



OLYMPUS CORPORATION,
Opposer,

- versus -

NICHOLAS W. WU,
Respondent-Applicant.

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IPC No. 14-2009-00054
Opposition to:

Appln. No. 4-2005-000614
Date Filed: 21 January 2005
Trademark : "**S.E.A. OLYMPUS
Marketing Inc.**"
Decision No. 2015 - 11

DECISION

OLYMPUS CORPORATION ("Opposer")¹ filed a verified opposition to Trademark Application Serial No. 4-2005-000614. The application, filed by NICHOLAS W. WU ("Respondent-Applicant")², covers the mark "SEA OLYMPUS Marketing, Inc." for use on "*retail selling of hardware items and chemicals used in the business of Fiber Reinforce Plastics (FRP)*" under class 35 of the International Classification of Goods³

The Opposer alleges the following:

"3.1 It possesses the rights, title, and interests in and to the word mark OLYMPUS in the Philippines.

"3.2 It is the prior user and registrant of the mark OLYMPUS which is used in commerce worldwide, including the Philippines.

"3.3 The word mark OLYMPUS is an internationally well-known mark, protected broadly under Article 6(bis) of the International Convention for the Protection of Industrial Property ('Paris Convention'); Article 16 of the Agreement on Trade Related Aspects of Intellectual Property Rights ('TRIPS'), to which the Philippines is a signatory; and section 123.1(e) & (f), and other provisions of the Intellectual Property Code of the Philippines ('IP Code').

"3.4 Nicholas W. Wu is not among the worldwide users of licensees authorized to use the mark OLYMPUS.

"3.5 Nicholas W. Wu's mark OLYMPUS & LOGO is identical to opposer's mark OLYMPUS; and the use and registration thereof on any products will mislead the purchasing public into believing that such good are produced by, originate from, or are under the sponsorship of Olympus Corporation.

"3.6 Nicholas W. Wu's predatory intent or bad faith in adopting the word OLYMPUS entitled Olympus Corporation to oppose said trademark application.

¹ A corporation organized and existing under the laws of Japan, with business address at 43-2, Hatagaya 2-chome, Shibuya-ku, Tokyo, Japan.

² A Filipino citizen with address at 3934 Forest Hills, Banawa, Cebu City.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

"3.7 The Intellectual Property Office has not issued any trademark registration for OLYMPUS to any entity except to Olympus Corporation.

"3.8 The registration of Nicholas W. Wu's mark OLYMPUS & LOGO contravenes the IP Code."

The Opposer's evidence consists of the following:

1. Exhibit "A" - Authenticated and Legalized Affidavit of Twuyoshi Kikukawa;
2. Exhibit "B" - Authenticated and Legalized Certification on Worldwide Registration of Twuyoshi Kikukawa;
3. Exhibit "B-1" - Registration of OLYMPUS in Japan Patent Office;
4. Exhibit "B-2" - Registration of OLYMPUS in United States Patent and Trademark Office;
5. Exhibit "B-3" - Registration of Trademark No. 765408 in the name of Olympus Optical Company Limited;
6. Exhibit "B-4" - Registration of Olympus in German Patent and Trademark Office;
7. Exhibit "B-5" - Company Profile;
8. Exhibit "B-5-A"- Financial Highlights;
9. Exhibit "B-5-B"- Ten-Year Summary of Financial Position;
10. Exhibit "B-5-C"- Tables of Sales in Millions of yen;
11. Exhibit "B-5-D"- Financial Information by geographic location in Millions of yen;
12. Exhibit "B-5-E"- Independent Auditor's Report;
13. Exhibit "B-5-F"- Intellectual Property Report;
14. Exhibit "B-5-G"- List of principal business bases and Consolidated subsidiaries and affiliated companies;
15. Exhibit "B-5-H"- List of Overseas OLYMPUS offices;
16. Exhibit "B-6" - List of OLYMPUS worldwide registrations;
17. Exhibit "C" - Certificate of Renewal of Registration No. R-15450 for the trademark OLYMPUS;
18. Exhibit "C-1" - Affidavit of Use for the Fifth Anniversary of OLYMPUS;
19. Exhibit "C-2" - Affidavit of Use for the Tenth Anniversary of OLYMPUS;
20. Exhibit "C-3" - Affidavit of Use for the Fifteenth Anniversary of OLYMPUS;
21. Exhibit "D" - Certificate of Renewal of Registration No. 03808 for OLYMPUS;
22. Exhibit "D-1" - Certificate of Registration No. 38084 for OLYMPUS;
23. Exhibit "D-2" - Affidavit of Use for the Fifth Anniversary of OLYMPUS;
24. Exhibit "D-3" - Affidavit of Use for the Tenth Anniversary of OLYMPUS;
25. Exhibit "D-4" - Affidavit of Use for the Fifteenth Anniversary of OLYMPUS;
26. Exhibit "E" - Certificate of Registration No. 60608 for OLYMPUS (Word);
27. Exhibit "E-1" - Affidavit of Use for the Fifth Anniversary of OLYMPUS;
28. Exhibit "E-2" - Affidavit of Use for the Tenth Anniversary of OLYMPUS;
29. Exhibit "F" - Certificate of Registration No. 4-1997-124493;
30. Exhibit "G" - Certificate of Registration no. 4-1997-124494;
31. Exhibit "H" - Certificate of Registration no. 4-1997-124495;
32. Exhibit "I" - Pictures of OLYMPUS billboards in Ortigas Northbound and Southbound;
33. Exhibit "J" - OLYMPUS promotional materials;
34. Exhibit "K" - WIPO Arbitration and Mediation Center - Administrative Panel Decision in Case No. D2001-1464 entitled Olympus USA, Inc., Olympus America, Inc.,

- and Olympus Optical Co., Ltd. v. World Photo Video and Imaging Corporation;
35. Exhibit "L" - Supplemental Affidavit of Tsuyoshi Kikuwara; and,
 36. Exhibit "L-1" - Authenticated listing of Well-Known Trademarks in Japan.

On 21 May 2005, Respondent-Applicant filed its Answer containing among others the following allegations:

"4. Respondent-applicant, Nicholas W. Wu also known as Wu Kin Chung is one of the incorporators of CEBU OLYMPUS MARKETING INCORPORATED which was registered in the Securities and Exchange Commission on March 12, 1991;

One of the company's primary business purpose as stated in the articles of Incorporation is to engaged in and operate a hardware store selling, distributing and marketing any kind of hardware, industrial and chemical products, equipments and machineries which may be needed, used, or necessary in any construction, industrial, commercial or manufacturing works;

x x x

"6. On January 21, 2005, respondent-applicant filed the trademark application for S.E.A OLYMPUS MARKETING, INC., its name and logo which was lodged by the Bureau of Trademarks as application no. 4-2005-000614. The main goods or services which the respondent-applicant intends to use the trademark is retail selling of hardware items and chemicals used in the business of Fiber Reinforced Plastics (FRP). This was classified by the aforesaid bureau in its registrability report as Class "35" in the NICE Classification of goods and services;

"7. The contention of the opposer that the respondent-applicant's application registration of the trademark, OLYMPUS and LOGO might damage its rights and interests is baseless, misplaced and out of context in provisions of the Intellectual Property Code of the Philippines or RA 8293;

The main argument which the opposer anchored his opposition is the probable violation of Section 123.1, paragraph (d) of RA 8293. As stated in its opposition that the respondent-applicant's mark, OLYMPUS and LOGO will mislead the purchasing public into believing that such goods are produced by, originate from, or are under the sponsorship of the opposer, OLYMPUS CORPORATION;

x x x

"8. Respondent-applicant's goods and services is classified as Class "35" which categorically includes "mainly services rendered by persons or organizations principally with the object of: (1) help in the working or management of a commercial undertaking, or (2) help in the management of the business affairs or commercial functions of an industrial or commercial enterprise, as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcement by all means of diffusion and concerning all kinds of goods or services." On the other hand, opposer's goods and services are classified as Class "02" - dyestuffs, pigments, painting materials excluding electrical insulating paints, printing inks, shoe polishes and polishing agents; Class "09" - electrical machines and apparatus, electrical communication machines and apparatus, applied electronic machines and apparatus, electrical material, excluding data processing equipments for office use and office machines of any kind; Class "16" - printing paper, copying paper, carbon paper, postcard paper, photographic printing paper, paper for digital printers and albums, etc. and Class "37" - services: repairs and maintenance of electrotechnical, electronic, fine-mechanical optical, medical-technical products;

By the aforesaid comparison, it is very clear the goods and services of both the respondent-applicant and the opposer are DISSIMILAR AND UNRELATED;

Respondent-applicant's products is retail services whereas the opposer's products are goods. The mark which the respondent-applicant sought to register is plainly related to its corporate name wherein, he wants his company to be identified and known as the service retailing company selling and distributing hardware items and chemicals used in the business of fiber reinforced plastics (FRP) for fashion accessories and furniture industries whereas the registered mark of the opposer pertains to goods and services related to optical and digital imaging. A plain comparison would tell that the two goods and services are of different species, dissimilar and very much unrelated. x x x

"9. As to matter of confusion of business or origin as conclusively alleged by the opposer particularly in paragraph 3.4 in its Verified Notice of Opposition, such argument is without basis. As explained in the preceding paragraphs, goods and services of both the opposer and the respondent-applicant are VERY MUCH DISSIMILAR AND UNRELATED. Although the trademark of the opposer particularly the mark 'OLYMPUS' is widely known for digital and optical imaging devices specifically its camera, still the purchasing public could not and would not be deceived or confused. x x x

"10. The apprehension of the opposer that the mark sought to be registered by the respondent-applicant might cause damage to its rights and interests is very unrealistic, imaginary and pure product of insinuation. The respondent-applicant's company has been in existence since 1991 bearing the mark or name 'Olympus' (as it was registered as Cebu Olympus Marketing, Inc. and later amended as S.E.A. Olympus Marketing, Inc.). If the use of such trademark has caused or likely to cause damage to the opposer then why there is no single iota of evidence presented by the opposer to prove damage in its business? Paragraph 6 in its verified Notice of Opposition even showed an upswing or increasing trend of net sales. Thus, clearly indicates absence of damage. Even in territorial boundaries, there is no way for the respondent-applicant could inflict whatsoever damages to the opposer through the use of such trademark. Respondent-applicant is operating only in the Philippines particularly in Cebu City whereas, the opposer is operating worldwide."

The Respondent-Applicant's evidence consists of the following:

1. Exhibit "1" - Certified true copies of Articles of Incorporation and By-Laws of Cebu Olympus Marketing Incorporated;
2. Exhibit "2" - Certified true copies of Article of Incorporation and By-Laws of S.E.A. Olympus Marketing Inc. (Formerly Cebu Olympus Marketing Incorporated); and,
3. Exhibit "3" - Downloaded articles on the company's profile;
4. Exhibit "4" - Certificate of Naturalization;
5. Exhibit "5" - Declaration of Actual Use for S.E.A. Olympus Marketing, Inc.;
6. Exhibit "6" - Secretary's Certificate executed by Edwina G. Wu; and,
7. Exhibit "7" - Order No. 2009-738 by the Bureau of Legal Affairs.

Opposer submitted its Reply 05 June 2009; and, Respondent-Applicant submitted its Rejoinder on 06 July 2009. Thereafter, the Preliminary conference was conducted and terminated on 01 July 2009. Upon the filing of the Opposer and Respondent-Applicant's position papers on 13 and 21 July 2009 respectively, the case is deemed submitted for resolution.

Should the Respondent-Applicant be allowed to register the trademark S.E.A. OLYMPUS MARKETING, INC. and LOGO?

As culled from the records and evidence, the Opposer has valid and existing registration for its mark "OLYMPUS", including prior-dated international registrations⁴ and Philippine trademark registrations which were timely renewed⁵. On the other hand, Respondent-Applicant filed its application only on 21 January 2005.

But are the competing marks, as shown below, confusingly similar?

OLYMPUS

Opposer's Trademark



Respondent-Applicant's Trademark

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁶ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The eyes can easily see that the marks are different. The similarity between the marks manifests in the word mark OLYMPUS. Such resemblance, however, is not sufficient to conclude that confusion is likely to occur. The appearance of the acronym "S.E.A" in darker shade of blue, the words "Marketing, Inc." in red color, and the logo consisting of a red circle with a white letter "M" and a blue circle around it makes the mark easily distinguishable to that of the Opposer's.

Moreover, confusion or mistake, much less deception, is unlikely in this instance because the goods or service covered by Opposer's trademark registration are far different from that of the Respondent-Applicant's. The Opposer's brand covers Trademark Registration Certificate No. 015450⁷, classes 37⁸, 09⁹, 02¹⁰, 09¹¹, and 16¹²; while the Respondent-Applicant's goods consist of service under class 35.¹³ The parties' respective goods/service neither flow in the same channels of trade nor target the same market as to result to any confusion. A consumer could easily discern that there is no connection between the two marks where the Opposer's goods with the brand of OLYMPUS are high valued photographic and medical apparatus and other electronic equipment, compared to Respondent-Applicant's business of retail selling of hardware items and chemical used in Fiber Reinforce Plastics (FRP) or fiber

⁴ Exhibits "B-1"- "B-4", "B-6" of Opposer.

⁵ Exhibits "C", "D", "E", "F", "G", "H" inclusive of submarkings of Opposer.

⁶ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

⁷ Exhibit "C" of Opposer.

⁸ Exhibit "D" of Opposer.

⁹ Exhibit "E" of Opposer.

¹⁰ Exhibit "F" of Opposer.

¹¹ Exhibit "G" of Opposer.

¹² Exhibit "H" of Opposer.

¹³ Filewrapper records.

glass.¹⁴ Therefore, it is doubtful that a purchaser of the mentioned goods of Opposer's or securing the service, repair and maintenance of the said goods would go to Respondent-Applicant's retail store of hardware and items and chemicals used in FRP to purchase a branded high valued goods. Buyers of branded products are highly aware of the channels of trade either to make a purchase, or for the repair and maintenance of the same.

Corollarily, the enunciation of the Supreme Court in the case of Mighty Corporation vs. E. & J. Gallo Winery¹⁵ aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. he is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The situation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

It is important to note that the word OLYMPUS is not a coined or invented word mark by the Opposer. OLYMPUS is "traditionally regarded as the heavenly abode of the Greek gods and the site of the throne of Zeus, Olympus seems to have originally existed as an idealized mountain that only later came to be associated with a specific peak. The early epics, the Illiad and the Odyssey (composed by Homer around 700BC) offer little information regarding the geographic location of the heavenly mountain and there are several peaks in Greece, Turkey and Cyprus that bear the name Olympus."¹⁶ Therefore, it is not impossible for the Respondent-Applicant to have concocted the word OLYMPUS as part of his trademark without having the intent to copy that of Opposer's trademark.

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.¹⁷ This Bureau finds that the Respondent-Applicant's mark meets this function.

¹⁴ *Fibre-reinforced polymer (FRP)*, also *Fibre-reinforced plastic*, is a composite material made of a polymer matrix reinforced with fibres. The fibres are usually glass, carbon, or aramid, although other fibres such as paper or wood or asbestos have been sometimes used. The polymer is usually an epoxy, vinyl ester or polyester thermosetting plastic, and phenol formaldehyde resins are still in use. FRPs are commonly used in the aerospace, automotive, marine, and construction industries. Available at <http://www.intechopen.com/books/fiber-reinforced-polymers-the-technology-applied-for-concrete-repair/introduction-of-fibre-reinforced-polymers-polymers-and-composites-concepts-properties-and-processes> (last accessed 12 February 2015).

¹⁵ G.R. No. 154342, 14 July 2004.

¹⁶ Places of Peace and Power Mt. Olympus, available at http://sacredsites.com/europe/greece/mt_olympus.html (last accessed 12 February 2015).

¹⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2005-000614 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 February 2015.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs