

NIKON CORPORATION	}	IPC No. 4091
Opposer	}	Opposition to:
	}	
-versus-	}	Appln. Serial No. 82738
	}	Filed: September 18, 1992
NIKON INDUSTRIAL CORP.	}	
Respondent-Applicant	}	Trademark: NIKON & DEVICE
x-----x	}	
NIKON CORPORATION	}	IPC No. 4092
Opposer	}	Opposition to:
	}	
-versus-	}	Appln. Serial No. 83782
	}	Filed: December 14, 1992
NIKON INDUSTRIAL CORP.	}	
Respondent-Applicant	}	Trademark: NIKON & DEVICE
x-----x	}	Decision No. 2006-10

### DECISION

This is a consolidation of two inter-partes cases in opposition to the application for registration of the trademark "NIKON & DEVICE" with Serial No. 82738 for goods under class 9 on September 18, 1992 and Serial No. 83782 for goods under Class 14 filed on December 14, 1992 by Respondent-Applicant.

On September 18, 1992, Respondent-Applicant, NIKON INDUSTRIAL CORPORATION, filed its application for registration of the trademark "NIKON & DEVICE" with Serial No. 82738 for goods under class 9. Then on December 14, 1992 Respondent-Applicant also filed an application for the registration of the same mark with Serial No. 83782 for goods under Class 14. The said trademark applications were given due course and published in the Official Gazette.

Opposer filed its Verified Notices of Opposition on September 29, 1994 which cases were later docketed as Inter Partes Cases Nos. 4091 and 4092. Thereafter, Respondent-Applicant filed its Answer for IPC No. 4091, and for IPC No. 4092. The respective cases were then set for pre-trial conference, which was thereafter held and eventually terminated.

On March 22, 1995, Respondent-Applicant filed a Motion for Consolidation of the two IPC cases which was granted by this Honorable Office in Order No. 95-284.

A hearing was then set for the initial presentation of Opposer's evidence. Opposer submitted the Affidavit-Testimony of its witness, Mr. Shoichiro Yoshida together with the Annexes and requested to mark the various exhibits as evidence via a List of Exhibits in support of the testimony of its witness which it filed on March 18, 1996 marked as Exhibits "A" up to "F" inclusive of sub-markings.

Thereafter, Respondent-Applicant filed its Cross written Interrogatories, to which Opposer filed its Comments and objections on October 21, 1996. After a Reply was filed by Respondent, this Honorable Office resolved the comments and objections via order no. 99-71 dated February 15, 1999.

On March 11, 1999, Opposer filed a Motion for issuance of Letters Commission for the deposition of its witness before the Philippine consulate Office in Japan. On March 24, 1999, this Office granted the Letters Commission as requested by Opposer. Opposer then proceeded to request the Department of Foreign Affairs to approve and direct the Philippine Consulate in Tokyo, Japan to take the deposition of its witness, Mr. Shoichiro Yoshida.

Meanwhile, the witness, Mr. Shoichiro Yoshida was promoted as President of the Opposer Corporation rendering him unable to physically attend to the taking of his deposition. Consequently, the period lapsed for the requested deposition-taking. Hence, this Office issued Order No. 2002-626 striking out from the records the affidavit-testimony of Mr. Yoshida and setting the case for hearing for the continuation of reception of Opposer's evidence.

During the hearing on February 1, 2001, Opposer submitted the affidavit-testimony of its new witness, Mr. Naoto Toki, the Manager of the Intellectual Property Department of Opposer Corporation. Respondent was then given fifteen (15) days to submit its cross written interrogatories, if any. However, despite personal notices granting Respondent failed to do so. Therefore, upon Opposer's Motion dated March 9, 2001, this Office declared Respondent to have waived its right to do so in its Order No. 2001-232 dated May 10, 2001 which was received by Opposer on May 20, 2001. Opposer then was given up to June 20, 2001 within which to file its Formal Offer of Exhibits.

On June 15, 2001, Opposer filed its Formal Offer of Exhibits. Again, Respondent, despite Notices to submit its Comments, if any, to Opposer's Formal Offer of Evidence, failed to do so. Hence, upon Opposer's Motion, Respondent was declared to have waived its right to file its Comments to the Formal Offer, per its Order No. 2001-605 dated October 1, 2001. This Office likewise issued Order No. 2001-604 admitting Opposer's Formal Offer of Exhibits.

The hearing was then set for the presentation of Respondent's evidence, if any, on October 22, 2001. Respondent failed to appear on this scheduled hearing. Several settings were made (November 20, 2001 and November 27, 2001) but both hearings were cancelled for Respondent's failure to appear. Hence, Respondent-Applicant was declared by this Office as having waived its right to present its evidence for its defense under Order No. 2003-41 dated January 28, 2003.

Hence, these cases are now submitted for decision.

The sole issue in the present case is whether or not Respondent-Applicant is entitled to the registration of the trademark "NIKON & DEVICE".

There is no denying that the competing marks are identical but this will not automatically preclude the junior user from using the mark. This is reflected in Section 4(d) of R.A. 166, as amended:

*"Sec. 4. Registration of trademark, trade names and service marks on the principal register. There is hereby established a register of trade marks, trade names and service marks which shall be known as the principal register. the owner of the trademark, tradename and service mark used to distinguish his goods, business or services from the 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 pr comprises a mark pr tradename which so resembles a mark or tradename registered in the Philippines or a mark or tradename 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 service of the applicant, to cause confusion or mistake or to deceive purchasers."

With the Supreme Court in *Philippine Refining Co. Inc. vs. Ng Sam* (115 SCRA 476) interpreted to mean:

“Such restricted right over a trademark is likewise reflected in our Trademark Law. Under Section 4(d) of the law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, as in this case, registration of a similar or even identical mark may be allowed.”

It is a basic precept in trademark protection that “the right to trademark is a limited one, in the sense that others may use the same mark on unrelated goods.” Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, “the mere fact that one person has adopted and used a trademark on his good does not prevent the adoption and use of the same trademark by others on articles of a different description” (*Philippine Refining Co., Inc. vs. Ng Sam*, 115 SCRA 476 quoting Sec. 221, *nims Unfair Competition and Trademark*, vol. 1 p. 657 and 269 US 372, 381, 70 L ed 317, 46 Sct. 160)

In the case at bar, there is no difficulty in arriving at a conclusion that the goods of the two parties connected with their respective trademarks is distinct of the two parties connected with their respective trademarks is distinct and different from each other. The mark “NIKON” is used by the Respondent-Applicant under Application No. 82738 for the goods under class 9:

WATER JUGS, BLENDERS, OVEN TOASTERS, GAS STOVES, FLAT IRONS, DESK LAMPS, CASSETTES RACKS, RECHARGEABLE LANTERNS, RICE DISPENSERS, BASINS, PAILS, PLATES, CUPS, TRAYS, WASTE BASKETS, HANGERS AND CHAIRS

and under Application No. 83782 for the goods under class 14:

WATCHES, ALARM, DESK, WALL CLOCKS

While the Opposer uses the mark “NIKON” for goods under class 9 and class 10 as enumerated on its Certificate of Registration No. 29860:

#### Class 9

PHYSICAL AND CHEMICAL APPARATUS, AND INSTRUMENTS (EXCLUDING THOSE BELONGING TO APPLIED ELECTRONIC MACHINERY AND APPARATUS), OPTICAL APPARATUS AND INSTRUMENTS (EXCLUDING THOSE BELONGING TO APPLIED ELECTRONIC MACHINERY AND INSTRUMENTS, MOTION PICTURE APPARATUS AND INSTRUMENTS), MEASURING APPARATUS AND INSTRUMENTS (EXCLUDING THOSE BELONGING TO APPLIED ELECTRONIC MACHINERY AND APPARATUS AND ELECTRIC AND MAGNETIC INSTRUMENTS), MEDICAL INSTRUMENTS, THEIR PARTS AND ACCESSORIES (EXCLUDING THOSE BELONGING TO OTHER CLASSES), PHOTOGRAPHIC MATERIALS.

#### Class 10

PHYSICAL AND CHEMICAL APPARATUS AND INSTRUMENTS (EXCLUDING THOSE BELONGING TO APPLIED ELECTRONIC MACHINERY AND APPARATUS), OPTICAL APPARATUS AND INSTRUMENTS (EXCLUDING THOSE BELONGING TO APPLIED ELECTRONIC MACHINERY AND INSTRUMENTS, MOTION PICTURE APPARATUS AND INSTRUMENTS), MEASURING APPARATUS AND INSTRUMENTS (EXCLUDING THOSE BELONGING TO APPLIED ELECTRONIC MACHINERY AND APPARATUS

AND ELECTRIC AND MAGNETIC INSTRUMENTS), MEDICAL INSTRUMENTS, THEIR PARTS AND ACCESSORIES (EXCLUDING THOSE BELONGING TO OTHER CLASSES), PHOTOGRAPHIC MATERIALS.

While some of Respondent's product and some of the products of Opposer's are classified under Class 9, this alone cannot serve as the decisive factor in the resolution of whether or not they are related goods. Emphasis should be on the similarity of the products involved and not on the arbitrary classification or general description of their properties or characteristics. (*Philippine Refining Co., Inc. vs. Ng Sam And The Director Of Patents, G.R. No. L-26676. July 30, 1982.*)

The particular goods of the parties are so unrelated that consumers would not in any probability mistake one as the source or origin of the product of the other. They do not serve the same purpose through it might flow through the same channel of trade like say in a department store or mall but it will be definitely be displayed or shelved in a different section of the store, hence, they are neither competing not can be considered as related goods.

The Supreme Court in the case of *ESSO Standard Eastern, Inc. vs. The Honorable Court of Appeals and United Cigarette Corporation (116 SCRA 336, 342 [1982])* ruled that:

“Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characters with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or sold in grocery store. (2 Callman Unfair Competition & Trademarks, p. 1257). Thus, biscuits were held related to milk because they are both food products (*Arce vs. Selecta Supra*). Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays. (*Chua Che vs. Phil. Patent Office Supra*)”

Pursuant to the aforesaid Supreme Court ruling, the goods of the parties are obviously different from each other. They are so foreign to each other as to make it unlikely that the purchasers would think that Opposer is the manufacturer of Respondent-Applicant's goods as they are distinct from each other. 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 unrelated articles of a different kind. (*American Fondries vs. Robertson, 269 US 372, 381*)

It is, therefore, clear that the goods on which the trademark “NIKON” is being used by Respondent-Applicant is non-competing, cot sold on the same channels of trade and entirely unrelated to the products of Opposer so that there is no likelihood of confusion or deception on the part of the purchasing public as to the origin or source of the goods.

Opposer, Nikon Corporation, likewise claims entitlement for protection of its registered trademark under the Convention of Paris for the Protection of Industrial Property, the relevant article thereof provides:

Article 6 bis  
[Marks: Well-Known marks]

“The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use of a trademark which constitutes a reproduction, an imitation or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this convention and used for identical or similar goods. These provisions shall also apply when the

essential part of the mark constitutes a reproduction of any well-known mark or an imitation liable to create confusion therewith.” (underscoring provided)

To support its claim that its trademark “NIKON” had attained the status of a well-known mark, Opposer stated that they are the exclusive owner of the disputed trademark and has registered and used the same in the Philippines and worldwide. Likewise, it submitted in evidence worldwide registration where the trademark “NIKON” is registered.

But even if “NIKON” is well-known mark, thus deserves a broader scope of protection (see e.g. *Kenner Parker Toys, Inc. vs. Rose Art Industries* 22 USPQ 2d 1453 [Fed. Cir. 1992] and cases cited therein) such broader scope of protection may be invoked only when the latter is used for identical or similar goods by another and is liable to create confusion pursuant to Article 6 bis of the convention. In a Memorandum cited by the Opposer, issued by the then Minister of Trade and Industry, Roberto V. Ongpin, dated 25 October 1983 to the Director of Patents, he laid down a set of guidelines in the implementation of Article 6 bis of the Treaty of Paris. These conditions are:

- a) the mark must be internationally known;
- b) the subject of the right must be a trademark, not a patent or copyright or anything else;
- c) the mark must be used for the same or similar kinds of goods; and
- d) the person claiming must be the owner of the mark. (*The Parties Convention Commentary of the Paris Convention. Article by Dr. Bogesch, Director General of the World Intellectual Property Organization, Geneva, Switzerland, 1985*) (underscoring ours)

From the goods indicated in the certificates of registration submitted, the Opposer failed to comply with the third requirement of the said Memorandum that is, the mark must be used for the same or similar goods. The Opposer is using the mark “NIKON” for the goods different from the goods Respondent-Applicant is using the mark. None of the goods is related to the goods covered by the trademark of Respondent-Applicant, the products involved are so unrelated that the public will not be misled in the use of identical marks. Hence, Article 6 bis does not apply.

In fine, we hold that the business of the parties are non-competitive and their products so unrelated that the use of identical trademarks is not likely to rise to confusion, much less cause damage to Opposer. (*Philippine Refining as Co. Inc. vs. Ng Sam, 115 SCRA 479*).

Finally, in *Canon Kabushiki Kaisha vs. CA (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.

WHEREFORE, in view of the foregoing, the Notices of Opposition filed by the Opposer are, as they are hereby DENIED.

Considering however that, as shown by the records, Respondent-Applicant, despite due notices failed to present its evidence nor filed any motion to explain its failure is indicative of Respondent-Applicant’s lack of interest in its applications, hence, it is deemed to have 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 its own interest in the prosecution of its applications. On the contrary, the applicant in this case appears to have no interest in defending his cases nor his trademark applications subject of the instant Notices of Opposition.

IN VIEW THEREOF, Application Serial No. 82738 filed on September 28, 1992 and Application Serial No. 83782 filed on December 14, 1992 both for the mark “NIKON” by

Respondent-Applicant, NIKON INDUSTRIAL CORPORATION are hereby considered ABANDONED/WITHDRAWN for Respondent's lack of interest to prosecute subject application.

Let the filewrappers of NIKON and Device subject matter of these case be forwarded to the Administrative, Financial and Human Resource 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, February 10, 2006.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs