

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

Opposer,

-versus-

STEELRICH ENTERPRISE CORP.,
Respondent-Applicant.

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IPC No. 14-2008-000101

Opposition to:

Application No. 4-2006-012604
Date Filed: 22 November 2006

Trademark: Omega and Logo

Resolution No. 2025-01

RESOLUTION

Omega SA (Omega AG) (Omega LTD.) ("Opposer") filed a Motion for Reconsideration of this Bureau's Decision No. 2009-178 dated 16 December 2009, the dispositive portion of which reads, as follows:

*"IN VIEW of all the foregoing, the instant Verified Opposition is, as it is, hereby **DENIED**. Consequently, trademark application bearing Serial No. 4-2006-012604 for the mark "OMEGA AND LOGO" on goods under classes 18, 20, 24 and 25 as enumerated in the application and on page 1 of this Decision, filed on 22 November 2006 by respondent-applicant Steelrich Enterprises Corp., is, as it is hereby, **GIVEN DUE COURSE**.*

Let the file wrapper of "OMEGA AND LOGO", subject of this case be forwarded to the Bureau of Trademark (BOT) together with a copy of this Decision for appropriate action.

SO ORDERED."

In the aforementioned Motion for Reconsideration, the Opposer seeks the reversal of the Decision based on the following grounds, to wit:

"A. This Honorable Director of the Bureau Legal Affairs (BLA) erred in allowing the registration of Trademark Application No. 4-2006-012604 for the "OMEGA AND LOGO" trademark notwithstanding the finding / conclusion in the same assailed decision that Respondent- Applicant's "OMEGA AND LOGO" mark is confusingly similar to Opposer's "OMEGA & DEVICE" trademark.

B. The Honorable Director of the BLA erred in her finding that Opposer's "OMEGA & DEVICE" is not a well-known trademark."

On 28 December 2022, the Opposer filed an Urgent Ex-Parte Motion for Early Resolution praying for the immediate resolution of the case on the ground of failure of the Respondent-Applicant to file the Declaration of Actual Use (DAU) and Renewal DAU for its "OMEGA AND LOGO" with Trademark Application No. 4-2006-012604 due on

March 2008. The Opposer reiterated its prayer in an Ex-Parte Manifestation filed on 11 November 2024.

After a careful review of the records, this Bureau notes that a Declaration of Actual Use (DAU) was filed by the Respondent-Applicant on 10 March 2008, as evidenced by the Certification issued by the Bureau of Trademarks on 27 January 2025. The counsel of the Opposer, on the contrary, failed to prove otherwise. Hence, the Opposer's allegation that the Respondent-Applicant failed to file the required DAU must fail.

Proceeding to the substantive issue, this Bureau notes that the arguments raised by the Opposer in its Motion for Reconsideration are mere rehash of the arguments raised in its pleadings which were already passed upon and considered by this Bureau in the assailed decision. Nevertheless, this Bureau reviewed the records of this case and finds no cogent reason to reverse the decision.

"OMEGA AND LOGO" mark is not confusingly similar to Opposer's "OMEGA & DEVICE" trademark.

In ascertaining whether a mark is confusingly similar to another, the Rules and jurisprudence laid down several factors in determining likelihood of confusion. Out of the said criteria two are uniformly significant in resolving this case: (1) resemblance of marks and the (2) relatedness of goods or services.

In determining the resemblance of a mark, the Supreme Court previously used two tests: (1) Dominancy Test and (2) Holistic Test. However, in the *en banc* Decision laid down by the Supreme Court in *Kolin Electronics Co. Inc. vs. Kolin Philippines International, Inc. (Kolin Case)*¹, the use of the Holistic Test is already abandoned. Instead, the Court emphasized the use of the so called multifactor test and the Dominancy test, viz:

In determining likelihood of confusion - which can manifest in the form of "confusion of goods" and/or "confusion of business" - several factors may be taken into account, such as:

- a. the strength of plaintiffs mark;*
- b. the degree of similarity between the plaintiffs and the defendant's marks;*
- c. the proximity of the products or services;*
- d. the likelihood that the plaintiff will bridge the gap;*
- e. evidence of actual confusion;*
- f. the defendant's good faith in adopting the mark;*
- g. the quality of defendant's product or service; and/or*
- h. the sophistication of the buyers.*

¹G.R. No. 228165. February 09, 2021


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Administrative Officer II
Bureau of Legal Affairs

These criteria may be collectively referred to as the multifactor test. Out of these criteria, there are two which are uniformly deemed significant under the Trademark Law and the IP Code: the resemblance of marks (the degree of similarity between the plaintiffs and the defendant's marks) and the relatedness of goods or services (the proximity of products or services).

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*Using the Dominancy Test, the Court should now determine the resemblance between **KOLIN** and kolin in terms of the similarity of the dominant features used. This is consistent with the basic rule in determining resemblance of marks, which requires that the appearance, sound, meaning, and overall impressions generated by the marks shall be considered."*

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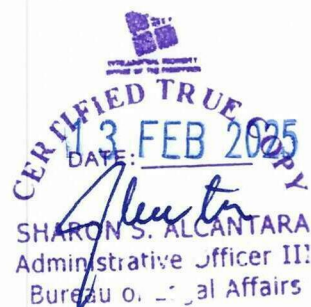
Applying the aforementioned tests in the present case, the Opposer is correct in arguing that the two marks have resemblance since their appearance, sound, meaning and overall impression are remarkably the same. However, as to the relatedness of goods and services, the Opposer's claim that the goods and services are related is not meritorious.

In the Kolin Case, the Supreme Court reiterated the factors laid down in the case of Mighty Corporation², viz:

- a. *the business (and its location) to which the goods belong;*
- b. *the class of product to which the goods belong;*
- c. *the product's quality, quantity, or size, including the nature of the package, wrapper or container;*
- d. *the nature and cost of the articles;*
- e. *the descriptive properties, physical attributes or essential characteristics with reference to their form, composition, texture or quality;*
- f. *the purpose of the goods*
- g. *whether the article is bought for immediate consumption, that is, day-to-day household items;*
- h. *the fields of manufacture;*
- i. *the conditions under which the article is usually purchased; and*
- j. *the channels of trade through which the goods flow, how they are distributed, marketed, displayed and sold.*

The Opposer used the above-mentioned factors in arguing that the two marks are closely related. The Opposer argued that the products are both wearable items and that both are distributed to same channels of trade and is marketed, displayed and sold in same business establishments. However, the Opposer failed to provide evidence to support its arguments. Hence, this Bureau finds that both products are not closely related to each other as they fall under different classes and they do not serve the same purpose and that they flow through different channels of trades.

² G.R. No. 154342, July 14, 2004



"OMEGA & DEVICE" is not a well-known mark.



Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers provides criteria in determining a well-known mark. Under the said rule, it is not required that all criteria are present, any combination of the said criteria is sufficient. However, in the case at bar, the Opposer was not able to prove by sufficient evidence that the OMEGA & DEVICE trademark is well-known internationally and in the Philippines. It failed to present evidence to show the duration, extent and geographical area of the registration of the mark, actual use or sales and its promotion in foreign countries and in the Philippines. As stated in the rules, the fact of being well-known has to be established not only in foreign land but also in the Philippines.

WHEREFORE, premises considered, the Motion for Reconsideration is hereby **DENIED**. Let the file wrapper of Trademark Application Series No. 4-2006-012604 together with a copy of this **RESOLUTION** be returned to the Bureau of Trademarks (BOT) for information and appropriate action.

SO ORDERED.

Taguig City, 12 February 2025.


Atty. CHRISTINE V. PANGILINAN-CANLAPAN, CESO IV
OIC-Director, Bureau of Legal Affairs


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