

SEA WORLD, INC.,	}	IPC No. 14-2005-00021
Opposer,	}	Opposition to:
	}	Appln. Ser No. 4-1997-120810
-versus-	}	Date Filed: May 21, 1997
	}	
LUY KIM KOK	}	TM: "SEA WORLD WITH CIRCLE
Respondent-Applicant.	}	CENTER WITH LOBSTER
	}	DESIGN AND SEA WATER"
x-----x		
SEA WORLD, INC.,	}	IPC No. 14-2005-00136
Opposer,	}	Opposition to:
	}	Appln. Ser No. 4-2003-009703
-versus-	}	Date Filed: October 22, 2003
	}	
LUY KIM KOK	}	TM: "SEA WORLD WITH CIRCLE
Respondent-Applicant.	}	CENTER WITH LOBSTER
	}	DESIGN AND SEA WATER"
x-----x		Decision No. 2006-122

JOINT DECISION

This pertains to the following oppositions:

- 1) the authenticated and verified NOTICE OF OPPOSITION filed on April 14, 2005 by opposer Sea World, Inc. to Application Serial No. 4-1997-120810 for the registration of the trademark "SEA WORLD WITH CIRCLE CENTER, WITH LOBSTER DESIGN & SEA WATER" for goods under Class 29, namely, octopus, fish ball, kikiyam, scallop, cuttlefish fillet, abalone, squid ball, squid roll, tempura, asari which was published for opposition in the December 17, 2004 issue of the IP Philippines (IPPhil.) Official Gazette, Page 377; and docketed as IPC No. 14-2005-00021; and
- 2) the authenticated and verified NOTICE OF OPPOSITION filed on December 19, 2005 by same opposer Sea World, Inc. to Application Serial No. 4-2003-009703 for the registration of the same mark "SEA WORLD WITH CIRCLE CENTER, WITH LOBSTER DESIGN & SEA WATER" likewise for goods under Class 29, also namely, fish balls, squid balls, squid rolls, kikiyam, and tempura; and further, under the same class of goods, for sashimi, sushi, frozen fish, frozen prawns, and lobster which was published for opposition in the August 24, 2005 issue of the IPPhil Official Gazette, Volume, Page 235; and docketed as IPC No. 14-2005-00136.

The record shows that on May 21, 1997, respondent-applicant filed an application for registration of the subject mark for Class 29 goods, which application was demonstrated as Application Serial No. 4-1997-120810. This application was published in the December 17, 2004 issue of the IP Philippines (IPPhil.) Official Gazette, Page 377. On February 16, 2005, opposer filed an unverified NOTICE OF OPPOSITION docketed as IPC No. 14-2005-00021.

At the hearing on September 5, 2005 for IPC Co. 14-2005-00021, respondent-applicant's counsel manifested that respondent-applicant was told by this Office, and an order was issued, to the effect that said application for registration was deemed abandoned in view of the non-filing of a declaration of actual use albeit within the reglementary period and that he had to file another application (TSN, September 5, 2005, p.3).

On October 22, 2003, thus, respondent-applicant filed an application for registration, denominated as Application Serial No. 4-2003-009703, of the same subject mark likewise for the Class 29 goods it applied for under Application Serial No. 4-1997-120810 such as fish balls, squid balls, squid rolls, kikiyam, tempura and other Class 29 goods such as sashimi, sushi, frozen fish, frozen prawns, and lobster.

Notwithstanding the apparent communication by this Office to respondent-applicant that Application Serial No. 4-1997-120810 was deemed abandoned for respondent-applicant's failure to file a declaration of actual use and that respondent-applicant had to file another application, Application Serial No. 4-1997-120810 was published for opposition in the December 17, 2004 issue of the IPPhil. Gazette for which the unverified NOTICE OF OPPOSITION earlier mentioned was filed on February 16, 2005 and docketed as IPC No. 14-2005-00021. On April 14, 2005, opposer filed an authentication verified opposition.

Meanwhile, Application Serial No. 4-2003-009703 was published for opposition in the August 24, 2005 issue of the IP Phil. Official Gazette.

On May 11, 2005, respondent-applicant filed an Answer in IPC No. 14-2005-00021 which is the opposition to Application Serial No. 4-1997-120810 admitting opposer's allegations in regard to the application for registration on May 21, 1997 of the subject mark under Class 29 but specifically denying the rest of opposer's allegations. Respondent-applicant then basically alleged that opposer's and respondent-applicant's respective goods/products are entirely distinct from each other as respondent-applicant's goods/products belong to Class 29 while opposer's goods/products belong to Classes 6, 9, 14, 16, 18, 21, 25, 28, 34 and 41, and prayed that the opposition be denied for lack of merit, citing the case of Canon Kabushiki Kaisha v. Court of Appeal, G.R. No. 120900, July 20, 2000.

At the hearing for pre-trial on September 5, 2005 for IPC No. 14-2005-00021, respondent-applicant through counsel moved in the alternative for the dismissal or withdrawal of this opposition in view, as discussed earlier, of this Office's apparent communication that said application was deemed abandoned for respondent-applicant's failure to file a declaration of actual use, or for the consolidation of this opposition to the yet unverified opposition that opposer shall file in regard to Application Serial No. 4-2003-009703 as manifested in opposer's PETITION FOR EXTENSION OF TIME TO FILE NOTICE OF OPPOSITION filed on September 23, 2005 in IPC No. 14-2005-00136.

This Bureau thereafter, issue Order No. 14-2005-00021 was issued on October 26, 2005 with the following rulings:

- 1) Application Serial No. 4-1997-120810 is not deemed abandoned notwithstanding the lack of a declaration of actual use as this is not a requirement of the law but only of Memorandum Circular No. BT Y2K-8-03 DATED August 2000 issued by the Bureau of Trademarks which cannot prevail over the law;
- 2) Application Serial No. 4-1997-120810 is, not deemed abandoned and in fact subsists as it was published in the IPPhil. Gazette on December 17, 2004;
- 3) Consolidation of IPC No. 14-2005-00021 with IPC No. 14-2005-00136 while the latter was unverified cannot be made as it is only upon the filing of a verified opposition that this Office acquires jurisdiction over said opposition;
- 4) In the meantime that there is no consolidation yet, IPC No. 14-2005-00021 and IPC No. 14-2005-00136 are respectively and separately subject to the applicable and proper rules in *inter partes* proceedings to which the parties must be duly comply.

The parties were directed in IPC No. 14-2005-00021, thus, comply with the Notice To Comply with Office Order No. 79, that is, to file and complete their respective evidences within the period given considering that this case was mandatorily covered by Office Order No. 79. Opposer failed to file and complete all its evidences within the required period.

Meanwhile, in IPC No. 14-2005-00136, opposer filed on December 19, 2005 an authenticated verified opposition, attaching thereto an authenticated Special Power of Attorney and four (4) original pamphlets-advertisements of opposer's adventure park in San Diego using its mark "Sea World".

On January 2, 2006, in regard to IPC No. 14-2005-00021, respondent-applicant filed by express delivery its position paper, attaching thereto his evidences consisting of a sample plastic bag with the subject mark, and photocopies of his Certificates of Registration of Business Name for the business name "Sea World Ex-IM Traders" issued by the Department of Trade and Industry (DTI) respectively in 1995 and 2000; Mayor's Business Permit; Acknowledgment issued by the Bureau of Trademarks (BOT) of the application for registration; receipt for the filing of the application for registration; the filled-out Trademark Application Form; a sample plastic bag with the subject mark; and this Declaration of Actual Use. Opposer, on the other hand, failed to file and complete all its evidences within the required period.

On May 22, 2006, in regard to IPC No. 14-2005-00136, a Notice To Answer was furnished to respondent-applicant. Per Order No. 2006-1251 issued on September 4, 2006, respondent-applicant was deemed to have waived his right to file his Answer and the supporting documentary evidences thereof as he failed to file these within the reglementary period. Said Order No. 2006-1251 provided that the case was deemed submitted for decision based on the Verified Notice of Opposition and the supporting documents attached thereto. It appears, though, that as late as October 9, 2006, respondent-applicant filed a MOTION TO ADMIT ANSWER, attaching thereto his ANSWER as well as his evidences consisting of a sample plastic bag with the subject mark, and photocopies of his Certificate of Registration of Business Name for the business name "Sea World Ex-IM Traders" issued by the Department of Trade and Industry (DTI) on November 17, 2005; and his Declaration Of Actual Use.

Though it failed to file and complete all its evidences within the required period in IPC No. 14-2005-00021, opposer filed its evidences in IPC No. 14-2005-00136 by attaching to its authenticated verified opposition an authenticated Special Power of Attorney and four (4) original pamphlets-advertisements of opposer's adventure park in San Diego, California with its mark "Sea World". And though he belatedly filed his ANSWER and evidences in IPC No. 14-2005-00136, respondent-applicant timely filed his Answer and evidences in IPC No. 14-2005-00021. This Bureau notes that the two cases herein involve the same parties, the same trademarks, and the same goods under the same class due to the peculiar factual circumstances narrated herein: Subsequent to the filing of an application for registration of the subject mark for Class 29 goods (Application Serial No. 4-1997-120810), opposer filed an application for registration of the same mark for the same goods under the same class (Application Serial No. 4-2003-00136) in view of the information given to it by this Office that the previous application was deemed abandoned but which was not so and in fact was published for opposition, and to which an opposition was in fact filed. The subsequent application for registration (Application Serial No. 4-2003-00136) was nonetheless published for opposition to which an opposition was filed. There are 2 simultaneous cases, thus, involving the same mark over the same goods under the same class.

In view of all these circumstances, and in the interest of justice, this Bureau shall treat the evidences filed by opposer in IPC No. 14-2005-00136 as its evidences in IPC No. 14-2005-00021 notwithstanding its failure to file its evidences in IPC No. 14-2005-00021, and shall treat respondent-applicant's ANSWER and evidences in IPC No. 14-2005-00021 as respondent-applicant's ANSWER and evidences in IPC No. 14-2005-00136 notwithstanding this Bureau's ruling in IPC No. 14-2005-00136 that respondent-applicant is deemed to have waived his right to file his answer and the supporting documents thereof.

With the aforementioned ruling, this Bureau shall now proceed to jointly adjudicate IPC No. 14-2005-00021 and IPC No. 14-2005-00136.

Opposer Sea World, Inc. is a foreign corporation organized and existing under the laws of the United States of America with office address at 1720 Shores Road, San Diego, California, 92109, U.S.A.

The grounds for opposition are as follows:

- “1. Opposer is the registered owner of the mark SEA WORLD for goods in Classes 6, 9, 14, 16, 18, 21, 25, 28, 34, and 41 under U.S. Certificate of Registration No. 1,195,498 on May 18, 1982;
2. Opposer has likewise registered the mark “SEA WORLD” in many other countries of the world;
3. Opposer has also registered in the Philippines the mark “SEA WORLD & DESIGN” for clothing, footwear, and headgear in Class 25 under Certificate of Registration No. 52168 issued on February 6, 1992 but which registration has lapsed due to opposer’s mistake when it failed to file the required affidavit of use/non-use;
4. Opposer has since applied for the re-registrations of the mark “SEA WORLD” with IPPhil. Under Application Serial No. 00122365 filed on July 8, 1997 for goods under class 16, namely, publications, printed matter, photographs, and paper products (i.e., educational books on marine subjects, posters, postcards, children coloring books, playing cards, decals, letter openers, pens and bases for pens, and paper weights); and under Application Serial No. 00122366 likewise filed on July 8, 1997 for amusement park amusement park services under Class 41;
5. Opposer has widely used the mark “SEA WORLD” throughout the world and the same is widely known around the world to be exclusively owned by opposer for which reason registration of the subject mark “SEA WORLD WITH CIRCLE CENTER, WITH LOBSTER DESIGN & SEA WATER” in respondent-applicant’s name is contrary to the provisions of Article 6bis of the Paris Convention as modified by the Lisbon Revision, and to the provisions of the GATT-TRIPS Agreement, both of which are being enforced in this jurisdiction through Section 123 (e) of the IP Code;
6. Respondent-applicant’s mark “SEA WORLD WITH CIRCLE CENTER, WITH LOBSTER DESIGN & SEA WATER” is identical and/or confusingly similar to opposer’s mark “SEA WORLD” as to be likely, when applied to or used in connection with respondent-applicant’s goods, to cause confusion or mistake, and deceive the public or the public may be led to believe that respondent-applicant’s goods is owner by, originated from, or sponsored by opposer;
7. Opposer’s mark “SEA WORLD” is a world-famous mark protected by Section 123.1(e) and (f) of the IP Code;
8. The registration of the mark “SEA WORLD WITH CIRCLE CENTER, WITH LOBSTER DESIGN & SEA WATER” in respondent-applicant’s name will cause grave and irreparable injury and damage to opposer within the meaning of Section 134 of the IP Code;
9. “SEA WORLD” is the registered corporate name of opposer;

10. The mark "SEA WORLD" was first adopted and used by opposer as early as June 1964;
11. The uncanny similarity in the mark and the use of respondent-applicant's mark make it very obvious that respondent-applicant is riding on the international popularity of opposer's mark "SEA WORLD" and is passing off its goods as those of the opposer;
12. Opposer has spent large sums of money for advertising and popularizing its products using the mark "SEA WORLD" which, coupled with opposer's long use and unblemished and esteemed public reputation as provider of the marine amusement parks services and as manufacturer of superior and high quality goods and products, has generated and established an immense and valuable goodwill for its mark "SEA WORLD" the world over;
13. The use and registration of the mark "SEA WORLD WITH CIRCLE CENTER, WITH LOBSTER DESIGN & SEA WATER" by respondent-applicant will likely cause the dilution of the advertising value of opposer's mark "SEA WORLD" and its excellent image will surely weaken its power of attraction; and
14. Respondent-applicant's use and registration of the mark "SEA WORLD WITH CIRCLE CENTER, WITH LOBSTER DESIGN & SEA WATER" will amount to a violation of opposer's proprietary rights over the mark "SEA WORLD".

The issues to be resolved are as follows:

1. Whether there is confusing similarity between opposer's goods and/or business with respondent-applicant's goods and/or business; and
2. Whether opposer's mark is internationally well-known.

The application for registration of the trademark being opposed in the instant case was filed on May 21, 1997 which was during the effectivity of Republic Act (R.A.) No. 166 which is the old trademark law. This Office, thus, shall resolve the instant case under said law so as not to adversely affect the rights already acquired prior to the effectivity of the Intellectual Property (IP) Code (R.A. No. 8293).

The provision of law specifically applicable to the instant case is Section 4(d) of R.A. No. 166 which provides:

*"SEC. 4. Registration of trade-marks, 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 shown as the principal register. the owner of a trade-mark, trade-name or 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:*

*(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name 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 to deceive purchasers;"*

Opposer's goods fall under Classes 6, 9, 14, 16, 18, 21, 25, 28, 34, and 41. These goods comprise of common metals and their alloys including such metallic materials as anvils, rails, chains, pipes, tubes, boxes, balls, nails, and the like (Class 6); Scientific, nautical, surveying, electrical, photographic, weighing, life-saving, teaching, coin, and other like apparatuses (Class

9); precious metals and their alloys and goods in precious metals or coated therewith, jewelry, horological instruments and other like instruments (Class 14); paper and paper articles, printed matter, photographs, adhesive materials, artists' materials, instructional and teaching materials, and such other similar materials (Class 16); leather, imitations of leather, articles made for these materials, parasols, and walking sticks (Class 18); small domestic non-metal utensils and containers, sponges, brushes and brush-making materials, instruments and materials used for cleaning purposes, glass, and glassware and earthenware not included in other classes (Class 21); clothing, including footwear (Class 25); games, sporting articles except clothing, and ornaments for Christmas trees (Class 28); tobacco, smokers' articles, and matches (Class 34); and education and entertainment services (Class 41).

Respondent-applicant's goods fall under Class 29, namely octopus, fish ball, kikiam, scallop, cuttlefish fillet, abalone, squid ball, squid roll, tempura, and asari.

It is clear, the, that respondent-applicant's goods are not identical to those produced and sold by opposer. They are obviously different from each other with absolutely no iota of similitude. They are not even related as they do not belong to the same class of goods, and much less do they have the same descriptive properties. They are non-competing goods: They could not reasonably be assumed to have a common source or to have originated from one manufacturer. Also, they flow through different channels of trade: Respondent-applicant's goods are sold in supermarkets, groceries, markets, sari-sari stores, pushcarts or kiosks on side streets for the public in general while almost all of opposer's goods are sold in specialized stores or stores specially put up to cater to specific needs, purposes, and a specific segment of the public. There is, thus, no likelihood either of confusion of goods or business of respondent-applicant with that of opposer. Respondent-applicant's use of the mark "SEA WORLD WITH CIRCLE CENTER, WITH LOBSTER DESIGN & SEA WATER" on his goods would not indicate a connection between these goods, and opposer and opposer's goods.

The Supreme Court has allowed in a number of cases the registration of a mark used on goods which are different or are not related to the goods bearing the same mark even if the latter mark is a registered mark. In *ESSO STANDARD EASTERN, INC. V. THE HONORABLE COURT OF APPEALS* and *UNITED CIGARETTE CORPORATION, G.R. NO. L-29971, AUGUST 31, 1982*, the Supreme Court held:

"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 characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays. The trademark "Ang Tibay" for shoes and slippers was disallowed to be used for shirts and pants because they belong to the same general class of goods. Soap and pomade, although non-competitive, were held to be similar or to belong to the same class, since both are toilet articles. But no confusion or deception can possibly result or arise when the name "Wellington" which is the trademark for shirts, pants, drawers and other articles of wear for men, women and children is used as a name of a department store."

The Supreme Court's ruling in *ESSO STANDARD EASTERN, INC., supra* was reiterated in *CANON KABUSHIKI KAISHA v. COURT OF APPEALS et al, G.R. NO. 120900, July 20, 2000*. The Supreme Court held in this case:

" . . . the paints, chemical products, toner and dyestuff of petitioner that carry the trademark CANON are unrelated to sandals . . . The products of petitioners are sold through special chemical stores or distributors while the products of private respondent are sold in grocery stores, sari-sari stores and department stores. Thus, the evident disparity of the products of the parties in the case at bar, renders unfounded the apprehension of petitioner that confusion of

business or origin might occur if private respondent is allowed to use the mark CANON.”

In the recent case of MIGHTY CORPORATION and LA CAMPANA FABRICA DE TABACO, INC., V. E. & J. GALLO WINERY and THEANDERSON GROUP, INC., G.R. No. 154342, July 14, 2004, the Supreme Court reiterated the doctrine that registration of a mark similar to another mark used and owned by another person is allowed so long as the goods covered by the applicant’s mark is neither similar nor related to the latter’s goods bearing the same mark, citing established jurisprudence which includes the two (2) aforementioned cases. In this particular case before the Supreme Court, the goods involved are wines on the one hand, and cigarettes on the other hand.

As to the first issue, thus, Office rules in the negative.

Anent the second issue, i.e. whether Opposer’s mark is internationally known, Opposer’s evidence consists of only 4 original pamphlets-advertisements of opposer’s adventure park in San Diego, California using its mark “Sea World”. These by themselves, cannot establish that opposer’s mark is internationally well-known. The pamphlets-advertisements simply show that opposer has an adventure park in San Diego, California and that such adventure park has certain features and amenities that cater to the general public. There is no way that this Bureau can deduce from such pamphlets that any of the following criteria provided in the “Rules on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers” is met to such extent that opposer’s mark may be considered as well-known:

- “a) the duration, extent and geographical area of any use of the mark;
- b) the market share in the Philippines and in other countries of the 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;
- 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.

Thus, this Bureau likewise rules in the negative.

WHEREFORE, considering that there is no confusing similarity between the two (2) competing marks and that opposer failed to present and offer evidence to prove that its mark is a well-known mark, the NOTICE OF OPPOSITION is, as it is, hereby DENIED. Consequently, Application Serial Nos. 4-1997-120810 filed on May 21, 1997 and 4-2003-009703 filed on October 22, 2003 for the registration of the mark “SEA WORLD WITH CIRCLE CENTER, WITH LOBSTER DESIGN & SEA WATER” used for octopus, fish ball, kikiyam, scallop, cuttlefish fillet, abalone, squid ball, squid roll, tempura, asari, and seafood namely, fish balls, squid balls, squid rolls, kikiyam, tempura, sashimi, sushi, frozen fish, frozen prawns and lobster both under Class 29 are, as they are hereby, GIVEN DUE COURSE.

Let the filewrapper of “SEA WORLD WITH CIRCLE CENTER, WITH LOBSTER DESIGN & SEA WATER” under IPC Cases 14-2005-00021 and 14-2005-00136 together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City. October 30, 2006.

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