ALFONSO ANGGALA,	}	INTER PARTES CASE NO. 14-2006-00013
Opposer,	}	Opposition to:
	}	TM: “AIIZ XII and DEVICE”
-versus-	}	Application Serial No. 4-2002-009791
	}	Goods: shirt, T-shirts, jackets, pants, skirts,
RENO (THAILAND) CO., LTD.,	}	shoes, knits, socks, underwear, hats, necktie
Respondent-Applicant.	}	Decision No. 2006 - 121

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DECISION

This action is a Notice of Opposition filed by Alfonso Anggala, opposer, with address at 65 Basilio corner Ibarra Streets, Acacia, Malabon City against the application for registration of the trademark AIIZ XII and DEVICE (IN COLOR) for shirt, T-shirts, jackets, pants, skirts, shoes, knits, socks, underwear, Hats, Necktie, in Class 25 under application No. 4-2002-009791 filed on 14 November 2002 by Reno (Thailand) Co., Ltd., respondent-applicant, a corporation organized under the laws of Thailand with address at 23/65-68, 23/23/35, 23/30-31, Soi Soon Vijal- Rama 9, Rama 9 Road, Bangkapi, Huay Kwang, Bangkok 10320, Thailand.

Opposer alleges that he would be damaged by the registration of the mark AIIZ XII by respondent-applicant on the ground that such registration will violate his existing rights over the mark. Opposer points out that he has an earlier application under application No. 4-2002-07611 for the trademark “A to Z” which was filed in 9 September 2002. (Annex “A”). Opposer argues that the dominant letters “A” and “Z” in his mark are identical to respondent’s “AIIZ” mark except for the Roman number “II” (two) in the middle.

Respondent-applicant filed its Answer on 15 July 2006 and raised affirmative allegations and defenses as follows:

4.1 The respondent-applicant is the lawful proprietor of the trademarks “AIIZ” which is used n many countries around the world in connection with goods in Class 25 such as shirts, t-shirts, jackets, pants, skirts, shoes, knits, socks, underwear, hats and neckties since 17 August 1998, prior to the filing date accorded to Opposer’s Philippine application for the mark “A TO Z”. In fact, Respondent-Applicant started using “AIIZ” mark in 1993. The Respondent-Applicant, through its Managing Director, Mr. Piya Thanakitamnuay, first obtained its registration for the “AIIZ XII” trademark in Thailand for goods in Class 25.

4.2 The respondent-Applicant’s “AIIZ XII” trademark is well known not only in Thailand but also in many countries throughout the world. The Respondent-Applicant has registered the “AIIZ XII” trademark in Jordan, Lebanon, United Arab Emirates, Brunei, Saudi Arabia, Bahrain, and Cyprus.

4.3 The Respondent-Applicant also has pending application for “AIIZ XII” trademarks in other foreign countries. The Respondent-Applicant has filed applications for the registration of the mark “AIIZ XII” in Pakistan and Brazil.

4.4 As a lawful exercise of its ownership over the “AIIZ XII” trademark, Respondent-Applicant, on 14 November 2002, filed with this Honorable Office its trademark application for the mark “AIIZ XII (in color)”, which was assigned Application No. 4-2002-009791, covering goods under Class 25, namely – shirt, jackets, pants, skirts, shoes, knits, socks, underwear, hats, and neckties.

4.5 The Respondent-Applicant has continuously marketed and advertised Class 25 goods bearing the trademarks “AIIZ” and “AIIZ XII” worldwide.

4.6 Because of the Respondent-Applicant's extensive and continuous use of the trademark "AIIZ XII" in various countries in connection with goods under Class 25, the relevant sector of the purchasing public has come to identify the trademark "AIIZ XII" with the Respondent-Applicant. Due to the Respondent-Applicant's efforts, the trademark "AIIZ XII" has been associated by the public with quality - shirt, jackets, pants, skirts, shoes, knits, socks, underwear, hats, and neckties manufactured and sold by Respondent-Applicant.

4.7 In his Opposition, the Opposer claims that he will be damaged by the Respondent-Applicant's application for registration of the trademark "AIIZ XII" on the ground that it violated/s his existing prior rights over his trademark "A TO Z". More specifically, Opposer claims that his application for the trademark "A TO Z" was filed much earlier than that of the Respondent-Applicant.

4.8 In his Opposition, the Opposer attached his Affidavit and the Declaration of Actual Use ("DAU", for brevity) for his application for the registration of the mark "A TO Z" bearing Application No. 4-2002-007611. However, the proof of actual use attached to the Opposer's DAU shows Respondent-Applicant's "AIIZ" trademark instead of "A TO Z" which is the mark of the Opposer. Without any proof of use of the mark "A TO Z" mark of the Opposer does not have any existing prior rights over the trademark "A TO Z" that may be damaged with the registration of Respondent-Applicant's application for the mark "AIIZ XII".

Respondent submitted the following evidence in support of its position:

EXHIBIT	DESCRIPTION
"1"	Affidavit of Piya Thanakitamnuay with Annexes "1" to "60"
"2"	Certification of Trademark Office, Thailand
"3"	List of pending registrations
"4"	Certificate of Registration of mark "AIIZ XII" in Jordan
"5"	Certificate of Registration of mark "AIIZ XII" in Lebanon
"6"	Certificate of Registration of mark "AIIZ XII" in United Arab Emirates
"7"	Certificate of Registration of mark "AIIZ XII" in Brunei
"8"	Certificate of Registration of mark "AIIZ XII" in Saudi Arabia
"9"	Certificate of Registration of mark "AIIZ XII" in Bahrain
"10"	Certificate of Registration of mark "AIIZ XII" in Cyprus
"11"	Certificate of Registration of mark "AIIZ XII" in Pakistan
"12"	Certificate of Registration of mark "AIIZ XII" in Brazil
"13"	Letter dated 11 November 2002
"14"	Photos of outlets in Singapore, Indonesia and Brunei
"15"	Flyers distributed in Deira City
"16"	DHL receipt (28 September 2004)
"17"	Invoice (27 September 2004)

"18" Invoice (4 January 2006)

"19" Secretary's Certificate

The pre-trial conference was terminated on 24 August 2006 for failure of the parties to reach an amicable settlement. Respondent-applicant submitted its position paper on 22 September 2006.

The issue in this case is whether the mark of respondent-applicant "AIIZ XII" mark is identical with the opposer's "A TO Z" mark or is similar to the opposer's mark as to cause confusion and deception.

The marks of the parties are reproduced hereunder for comparison:

A TO Z

OPPOSER'S TRADEMARK

RESPONDENT-APPLICANT'S TRADEMARK

Republic 8293 states that a mark cannot be registered if it is identical to a mark with an earlier filing date or if it merely resembles a mark with an earlier filing date, and thereby causes confusion or deceit. The law states:

"Section 123. Registrability. 123.1 A mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing date 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"

The likelihood of confusion is a relative concept; to be determined only according to the particular, and sometimes peculiar, circumstances of each case. In trademark cases, even more than in any litigation, precedent must be studied in the light of the facts of the particular 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 attendants to an accurate assessment of likelihood of confusion require that the entire panoply of elements constituting the relevant factual landscape be comprehensively examined. (Thompson Medical Co. v. Pfizer, Inc., 735F. 2d 208, 225 USPQ 124 (2d Cir. 1985)."

The phrase "colorable imitation" denotes close or ingenious imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives and to cause him to purchase the one supposing it to be the other [(87 C.J.S. 287) Etepha v. Director of Patents No. L-20635; 31 March 1966]

A perusal of the marks AIIZ XII (with claim of color) and opposer's mark "A to Z" show that each of the mark creates a distinct visual impression. For one, respondent's mark claims the color blue and green while the opposer does not. In addition to "AIIZ", the numeral/letter "XII" also appears parallel to it in exactly the same proportions. It is also observed that "II" written between the letters "A" and "Z" in "AIIZ" are in slightly taller proportions to "A" and "Z". These differences are sufficient to hold that no confusion is likely to result in the use by respondent of its mark. As a whole, the mark "AIIZ" and "XII" printed in color and each of which is encased or contained in boxes of green and blue arranged side by side creates a distinct impression from Opposer's "A to Z" mark.

The parameters in determining that no confusion will result in the contemporaneous use of the marks find support in Philip Morris, Inc. Benson & Hedges (Canada), Inc., and Fabriques de Tabac Reunies, S.A. v. Fortune Tobacco Corporation, GR No. 15859, 27 June 2006, here the Supreme Court applied the holistic test in determining the issue of infringement. It held:

> "In contrast, the holistic test entails a consideration of the entirety of the marks as applied to the products, including the labels and packaging, in determining confusing similarity.
>
> x x x
>
> For one, as rightly concluded by the CA after comparing the trademarks involved in their entirety s they appear on the products, the striking dissimilarities are significant enough to warn any purchaser that one is different from the other. Indeed, although the perceived offending word is "MARK" is itself prominent in petitioner's trademarks "MARK VII" and "MARK TEN", the entire marking system should be considered as a whole and not dissected, because a discerning eye would focus not only on the predominant word but also on the other features on the labels. Only then would such discerning observer draw his conclusion whether one mark would be confusingly similar to the other and whether or not sufficient differences existed between the marks."

Finally, this Bureau is bothered and concerned by opposer's submission in his Declaration of actual use attached to his trademark application (Annex "A"). Indeed, as correctly observed by respondent-applicant, opposer has attached what appear to be an "AIIZ" mark (as seen below) similar to that of respondent-applicant's mark and not opposer's own "A to Z" mark.

WHEREFORE, premises considered the OPPOSITIONFILED BY Alfonso Anggala is hereby DENIED. Accordingly, Application Serial No. 4-2002-009791 filed by Respondent-Applicant, Reno (Thailand) Co., Ltd., on 14 November 2002 for the mark "AIIZ XII and DEVICE" used on shirts, T-shirts, jackets, pants, skirts, shoes, knits, socks, underwear, hats, necktie under class 25, is as it is hereby GIVEN DUE COURSE.

Let the filewrapper of "AIIZ XII and DEVICE", subject matter of this case together with this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 20 October 2006.

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