

BRIDGESTONE CORPORATION,	}	IPC NO. 14-2006-00199
Opposer,	}	Opposition to:
	}	
- versus -	}	Serial No. 4-2005-000132
	}	Date Filed: 04 January 2005
	}	
RICHARD D. UY,	}	Trademark: "RIVERSTONE"
Respondent-Applicant.	}	
x-----x	}	Decision No. 2008-48

DECISION

This pertains to the Notice of Opposition to the registration of the mark "RIVERSTONE" bearing Application Serial No. 4-2005-000132 filed on 04 January 2005 for goods falling under Class 12, used on tires, which application was published and released for opposition on August 25, 2006 of the Intellectual Property Office (IPO) Electronic Gazette.

The Opposer in the above-entitled case is a foreign corporation organized and existing under the laws of Japan, with principal place of business at 10-1 Kyobashi 1-Chrome, Chuo-ku Tokyo, Japan.

On the other hand, Respondent-Applicant is RICHARD D. UY, with business and office address at 106 Aguirre Avenue, BF Homes, Parañaque City.

Accordingly, the grounds for opposition are as follows:

- "1. Section 147.1 of the IP Code which pertains to the exclusive right of the owner of a registered mark;
- "2. Section 147.2 and related Sections 123.1 (d), 123.1 (e), and 123.1 (f) of the IP Code which relates to Opposer's rights as owner of an earlier registered trademark and as owner of a well-known trademark;
- "3. Section 168.1 of the IP Code;
- "4. Section 165 of the IP Code.

In support of the above opposition, Opposer relied on the following facts and circumstances:

- "1. Opposer herein is a foreign corporation duly organized and existing under the laws of Japan, with principal office at 10-1 Kyobashi 1-Chrome, Chuo-ku Tokyo, Japan. Its legal existence has long been recognized by the Philippine government, having obtained several Philippine trademark registrations, the earliest of which being in the name of its predecessor which has issued since the early 50's.
- "2. Opposer has appointed Federis & Associates Law Offices as its attorney and resident agent for the purpose of filing and prosecuting trademark applications and also for purpose of representing Opposer in the subject opposition proceedings. Thus, notices and processes in connection with this case and related proceedings may be served upon the Opposer through the undersigned counsel. A legalized Power of Attorney is herewith attached and marked as *Exhibit A*.

"3. Opposer has established a Representative Office in the Philippines and pursuant to that, it has obtained a license under the Corporation Code of the Philippines. Opposer can bring this action under Sections 3, 123 and 134 of IP Code solely for the protection of its business reputation, registered trademark and goodwill. Opposer's country of origin or domicile is a member-nation of, or signatory to, the Paris Convention and the World Trade Organization and Agreement on Trade-Related Aspects of Intellectual Property Rights, which grant corporate and juristic persons of the Philippines the same rights and privileges of bringing similar actions for protection of industrial property rights in Opposer's country of origin or domicile.

"4. Respondent-Applicant is RICHARD D. UY whose address of record as stated in the subject application is 106 Aguirre Avenue, BF Homes, Parañaque City and where he may be served with summons, orders and other processes of this Honorable Office.

"5. On January 4, 2005, Respondent-Applicant filed an application for registration of the trademark RIVERSTONE designated as Application Serial No. 4-2005-000132 for tires under International Class 12. The details of Respondent-Applicant's application were posted on the Electronic Gazette of the Intellectual Property Office which was released for circulation on August 25, 2006.

"6. Opposer timely filed with this Honorable Office a Motion for Extension of Time to File a Notice of Opposition, requesting that it be granted an extension of thirty (30) days from September 24, 2005 or until October 24, 2006, within which to file a Notice of Opposition against the trademark subject of this opposition. Subsequent Motions for Extension of Time to File a Verified Notice of Opposition were filed with payment of the corresponding fees.

"7. Opposer, a world-leading tire manufacturer, is the true owner of the trademark BRIDGESTONE. Opposer has been manufacturing, selling and distributing tires worldwide under the BRIDGESTONE mark for almost eighty (80) years and has widely and popularly sold and distributed its products in the Philippines and in all numerous countries around the world.

"8. Opposer was first to use and register BRIDGESTONE in connection with the design, manufacture and technology of tires. All products manufactured and sold by Opposer are affixed with the mark BRIDGESTONE. Opposer can trace its ownership and its right to use the BRIDGESTONE mark for more than seventy (70) years prior to the filing by Respondent-Applicant of its subject application on January 1, 2005.

"9. The very first BRIDGESTONE tire was produced on April 9, 1930 by the company Japan "Tabi" Socks Tire Division. On March 1, 1931, the founder Mr. Shojiro Ishiba made the decision independent and established the Bridgestone Tire Co., Ltd., in the city of Kurume, Fukuoka Prefecture.

"10. In 1951, Bridgestone was the first company in Japan to begin selling rayon cord tires. Due to modern production facilities in Tokyo, sales surpassed to 10 Billion Yen in 1953, which made Bridgestone the top of the tire industry in Japan. In 1959, the sale of nylon tires started and to cope with the fast-expanding market for motorization, a new Tokyo Plant was constructed.

"11. The 60's was an era of overseas expansion for Bridgestone. Overseas plants were established in Singapore and Thailand, and a representative sales branch was established in the United States. In the late 70's and early 80's, the company actively engaged in overseas expansion activities

and in addition to starting up production in Indonesia and Iran, it invested in a Taiwanese Tire manufacturer and purchased its tire plant and plant for diversified products in Australia. As part of its reinforcement plans, the company purchased a plant in Tennessee from Firestone Tire and rubber Co, which became its first manufacturing plant in North America. Bridgestone later on, took over Firestone, later placed as a subsidiary company, this brought about the large number of production in North America, Central & South America and in Europe. In 1984, the company changed its name from Bridgestone Tire Co. Ltd., to Bridgestone Corporation.

“12. From the time of its foundation, Opposer took great pains to create and establish trademark that would be uniquely BRIDGESTONE. In the early years of the company, the representation of its name took many forms until 1984 when the BRIDGESTONE mark made its first appearance. Although modified over the years, its basic design has remained constant ever since, and together with the word mark BRIDGESTONE, it gives the Opposer the distinctive identity it enjoys today.

“13. The ownership and association of the word STONE as a mark to Bridgestone Corporation was strengthened through acquisition of Firestone Tire & Rubber in 1988. With the acquisition of Firestone Tire & Rubber, the second-largest U.S. tire manufacturer, the brand awareness of the Bridgestone Corporation and its family of marks increased over time. Attached herewith and marked as *Exhibit B* is a list of all trademark applications and registrations filed and/or issued for the trademark FIRESTONE from many countries around the world.

“14. Today, all consumers are used to seeing the name BRIDGESTONE in uniform black capital letters. It may appear in different sizes but the basic shape of the eleven capitalized letters is easily recognizable wherever in the world we encounter it. The word STONE attached with another word such as BRIDGE and FIRE has already acquired a secondary meaning which refers to a brand of tires produced by Opposer. What distinguishes BRIDGESTONE from FIRESTONE are the type of tires they produce, which is based on the specifications of the consumers. However, it must be emphasized that whether the consumers choose BRIDGESTONE or FIRESTONE, they are purchasing these products based on its reliability and high quality which Bridgestone Corporation is known for.

“15. Opposer and the mark BRIDGESTONE are internationally well-known by reason of, among others, the long and continuous use of the mark for almost a century, and the worldwide applications and registration of the said mark. To date, Opposer owns approximately five hundred (500) trademark applications and/or registrations and approximately two hundred forty three (243) domain name registrations around the world. Attached herewith and marked as *Exhibit C* is a list of all trademark applications and registrations filed and/or issued for the trademark BRIDGESTONE from many countries around the world. Also attached herewith and marked as *Exhibit D* is a list of all domain names owned by Opposer or related companies which contains the word BRIDGESTONE or BRIDGESTONE derivative domain names.

“16. Opposer is the first to use and register BRIDGESTONE in many countries around the world. Attached herewith and marked as *Exhibits E through E-45* are photocopies of some of the registrations issued for BRIDGESTONE from different countries:

Country	Mark	Registration No.	Registration Date	Exhibit
Armenia	Bridgestone	4767	3/11/1999	E
Bahrain	Bridgestone	14867	3/20/2002	E-1
Bermuda	Bridgestone	21112	10/29/1990	E-2
Bosnia and Herzegovina	Bridgestone	BAZ993518	1/5/2004	E-3
Canada	Bridgestone and Device	TMA296,403	10/5/1999	E-4
Canada	Bridgestone	TMA315,459	10/5/2001	E-5
Canada	Bridgestone	TMA358,734	5/6/2004	E-6
Croatia	Bridgestone	Z930041	12/3/2002	E-7
Estonia	Bridgestone	16363	8/14/1995	E-8
Ethiopia	Bridgestone	6135	11/21/2001	E-9
Ghana	Bridgestone Logo	31541	12/14/2005	E-10
Hong Kong	Bridgestone	300143072	1/14/2004	E-11
Ireland	Bridgestone	217519	11/16/1999	E-12
Jordan	Bridgestone	64940	12/11/2001	E-13
Kenya	Bridgestone	54531	5/8/2003	E-14
Korea	Bridgestone	260677	12/7/1992 (renewed 2/18/02)	E-15
Lao People's Democratic Republic	Bridgestone	414(Renewal)	7/24/2003	E-16
Lithuania	Bridgestone	21712	9/16/2002	E-17
Macedonia	Bridgestone	08783	4/14/1967	E-18
Malaysia	Bridgestone	M/47697	2/17/1955	E-19
Malaysia	Bridgestone	M/25297	11/12/2001	E-20
Malta	Bridgestone	35279	4/15/2002	E-21
Nepal	Bridgestone	17645/059	10/6/1994	E-22
Russia	Bridgestone	120930	12/10/1991	E-23
Portugal	Bridgestone	235412	4/22/1991	E-24
Saudi Arabia	Bridgestone	235/87	4/22/1991	E-25
Saudi Arabia	Bridgestone	235/88	4/22/1991	E-26
Saudi Arabia	Bridgestone	235/89	4/22/1991	E-27
Saudi Arabia	Bridgestone	235/90	4/22/1991	E-28
Singapore	Bridgestone	T84/03927G	7/24/2001	E-29
Sudan	Bridgestone	27226	14/20/2002	E-30
Syria	Bridgestone	20659	11/26/2000	E-31
Tanzania	Device	B19298	12/11/2001	E-33
Thailand	Bridgestone	Kor22779	12/18/1984	E-34
Thailand	Bridgestone	Kor23218	12/18/1984	E-35
Thailand	Bridgestone	Kor23767	12/18/1984	E-36
Thailand	Bridgestone	Kor25387	12/18/1984	E-37
Thailand	Bridgestone	Kor23768	12/18/1984	E-38
Trinidad & Tobago	Bridgestone	B1529	11/6/2003	E-39
Turkmenistan	Bridgestone	7120	9/25/2001	E-40
Uganda	Bridgestone	24506	12/6/2001	E-41
United Arab Emirates	Bridgestone	3798	01/20/1996	E-42
United States	Bridgestone	1,340,354	6/11/1985	E-43
United States	Bridgestone	2,607,465	8/13/2002	E-44
Vietnam	Bridgestone	17844	8/28/1995	E-45

“17. The fame and well-known status of the subject mark are likewise attributed to the legal protection obtained for the trademark BRIDGESTONE in many countries, and Opposer’s efforts at obtaining and maintaining exclusive rights to the use and ownership of said marks. More information about the Opposer, its products and the BRIDGESTONE brand history are available at its main website: <http://www.bridgestone.com> and at Opposer’s specific country or area/language websites. Visitors to this website include internet users and customers from all parts of the world including the Philippines. The said website serves as a powerful advertising medium for the brand BRIDGESTONE as it is accessible at all times to all customers who purchase and patronize Opposer’s goods that are sold under the mentioned brand. Attached herewith as *Exhibits F to F-3* are printouts of various website all demonstrating advertising and promotions of Opposer’s BRIDGESTONE trademark.

“18. Opposer’s trademark BRIDGESTONE is well-known internationally and in the Philippines because of Opposer’s aggressive worldwide sale, promotions and advertising. Its fame and popularity was achieved through extensive advertising and promotion.

“19. In the Philippines, Opposer owns Philippine Trademark Registration No. 39620 subject of which is the Stylized Bridgestone mark registered on June 27, 1988. The said registration covers goods and services in International Class 12 particularly the following: tires, tubes, vehicles, wheels, bicycles and their parts as well as other goods included in Class 12. The mark was first used in the Philippines on July 31, 1984. A certified copy of Philippine Trademark Registration No. 39620 in connection with goods in International Class 12 is attached to the Affidavit-Testimony of Jan Abigail L. Ponce-Roxas as Exhibit B.

“20. Opposer also owns Philippine Trademark Registration No. 012205 of which is the Firestone mark registered on March 24, 1966, in connection with goods and services in International Class 12 particularly the following: rubber tires, pneumatic and solid, inner tubes, rubber impregnated tire building and rebuilding fabrics, tire accessories namely, fabric and rubber repair-patches, tube-patches in sheet and patch form-and tire repair gum materials namely, tread-gums, and camel-back tread gums. A certified copy of Philippine Trademark Registration No. 012205 in connection with goods in International 12 is attached to the Affidavit-Testimony of Jan Abigail L. Ponce-Roxas as Exhibit C.

“21. Opposer was the first to use the BRIDGESTONE trademark in the Philippines. As proof of its use in the Philippines, Opposer presented an Affidavit of Use herewith attached and marked as *Exhibit G*. attached also herewith are invoices which are marked as *Exhibits H through H-2*.

Invoice	Exhibit
Invoice No. 6B92PHI, Sept. 27, 2006, for 5,250 tires and 1,900 tire tube and flap	<i>H</i>
Invoice No. 62AXK63, Oct. 10, 2006, for 4,320 tires and 95 tire tube and flap	<i>H-1</i>
Invoice No. 6L2137, Oct. 11, 2006, for 1,110 tire and 1,200 tire tube and flap	<i>H-2</i>

“22. Opposer has invested enormous resources in advertising and popularizing its BRIDGESTONE trademark in the Philippines around the world. On an annual basis, Opposer spends approximately US\$ 115.82 in promotion and advertising costs. Attached herewith as *Exhibits* are representative sample of promotional materials published in Philippine magazines and newspapers, to wit:

Title/Description of advertising material or news	Exhibit
Bridgestone Turanza ER-60, Philippine Star, Oct. 7, 2005	I
Bridgestone: Designed for Speed, Phil. Daily Inquirer, Oct. 17, 2005	I-1
Get a Super Galing T-Shirt fr. Bridgestone, Mindanao Gold Star Daily, Jan. 14, 2002	I-2
Get a Super Galing T-Shirt from Bridgestone, Daily Informer, Jan. 16, 2002	I-3
Bridgestone: A grip on the Future, C! Magazine, Jan/Feb 2002, Vol. 1, Issue 1	I-4
The Choice Is Yours: Potenza, Turanza, Bseries, C! Magazine, March 2003, Vol. 2 No. 2	I-5
The new Turanza GR-80, C! Magazine, 2 nd Anniversary Issue 2004, Vol. 3, Issue 1	I-6
The new Turanza GR-80, C! Magazine, April 2004, Issue 2004, Vol. 3, No. 4	I-7
Bridgestone Highly Evolved, C! Magazine, July 2005, Vol. 4, Issue 7	I-8
"Look at they style. Feel Comfort," C! Magazine, Sept. 2006, Vol. 5, Issue 9	I-(

"23. Although Bridgestone has diversified to include products such as sporting goods, chemical and industrial products and bicycles, its major product remains to be tires. In 2005, Bridgestone occupied the largest market share in the global tire market at 18.2% with sales reaching as high as US\$ 24,440 million dollars.

"24. In the Philippines, Bridgestone controls about 80% of the Original Equipment market and 50% of the local tire market. To increase the awareness and provide better service to their clients, Bridgestone opened a 1,300 square-meter Bridgestone Tire Showroom and service center at Bonifacio Global City in Taguig, Metro Manila. The said tire center is considered the most modern facility in the country.

"25. Bridgestone products are being sold locally through its Philippine Representative Office located at Pasong Tamo Extension, Makati City as well as its local distributor Philippine allied Enterprises Corporation.

"26. Bridgestone tires are also being sold online at www.tirecenter.com.ph. The said website is owned and managed by Tire Center Philippines ("TCP") which is also a distributor of various brands of tires in the Philippines, including Bridgestone. Aside from that, Bridgestone tires are also being sold at www.ebay.ph which is a Philippine based auction sites as well as www.ebay.com. At www.ebay.ph and www.ebay.com individuals list items for sale on the site, as well as an initial purchase price. Thereafter, the purchasing public posts bids (in US dollars) on the items and at the end of the bidding period, highest bidder is awarded the item subject to the payment of the bid. Some items sell for over the original retail value. Review of search results of a search for BRIDGESTONE on www.ebay.ph on December 7, 2006 uncovered 4 listings. A search of the www.ebay.com which is one of the biggest auction website on December 7, 2006 uncovered 1249 listings. Enclosed and incorporated as Exhibits J and K are printouts of the BRIDGESTONE search results from www.ebay.ph and www.ebay.com, respectively.

"27. Opposer has been using BRIDGESTONE not only as a trademark but also as a trade name or company name from the inception of its business and to this day, continues to use the same as its company name in all of its business dealings not only in its country of origin or domicile but in all countries around the

world where it has business dealings or transactions. As a trade name, "BRIDGESTONE" is protected under Section 165 of the IP Code, as it is registered as a trademark in the Philippines.

"28. The subject trademark RIVERSTONE is identical and/or has the same sight, sound and meaning as Opposer's trademark BRIDGESTONE and is used in connection with goods in the same category for which Opposer uses its trademark such that if allowed to register, RIVERSTONE will likely deceive or cause confusion, in contravention of Section 123.1 (d) of the IP Code.

"29. Opposer's BRIDGESTONE trademark is well-known internationally and in the Philippines and the registration and use of RIVERSTONE by Respondent-Applicant will falsely indicate a connection between the Opposer's and Respondent-Applicant's goods which will result in damage to Opposer's and Respondent-Applicant's goods which will result in damage to Opposer in terms of, among others, the whittling away of Opposer's goodwill and the dilution of the rights of Opposer to its BRIDGESTONE trademark --- all in contravention of Section 123.1 (e) and 123.1 (f) of the IP Code.

"30. As BRIDGESTONE also constitutes Opposer's company or trade name which is protected under Section 165 even without registration, the registration and use of RIVERSTONE in the name of Respondent-Applicant violate Opposer's legal rights to its trade name which consists, among others, in Respondent-Applicant unfairly profiting from the high reputation and goodwill generated by the overwhelming popularity of Opposer's trademark.

"31. Confusion and deception upon the consuming public with respect to, among others, the source of goods and services or the sponsorship of goods and services will likely result if RIVERSTONE is allowed to be used and registered in the name of Respondent-Applicant.

"32. BRIDGESTONE is a highly distinctive trademark such that if subject is approved, Opposer stands to suffer grave and irreparable damage and injury.

"33. The suffix STONE as a component in Opposer's trademarks such as BRIDGESTONE or FIRESTONE is closely associated with the products of Opposer herein. Being a highly distinctive brand component, Opposer has the right to the exclusive use of suffix STONE as a trademark whether STONE is used alone or in combination with another word as prefix, particularly if the goods connected or used therewith are the same goods as those of Opposer's. Thus, Respondent-Applicant's mark which merely changes BRIDGE or FIRE to RIVER but use the same suffix STONE violates Opposer's right to BRIDGESTONE or FIRESTONE and must not be allowed.

"34. Supporting Affidavits are concurrently submitted herewith pursuant to the Rules.

On January 04, 2007, a Notice to Answer was sent to Respondent-Applicant, through Counsel, TAM-YAP CAGA & ASSOCIATES requiring Respondent-Applicant to file its Verified Answer within thirty (30) days from receipt thereof. After several extensions were granted by this Office for Respondent-Applicant to file the required Answer, Respondent-Applicant finally filed its Answer on 22 March 2007.

Respondent in its Answer interposed the following ADMISSIONS and DENIALS:

1. "Respondent is without knowledge or information to form a belief as to the truth or falsity of the allegation (page 1, first sentence) that Opposer is the registered owner of a purported well-known trademark "BRIDGESTONE" and therefore specifically denies the same. Respondent likewise specifically denies the purported grounds for the opposition to the application as they are but mere conclusions of facts of law and for reasons stated hereinafter;
2. "Respondent has no knowledge or information sufficient to form a belief to the allegations in paragraphs 1 and 2 and therefore specifically denies the same;
3. "Respondent has likewise no knowledge or information sufficient to form a belief as to the allegations in paragraph 3 as to the purported Representative Office and license and therefore specifically denies the allegations as to the allegation that Opposer can file the instant action under the IP Code of the Philippines, it being a mere conclusion of law. Respondent specifically denies the rest of the paragraphs for lack of sufficient knowledge or information to form a belief;
4. "Respondent admits the allegations in paragraph 4 and 5;
5. "Respondent has no knowledge or information sufficient to form a belief as to the allegations in paragraph 6 and therefore specifically denies the same;
6. "Respondent has no knowledge or information sufficient to form a belief as to the allegations in paragraphs 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17 and 18 including all the exhibits, annexes and attachments and therefore specifically denies the same;
7. "Respondent has no knowledge or information sufficient to form a belief as to the allegations in paragraphs 19, 20, 21, 22 including all the exhibits, annexes and attachments and therefore specifically denies the same;
8. "Respondent has no knowledge or information sufficient to form a belief as to the allegations in paragraphs 23, 24, 25 and 26 including all the exhibits, annexes and attachments and therefore specifically denies the same;
9. "Respondent specifically denies the allegations in paragraphs 27, 28, 29, 30, 31, 32, 33 for lack of knowledge or information sufficient to form a belief as to the truth and falsity and for being mere baseless conclusions of facts and of law;

and by way of defense further stated the following, to wit:

- a. "Respondent humbly submits that the grounds for opposition are factually and legally baseless;
- b. "The name sought to be registered "RIVERSTONE" and the purported trademark of Oppositor "BRIDGESTONE" are so different that respondent or any other ordinary person would be able to distinguish. How much more to the discriminating buyer of tires, which costs much more than the ordinary products being consumed daily? Truth to tell, under ordinary circumstances, tires are being replaced after more than several months or even years of use. Thus, buyers are normally even more discriminating as it costs higher than the day to day products and it relates to the safety of the car;
- c. "Respondent's "RIVERSTONE" is not deceptively or confusingly similar or even plainly similar to oppositor's purported trademark "BRIDGESTONE". It cannot never even mislead an elementary student. In fact, in the case of Philip Morris, Inc. vs. Fortune Tobacco Corporation (G.R. No. 158589, June 27, 2006, 493

SCRA 333), a very recent case involving names of cigarettes, the Supreme Court even dismissed the opposition to the registration of the trademark "MARK" applied for by Fortune Tobacco even though the ground being used in the opposition is that Oppositor therein had already a registered trademark "MARK VII" and "MARK TEN". The decision of the Supreme Court is very instructive to wit:

The "likelihood of confusion" is the gravamen of trademark infringement. But likelihood of confusion is a relative concept, the particular, and sometimes peculiar, circumstances of each case being determinative of its existence. Thus, in trademark infringement cases, more than in other kinds of litigation, precedents must be evaluated in the light of each particular case.

In determining similarity and likelihood of confusion, jurisprudence has developed two tests: the dominancy test and the holistic test. The dominancy test sets sight on the similarity of the prevalent features of the competing trademarks that might cause confusion and deception, thus constitutes infringement. Under this norm, the question at issue turns on whether the use of the marks involved would be likely to cause confusion or mistake in the mind of the public or deceive purchasers.

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.

Upon consideration of the foregoing in the light of the peculiarity of this case, we rule against the likelihood of confusion resulting in infringement arising from the respondent's use of the trademark "MARK" for its particular cigarette product.

For one, as rightly concluded by the CA after comparing the trademarks involved in their entirety as 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 "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 appearing in 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.

This said, the CA then, in finding that respondent's goods cannot be mistaken as any of the three cigarette brands of the petitioners, correctly relied on the holistic test.

But, even if the dominancy test were to be used, as urged by the petitioners, but bearing in mind that a trademark serves as a tool to point out distinctly the origin or ownership of the goods to which it is affixed, the likelihood of confusion tantamount to infringement appears to be farfetched. The reason for the origin and/or ownership angle is that unless the words or devices do so point out the origin or ownership, the person who first adopted them cannot be injured by any appropriation or imitation of them by others, nor can the public be deceived.

Since the word "MARK", be it alone or in combination with the word "TEN" and the Roman numeral "VII", does not point to the origin or ownership of the cigarettes to which they apply, the local buying public could not possibly be

confused or deceived that respondent's "MARK" is the product of petitioners and/or originated from the U.S.A., Canada or Switzerland. And let it be overlooked, no actual commercial use of petitioners' marks in local commerce was proved. There can thus be no occasion for the public in this country, unfamiliar in the first place with petitioners' marks, to be confused.

For another, a comparison of the trademarks as they appear on the goods is just one of the appreciable circumstances in determining likelihood of confusion. *Del Monte Corp. v. CA* dealt with another, where we instructed to give due regard to the "ordinary purchaser", thus:

The question is not whether the two articles are distinguishable by their label when set side by side but whether the general confusion made by the article upon the eye of the casual purchaser who is unsuspecting and off his guard, is such as to likely result in his confounding it with the original. As observed in several cases, the general impression of the ordinary purchaser, buying under the normally prevalent conditions in trade and giving the attention such purchasers usually give in buying that class of goods is the touchstone.

When we spoke of an "ordinary purchaser", the reference was not to the "completely unwary customer" but to the "ordinarily intelligent buyer" considering the type of product involved.

It cannot be over-emphasized that the products involved are addictive cigarettes purchased mainly by those who are already predisposed to a certain brand. Accordingly, the ordinary buyer thereof would be all too familiar with his brand and discriminating as well. We, thus, concur with the CA when it held, citing a definition found in *Dy Buncio v. Tan Tiao Bok*, that the "ordinary purchaser" in this case means "one accustomed to buy, and therefore to some extent familiar with, the good in question."

Pressing on with their contention respecting the commission of trademark infringement, petitioners finally point to Section 22 of R.A. No. 166, as amended. As argued, actual use of trademarks in local commerce is, under said section, not a requisite before an aggrieved trademark owner can restrain the use of his trademark upon goods manufactured or dealt in by another, it being sufficient that he had registered the trademark or trade-name with the IP Office. In fine, petitioners submit that respondent is liable for infringement, having manufactured and sold cigarettes with the trademark "MARK" which, as it were, are identical and/or confusingly similar with their duly registered trademarks "MARK VII," "MARK TEN" and "LARK".

This Court is not persuaded.

In *In might Corporation v. E & J Gallo Winery*, the Court held that the following constitute the elements of trademark infringement in accordance not only with Section 22 of R.A. No. 166, as amended, but also Sections 2, 2-A, 9-A and 20 thereof;

(a) a trademark actually used in commerce in the Philippines and registered in the principal register of the Philippine Patent Office.

(b) is used by another person in connection with the sale, offering for sale, or advertising of any goods, business or services or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers or others as to the source or origin of such goods or services, or identity of such business; or such trademark is reproduced, counterfeited, copied or colorably

imitated by another person and such reproduction, counterfeit, copy or colorable imitation is applied to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used upon or in connection with such goods, business or services as to likely cause confusion or mistake or to deceive purchasers.

(c) the trademark is used for identical or similar goods, and

(d) such act is done without the consent of the trademark registrant or assignee.

As already found herein, while petitioners have registered the trademark "MARK VII," "MARK TEN" and "LARK" for cigarettes in the Philippines, prior actual commercial use thereof had not been proven. In fact, petitioners' judicial admission of not doing business in this country effectively belies any pretension to the contrary.

Likewise, we note that petitioners even failed to support their claim that respective marks are well-known and/or have acquired goodwill in the Philippines so as to be entitled to protection even without actual use in this country in accordance with Article 6 of the Paris Convention. As correctly found by the CA, affirming that of the trial court:

xxx the records are bereft of evidence to establish that the appellants' [petitioners] products are indeed well-known in the Philippines, either through actual sale of the product or through different forms of advertising. This finding is supported by the fact that appellants admit in their Complaint that they are not doing business in the Philippines, hence, admitting that their products are nor being sold in the local market. We likewise see no cogent reason to disturb the trial court's finding that the appellants failed to establish that their products are widely known by local purchasers as "(n)o specific magazine or periodical published in the Philippines, or in other countries but circulated locally" have been presented by the appellants during trial. The appellants also were not able to show the length of time or the extent of the promotion or advertisement made to popularize their products in the Philippines.

Last, but not the least, we must reiterate that the issue of trademark infringement is factual, with both the trial and appellate courts having peremptorily found allegations of infringement on the part of respondent to be without basis. As we said time and time again, factual determinations of the trial court, concurred in by the CA, are final and binding on this Court.

- d. "Respondent humbly submits that the foregoing ruling and the ratio decidendi are squarely applicable to the instant case. Respondent likewise reserves the right to submit and present evidence or testimonies in support of his Answer.
- e. "In view of the foregoing, respondent reiterates that the opposition is factually and legally baseless.

Considering that this case is mandatorily covered by the summary rules, Opposer was directed to file its evidences in the required form and duly marked in accordance with Section 7 and Subsection 7.1 of Office Order No. 79.

Opposer submitted his evidences in support of his Notice of Opposition, consisting of the following:

Exhibit	Description
"A"	A legalized Power of Attorney;
"B"	List of all trademark applications and registrations filed and/or issued for the trademark BRIDGESTONE from many countries around the world;
"C"	List of all trademark applications and registrations filed and/or issued for the trademark BRIDGESTONE from many countries around the world;
"D"	List of all domain names owned by Opposer or related companies which contains the word BRIDGESTONE or BRIDGESTONE derivative domain names;
"E", "E-1" to "E-45"	Photocopies of some of the registrations issued for BRIDGESTONE from different countries;
"F", "F-1" to "F-3"	Printouts of various website all demonstrating advertising and promotions of Opposer's BRIDGESTONE trademark;
"G"	Affidavit of Use for BRIDGESTONE trademark;
"H", "H-1" and "H-2"	Invoices to prove sale in the Philippines of trademark BRIDGESTONE;
Exhibit	Description
"I", "I-1" and "I-9"	Representative sample of promotional materials published in Philippine magazines and newspapers;
"J" and "K"	Printouts of the BRIDGESTONE search results from www.ebay.ph and www.ebay.com ;
"L" to "L-6"	Photographs of PAEC, exclusive distributor of BRIDGESTONE outlets, to wit: <ol style="list-style-type: none"> 1. Bridgestone Tire Center at Bonifacio Global City 2. Millennium Tire Venture at San Fernando, Pampanga 3. Robust Trading & Care

- Center at Shaw Blvd.
4. AQCD System Marketing Corp. at Bacoor Cavite
 5. FB LadaoSales at Timog Avenue, Queszon City
 6. GNS Tire & General Merchandising at Dagupan City

“M”	List of stores and retail outlets selling BRIDGESTONE tires
“N” to “N-1”	Printouts of www.ebay.com and www.ebay.com,ph showing search result for BRIDGESTONE
Affidavit of Jan Abigail L. Ponce	Printout of the www.ebay.com website
“A”	Philippine trademark registration no. 39620 for stylized BRIDGESTONE which was registered on June 27, 1988 under Class 12
“B”	Philippine trademark registration no. 012205 for FIRESTONE which was registered on March 24, 1966 under Class 12
“C”	Newspaper articles featuring the launching of Bridgestone products
“D” to “D-3”	Copy of the page containing the editorial team of the C! Magazine and address of the magazine's publisher
“E” to “E-1”	

The main issue presented to this Bureau for resolution is:

Whether or not Respondent-Applicant's "RIVERSTONE" mark is confusingly similar to Opposer's trademark "BRIDGESTONE" in respect of the classification of goods and of other relevant circumstances.

It should be noted that the trademark application being opposed was filed on January 04, 2005 or during the effectivity of Republic Act No. 8293, which provides that:

“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;

x x x

In the present opposition proceeding, it is undeniable that the competing mark of Opposer and Respondent-Applicant both bear the suffix "STONE". Although as established in

several jurisprudence, that the mere adoption and use of one person of a trademark will not automatically prevent another from adopting and suing the same trademark, a careful review and consideration of the facts and evidence presented should be taken in determining whether likelihood of confusion is likely to arise by the adoption of the same or substantially similar trademark.

A trademark application should be outrightly denied if the mark sought to be registered is confusingly similar to a mark already registered or previously used in the Philippines. In *Chuanchow Soy & Canning Co. vs. the Director of Patents*, no less than the Supreme Court ruled that:

“when one applies for the registration of a trademark of label which is almost the same or very closely resembles one already used and registered by another, the application should be rejected and dismissed outright, even without opposition on the part of the owner and user of a previously registered label or trademark, this is not only to avoid confusion on the part of the public, but also to protect an already used and registered trademark and an established goodwill. There should be no halfway measures, as when an examiner of the Office of the Director of Patents directs an applicant to amend or modify the label or trademark he seeks to register by eliminating some portions thereof.”

This Bureau finds that the issue of confusing similarity can best be resolved by comparative examination or analysis of the marks in question. A comparison of Opposer’s and Respondent-Applicant’s marks will show that Respondent’s RIVERSTONE is confusingly similar to any of Opposer’s registered BRIDGESTONE and FIRESTONE trademarks.

This Bureau reproduced Opposer’s as well as Respondent-Applicant’s marks for purposes of comparison:

BRIDGESTONE

RIVERSTONE

Firestone

The STONE element in Respondent-Applicant’s RIVERSTONE is identical to the BRIDGESTONE and FIRESTONE trademarks owned and unabandoned by the Opposer that included the STONW component. As such, Respondent-Applicant’s use and application if RIVERSTONE in connection with tires of Respondent-Applicant results in a misappropriation of the very component of the Opposer’s trademarks, the suffix STONE is present and prominent in both BRIDGESTONE and FIRESTONE trademarks of Opposer.

Considering that the goods of Opposer vis-à-vis Applicant’s products are the same in that they deal mainly with TIRES falling under Class 12 of the International Classification of Goods, thus, applying these competing marks to the same goods which passed through the same channels of trade and marketed similarly, may lead to confusion in trade and would damage Opposer’s goodwill or reputation which it has painstakingly earned and established for many years in the Philippines alone.

In like manner, the Supreme Court made the following pronouncements to the effect that:

“The tradename “LIONPAS” for medicated plaster cannot be registered because it is confusingly similar to “SALONPAS”, a registered trademark also for medicated plaster. x x x Although the 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.” (Marvex Commercial Co vs. Hawpia & Co., 18 SCRA 1178),

“The similarity between the two competing trademarks, DURAFLEX and DYNAFLEX is apparent. Not only are the initial letters and the last half of the appellations identical but the difference exists in only two out of the eight literal elements of the designations. Coupled with the fact that both marks cover insulated flexible wires under Class 20; x x x no difficulty is experienced in reaching the conclusion that there is a deceptive similarity that would lead the purchaser to confuse one product with the other.” (American Wire and Cable Co. vs. Director of Patents, 31 SCRA 544),

Having shown and proven resemblance of the two marks, we now delve into the matter of ownership and priority in application which certainly has decisive effect in the adjudication of the case.

With R.A. 8293 as basis of registrability, this Bureau adheres to the First-to-File Rule and applying specific provisions of R.A. 8293 (Sec. 122 and Sec. 127). The records will show that as between the parties, Opposer has prior application and registration obtained for both BRIDGESTONE and FIRESTONE trademarks. Opposer’s trademark BRIDGESTONE (*Exhibit “B”, Affidavit of Atty. Ponce, Opposer*) was first filed in the Philippines on 20 November 1984 and its FIRESTONE trademark was first registered in the Philippines on 24 March 1966 (*Exhibit “C”, Affidavit of Atty. Ponce, Opposer*), while Respondent-Applicant’s application for substantially the same mark RIVERSTONE came more than two decades later on 04 January 2005. Being the prior user and registrant of the trademarks BRIDGESTONE and FIRESTONE in the Philippines, Opposer is the actual owner thereof.

The right to register trademarks, trade names and service marks is based on ownership. Only the owner of the mark may apply for its registration (*Bert R. Bagano v. Director of Patents, et.al.*, G.R. No. L-20170, August 10, 1965). And where a trademark application is opposed, the Respondent-Applicant has the burden of proving ownership (*Marvex Commercial Co., Inc. v. Peter Hawpia and Co.*, 18 SCRA 1178). In the instant case, Respondent-Applicant did not overcome or presented any evidence of prior use of its RIVERSTONE mark in the Philippines vis-à-vis Opposer’s trademarks BRIDGESTONE and FIRESTONE. Opposer, considering the above factual circumstances is the actual and registered owner and prior user of the trademarks BRIDGESTONE and FIRESTONE.

Clearly etched in *Converse Rubber Corp. vs. Universal Rubber Products, Inc.* is the concept of likelihood of confusion where it said “The similarity in the general appearance of respondent’s trademark and that of petitioner would evidently create a likelihood of confusion among the purchasing public. xxx The risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation if the public could reasonably assume that the goods of the parties originated from the same source”. The law does not require actual confusion, it suffices that confusion is likely to occur in the sale of the goods and adoption of both marks (*Philips Export B.V., et. al vs. Court of Appeals, et. al G.R. No. 96161, February 21, 1992*). Hence, the likelihood that prospective buyers may perceive that Respondent’s goods are manufactured by or is associated or connected with Opposer is probable.

It is worth mentioning at this juncture to bolster Oppositor’s exclusive right over its BRIDGESTONE and FIRESTONE trademarks and accord protection henceforth against any subsequent user is the established goodwill and reputation BRIDGESTONE and FIRESTONE trademarks have earned over the years. The trademark BRIDGESTONE alone is widely and popularly used by Opposer in the Philippines especially on its main product of TIRES. The use

and adoption by Applicant of the mark as subsequent user can only mean that applicant wishes to reap on the goodwill, benefit from the advertising value and reputation of Opposer's BRIDGESTONE and FIRESTONE trademarks.

On the basis of the evidence presented and as the record eloquently shows, Opposer's mark is popular, widely used and extensively advertised in many countries including the Philippines (*Exhibits "I" to "I-9", Opposer*). The trademarks, BRIDGESTONE and FIRESTONE trademarks have registrations and pending applications in the name of the Opposer (*Exhibit "E" to "E-45", Opposer*) in almost all the countries in the world and has enjoyed international reputation and goodwill for the quality of the products they sell bearing these trademarks. Over the years, Opposer's tire products bearing BRIDGESTONE and FIRESTONE trademarks have been sold worldwide and advertised extensively in many countries, including the Philippines.

By appropriating a word which is almost identical or closely resembles that of a registered and widely used and popularly known trademark, and taking into account the evidence submitted by Opposer, this Bureau finds and so holds that indeed there was a deliberate intent by Respondent-Applicant to ride on the popularity of the trademarks of the Opposer generated through extensive use and advertisement without the Respondent-Applicant having incurred any expense to gain such goodwill and/or reputation. Thus, under Sec. 123.1 (d) of R.A. 8293, Respondent-Applicant's RIVERSTONE can not be allowed registration.

Finally, in the case of American Wire & Cable Co. vs. Director of Patents, 31 SCRA 544, it was observed that:

"Why of the million of terms and combination of letters and designs available the appellee had to choose a mark so closely similar to another's trademark if there was no intent to take advantage of the goodwill generated by the other mark"

As the rightful owner and prior user of the trademarks BRIDGESTONE and FIRESTONE, Opposer should be given protection against entities that merely wish to take advantage of the goodwill its marks have generated.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, application bearing Serial No. 4-2005-000132 filed by Richard D. Uy on 04 January 2005 for the registration of the mark "RIVERSTONE" for use on tires falling under Class 12 is, as it is hereby REJECTED.

Let the filewrapper of the trademark "RIVERSTONE" subject matter of this case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 24 March 2008.

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