

GALENICA, A. G.,  
Opposer,

-versus-

P.T. DEXA MEDICA,  
Respondent- Applicant.

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}  
} IPC No. 14-2012-00475  
} Opposition to:  
} Appln. No. 4-2012-005694  
} Date Filed: 11 May 2012  
} TM: "OMZ"  
}

**NOTICE OF DECISION**

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**P.T. DEXA MEDICA**  
Respondent- Applicant  
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No. 5 Bintaro Jaya Sector 7  
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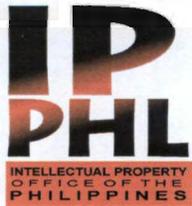
**GREETINGS:**

Please be informed that Decision No. 2016 - 264 dated July 28, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 28, 2016.

For the Director:

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



**GALENICA, A. G.,**

Opposer,

- versus -

**P.T. DEXA MEDICA,**

Respondent-Applicant.

**IPC NO. 14 - 2012- 00475**

Opposition to:

Appln Serial No. 42012005694

Date filed: 11 May 2012

**TM: "OMZ"**

**DECISION NO. 2016 - 264**

X-----X

## DECISION

GALENICA, A.G. (Opposer)<sup>1</sup>, filed an Opposition to Trademark Application No. 4-2012- 005694 on 11 May 2012. The application filed by P.T. DEXA MEDICA (Respondent-Applicant)<sup>2</sup>, covers the mark "OMZ" for "*pharmaceutical preparation for management of peptic ulcer and gastro-esophageal reflux disease*" under Class 5 of the International Classification of Goods.<sup>3</sup>

The Opposer based its opposition on the following grounds:

- 1.) The Opposer is the registered owner of the trademark "OM" as used on goods falling under Class 5 in the Philippines under Certificate of registration No. 055315.
- 2.) The trademark "OMZ" by Respondent-Applicant is confusingly similar to the Trademark "OM" of the Opposer and is being used for the same class of goods.

To support its opposition, the Opposer submitted the following:

1. Copies of Actual product labels that show the use of the registered trademark in the Philippines;
2. Copies of trademark registrations from different countries

This Bureau issued a Notice to Answer on 12 February 2013 and served a copy to the Respondent-Applicant on 1 March 2013. However, the Respondent-Applicant did not file an answer to the Opposition. In view of the failure to file an

<sup>1</sup> With business address at Untermattweg 8, CH-3001 Bern, Switzerland

<sup>2</sup> With address at Titan Center, 3<sup>rd</sup> Floor, Jalan Boulevard, Bintaro Block B7/B1 No. 5, Bintaro Jaya Sector 7, Tangerang 15224, Indonesia

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the World Intellectual Property Office, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

Answer, an Order dated 12 August 2013 was issued declaring the Respondent-Applicant in default. Consequently, this case was deemed submitted for decision.

The issue in the present case is whether to allow the registration of herein Respondent-Applicant "OMZ" trademark.

The instant opposition is anchored on Section 123.1, paragraph (d), of the IP Code which provides that 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 the same goods or services or closely related goods or services or if it nearly resembles such mark as to be likely to deceive or cause confusion.

The Opposer argues that the two competing marks are confusingly similar and being applied for use in the same class of goods. Opposer further argues that allowing the registration of Respondent-Applicant's mark will inevitably cause the dilution and loss of distinctiveness of Opposer's trademark.

The trademarks subject of the instant case are reproduced below for examination.

**OMZ**

Respondent-Applicant's Mark

**OM**

Opposer's Mark

Upon examination of the two competing trademarks and the evidence submitted by the Opposer, this office finds merit to the contentions of the Opposer.

"OMZ" is almost identical to the trademark "OM" of the Respondent-Applicant, both visually and aurally. The additional letter "Z" in the Respondent-Applicant's mark is negligible. In fact, when pronounced the one-syllable trademark of Respondent-Applicant would readily sound as "OMS" which seems to be a mere plural form of the product of the Opposer. Our Court consistently held that trademarks with *idem sonans* or similarities as to sound constitute confusing similarity in trademarks.<sup>4</sup>

Records show that when the Respondent-Applicant filed their trademark application on 11 May 2012, the Opposer already has a prior registration for the above confusingly similar trademark covering pharmaceutical and veterinary preparations.<sup>5</sup> Thus, this Bureau finds that both products of the Opposer and Respondent-Applicant comprise of pharmaceutical preparations under Class 5 and are considered related goods. It is very likely that the public would assume that the two products originate from a single manufacturer or from related sources.

<sup>4</sup> Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

<sup>5</sup> Certificate of Registration No. 055315

Time and again, it has been held in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for purposes of the law that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.<sup>6</sup> Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.<sup>7</sup> Because the Respondent-Applicant will use his mark on goods that are similar and/or closely related to the Opposer's, the consumer is likely to assume that the Respondent-Applicant goods originate from or sponsored by the Opposer or believe that there is a connection between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:<sup>8</sup>

Callman 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. 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.

Definitely, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.<sup>9</sup>

**WHEREFORE**, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2012-005694 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

**SO ORDERED.**

Taguig City, 28 JUL 2016

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

<sup>6</sup> American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

<sup>7</sup> Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

<sup>8</sup> Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

<sup>9</sup> American Wire & Cable Company vs. Dir. Of Patent, G.R. No. L-26557, February 18, 1970.