

OMEGA SA (OMEGA AG), (OMEGA LTD.),  
Opposer,  
- versus -

IPC 14-2007-00133

Opposition to:  
TM Application No. 4-2004-001624  
(Filing Date: 24 February 2004)

MARCH RESOURCES MFG. CORP.,  
Respondent-Applicant.

TM: "OMEGA"

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Decision No. 2007 – 148

## DECISION

This is an opposition to the registration of the mark "OMEGA & Device" bearing trademark Application No. 4-2004-001624 filed on 24 February 2004 covering the good "sandpaper" falling under class 3 of the International Classification of goods which application was published in the Intellectual Property Philippines (IPP) E-Gazette officially released on January 12, 2007.

The Opposer in the instant opposition is "OMEGA SA (OMEGA AG) (OMEGA LTD.)", a foreign corporation organized and existing under the laws of Switzerland with principal address at Jakob-Stampfli, Strasse 96, and 2502 Biel Bienne, Switzerland.

The Respondent-Applicant on the other hand, is "MARCH RESOURCES MANUFACTURING CORPORATION" with address at 58 Rubber Master Road, Lingunan, Valenzuela City.

The grounds for the opposition are as follows:

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".

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" for sandpaper 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 the one hand and sandpaper on the other are not related or similar, the Respondent-Applicant's trademark "OMEGA" cannot be registered in the Philippines pursuant to the express provision of Section 147.2 of Republic Act No. 8293. There is no doubt that the use of Respondent-Applicant's trademark "OMEGA" for sandpaper would indicate a connection between these goods and the Opposer. Likewise, the interests of Opposer are likely to be damaged by Respondent-Applicant's use of the trademark "OMEGA" for sandpaper.

4. The Respondent-Applicant, by using "OMEGA" 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 Republic Act No. 8293.

5. Respondent-Applicant, in adopting the trademark “OMEGA” 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 Republic Act No. 8293.

On June 19, 2007 the Bureau of Legal Affairs issued a Notice to Answer which was sent to agent for Respondent-Applicant (Rosamond S. Alejar) through registered mail with Return Card No. C-3369, however, no answer has been filed despite the notice.

On July 19, 2007, the Bureau of Legal Affairs sent again an Alias Notice to Answer, addressed to the Respondent-Applicant “MARCH RESOURCES MANUFACTURING CORPORATION” through registered mail with Return card No. S-132, yet still no Answer has been filed to date September 2007.

Despite two notices were issued to the Respondent-Applicant to file its Answer, said party did not file the required answer together with the affidavit of its witness and other documents in support of its application, hence, the same is considered WAIVED.

Section 11 of the Summary Rules (Office Order No. 79, Series of 2005) provides:

Sections 11. Effect of failure to file an Answer. – In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

Opposer submitted the in evidence the following:

Exhibit	Description
Exhibit “A”	Affidavit of Dennis R. Gorecho
Exhibit “B” and “C”	Registration No. 4-1996-110786 and Registration No. R-1766
Exhibit “D”	Listing of current registrations and applications for the trademark “OMEGA”
Exhibit “E” to “E-4”	Copies of photographs showing the shops.
Exhibit “F” to “F-5”	Promotional materials

On the other hand, Respondent-applicant failed to file the required Answer and so with the affidavits of its witness and the documents in support of its application subject of the instant opposition.

The only issue to be resolved in the instant opposition is:

WHETHER OR NOT THE RESPONDENT-APPLICANT IS ENTITLED TO THE REGISTRATION OF THE MARK “OMEGA AND DEVICE”.

The applicable provision of the law is, Section 123 (d) of Republic Act No. 8293, which provides:

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

(d) Is identical with a registered mark belonging to a different proprietor or 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;

In order to arrive at a just and fair conclusion whether the contending marks are confusingly similar, both are reproduced below for comparison and scrutiny.

Records will show that the Opposer's mark "OMEGA AND DEVICE" has been registered with the Intellectual Property Philippines (IPP) bearing Registration No. 4-1996-110786 on September 28, 2000 (Exhibit "B") and Registration No. R-1766 on August 23, 1976 (Exhibit "C").

The products of the Opposer bearing the mark "OMEGA AND DEVICE" are sold worldwide and nationwide in the Philippines, Exhibits "E" and "E-4" such as in Rockwell, Glorietta, Ayala Center, Rustan's Silver vault.

A practical approach to the problem of similarity or dissimilarity is to go into the whole of the trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of 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. (87 C.J.S., pp. 288-291) Some factors as "sound, appearance; form, style shape, size or format; color, ideas connoted by the marks; the meaning, spelling and pronunciation of the words appear" may be considered. (87 C.J.S., pp. 291-292) For indeed, trademark infringement is a form of unfair competition. (Clarke vs. Manila Candy Co., 36 Phil. 100, 106; Co Tiong Sa vs. Director of Patents, 95 Phil 1, 4)

Confusion is likely between trademarks only if their over-all presentations in any of the particulars of sound, appearance or meaning are such as would lead the purchasing public into believing that the products to which the marks are applied emanated from the same source.

It cannot be denied that the trademark "OMEGA AND DEVICE" which Respondent-Applicant seeks to register in its name is an exact replica or copy of the registered trademark of the Opposer. It is the same in composition, spelling, pronunciation and even the device accompanying both trademarks are likewise the same or identical.

It is very difficult to understand why the Respondent-Applicant has created a mark which is exactly the same as the mark of the Opposer despite the availability of thousands of words in the dictionary and symbols or designs from which to select from.

Being that the Respondent-Applicant's mark "OMEGA & DEVICE" is identical to the mark of Opposer, the consuming public, particularly the unwary consumers will be deceived, confused and mistaken into believing that the goods of the Respondent-Applicant come from or are authorized by the Opposer, to its damage and prejudice.

In the case at bar, there exists a "confusion of business" wherein the goods of the parties may be different but the Respondent-Applicant's products can reasonably (though mistakenly) be assumed to originate from the Opposer, thus deceiving the public into believing that there is some connection between the Opposer and the Respondent-Applicant which, in fact does not exist.

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. (Pribhadas J. Mirpuri vs. Court of Appeals, G.R. No. 114508)

The Opposer's trademark is a registered mark with the Intellectual Property Philippines (IPP) bearing Registration No. 4-1996-110786 issued on September 28, 2000 and Registration No. R-1766 issued on August 23, 1976.

In trademark cases, certificate of registration is a prima facie evidence of the validity of the registration, the registrant and ownership of the mark and the exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate (Levi Strauss & Co. vs. Clinton Apparelle, Inc., (470 SCRA 253-253) 2005).

Considering that as shown by the records, Respondent-Applicant, despite the fact that two notices were issued by the Bureau of Legal Affairs and sent to the Respondent-Applicant requiring it to file the required Answer, yet failed to file the same, was an indicative of its lack of concern in protecting its trademark application which is contrary to the provision of Section 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". (Pag-asa Industrial Corporation vs. Court of Appeals, L-54158 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."

WHEREFORE, premises considered, the Notice of Opposition is, as it is hereby SUSTAINED. Consequently, Trademark Application No. 4-2004-001624 for the mark "OMEGA & DEVICE" filed on February 23, 2004 is hereby REJECTED.

Let the filewrapper of the trademark "OMEGA AND DEVICE" 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, 22 October 2007.

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