

OMEGA SA (Omega AG) (Omega Ltd.).  
Opposer,

- versus -

IPC No. 14-2008-00106  
Opposition to:  
Appl'n Serial No. 4-2006-012583  
Date Filed: November 21, 2006  
Trademark: "MEGA"

SHARON CUNETA-PANGILINAN  
Respondent-Applicant  
X-----X

Decision No. 2009-98

## DECISION

For decision is the Notice of Opposition filed by Omega SA (Omega AG) (Omega Ltd.), (hereinafter referred to as opposer) a corporation organized under the laws of Switzerland with business address at Jakob Stampfli-Strasse 96 2502 Biel/Bienne (Switzerland) against Application Serial No. 4-2006-012583 for the mark MEGA filed on November 21, 2006, used for goods under class Class 3 namely: perfumery, cologne, essential oils, cosmetics, hair lotions, soaps, toiletries; Class 14 for "precious metals and their alloys, namely gold, silver, bronze, copper, and the like and in precious metals or coated therewith, not included in other classes, namely bracelets, necklace, rings, anklets, bangles, earrings, chains, brooches, charms, tie clips, tie pins, cuff links, ornamental pins, statues, statuettes, works of art, watch straps, and watch bands; jewelry, precious stones; fashion/costume jewelry and ornaments; and horological and chronometric instruments". Class 18 namely: leather and imitations of leather, and goods made of these materials and not included in other classes, namely notebook or personal planner, cover jackets, binders, folders, fashion accessories, keychains, cellular phone casings, vanity kits, boxes, card cases, briefcases, music cases, casings, covers, furniture coverings, frames, slings, and sling bags, and trimmings; animal skins, hides, trunks and travelling bags, shoulder bags, handbags, clutch bags, purses, coin purses, belts, umbrellas; and wallets; Class 25 namely: clothing, namely gowns, skirts, pants, shorts, blouses, shirts, jackets, sweaters, knitwear, suits, vests, overalls, overcoats, waistcoats, hoods, pyjamas, tights, pants, robes, saris, shashes, shawls, veils, swimwear, trunks, swimsuits, wristbands, smocks, pelisses, gloves, and underwear, footwear namely ladies shoes, sandals, slippers, boots, half boots, lace boots, wooden shoes, gymnastic shoes, soles, heelpieces, heels, socks, stockings, and headgear namely, ladies' hats, hat frames, caps, shower caps, skull caps, helmets, bonnets, bandan, headbans" Class 26 namely: "lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles, artificial flower, and hair ornaments" and Class 41 namely, education, providing of training, entertainment, and sporting and cultural activities, filed by Sharon Cuneta-Pangilinan (hereinafter referred to as Respondent-applicant), a Filipino citizen, with address at Unit 1804, Goldloop Towers Condominium, J.M. Escriva Drive, Ortigas Center, Pasig City.

The grounds for opposition are as follows:

"1) Opposer is the first to register, adopt and use the trademark "OMEGA" for goods under international classes 14, especially horological goods, in the Philippines and other countries worldwide; and therefore enjoys under Section 147 of Republic Act (R.A.) No. 8293 the right to exclude others from registering or using, in the Philippines, an identical or confusingly similar mark such as Respondent-Applicant's trademark "MEGA" under international class 14 for "PRECIOUS METALS AND THEIR ALLOYS, NAMELY GOLD, SILVER, BRONZE, COPPER, AND THE LIKE AND IN PRECIOUS METALS OR COATED THEREWITH, NOT INCLUDED IN OTHER CLASSES, NAMELY BRACELETS, NECKLACE, RINGS, ANKLETS, BANGLES, EARRINGS, CHAINS, BROOCHES, CHARMS, TIE CLIPS, TIE PINS, CUFF LINKS, ORNAMENTAL PINS, STATUES, STATUETTES, WORKS OF ART, WATCH STRAPS, AND WATCH BANDS; JEWELRY, PRECIOUS STONES; FASHION/COSTUME JEWELRY AND ORNAMENTS; AND HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS".

2) There is a likelihood of confusion between Opposer's trademark "OMEGA" for goods under international classes 14 and Respondent-Applicant's trademark "MEGA" under international class 14 for "PRECIOUS METALS AND THEIR ALLOYS, NAMELY GOLD, SILVER, BRONZE, COPPER, AND THE LIKE AND IN PRECIOUS METALS OR COATED THEREWITH, NOT INCLUDED IN OTHER CLASSES, NAMELY BRACELETS, NECKLACE, RINGS, ANKLETS, BANGLES, EARRINGS, CHAINS, BROOCHES, CHARMS, TIE CLIPS, TIE PINS, CUFF LINKS, ORNAMENTAL PINS, STATUES, STATUETTES, WORKS OF ART, WATCH STRAPS, AND WATCH BANDS; JEWELRY, PRECIOUS STONES; FASHION/COSTUME JEWELRY AND ORNAMENTS; AND HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS", because the latter is identical with Opposer's trademark "OMEGA".

3) The Opposer's "OMEGA" trademark is well known internationally and in the Philippines, especially for horological goods, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being a trademark owned by the Opposer; hence, even assuming for the sake of argument that horological and related products on one hand and PRECIOUS METALS AND THEIR ALLOYS, NAMELY GOLD, SILVER, BRONZE, COPPER, AND THE LIKE AND IN PRECIOUS METALS OR COATED THEREWITH, NOT INCLUDED IN OTHER CLASSES, NAMELY BRACELETS, NECKLACE, RINGS, ANKLETS, BANGLES, EARRINGS, CHAINS, BROOCHES, CHARMS, TIE CLIPS, TIE PINS, CUFF LINKS, ORNAMENTAL PINS, STATUES, STATUETTES, WORKS OF ART, WATCH STRAPS, AND WATCH BANDS; JEWELRY, PRECIOUS STONES; FASHION/COSTUME JEWELRY AND ORNAMENTS; AND HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS on the other are not related or similar, the Respondent-Applicant's trademark "MEGA:" cannot be registered in the Philippines pursuant to the express provision of Section 147.2 of R.A. No. 8293. There is no doubt that the use of Respondent-Applicant's trademark "MEGA" under international class 14 for "PRECIOUS METALS AND THEIR ALLOYS, NAMELY GOLD, SILVER, BRONZE, COPPER, AND THE LIKE AND IN PRECIOUS METALS OR COATED THEREWITH, NOT INCLUDED IN OTHER CLASSES, NAMELY BRACELETS, NECKLACE, RINGS, ANKLETS, BANGLES, EARRINGS, CHAINS, BROOCHES, CHARMS, TIE CLIPS, TIE PINS, CUFF LINKS, ORNAMENTAL PINS, STATUES, STATUETTES, WORKS OF ART, WATCH STRAPS, AND WATCH BANDS; JEWELRY, PRECIOUS STONES; FASHION/COSTUME JEWELRY AND ORNAMENTS; AND HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS" would indicate a connection between these goods and the Opposer. Likewise, the interests of the Opposer are likely to be damaged by Respondent-Applicant's use of the trademark "MEGA:" under international class 14 for "PRECIOUS METALS AND THEIR ALLOYS, NAMELY GOLD, SILVER, BRONZE, COPPER, AND THE LIKE AND IN PRECIOUS METALS OR COATED THEREWITH, NOT INCLUDED IN OTHER CLASSES, NAMELY BRACELETS, NECKLACE, RING, ANKLETS, BANGLES, EARRINGS, CHAINS, BROOCHES, CHARMS, TIE CLIPS, TIE PINS, CUFF LINKS, ORNAMENTAL PINS, STATUES, STATUETTES, WORKS OF ART, TCH STRAPS, AND WATCH BANDS; JEWELRY, PRECIOUS STONES; FASHION/COSTUME JEWELRY AND ORNAMENTS; AND HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS"

4) The Respondent-Applicant, by using "MEGA" as its trademark for its goods has given them the general appearance of the products of the Opposer, which would likely influence purchasers to wrongly believe that these products originate from the Opposer, thereby deceiving the public and defrauding the Opposer of its legitimate trade hence, Respondent-Applicant is guilty of unfair competition as provided in Section 168.3 of R.A. No. 8293.

5) Respondent-Applicant, in adopting the trademark "MEGA:" for its products is likely to cause confusion, mistake, or deception as regards its affiliation, connection, or association with the Opposer, or as to the origin, sponsorship, or approval of its products

by the Opposer, for which it is liable for false designation of origin, false description or representation under Section 169 of R.A. No. 8293.

Opposer submitted the following evidence in support of the opposition:

EXHIBIT	DESCRIPTION
"A"	Certificate of Renewal of Registration
"B"	OMEGA labels

Respondent-applicant in her Answer filed on 26 August 2008 raised the following defenses:

- A. Opposer's alleged prior use and registration of the trademark "OMEGA" for watches under class 14 do not constitute a bar to the registration of respondent-applicant's trademark "MEGA" under class 14 for horological and chronometric instruments.
- B. Opposer's alleged prior use and registration of the trademark "Omega" for Watches under class 14 do not bar respondent-applicant's registration of the mark "MEGA" for goods unrelated and non-competing with opposer's goods.
- C. Respondent-applicant is not guilty of unfair competition."

Respondent-applicant did not submit any evidence in support of its defense.

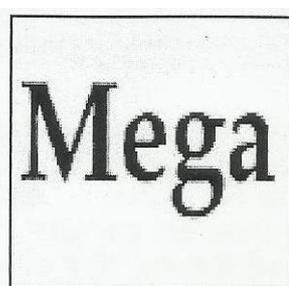
The preliminary conference was set initially set on 2 October 2008 but no amicable settlement was obtained by the parties. In view thereof, the parties were directed to file their respective position papers.

The issues for consideration are whether the registration of the mark MEGA is barred by opposer's prior use and registration of the mark OMEGA mark's previous registration. Simultaneously, the Bureau will determine whether the marks OMEGA and MEGA are confusingly similar. Corollary is whether OMEGA is a well-known mark.

Opposer's mark



Respondent-applicant's mark



First, the Supreme Court in *Societe des Produits Nestle v. Court of Appeals*, G.R. No. 112012, cautions:

"It must be emphasized that in infringement or in trademark cases in the Philippines, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set of rules can be deduced. Each case must be decided on its own merits.

The applicable provision of Republic Act 8293 provides:

“Section d 123. Registrability. 123.1 A mark cannot be registered if it:

( ) 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”

Evidence show that opposer is the registered owner of the mark OMEGA under Certificate of Renewal of Registration No. R-1766 (Exhibit “A”, Annex “B” of affidavit of Edith Dychiao) dated 23 August 1976 for goods under class 14, namely “watches”. As to whether the contending marks OMEGA and MEGA are similar as likely to deceive or cause confusion, jurisprudence has developed two tests in determining the issue of confusing similarity. The Supreme Court in McDonald’s Corporation v. L.C. Big Mak Burger, Inc., G.R. No. 143993, dated 18 August 2004 held:

“In determining likelihood of confusion, jurisprudence has developed two tests, the dominance test and the holistic test. The dominance test focuses on the similarity of the prevalent features of the competing trademarks that might cause confusion. In contrast, the holistic test requires the court to consider the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity. xxx

The test of dominance is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the “colorable imitation of a registered mark xxx or a dominant feature thereof.”

Applying the dominance test, the Court finds that respondents’ use of the “Big Mak” mark results in likelihood of confusion. First, “Big Mak” sounds exactly the same as “Big Mac”. Second, the first word in “Big Mak” is exactly the same as the first word in “Big Mac”. Third, the first two letters in “Mak” are the same as the first two letters in “Mac”. Fourth; the last letter in “Mak” while a “K” sounds the same as “c” in spelling, thus “Caloocan” is spelled “Kalooacan”.

Applying the dominance standard in perusing the marks, the dominant feature of opposer’s mark is the word OMEGA. On the other hand, respondent-applicant’s mark is the word MEGA. As regards to the literal elements, the addition of the word “O” is the only difference between the word components of the marks. When pronounced, the phonetic similarity is at once apparent. *Idem sonans* or similarity in sound would be a criteria for a finding that confusing similarity exists.

In Marvex Commercial Co., Inc. vs. Petra Hawpia & Co. (18 SCRA 1178), the Supreme Court held:

“ The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, Unfair Competition and Trade Marks, 1947, vol. 1, will reinforce our view that “SALONPAS” and “LIONPAS” are confusingly similar in sound: “Gold Dust” and “Gold Drop”; ‘Jantzen and “Jazz-Sea”; “Silver-splash” and “Supper-Flash”; “Cascarete” and “Celborite”; “Celluloid” and “Cellonite”;

“Charteuse” and “Charseurs”; “Cutes” and “Cuticlean”; “Hebe” and “Meje”; “Kotex” and “Femetex”; “Zuso” and “Hoo-hoo” Leon Amdur, in his book “Trademark law and Practice”, pp. 419-421, cites, as coming within the purview of the *idem sonans* rule. “Yusea” and “U-C-A”, “Steinway Pianos” and “Stienberg Pianos” and “Seven-Up” and “Lemon-Up”. In Co Tiong vs. Director of Patents, this Court unequivocally said that “Celdura” and “Condura” are confusingly similar in sound; this Court held in Sapolin Co. vs. Balmaceda, 67 Phil. 795 that the name “Lusolin” is an infringement of the trademark “Sapolin”, as the sound of the two names is almost the same.

In the case at bar, "SALONPAS" and "LIONPAS" when spoken sound very much alike. Similarity of sound is sufficient ground for this court to rule that the two are confusingly similar when applied to merchandise of the same descriptive properties. (See *Celanese Corporation of America vs. E.I. Du Pont*, 154 F. 2d. 146, 148).

"A trade-name in order to be an 'infringement' upon another need not be exactly like it in form and sound, but it is enough if the one so resembles another as to deceive or mislead persons of ordinary caution into the belief that they are dealing with the one concern when in fact they are dealing with the other." (*Foss v. Culbertson*, 136 P. 2d 711, 718, 17 Wash. 2d 610). xxx

Moreover, it could be that because of the striking similarity of the word mark component, confusion as to source or origin is likely. Customers might assume that there is a connection between the respondent-applicant's goods and the opposer. Clearly, on account of the fact that opposer is the senior registrant of OMEGA AND DEVICE for goods under Class 14, respondent applicant's use of MEGA also for goods under class 14 should be disallowed. In the landmark case of *Sta. Ana v. Maliwat* [G.R. No. L-23023. August 31, 1968.], the Supreme Court held:

"Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade-mark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field or is in any way connected with the activities of the infringer or when it forestalls the normal potential expansion of his business."

Anent the issue of whether opposer's prior registration bars respondent-applicant in registering the MEGA mark for goods under classes 3, 18, 25, 26, 41, the Bureau adopts the principle laid down by the Supreme Court in the case of *Philippine Refining Co., Inc. vs. Ng Sam and the Director of Patents* (No. L-26676 July 30, 1982), it held:

"A rudimentary precept in trademark protection is that "the right to a 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 goods does not prevent the adoption and use of the same trademark by others of on articles of a different description.

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, 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. (Emphasis supplied).

Confusion is unlikely to result from the use of the mark MEGA on totally different categories of goods and service. This trademark concept is applied in the case of *Esso Standard Eastern, Inc. vs. Court of Appeals and United Cigarette Corporation* (G.R. No. L29971. August 31, 1982), wherein the Supreme Court ruled that there is no infringement of the trademark "ESSO" owned and used by petitioner on petroleum products by respondent's use of the same "ESSO" mark on its cigarette goods. It held:

"the law defines infringement as the use without the consent of the trademark owner of any "reproduction, counterfeit, copy or colorable imitation of any registered mark or tradename in connection with the sale, offering for sale, or advertising of any goods, business or services on or in connection with which the use is likely to cause confusion, mistake or to deceive purchasers or others as to the source or origin of such good".

Implicit in this definition is the concept that the goods, must be so related that there is likelihood either of confusion of goods or business.” (Emphasis supplied)

The Bureau finds no objection to respondent-applicant’s application for the mark MEGA for goods under Class 3 namely: perfumery, cologne, essential oils, cosmetics, hair lotions, soaps, toiletries; Class 18 namely: leather and imitations of leather, and goods made of these materials and not included in other classes, namely notebook or personal planner, cover jackets, binders, folders, fashion accessories, keychains, cellular phone casings, vanity kits, boxes, card cases, briefcases, music cases, casings, covers, furniture coverings, frames, slings, and sling bags, and trimmings; animal skins, hides, trunks and travelling bags, shoulder bags, handbags, clutch bags, purses, coin purses, belts, umbrellas; and wallets; Class 25 namely: clothing, namely gowns, skirts, pants, shorts, blouses, shirts, jackets, sweaters, knitwear, suits, vests, overalls, overcoats, waistcoats, hoods, pyjamas, tights, pants, robes, saris, shashes, shawls, veils, swimwear, trunks, swimsuits, wristbands, smocks, pellices, gloves, and underwear, footwear namely ladies shoes, sandals, slippers, boots, half boots, lace boots, wooden shoes, gymnastic shoes, soles, heelpieces, heels, socks, stockings, and headgear namely, ladies’ hats, hat frames, caps, shower caps, skull caps, helmets, bonnets, bandan, headbans” Class 26 namely: “lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles, artificial flower, and hair ornaments” and Class 41 namely, education, providing of training, entertainment, and sporting and cultural activities, because these goods and services are of a different category and unrelated to goods under Class 14, namely: “watches”.

The opposer also claims to be that its mark is well-known which precludes the registration of respondent-applicant. The law states:

“Sec. 123. Registrability. - 123.1 A mark cannot be registered if it:

(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, that in determining whether a mark is well known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark; x x”

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: Provided further, That the interests of the owner of the registered mark are likely to be damaged by such use”

The Bureau has earlier ruled held that the marks when used for goods under the same class 14 can lead to confusion on account of opposer’s prior registration of its mark in the Philippines but such confusion does not necessarily result if respondent-applicant’s mark is used on goods of a different class. Regarding the issue of well-knownness, the Bureau does not agree that the opposer’s mark is well-known. The mere establishment of boutiques in the Philippines as evidenced by pictures (Annex “D”) and advertising materials in the form of pictures (Annex “E”) with no indication as to the source, dates of publication or duration of these promotional efforts cannot establish- its fame in the Philippines or abroad.

WHEREFORE, premises considered the OPPOSITION filed by Omega SA (Omega AG) (Omega Ltd) is, as it is hereby, SUSTAINED in respect of class 14 and DENIED in respect of classes 3, 18, 25, 26, and 41. Accordingly, Application Serial No. 4-2006-012583 for the mark MEGA covering goods under Class 3, 18, 25, 26, 41 filed by respondent-applicant, Sharon

Cuneta-Pangilinan is, as it is, hereby given DUE COURSE, except for goods under class 14 which is hereby REJECTED.

Let the filewrapper of "MEGA", subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 30 July 2009.

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