

OMEGA SA (OMEGA AG)	}	IPC No. 14-2005-00072
(OMEGA LTD.)	}	Opposition to:
Opposer,	}	Appln. Ser. No.: 4-2001-008726
	}	Date Filed: November 2, 2001
-versus-	}	TM: "OMEGA MAGIC"
	}	
CONSUMER CARE PRODUCTS,	}	
INC.,	}	
Respondent-Applicant .	}	Decision No. 2006-78
x-----x		

DECISION

Before us is an Opposition filed by Omega SA (Omega AG) Omega Ltd., a company duly organized under the laws of Switzerland against the application bearing serial no. 4-2001-008726 for the registration of the mark "OMEGA MAGIC" used for a natural blend of high-grade omega 6 and omega 3 essential oils, which application was filed by Consumer Care Products, Inc., on November 22, 2001 with address at Industria Street, Bagumbayan, Quezon City.

The subject trademark application was published for opposition in the IPO Electronic Gazette, which was released on April 11, 2005.

Opposer relied on the following grounds for opposition:

"1. Opposer is the first to register, adopt and use the trademark "OMEGA" for goods under international classes 14 and 16, 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 "OMEGA MAGIC" for a natural blend of high grade omega 6 and omega 3 essential oils.

"2. There is a likelihood of confusion between Opposer's trademark "OMEGA" for goods under international classes 14 and 16 and Respondent-applicant's trademark "OMEGA MAGIC" for a natural blend of high grade omega 6 and omega 3 essential oils under international class 3, 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 a natural blend of high grade omega 6 and omega 3 essential oils on the other are not related or similar, the Respondent-Applicant's trademark "OMEGA MAGIC" cannot be registered in the Philippines pursuant to the express provision of Section 147.2 of R.A 8293. There is no doubt that the use of Respondent-Applicant's trademark "OMEGA MAGIC" for a natural blend of high-grade omega 6 and omega 3 essential oils 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 "OMEGA MAGIC" for a natural blend of high-grade omega 6 and omega 3 essential oils.

"4. The Respondent-Applicant, by using "OMEGA MAGIC" 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 goods 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. 8293.

“5. Respondent-Applicant, in adopting the trademark “OMEGA MAGIC” 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. 8293.

Likewise, Opposer relied on the following fact to support its opposition:

“1. The Opposer is the first to adopt, use and register the “OMEGA” trademarks in the Philippines and many countries worldwide.

Opposer is the first to adopt and use its “OMEGA” trademark for goods falling under classes 14 and 16 in the Philippines and many countries around the world. Opposer has prior use and registrations for “OMEGA” trademark in the Philippines and abroad. As a matter of fact, the trademark “OMEGA” has been used in the Philippines by the herein Opposer and its predecessor since 1906.

Opposer was issued by the IPO the following certificates of trademark registration:

Trademark	Registration No.	Date Issued	Classes of Goods
Omega & Device	4-1996-110786	September 28, 2000	16
Omega & Device	R-1766	August 23, 1996	14

“2. There is a likelihood of confusion between Respondent-Applicant’s trademark “OMEGA MAGIC” and Opposer’s “OMEGA” trademark.

Respondent-Applicant’s trademark “OMEGA MAGIC” is identical with and/or similar to Opposer’s “OMEGA” trademark hence, would likely influence the purchasers to believe that it belongs to the Opposer.

“3. The Opposer’s “OMEGA” trademark is well-known internationally and in the Philippines.

The Opposer has obtained registrations and pending applications for its “OMEGA” trademark covering goods under international classes 14 and 16 in the Philippines and several countries of the world. As a matter of fact, Opposer has more than a hundred registrations for its “OMEGA” mark in various countries worldwide.

The Opposer’s “OMEGA” trademark has been used, promoted and advertised for a considerable duration of time and over wide geographical areas. Opposer has invested tremendous amount of resources in the promotion of its trademark through sponsorships of sports competition and placement of advertisements in magazines, newspapers, videos, movies, etc. In fact, the Opposer’s “OMEGA” trademark has a considerable share in the markets in the Philippines and in other countries. There is already a high degree of distinction of the Opposer’s “OMEGA” trademark. Its products carried under said trademarks had, through the

years, earned international acclaim, as well as the distinct reputation of being highly quality products.

“4. The use of Respondent-Applicant’s trademark “OMEGA MAGIC” for goods under international class 3 would indicate a connection to the products covered in Opposer’s “OMEGA” trademark, hence, the interests of the Opposer are likely to be damaged.

The use of the Respondent-Applicant’s trademark “OMEGA MAGIC” for goods under international class 3 definitely misleads the public into believing that the products originate from, or are licensed or sponsored by Opposer or that Opposer.

Respondent-Applicant has appropriated the trademark “OMEGA MAGIC” for the obvious purpose of capitalizing upon or riding on the valuable reputation, goodwill and popularity in the international market for “OMEGA” products which Opposer gained through tremendous effort and expense over a long period of time. This clearly constitutes an invasion of Opposer’s intellectual property rights.

Undoubtedly, the use of the “OMEGA MAGIC” trademark and the sale and distribution of goods falling under international class 3 bearing the trademark “OMEGA MAGIC” by the Respondent-Applicant are inflicting considerable damage to the interests of the Opposer. To allow Respondent-Applicant to register “OMEGAMAGIC” trademark, will constitute a mockery of our laws protecting intellectual property rights, as it will legitimize Respondent-Applicant’s unfair and unlawful business practice.

A Notice to Answer dated August 10, 2005 was issued by this Office requiring the Respondent-Applicant to file his Answer within fifteen (15) days from receipt thereof. However, Respondent-Applicant failed to file its Answer within the reglementary period despite receipt of the notice.

Subsequently, this case was later mandatorily covered by Office Order No. 79 when it took effect on September 1, 2005. Considering that Respondent-Applicant failed to file an answer, Opposer was directed to file its evidence within a specified period pursuant to the Notice to Comply dated October 10, 2005. On February 23, 2006, this Bureau issued Order No. 2006-317 by noting that Opposer actually filed its Compliance on December 9, 2005. Thereafter, this case is deemed submitted for decision.

The main issue to be resolved in this case is whether or not Respondent-Applicant’s mark “OMEGA MAGIC” is confusingly similar to Opposer’s mark “OMEGA” which violates the provisions of Republic Act 8293 otherwise known as the Intellectual Property Code of the Philippines, the law governing the instant opposition considering that the application was filed during the effectivity of the said statute.

Sec. 123 (d) of RA 8293 states to wit:

“Sec. 123. Registrability-123.1 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;

x 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;

x x x"

the question of confusing similarity of a mark to another mark is question of fact the determination of which no all-embracing rule applies as a number of factors such as the class of product or business to which the goods apply; the appearance, commercial impression, meaning, and sound of the mark, the product's quality and quantity, to name a few, must be considered. Likelihood of confusion is a relative concept to be determined only according to the particular, and sometimes peculiar, circumstances of each case. The wisdom of the likelihood of confusion test lies in its recognition that each trademark infringement case presents its own unique set of facts. Indeed the complexities attendant to an accurate assessment of likelihood of confusion require that the entire panoply of elements constituting the relevant factual landscape must be comprehensively examined.

After a careful examination of the records and the evidence presented, this Bureau finds that the simultaneous use of Opposer's mark "OMEGA" and Respondent-Applicant's "OMEGA MAGIC" neither results to actual confusion nor likelihood of confusion between the two marks. We find Opposer's contentions without merit and hold that there is no confusing similarity of trademarks, which justify an opposition to Respondent's application for registration of the mark "OMEGA MAGIC".

Indubitably, the competing marks of Opposer and respondent-applicant both contained the word "OMEGA" and as such, it is the *dominant* feature of both trademarks. Incidentally however, respondent-applicant has already disclaimed the word "OMEGA". The purpose of the disclaimer is only to make of record that a significant element of the mark is not being exclusively appropriated by itself apart from the mark itself. A disclaimer only shows that the applicant is not making a claim to exclusive appropriation of the disclaimed except in the precise relation and association to other mark (MAGIC) or marks appearing in the drawing, description and in the label. The disclaimer does not have the effect of removing from the mark the matter disclaimed. It disclaims only any exclusive right in those disclaimed words or symbols per se. that is, the applicant is merely stating that he is claiming only the whole composite mark as his property, and makes no claim to those particular portions disclaimed.

Furthermore, the respective trademarks of the parties are not being used on identical goods and for identical purposes and that this is an important factor in determining whether or not there is confusing similarity of trademarks. As already indicated earlier, Opposer's trademark is being used for goods under International classes 14 and 16. On the other hand, Respondent-Applicant's trademark covers "a natural blend of high grade omega 6 and omega 3.

In the case of ESSO STANDARD EASTERN, INC., vs. THE HONORALE COURT OF APPEALS and UNITED CIGARETTE CORPORATION [G.R. No. L-29971, August 31, 1982.] the Supreme Court ruled:

“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”

Applying these legal percepts to the instant case, Respondent-Applicant’s use of the trademark “OMEGA AND DEVICE” is not likely to cause confusion or mistake or to deceive the consumers of either the goods of the Opposer and that of the Respondent-Applicant or both as to the identity of the goods, their source and origin, or identity of the businesses of Opposer and Respondent.

It is undisputed that Opposer uses the trademark OMEGA and holds Philippine Certificate of Registrations for classes under 14 and 16 (watches under Reg. No. R-1766 and pencils, pens, propelling pens, ball-point pens, felt pens, painting brushes under Reg. No. 4-1996-110786)

On the other hand, Respondent-Applicant’s OMEGA MAGIC is being used solely for a natural blend of high-grade omega 6 and omega 3 essential oils which goods are very different, non-competitive and unrelated to Opposer’s goods. Neither do they belong to same class of goods. Opposer’s goods belong to classes 14 and 16 whereas Respondent-Applicant’s goods belong to class 3.

In this regard, the Supreme Court held that-

“We are mindful that product classification alone cannot serve as the decisive factor in the resolution of whether or not wines and cigarettes 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. But the mere fact that one person has adopted and used a particular trademark for his goods does not prevent the adoption and use of the same trademark by others on articles of a different description.” (MIGHTY CORPORATION and LA CAMPANA FABRICA DE TABACO, INC., petitioners, vs. E. & J. GALLO WINERY and THE ANDERSONS GROUP, INC., [G.R. No. 154342. July 14, 2004])

Another factor that shows that the goods involved are non-competitive and non-related is that they flow through different channels of trade.

In fine, We hold that the businesses of the parties are noncompetitive and their products so unrelated that the use of identical trademarks is not likely to give rise to confusion, much less cause damage to Opposer.

With all the foregoing circumstances, the consuming public, particularly, the unwary consumers will not be deceived, confused and mistaken into believing that the goods of the Respondent-Applicant came from or are authorized by the Opposer to its damage and prejudice.

Lastly, Opposer also argues that its mark "OMEGA" is a well-known mark, which deserves protection as a consequence of our adherence to the Paris Convention. In support of its position it submitted a list of registrations of trademark OMEGA (Exh. C-1); list of registrations of trademark OMEGA & DEVICE (Exh. C-2); samples of copies of foreign registrations (Exh. C-3); invoices (Exhs. D-1 to D-6); advertisements and press clippings for "OMEGA" watches (Exhs. F-1 to F-3). We do not agree.

As we have stated earlier the goods of the Opposer and that of the Respondent-Applicant are neither the same, identical, similar nor related goods, a requisite element under the Trademarks law and the Paris Convention.

Furthermore, the then Minister of Trade and Industry, the Hon. Roberto V. Ongpin, issued a memorandum dated 25 October 1983 to the Director of Patents, a set of guidelines in the implementation of Article 6bis (sic) 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 for use in the same or similar kinds of goods; and
- d) the person claiming must be the owner of the mark (The Parties Convention Commentary on the Paris Convention. Article by Dr. Bogsch, Director General of the World Intellectual Property Organization, Geneva, Switzerland, 1985).

From the set of facts found in the records, it is ruled that the Opposer failed to comply with the third requirement of the said memorandum that is the mark must be for use in the same or similar kinds of goods. The Opposer is using the mark "OMEGA" for products belonging to classes 14 and 16 while the Respondent is using the mark "OMEGA MAGIC" for class 3, hence, Opposer's contention that its mark is well-known at the time the Respondent filed its application for the same mark used on different and unrelated goods, must fail.

Moreover, even assuming for the same of argument that Opposer's OMEGA is a well known mark still, Opposer cannot seek protection under Section 123 (f) of R.A. 8293 as it has not complied with the conditions set therein namely, that use of the mark in relation to those goods or services would indicate a connection between those good or services, and the owner of the registered mark and that the interests of the owner of the registered mark are likely to be damaged by such use. In the case at bar, no evidence was presented by Opposer to show to Sec. 123 (f) of R.A. 8293.

WHEREFORE, in view of the foregoing, the Notice of Opposition filed by the Opposer is, as it is hereby DENIED.

Considering however, that as shown by the records, Respondent-Applicant, despite due notice failed to file its Answer to the Notice of Opposition nor did it even file any motion to lift the Order of Default, which is indicative of Respondent-Applicant's lack of concern in protecting its mark which is contrary to the provision of Sec. 3 (d) Rule 131 of the Rules of Court that "a person takes ordinary care of his concern" and the pronounced policy of the Supreme Court to the effect that "it is precisely the intention of the law to protect only the vigilant, not those guilty of laches". Xxx (Pagasa Industrial Corp. vs. Court of Appeals, L-54158, 118 SCRA 526, 533-534, 1982.

Moreover, the Supreme Court in the case of Del Bros Hotel Corporation vs. Intermediate Appellate Court, 159 SCRA 533, 543, has held that:

“Fundamentally, default orders are taken on the legal presumption that in failing to file an Answer, the defendant does not oppose the allegations and relief demanded in the complaint.”

Consequently, Application Serial No. 4-2000-000264 for the mark “OMEGA” used for a natural blend high-grade omega 6 and omega 3 essential oils under class 3 filed on November 22, 2001 by Respondent-Applicant, CONSUMER CARE PRODUCTS, INC. is hereby considered ABANDONED by Respondent-Applicant due to its lack of interest to prosecute subject application.

Let the filewrapper of OMEGA MAGIC subject matter of this case be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this decision.

SO ORDERED.

Makati City, August 11 2006.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs