

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

-versus-

AMEGA GLOBAL LLC,
Respondent -Applicant.

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}
} IPC No. 14-2009-00235
} Opposition to:
} Application No. 4-2008-013030
} Date Filed: 23 October 2008
} TM: "AMEGA (Stylized)"
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}
}

NOTICE OF DECISION

SAPALO VELEZ BUNDANG & BULILAN LAW OFFICES

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GREETINGS:

Please be informed that Decision No. 2016 - 36 dated February 09, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 09, 2016.

For the Director:

Edwin Danilo A. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

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IPC No. 14-2009-00235
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 Date Filed: 23 October 2008
 Trademark: AMEGA (stylized)
 Decision No. 2016- 36

DECISION

OMEGA SA (OMEGA AG) (OMEGA LTD.)¹ (“Opposer”) filed an opposition to Trademark Application Serial No. 4-2008-013030. The application, filed by Amega Global LLC² (“Respondent-Applicant”), covers the mark “AMEGA (stylized)” for use as “alloys of precious metal; works of art of precious metal; precious metals, unwrought or semi-unwrought; boxes of precious metal; jewellery; paste jewellery; precious stones; clocks; watches” under Class 14 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

“The grounds for opposition to the registration of the trademark 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 ‘AMEGA’ under international class 14 for ‘alloys of precious metal; works of art of precious metal; precious metals, unwrought or semi-unwrought; boxes of precious metal; jewellery; paste jewellery; precious stones; clocks; watches’.

“2) There is likelihood of confusion between Opposer’s trademark ‘OMEGA’ for goods under international classes 14 and Respondent-Applicant’s trademark ‘AMEGA’ under international class 14 for ‘alloys of precious metal; works of art of precious metal; precious metals, unwrought or semi-unwrought; boxes of precious metal; jewellery; paste jewellery; precious stones; clocks; watches’, because the latter is similar with Opposer’s trademark ‘OMEGA’.

¹A foreign corporation organized and existing under and by virtue of the laws of Switzerland with office address at Jakob-Stampfli-Strasse 96, 2502 Biel/Bienne (Switzerland).

²With address at 101 Thomson Road #23-01 United Square Singapore 307591.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

"3) The Opposer's 'OMEGA' trademark is well-known internationally and in the Philippines, especially for horological goods, taking into 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 'alloys of precious metal; works of art of precious metal; precious metals; unwrought or semi-unwrought; boxes of precious metal; jewellery; paste jewellery; precious stones; clocks; watches' on the other are not related or similar, the Respondent-Applicant's trademark 'AMEGA' 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 'AMEGA' under international class 14 for 'alloys of precious metal; works of art of precious metal; precious metals, unwrought or semi-unwrought; boxes of precious metal; jewellery; paste jewellery; precious stones; clocks; watches' 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 'AMEGA' under international class 14 for 'alloys of precious metal; works of art of precious metal; precious metals; unwrought or semi-unwrought; boxes of precious metal; jewellery; paste jewellery; precious stones; clocks; watches'.

"4) The Respondent-Applicant, by using 'AMEGA' 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 'AMEGA' 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 relies on the following facts to support its opposition, reserving the right to present other evidence to prove these facts and others as may appear necessary or expedient in the course of the proceedings:

"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 class 14 in the Philippines and many countries around the world. Opposer has prior use and registrations for the '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 predecessors since 1906.

"Opposer was issued by the IPO the following certificate of trademark registration:

x x x

"2) There is likelihood of confusion between Respondent-Applicant's trademark 'AMEGA' and Opposer's 'OMEGA' trademark.

"Respondent-Applicant's trademark 'AMEGA' is similar, in all respects, with 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 class 14 in the Philippines and several countries around the world.

"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 magazines, newspapers, videos, movies, etc. In fact, the Opposer's 'OMEGA' trademark has a considerable share in the market 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 trademark had, through the years, earned international acclaim, as well as the distinct reputation of being high quality products.

"As a matter of fact, Opposer's 'OMEGA' watches have been used as the official timekeeper for the Olympic games several times, particularly in 1932, 1936, 1948, 1952, 1956, 1960, 1964, 1968, 1976, 1980 and 1984. Opposer's 'OMEGA' watches were also used in space exploration missions, including the Apollo 11 landing on the moon whereby an 'OMEGA' Speedmaster was worn by Neil Armstrong, the first man to walk on the moon's surface on July 21, 1969.

"4) The use of Respondent-Applicant's trademark 'AMEGA' under international class 14 for 'alloys precious metal; works of art of precious metal; precious metal, unwrought or semi-unwrought; boxes of precious metal; jewellery; paste jewellery; precious stones; clocks; watches' 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 'AMEGA' under international class 14 for 'alloys of precious metal; works of art of precious metal; precious metals, unwrought or semi-unwrought; boxes of precious metal; jewellery; paste jewellery; precious stones; clocks; watches' 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 'AMEGA' and the sale and distribution of goods falling under international class 14 bearing the trademark 'AMEGA' by the Respondent-Applicant are inflicting considerable damage to the interests of the Opposer. To allow Respondent-Applicant to register 'AMEGA' trademark, will constitute a mockery of our laws protecting intellectual property rights as it will legitimize Respondent-Applicant's unfair and unlawful business practice.

"5) Five (5) labels of Opposer's 'OMEGA' trademark, as actually used in commerce, which constitute the bases of its opposition, are hereto attached x x x



The Opposer's evidence consists of a copy of the Certificate of Registration No. R-1766 for the trademark OMEGA & DEVICE; and five sample labels bearing the OMEGA trademark as actually used in commerce.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 16 November 2009. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark AMEGA (stylized)?

The Opposer anchors its opposition on Sections 123.1, paragraphs (d) and (e), 147 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), 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;"

(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;

Sec. 147. *Rights Conferred.* - x x x 147.2. The exclusive right of the owner of the well-known mark defined in Subsection 123.1 (e) which is registered in the Philippines, shall extend to goods and services which are not similar to those in respect of which the mark is registered: *Provided,* That use of that 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.

Records show that at the time the Respondent-Applicant filed its trademark application on 23 October 2008, the Opposer has an existing registration for the mark

⁴ Marked as Exhibits "A" to "B", inclusive.



OMEGA AND DEVICE under Certificate of Registration No. R-1766 issued on 23 August 1976. The Opposer's registration covers watches under Class 16. This Bureau noticed that the Respondent-Applicant's trademark application indicates watches and clocks, as well as goods that are related thereto, namely: alloys of precious metal; works or art of precious metal; precious metals, unwrought or semi-unwrought; boxes of precious metal; jewellery; paste jewellery; precious stones (under Class 14). Watches and clocks, aside from their technical functions, are also considered valuable ornaments, accessories, or even jewelry.

But, are the competing marks, as shown below, resemble each other such that confusion, or even deception is likely to occur?



Opposer's trademark



Respondent-Applicant's mark

This Bureau finds that confusion or deception is likely to occur at this instance. An examination and comparison of the competing marks shows that both marks have five (5) letters. Four (4) letters of both marks are the same. Both marks have the same number of syllables: /O/ME/GA/ for Opposer's and /A/ME/GA/ for Respondent-Applicant's. The first syllable "O" of Opposer's OMEGA may not be confusingly similar to the first syllable "A" of Respondent-Applicant's mark AMEGA, however, it could result to mistake with respect to perception because the marks sound so similar. Under the idem sonans rule, the following trademarks were held confusingly similar in sound: "BIG MAC" and "BIG MAK"⁵, "SAPOLIN" and LUSOLIN"⁶, "CELDURA" and "CORDURA"⁷, "GOLD DUST" and "GOLD DROP". The Supreme Court ruled that similarity of sound is sufficient ground to rule that two marks are confusingly similar, to wit:

Two letters of "SALONPAS" are missing in "LIONPAS": the first letter a and the letter s. Be that as it may, when the two words are pronounced, the sound effects are confusingly similar. And where goods are advertised over the radio, similarity in sound is of especial significance...."SALONPAS" and "LIONPAS", when spoken, sound very much alike.

⁵ *MacDonalds Corp. et. al v. L. C. Big Mak Burger*, G.R. No. L-143993, 18 August 2004.

⁶ *Sapolin Co. v. Balmaceda and Germann & Co.*, 67 Phil, 705.

⁷ *Co Tiong SA v. Director of Patents*, G.R. No. L- 5378, 24 May 1954; *Celanes Corporation of America vs. E. I. Du Pont de Nemours & Co.* (1946), 154 F. 2d 146 148.)

Similarity of sound is sufficient ground for this Court to rule that the two marks are confusingly similar when applied to merchandise of the same descriptive properties.⁸

Succintly, the Respondent-Applicant's trademark application covers goods that are similar to the Opposer's, particularly, watches and clocks. Thus, it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:


Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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. Here, 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.⁹

It is emphasized that 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.¹⁰ This Bureau finds that the mark applied for registration by Respondent-Applicant does not meet this function.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2008-013030 is hereby SUSTAINED. Let the filewrapper 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, 09 February 2016.



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

⁸ *Marvex Commerical Co., Inc. v. Petra Hawpia & Co., et. al.*, G.R. No. L-19297,22 Dec. 1966.

⁹ *Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.

¹⁰ *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Eihepa v. Director of Patents, supra, Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).