corporate name/trade-name and trademark such that its use on the goods of Respondent-Applicant would infer that the latter’s goods are connected with the products manufactured and/or sold by Opposer as to falsely suggest a connection with the existing business of Opposer and therefore constitutes an intent to defraud Opposer;
- “g. The application for registration of “NIKON” was obviously intended to ride on the goodwill of Opposer’s corporate name/trade-name and trademarks;
- “h. The registration of “NIKON” diminishes the distinctiveness and strength of Opposer’s corporate name/trade-name and trademark which the public has already identified or associated with Opposer’s goods, to its prejudice and in violation of Opposer’s rights to said corporate name/trade-name and trademark.

During the pre-trial conference, the parties were encouraged to discuss the possibility of settling these cases amicably.

After all efforts have been extended by the parties, and no amicable settlement have been reached, a full blown trial have been conducted whereby the parties submitted their respective documentary evidence as well as testimonial.

Opposer filed its Formal Offer of Evidence consisting of Exhibits “A” to “H” inclusive of sub-markings per Order No. 2006-383 dated 9 March 2006.

On the other hand, Respondent-Applicant filed its Formal Offer of Evidence which are Exhibits “1” for the three consolidated cases which are the file wrappers of each application being opposed.

These three applications being opposed were filed during the effectivity of Republic Act No. 166, as amended. As such, said law shall be applied in the resolution of these three opposition cases.

The ultimate issue to be resolved in these three (3) consolidated cases is:

WHETHER OF OR NOT RESPONDENT-APPLICANT'S MARK  
"NIKON" IS CONFUSINGLY SIMILAR TO OPPOSER'S MARK "NIKON".

The applicable provision of law is Republic Act No. 166, as amended, particularly Section 4(d) thereof, which provides as follows:

Section 4. *Registration of trademarks, trade names and service marks on the Principal Register.* x x x The owner of a trademark, trade name or service mark used to distinguish his goods, business or services of others shall have the right to register the same on the Principal Register, unless it:

x x x

(d) Consist or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trademark previously used 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 purchasers.

The contending trademarks of the parties consist of the word "NIKON". It is undisputable that both marks are identical to each other considering that they have the same spelling, pronunciation as well as meaning.

Opposer's "NIKON" trademark has been registered with the Philippine Patent Office on August 4, 1981 under *Registration No. 29680* for the goods falling under classes 9 and 10 of the International classification of goods. (Exhibit "E-77")

The Respondent-Applicant's trademark applications for "NIKON & Device" which were filed on 28 September 1992, 14 December 1992 and 08 December 1993 respectively, covered the goods falling under classes 9, 11 and 21 of the international classification of goods. Thus, it is clear that the goods on which respondent intends to use its mark are of the same class of goods.

Another point to be taken into consideration is the fact that Opposer's trademark "NIKON" has been registered in many countries of the world including the Philippines for the goods falling under classes 9, 11 and 14 of the international classification of goods and other classes.

In the United States Patent and Trademark Office, Opposer's trademark "NIKON" has been registered on February 3, 1953, a period of more than thirty (30) years ahead of the filing of Respondent-Applicant's application.

Some countries where Opposer's mark "NIKON" have been registered are as follows:

Country	Goods/Class	Date	Exhibit
Australia	Class 9	11/17/1953	Exhibit "E-2"
Australia	Class 14	07/14/1995	Exhibit "E-5"
Brazil	Class 9		Exhibit "E-14"
Cambodia	Class 9	06/28/1993	Exhibit "E-15"
Canada	Class 14	04/03/1989	Exhibit "E-16"
China	Class 9	08/15/1999	Exhibit "E-18"
Costa Rica	Class 9	02/14/2000	Exhibit "E-19"
Costa Rica	Class 11	02/14/2000	Exhibit "E-20"
National Industrial	Class 9		Exhibit "E-31"

Property Institute			
Hong Kong	Class 9	12/09/1988	Exhibit "E-39"
Hong Kong	Class 11	12/09/1988	Exhibit "E-41"
Indonesia	Class 9	10/03/1989	Exhibit "E-51"
Iran	Class 9	03/28/1977	Exhibit "E-53"
Korea	Class 11	06/18/1973	Exhibit "E-58"
Mexico		11/25/1953	Exhibit "E-68"
New Zealand		04/17/1985	Exhibit "E-69"
South Africa	Class 9	07/05/1958	Exhibit "E-78"
Singapore	Class 9	03/24/1970	Exhibit "E-79"
Sweden	Class 9 & 16	05/28/1991	Exhibit "E-83"
China	Class 14	07/01/1980	Exhibit "E-88"
Great Britain and Northern Ireland	Class 9	08/05/1987	Exhibit "E-97"
Great Britain and Northern Ireland	Class 11	08/05/1987	Exhibit "E-101"
United States of America (first used May 7, 1949)		02/03/1953	Exhibit "E-110"
Vietnam	Class 9	12/18/1993	Exhibit "E-112"

On the other hand, the Respondent-Applicant failed to submit any evidence of use of its trademark "NIKON" in the Philippines and anywhere or any country of the world. The only evidence submitted are the three (3) trademark applications being opposed. (Exhibit "1" for the three (3) consolidated cases which are the file wrappers of each application.)

It is a fundamental principle in the Philippine Trademark law that actual use in commerce in the Philippines is a pre-requisite to the acquisition of ownership over a trademark or trade-name. (*Kabushiki Kaisha Isetan vs. Intermediate Appellate Court, et. al.*, G.R. No. 75420, November 15, 1991)

Likewise, the use required as foundation of trademark rights refers to local use at home and not abroad. (2 *Callman, Unfair Competition and Trademarks*, par. 76.4, p. 1006)

Relative thereto, Sections 2 and 2-A of Republic Act No. 166, as amended, provide:

*"Section 2. What are registrable? – Trademarks, tradenames and service marks owned by persons, corporations, partnerships and associations domiciled in the Philippines and by persons, corporations, partnerships or associations domiciled in foreign country may be registered in accordance with the provisions of this act: Provided, that said trademarks, trade-names or service marks are actually used in commerce and services or less than two months in the Philippines before the time of applications for registration are filed: And provided, further that the country of which the applicant for registration is a citizen grants by law substantially similar privileges to citizens of the Philippines, and such fact is officially certified with a certified true copy of the foreign law translated in English language, by the government of the foreign country to the government of the Republic of the Philippines."*

*"Section 2-A. Ownership of trademarks, trade-names 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 services in commerce, by actual use thereof in manufacture or trade, in business and in the service rendered, may appropriate to his exclusive use a trademark, a trade-name, or a service mark not so appropriated by another, to distinguish his merchandise,*

business, or service of others. The ownership or possession of a trademark, trade name or 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 other property rights known to the laws.”

From the evidences presented, this Bureau finds that Opposer is the prior user of the trademark “NIKON” in the Philippines. It is evident that it was previously registered in the Philippines prior to the filing of the applications being opposed. The registration bearing Registration No. 29680 was issued on August 4, 1981 (Exhibit “E-77”) while the applications being opposed were filed only on September 28, 1992, December 14, 1992 and December 8, 1993 respectively.

As further shown by the evidences presented, Opposer has been able to register its mark “NIKON” in various countries of the world including the Philippines, prior to the filing by Respondent-Applicant, Nikolite Corporation of the applications being opposed.

Moreover, the trademark “Nikon” of Opposer is likewise its trade-name or business name, to allow Respondent-Applicant to register and use the same identical mark on its goods would unduly infer that the latter’s goods are the same or connected with the products dealt in by the Opposer. This would falsely suggest a connection between the existing business of Opposer and that of Respondent’s, thereby causing fraud.

The purpose of the law in protecting a trademark cannot be over-emphasized. They are 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, and to prevent fraud and imposition. (Etepha vs. Director of Patents, [G.R. No. L-20635, March 31, 1966])

In the case of Western Equipment and Supply Co., vs. Reyes, 51 Phil. 115 (1927), the court declared that a corporation’s right to use its corporate and trade name is a property right, a right *in rem*, which it may assert and protect against the world in the same manner as it may protect its tangible property, real or personal, against trespass or conversion. It is regarded, to a certain extent, as a property right and one which cannot be impaired or defeated by subsequent appropriation by another corporation in the same field. (Red Line Transportation, Co., vs. Rural Transit Co., September 6, 1934, 60 Phil. 549)

In the case of Converse Rubber Corp., vs. Universal Rubber Products, Inc., (147 SCRA 155), the Supreme Court ruled that:

“A corporation is entitled to the cancellation of a mark that is confusingly similar to its corporate name. Appropriation by another of the dominant part of a corporate name is an infringement. The risk of damage is not limited to the possible confusion of goods but also includes confusion of reputation if the public could reasonably assume that the goods of the parties originated from the same source.”

Thus, it is clear from all the foregoing, that between the Opposer and the Respondent-Applicant, the former has sufficiently proven that it is the prior user of the mark “NIKON” in the Philippines and around the world, and is therefore entitled to protection from infringement thereof. Consequently, the mark “NIKON” of the Respondent-Applicant cannot be allowed registration for being confusingly similar to Opposer’s mark “NIKON” which is being used as its trademark as well as trade-name.

WHEREFORE, premises considered, the Notice of Opposition are hereby SUSTAINED. Consequently, applications bearing Serial Nos. 82736, 83781 and 89763 filed on September 28, 1992, December 14, 1992 and December 8, 1993, respectively for the registration of the mark

“NIKON & Device” by NIKOLITE INDUSTRIAL CORPORATION are, as they are hereby, REJECTED.

Let the filewrapper of the “NIKON & Device”, subject matter of the instant case be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, 21 September 2006.

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