

COMITE INTERNATIONAL  
OLYMPIQUE (INTERNATIONAL  
OLYMPIC COMMITTEE-OIC),  
Opposer,

-versus-

CALCADOS AZALEIA S/A,  
Respondent- Applicant.

X-----X

}  
} **IPC No. 14-2011-00420**  
} Opposition to:  
} Appln. Serial No.4-2011-5000272  
}  
} **TM: "OLYMPIKUS & DESIGN"**

### NOTICE OF DECISION

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#### GREETINGS:

Please be informed that Decision No. 2016 - 200 dated June 28, 2016 (copy enclosed) was promulgated in the above entitled case.

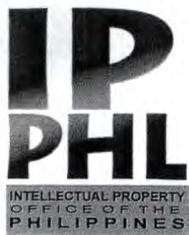
Taguig City, June 28, 2016.

For the Director:

**MARILYN F. RETUAL**  
IPRS IV  
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Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE

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**COMITE INTERNATIONAL OLYMPIQUE (INTERNATIONAL OLYMPIC COMMITTEE – OIC),**  
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**IPC NO. 14-2011-00420**

Opposition to:

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Date Filed:

Trademark: **"OLYMPIKUS & DESIGN"**

Decision No. 2016 - 200

**DECISION**

COMITE INTERNATIONAL OLYMPIQUE (INTERNATIONAL OLYMPIC COMMITTEE-IOC) ("Opposer")<sup>1</sup> filed a Verified Notice of Opposition to Trademark Application Serial No. 4-2011-5000272. The application filed by **CALCADOS AZALEIA S/A** ("Respondent-Applicant")<sup>2</sup>, covers the mark "OLYMPIKUS & DESIGN" for use on clothing, footwear, headgear under Class 25 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges that it is the owner of the "OLYMPIC" trademarks having been the first to adopt and use the same in actual trade and commerce world-wide and in the Philippines. The "OLYMPIC" trademarks which Opposer herein originated and adopted are well-known internationally. Its products and service carried under said trademarks had, through the years, earned international acclaim, as well as distinct reputation of high quality products and services. The official date of first use of Opposer's trademarks "OLYMPIC" and "OLYMPIC SYMBOL (five interlaced rings)" is in 1913. Further, the creation of the National Philippines Olympic Committee (POC), which uses the Opposer's "OLYMPIC" and "OLYMPIC SYMBOL" trademarks dates back in 1911.

Opposer obtained registrations for its "OLYMPIC" trademarks before the Intellectual Property Office (IPO). It also obtained registrations for its "OLYMPIC" trademarks covering products and services under International Classes 1 to 45 in many countries around the world. The Opposer's 'OLYMPIC' trademarks have been used, promoted and advertised for a considerable duration of time and over wide geographical areas.

The Opposer further alleged that the importance of the "OLYMPIC" trademarks, symbols, flag, motto, emblem, anthem, and other intangible properties associated with the "OLYMPIC" Games is also evident from the fact that there are various legislations in various countries to protect them in pursuance of the Nairobi Treaty on the Protection of the Olympic Symbol (1981). As to company's revenue, sponsorships by multinational companies and marketing are the most important sources of its revenue including products under similar and/or related goods under class 25, who are prepared to pay significant

<sup>1</sup> A Swiss corporation organized and existing under the laws of Switzerland.  
<sup>2</sup> A company incorporated and existing under the laws of the Federative Republic of Brazil with address at Rua Dr. Legendre, 34, Parobe, Rio Grande do Sul, Brazil, 95630-00.  
<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services 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.

license-fees to acquire the right to combine their sign with names like "OLYMPIC" or with the Olympic Symbols. Thus, Opposer believes that the use by Respondent-Applicant of the "OLYMPIKUS & DESIGN" mark for its products and services will definitely mislead the public into believing that its products and services originate from, or are licensed or sponsored by Opposer or that Respondent-Applicant is associated with or an affiliate of Opposer.

Opposer relied on the following grounds in this instant opposition: the Opposer is the exclusive owner and the first to adopt, use and register the "OLYMPIC" trademarks in the Philippines; the Opposer's "OLYMPIC" trademarks, with registrations and applications worldwide, are well-known internationally and in the Philippines; there is a likelihood of confusion between Respondent-Applicant's "OLYMPIKUS & DESIGN" mark and Opposer's "OLYMPIC" trademarks; and, the use of Respondent-Applicant's "OLYMPIKUS & DESIGN" mark for its products would indicate a connection to the products and services covered in Opposer's "OLYMPIC" trademarks.

Finally, Opposer made reference to Inter Partes Case No. 14-2011-00240 entitled "Comite International Olympique (International Olympic Committee-IOC) vs. Juanito B. Gervasio" involving the 'OLYMPIC VILLAGE & DEVICE' mark.

The Opposer's evidence consists of the following:

1. Secretary's Certificate;
2. Special Power of Attorney;
3. Certificate of Registration issued by the IPO for several OLYMPIC trademarks registered under Comite International Olympique;
4. Certificate of Registration from various countries covering products and services under Classes 1 to 45 for the OLYMPIC trademark registered under Comite International Olympique;
5. Series of Marketing Report Beijing 2008 with information on broadcasting in Asia, Worldwide licenses and Top Sponsors;
6. Series Marketing Report Sydney 2000;
7. Series documentation relating to financial assistance by means of Olympic Solidarity;
8. Affidavit of Howard Stupp; and,
9. Copies of Inter Partes Case No. 14-2011-00240 entitled Comite International Olympique vs. Juanito B. Gervasio involving OLYMPIC VILLAGE & DEVICE.

On 01 March 2012, the Respondent-Applicant filed its Answer raising the following special and affirmative defenses: Respondent-Applicant alleges that the instant opposition should be dismissed outright on two grounds, that the Special Power of Attorney and Secretary's Certificate supposedly appointing the counsel of record as agent of the Opposer are defective as these were not authenticated; and that the Opposer failed to allege its capacity to sue in this jurisdiction, and as a consequence, failed to state a cause of action in its Notice of Opposition. Respondent-Applicant further alleged that confusion between the two marks is unlikely and remote because Respondent-Applicant's mark "OLYMPIKUS & DESIGN" is highly distinctive by itself. The "OLYMPIKUS & DESIGN" mark can easily be distinguished from the marks of the Opposer visually, and phonetically. In fact, this is proven by the fact of the peaceful peaceful co-existence of the marks in other jurisdictions. The "OLYMP" marks co-exist in the Philippine Registry and in other jurisdictions which shows that the dominant element for the Respondent-Applicant's mark as well as that of the Opposer's is the term "OLYMP". Finally, Respondent-Applicant asserted the Opposer's failure to prove of goods under class 25.

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

1. Company's Articles of Incorporation;
2. Special Power of Attorney;
3. Details of the application for trademark of OLYMPIKUS & DESIGN;
4. Copy of Opposer's Special Power of Attorney and Secretary's Certificate;
5. Advertising/marketing campaigns for the brand OLYMPIKUS via the YouTube.com;
6. Print advertising and promotion for the brand OLYMPIKUS in Brazil and the Latin America;
7. Visits in the website www.olympikus.com.br;
8. Article published in Epoca Negocios magazine of 2009;
9. Copy of Resolution issued by INPI in the Official Gazette number 1857 of 08/08/2006;
10. Schedule of trademark registrations in Brazil, European Countries and in other jurisdictions;
11. Copies and Certified true copies of Certificates of Registration;
12. Proof of existence of the contending marks in Brazil, Switzerland and in other jurisdictions;
13. List of marks registered in the Philippines; and,
14. Proof of peaceful co-existence of OLYMP marks ad interlocking ring device marks.

The preliminary conference was held and terminated on 18 July 2012. Thereafter, the parties timely filed their respective position papers.

Should the Respondent-Applicant be allowed to register the trademark OLYMPIKUS & DESIGN?

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 out into the market a superior 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.<sup>4</sup>

Records show that at the time Respondent-Applicant filed its application for the trademark OLYMPIKUS & DESIGN on 23 February 2011<sup>5</sup>, herein Opposer already has existing registrations for its "OLYMPIC" trademarks in the Philippines<sup>6</sup> and in various foreign jurisdictions<sup>7</sup>, prior to Respondent-Applicant's application filing date. In the Philippines, a certificate of registration constitutes a prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.<sup>8</sup>

<sup>4</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

<sup>5</sup> Filewrapper records.

<sup>6</sup> Exhibits "A" to "A-5" of Opposer.

<sup>7</sup> Exhibit "B" of Opposer.

<sup>8</sup> Sec. 138, IP Code.

The competing marks are reproduced below for comparison and scrutiny:

  
OLYMPIC

OLYMPIC TORCH RELAY



YOUTH OLYMPIC GAMES

YOUTH OLYMPICS



Opposer's Trademarks



Respondent-Applicant's Trademark

It appears that the competing marks have striking similarities both in the word mark and the design. The word mark OLYMPIC as against OLYMPIKUS shows phonetic likeness and appearance. While it also appears that Respondent-Applicant's trademark OLYMPIKUS & DESIGN contain some dissimilarities with Opposer's OLYMPIC trademarks, such dissimilarities made by Respondent-Applicant can be observed as a way of hiding the intent to copy Opposer's trademarks. The OLYMPIKUS and the design of the *three-arched rings* is a mere translation of Opposer's *five-arched rings*, as well as the translation of the word OLYMPIC to OLYMPIKUS. The allowance of Respondent-Applicant's application will likely causes confusion to the consuming public, taking into consideration the wide market where Opposer's products are being sold.

Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other.<sup>9</sup> Colourable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colourable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark with that of the other mark or trade name in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.<sup>10</sup>

<sup>9</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 200, 356 SCRA 207, 217.

<sup>10</sup> Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.

Also, considering the similarity or relatedness of goods carried by the contending marks, the consumers will have the impression that these products originate from a single source or origin or they are associated with one another. The likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:<sup>11</sup>

Cullman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

In this instant case, the Olympic events as well as the marketing of goods or services bearing the OLYMPIC marks<sup>12</sup> demonstrates goods or services bearing the OLYMPIC marks, pertaining and originating from the Opposer. As such, considering the probable purchaser's attitude and habits, marketing activities, retail outlets, and commercial impression, there is a high likelihood that the trademarks of the Opposer and the Respondent-Applicant pertain to related fields of manufacture, distribution and marketing under similar conditions. Both are likely to be conveyed and move in the same channels of trade. In fact, Opposer's products and sponsorship agreements with various companies necessarily cover goods under Class 25, since clothing, footwear, and headgear are the most common and ordinary items available for sale during every Olympic Games.<sup>13</sup> Thus, the goods of the Opposer and the Respondent-Applicant are of a character which purchasers would be likely to attribute to a common origin.

Thus, Sec. 123.1 (d) of the IP Code provides:

A mark cannot be registered if it:

x x x

(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;

Corollarily, the public interest requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that the function of 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.<sup>14</sup>

<sup>11</sup>

Id.

<sup>12</sup>

Exhibits "C" and "D" series.

<sup>13</sup>

Id. at 12; Exhibit "E" series of Opposer.

<sup>14</sup>

Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2011-500272 is hereby **SUSTAINED**. Let the file wrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 June 2016.

  
**Atty. NATHANIEL S. AREVALO**  
*Director IV, Bureau of Legal Affairs*