

BRIDGESTONE TIRE CO., LTD.,
Opposer,

INTER PARTES CASE NO. 1318

OPPOSITION TO:

Application Serial No. 31421
Filed : January 6, 1977
Applicant : Ramcar, Inc.
Trademark : BRIDGESTONE

- versus -

BATTERY

Used on : Automotive storage
Battery

RAMCAR, INCORPORATED,
Respondent-Applicant.

Decision No. 88-107 (TM)
October 13, 1988

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DECISION

On October 24, 1979, Bridgestone Tire Co., Ltd., a Japanese company, filed an Unverified Notice of Opposition (Inter Partes Case No. 1318) to Application Serial No. 31421 for the trademark "BRIDGESTONE BATTERY" ("BATTERY" disclaimed) used on automotive storage batteries (Class 9), which application was filed on January 6, 1977 by Ramcar, Inc., a domestic corporation, and published in the Official Gazette (Vol. 75, No. 26, Page 5265) on June 25, 1979 and officially released on August 25, 1979.

On December 13, 1979, Opposer filed its Verified Notice of Opposition alleging the ground, among others, that Respondent-Applicant's trademark "BRIDGESTONE BATTERY" is confusingly similar with Opposer's registered trademark "BRIDGESTONE" (Certificates of Registration No, 11039 and 16672).

On February 20, 1980, Respondent-Applicant filed its Answer raising the following special/ Affirmative defenses: (1) that Respondent-Applicant is the prior adopter and user of the trademark "BRIDGESTONE" in the Philippines; (2) that no confusing similarity exists between the trademarks "BRIDGESTONE" and "BRIDGESTONE BATTERY" since automotive tires and batteries are non-competing and expensive products which are not purchased very often and are sold to sophisticated and discriminating buyers, and Respondent-Applicant's automotive batteries are clearly marked as "Manufactured by: Ramcar Inc., Metro Manila, Philippines"; and (3) that assuming arguendo that Opposer is the prior user of the trademark "BRIDGESTONE" in the Philippines, its opposition is nevertheless barred by laches or acquiescence due to its inaction for a period of nearly twelve (12) years, during which time Opposer allowed Respondent-Applicant to use "BRIDGESTONE" for its automotive batteries without protest.

The main issue to be resolved is whether or not the use of the trademark "BRIDGESTONE BATTERY" on Respondent-Applicant's goods would likely cause confusion, mistake or deception upon purchasers as to the source or origin thereof.

The evidence show that Opposer's trademark "BRIDGE-STONE" was first used in the Philippines on April 24 1952 on non-metallic tires; on September 10, 1960 on vehicles, auto bicycles and parts thereof; on May 25, 1966 on conveyor and transmission belts; on September 10, 1963 on hoses; on March 1, 1967 on rubber buffers, and on July 15, 1967 on rubber dock fenders (Exhs. "A-2" and "F-3"), while Respondent-Applicant's trademark "BRIDGESTONE BATTERY" was first used in the Philippines on November 3, 1968 on automotive storage batteries (Exhs. "1-B" and "2").

Therefore, Opposer's date of first use (April 12, 1952) is much earlier than that of Respondent-Applicant's (November 3, 1968). Accordingly, Opposer is the prior adopter and user of the trademark "BRIDGESTONE" in the Philippines.

Although Respondent-Applicant's trademark is used on automotive storage batteries under Class 9 (see records of Application Serial No. 31421), while Opposer's trademark is used, among others, on automotive tires under Class 12 (Exh. "A-2"), likelihood of confusion, mistake or deception upon purchasers as to the source or origin of Respondent-Applicant's goods cannot be avoided, considering the following; (1) Respondent-Applicant's trademark is similar or identical to Opposer's trademark in spelling, sound and appearance; the only difference is the word "BATTERY" added to Respondent-Applicant's trademark, which word, however, has been disclaimed (Exhs. "A-1", "F-1" and (2) automotive batteries are related to automotive tires, since both goods are used as component parts of motor vehicles and encountered by the same class of purchasers; hence, they flow through the same channels of trade; and (3) Opposer's trademark is well known throughout the world, including the Philippines, as evidenced by its one hundred twelve (112) foreign registrations (Exhs. "I-4" and "I-167") and long continuous use in the Philippines (first used on April 12, 1952; Exhs. "A-2", "B-1", "C", "D", "E", "G", "H" and "I-4" to "I-7").

Note that Section 4(d) of Republic Act 166, as amended, does not require that the goods of the previous user and late user of the mark should possess the same descriptive properties or fall under the same categories as to bar the registering of the later mark in the Principal Register. The likelihood of confusion, mistake or deception upon purchasers would suffice (See Sta. Ana vs. Maliwat, 24 SCRA 1018, citing Chua Che vs. Philippine Patent Office, 13 SCRA 67.) Thus, it has been ruled that:

"There is no requirement that goods or services be identical or even competitive in nature in order to find that likelihood of confusion exists; rather, it is sufficient that there be some relationship between involved goods or services and/or that circumstances surrounding their marketing would cause them to be encountered by same persons who might, because of similarity of marks, mistakenly believe that they have common origin or are somehow associated with same producer." (Mine Safety Appliances Co. vs. Management Science America, Inc., 212 U5PU, 105)

In Ang vs. Teodoro, 74 Phil. 50, the Supreme Court has ruled that;

"x x x The courts have come to realize that there can be unfair competition or unfair trading even if the goods are noncompeting, and that such unfair trading can cause injury or damage to the first user of a given trademark, first, by prevention of the natural expansion of his business and, second, by having his business reputation confused with and put at the mercy of the second user. When noncompetitive products are sold under the same mark, the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark created by its first user, inevitably results. x x x 'Experience has demonstrated that when a well-known trade-mark is adopted by another even for a totally different class of goods, it is done to get the benefit of the reputation and advertisements of the originator of said mark, to convey to the public a false impression of some supposed connection between the manufacturer of the article sold under the original mark and the new articles being tendered to the public under the same or similar mark. x x x The owner of a trademark or tradename has a property right in which he is entitled to protection, since, there is damage to him from confusion of reputation or goodwill in the mind of the public as well as from confusion of goods. The modern trend is to give emphasis to the unfairness of the acts and to classify and treat the issue as a fraud."

Even if the manufacturer of Respondent-Applicant's goods is indicated by the words "Manufactured by: Ramcar Inc., Metro Manila, Philippines", such indication is not sufficient to prevent likelihood of confusion considering that said words are printed in small letters, while the word "BRIDGESTONE" is printed in big bold letters and made the dominant portion of

Respondent-Applicant's trademark (Exh. "6"). Purchasers would therefore be guided by the word "BRIDGESTONE" in referring to Respondent-Applicant's goods and likely be deceived into believing that Respondent-Applicant is a licensee of, or its goods have some, connection with, Opposer.

This Bureau is not unaware of the ruling in the case of *Hickock Mfg. Co., Inc. vs. Court of Appeals* (116 SCRA 387) to the effect that "shoes", on the one hand, and "leather wallets, key cases, money folds made of leather, belts, men's briefs, neckties, handkerchiefs and men's socks", on the other hand, have different channels of trade. The Supreme Court further held that:

"The mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on unrelated articles of a different kind." (Underscoring supplied)

The Hickock doctrine, however, is not applicable in the present case in view of this Bureau's finding that "automotive tires" and "automotive batteries" are related goods. Moreover, a distinction should be made between the Hickock case and the present case. In the Hickock case, there was no finding that Petitioner-Appellee's trademark "HICKOCK" is a world-famous mark. In the present case, Opposer has proven that its trademark "BRIDGESTONE", which is registered in 112 countries and continuously used since 1952, is well known throughout the world, including the Philippines.

Opposer, therefore, also deserves protection under Article 6bis of the Paris Convention for the Protection of Industrial Property, to which the Philippines and Japan are signatories, the pertinent provision of which reads as follows:

"(1) The countries of the Union undertake; either administratively if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration and to prohibit the use of a trademark which constitutes a reproduction, imitation or translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of the present Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith."

And pursuant to this provision, the then Ministry of Trade issued Memorandum dated November 20, 1980 directing this Bureau "to reject all pending applications for Philippine registration of signature and other world-famous trademarks by applicants other than its original owners or users".

In spite of the million of terms available to Respondent-Applicant, it chose a term already appropriated by, and made well-known as a trademark of, Opposer. Evidently, Respondent-Applicant had the intention to ride on the popularity and goodwill generated by Opposer's trademark. (See *American wire & Cable Co. vs. Director of Patents*, 31 SCR4 544.)

Respondent-Applicant's defense that this Opposition is barred by laches or acquiescence is devoid of merit, because the right to file a notice of opposition accrues only after publication of the application in the BPTTT Official Gazette. (See Section 8, Republic Act 166, as amended; Rule 1871 Rules of Practice in Trademark Cases.)

WHEREFORE, the Opposition is GRANTED; Application Serial No. 31421 is DENIED.

Let the records of this case be remanded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director