AMERICAN EXPRESS CO.,	}	IPC No. 14-2004-00148
Opposer	}	Opposition to:
	}	Ser. No. 4-1999-003752
	}	Date Filed: May 28, 1999
-versus-	}	Trademark: "AMERICAN EXPRESS"
	}	
	}	
ALEXANDER UY,	}	
Respondent-Applicant,	}	
x----------x		Decision No. 2006 – 42

DECISION

This pertains to the Notice of Opposition filed by the American Express Company to Application Serial No. 4-2002-003886 for registration of the trademark "AMERICAN EXPRESS" for "All kinds of outwear and underwear for men, women, teenagers and children namely, shirts, t-shirts, polo shirts, blouses, skirts, suits, pants, trousers, jeans, vests, dresses, ties, coats, jackets, lingerie, panties, slips, camisoles, bras, girdles, briefers, sandos, robes, bathing suits, socks, gloves, scarves, shoes, slippers, sandals, headwear, caps and hats" under Class 25, published for opposition on the September 29, 2004 issue of the Intellectual Property Office (IPO) Official Gazette, Volume VII, p. 183 that was released for circulation on September 29, 2004.

This case was initially covered under the previous Regulations on *Inter Partes* Proceedings but was later mandatorily covered by Office Order No. 79 when it took effect on September 1, 2005. Pursuant thereto, the parties were directed to simultaneously file and complete their respective evidences within a specified period pursuant to the Notice to Comply With Office Order No. 79 dated October 11, 2005.

Opposer, upon motion, was given until December 16, 2005 to comply with Office Order No. 79. On December 16, 2005, opposer filed a COMPLIANCE with MANIFESTATION, attaching thereto the notarized affidavit of Stephen P. Norman. Opposer alleged that said affidavit was still undergoing consularization as of said date and that opposer was provisionally submitting said affidavit to be tentatively marked as Exhibit "A" instead of requesting for additional time to submit the same already authenticated with the undertaking to provide this Office with the authenticated version by the following week. Attached to the notarized affidavit are photocopies of documentary evidences itemized in the MANIFESTATION. On January 2, 2006, opposer filed a COMPLIANCE, attaching thereto the same affidavit but already authenticated, and attached to the authenticated affidavit were the originals of the same documentary evidences submitted with the COMPLIANCE with MANIFESTATION on December 16, 2005.

It is clear, then, that opposer filed its evidences beyond the reglementary period and is, thus, deemed to have waived its right thereto the filing of such evidences. Section 7.3 of Office Order No. 79 provides:

> "If the opposition is in the required form and complies with the requirements including the certification of non-forum shopping, the Bureau shall docket the same by assigning the Inter Partes Case Number. Otherwise, the case shall be dismissed outright without prejudice. . ."

Assuming *arguendo* that this case may be tried on its merits, the Opposition nevertheless will not prosper.

A clear reading of the Notice of Opposition, Answer, pre-trial briefs, and respondent-applicant's application for registration with the papers attached thereto would show that there is

no likelihood either of confusion of goods or business of respondent-applicant with that of opposer.

Respondent-applicant's use of the mark "AMERICAN EXPRESS" on its goods Class 25 would not indicate a connection between these goods, and opposer and opposer's goods.

Opposer engages in/sells services which fall under Class 35 for advertising, business management, business administration, office functions; Class 36 for insurance, financial affairs,, monetary affairs, real estate affairs; Class 39 for transport, packaging and storage of goods, travel arrangement; Class 41 for education, providing of training, entertainment, sporting and cultural activities; Class 42 for scientific and technological services and research and design relating thereto, industrial analysis and research services, design and development of computer hardware and software, and legal services. Respondent-applicant produces and sells goods which fall under Class 25.

It is clear, then, that as opposer engages in/sells services while respondent-applicant produces and sells goods, there is no similitude in the respective undertakings of both parties as well as in the particular end products with which they deal. Moreover, opposer's services and respondent-applicant's products not only belong to different classes; they are also not related and do not have the same descriptive properties. They are non-competing goods hence, they could not reasonably be assumed to have a common source or to have originated from one manufacturer. They are directed to different segments of the population and flow through different channels of trade: Opposer's services are promoted and marketed to a specific segment of the public who are versed in certain administrative, business, technical and scientific know-how while respondent-applicant's goods are sold to the public at large regardless of any particular knowledge; and opposer's services are promoted and marketed largely through the more sophisticated print and broadcast media and sales machinery while respondent-applicant's goods are sold through department stores and common clothing stores/stalls. There is no confusing similarity between respondent-applicant's goods and opposer's services/end products so as to indicate that respondent-applicant's goods originate from, or are licensed or sponsored by opposer.

In the case of MIGHTY CORPORATION and LA CAMPANYA FABRICA DE TABACO, INC. V. E. & J. GALLO WINERY and THE ANDERSONS GROUP, INC., G.R. No. 154342, July 14, 2004 the Supreme Court enumerated cases previously decided by it wherein registration of similar marks were allowed for goods that are dissimilar or unrelated to the goods of the opposers in the respective cases cited. The Supreme Court held that-

> "(a) in Acoje Mining Co., Inc. vs. Director of Patent, 67 we ordered the approval of Acoje Mining's application for registration of the trademark LOTUS for its soy sauce eve though Philippine Refining Company had prior registration and use of such identical mark for its edible oil which, like soy sauce, also belonged to Class 47;
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> (b) in Philippine Refining Co., Inc. vs. Ng Sam and Director of Patents, we upheld the Patent Director's registration of the same trademark CAMIA for Ng Sam's ham under Class 47, despite Philippine Refining Company's prior trademark registration and actual use of such mark on its lard, butter, cooking oil (all of which belonged to Class 47), abrasive detergents, polishing materials and soaps;
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> (c) in Hickok Manufacturing Co., Inc. vs. Court of Appeals and Santos Lim Bun Liong, we dismissed Hickok's petition to cancel private respondent's HICKOK trademark registration for its Marikina shoes as against petitioner's earlier registration of the same trademark for handkerchiefs, briefs, belts and wallets;

(d) in Shell Company of the Philippines vs. Court of Appeals, in a minute resolution, we dismissed the petitioner for review for lack of merit and affirmed the Patent Office's registration of the trademark SHELL used in the cigarettes manufactured by respondent Fortune Tobacco Corporation, notwithstanding Shell Company's opposition as the prior registrant of the same trademark for its gasoline and other petroleum products;

(e) in ESSO Standard Eastern, Inc. vs. Court of Appeals, we dismissed ESSO's complaint for trademark infringement against United Cigarette Corporation and allowed the latter to use the trademark ESSO for its cigarettes, the same trademark used by ESSO for its petroleum products, and

(f) in Canon Kabushiki Kaisha vs. Court of Appeals and NSR Rubber Corporation, we affirmed the rulings of the Patent Office and the CA that NSR Rubber Corporation could use the trademark CANON for its sandals (Class 25) despite Canon Kabushiki Kaisha's prior registration and use of the same trademark for its paints, chemical products, toner and dyestuff (Class 2)."

IN VIEW OF THE FOREGOING, the Notice of Opposition is DISMISSED. Consequently, Application Serial No. 4-1999-003752 filed by respondent-applicant for the registration of the mark "AMERICAN EXPRESS" for "All kinds of outwear and underwear for men, women, teenagers and children namely, shirts t-shirts, polo shirts, blouses, skirts, suits, pants, trousers, jeans, vests, dresses, ties, coats, jackets, lingerie, panties, slips, camisoles, bras, girdles, briefers, sandos, robes, bathing suits, socks, gloves, scarves, shoes, slippers, sandals, headwear, caps and hats" under Class 25 is hereby GIVEN DUE COURSE.

Let the filewrapper of AMERICAN EXPRESS subject of this opposition be forwarded to the Administrative, Financial and Human Resource Development Services Bureau for appropriate action in accordance with this Order with a copy hereof to be furnished to the Bureau of Trademarks for information and to update its record.

SO ORDERED.

Makati City, June 7, 2006.

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