

INDIAN MOTORCYCLE INT'L., INC.,
Opposer,

IPC 14-2007-00050

-versus -

Opposition to:
TM Application No. 4-2005-005659
(Filing Date: 20 June 2005)

GOOD YEAR IMPORT EXPORT CORP.,
Respondent-Applicant.

TM: "INDIANA (Stylized)"

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Decision No. 07-75

DECISION

This is an opposition to the registration of the mark "INDIANA (Stylized)" bearing application No. 4-2005-005659 filed on June 20, 2005, covering the goods "MOTORCYCLE and SCOOTER" falling under Class 12 of the International Classification of Goods which application was published in the issue of the Intellectual Property Philippines (IPP) E-Gazette, released for circulation on October 27, 2006.

The Opposer in the instant opposition is "INDIAN MOTORCYCLE INTERNATIONAL, LLC" a corporation duly organized and existing under the laws of the State of Delaware, United States of America, with principal office at 8161 15th Street East, Sarasota, FL 34243. U.S.A.

Respondent-Applicant, on the other hand is "GOOD YEAR IMPORT EXPORT CORPORATION" with address at 1301 F. Yuseco Street, Sta. Cruz, Manila, Philippines

The grounds of the opposition are as follows:

1. Opposer is the originator, prior user and rightful owner of the trade name and trademarks INDIAN, INDIAN CHIEF FACING RIGHT, INDIAN & DESIGN, INDIAN & DESIGN (IB), INDIAN (SCRIPT FONT), INDIAN IN SCRIPT W/ CHIEF DESIGN & MOTORCYCLE BELOW, INDIAN SPIRIT, INDIAN IN SCRIPT FORM – MADE IN THE USA BELOW, INDIAN V8 STYLIZED, INDIAN & CHIEF DESIGN FACING RIGHT/FACING LEFT-2 IMAGES, INDIAN HEAD DEVICE, INDIAN MOTORCYCLE FACING RIGHT, INDIAN IN SCRIPT W/CHIEF LOGO FACING RIGHT, INDIAN MOTORCYCLE, INDIAN MOTORCYCLE CAFÉ AND LOUNGE, INDIAN RIDERS GROUP, INDIAN TABAC CIGAR CO & DESIGN, INDIAN MOTORCYCLE (SCRIPT) and INDIAN MOTORCYCLE LEFT-FACING HEADADDRESS DESIGN (hereinafter collectively referred to as the "INDIAN Trademarks") for a wide variety of goods and services in Classes 3, 4, 5, 6, 7, 8, 9, 11, 12, 14, 16, 18, 20, 21, 24, 25, 26, 27, 32, 33, 34, 35, 37, 41, 42 and 43 in at least 39 countries and territories around the world.

Opposer is the prior user and registered owner of the INDIAN Trademarks and trade name for goods in International Class 12 specifically for "motorcycles" and other closely related goods, under Registration Nos. 2,594,450; 2,511,305; 2,486,405; 921,459; and 2,635,537 issued by the trademarks office of the United States of America on July 16, 2002; November 27, 2001; September 11, 2001; October 4, 1975 and October 15, 2002, respectively, long before applicant appropriated the trademark INDIANA (Stylized) for "motorcycle and scooter" in Class 12. Opposer also has obtained at least 49 registrations of its INDIAN Trademarks for goods in Class 12 in at least 30 other countries and territories worldwide.

Opposer or its predecessors-in-interest- first used its INDIAN Trademarks for goods in Class 12, specifically for “motorcycle” in 1901.

- “2. Applicant’s trademark INDIANA (Stylized) so resembles Opposer’s INDIAN Trademarks and trade name as to be likely, when applied to or used in connection with the goods of Applicant, to cause confusion, mistake and deception on the part of the purchasing public by misleading them into thinking that Applicant’s goods either come from Opposer or are sponsored or licensed by it. This is particularly true because Applicant’s trademark copies the distinctive script font that has been use in Opposer’s INDIAN Trademarks since at least as early as 1910.
- “3. The registration and use by the Applicant of the trademark INDIANA (Stylized) will diminish the distinctiveness and dilute the goodwill of Opposer’s INDIAN Trademarks, which are arbitrary and well-known trademarks used on Opposer’s products.
- “4. Applicant appropriated and used the identical and confusingly similar trademark INDIAN (Stylized) on his own goods with the obvious intention of misleading the public into believing that its goods bearing said trademark originate from, or are licensed or sponsored by Opposer, which has been identified in the trade and by consumers as the manufacturer of motorcycles and wide variety of goods bearing the INDIAN (Stylized) has been copied.
- “5. The approval of applicant’s trademark INDIANA (Stylized) is based on the false representation that its is the originator, true owner and first user of the trademark, which was merely copied/derived from Opposer’s INDIAN Trademarks and trade name.
- “6. Opposer is the first user of the INDIAN Trademarks and trade name in the United States of America and in numerous countries worldwide. Opposer as rightful owner of Indian trademarks the United States of America and in numerous other countries worldwide will be prejudiced by the unauthorized registration of a confusingly similar mark in the name of the applicant.
- “7. Applicant’s appropriation and use of the confusingly similar trademark Indiana (stylized) infringes upon opposer’s exclusive right to the trade name and registered INDIAN Trademarks, which are well-known trademarks protected under Section 123.1 (e), and 147 and 165 (2) (a) of the Intellectual Property (IP) Code, Article 6bis of the Paris Convention and article of the Agreement of Trade Related Aspects of Intellectual property Rights to which the Philippines and the United States of America adhere.
- “8. The registration of the trademark INDIANA (Stylized) in the name of the applicant is contrary to other provisions of the Intellectual Property (IP) Code and is an unlawful use of Opposer’s trade name under Section 165 of the IP Code.

Opposer relied on the following facts to support its opposition:

- “1. Opposer adopted and has been commercially using the INDIAN Trademarks and trade name for its goods in Class 12, among other, long

before Applicant's unauthorized appropriation of the confusingly similar trademark INDIANA (Stylized).

- "2. Opposer is the first user and registered owner of the INDIAN Trademarks and trade name in the United States of America, and in many other countries worldwide. Opposer has also used, registered and applied for the registration of the INDIAN Trademarks and trade name in many countries worldwide, including the countries listed in Annex 1 hereof.
- "3. Opposer's INDIAN Trademarks are arbitrary trademarks and are entitled to broad legal protection against unauthorized users like Applicant who has appropriated the confusingly similar trademark INDIANA (Stylized) for similar or closely related goods (i.e. motorcycle and scooters" in Class 12).
- "4. Opposer is the first user of the INDIAN Trademarks for the above-mentioned classes of goods. Applicant has appropriated the identical or confusingly similar trademark INDIANAN (Stylized) in bad faith for the obvious purpose of capitalizing upon the renown of Opposer's self-promoting trademarks by misleading the public into believing that its goods originated from, or are licensed or sponsored by Opposer.
- "5. The registration and use of an identical or confusingly similar trademark by the Applicant will tend to deceive and/or confuse purchasers into believing that Applicant's products emanate from or are under the sponsorship of Opposer and will damage Opposer's interest for the following reasons:
 - i.) The Opposer's and Applicant's trademarks are identical or confusingly similar.
 - ii) Applicant's unauthorized appropriation and use of the trademark INDIANA (Stylized) will due the goodwill and reputation of Opposer's Trademarks and tradename among consumers.
 - iii) Applicant intend to use INDIANA (Stylized) on his own products as a self-promoting trademark to gain public acceptability for them through their association with Opposer's popular INDIAN Trademarks and trade from which Applicant's trademark INDIANA (Stylized) has been derived.
 - iv) Applicant's trademark copies the distinctive script font that has been in Opposer's INDIAN trademarks since at least as early as 1910.

Applicant intends to trade Opposer's goodwill.

- "6. Opposer uses the INDIAN Trademarks not only as trademarks but also as its trade name – Indian Motorcycle International, LLC – and therefore, Opposer is protected against the use by others under Article 8 of Paris Convention and Section 165 of the IP Code.
- "7. The registration and use of an identical or confusingly similar trademark by Applicant will diminish the distinctiveness and dilute the good will of Opposer's INDIAN Trademarks.

The Bureau of Legal Affairs issued a Notice to Answer which was duly received by Respondent-Applicant's counsel on March 13, 2007.

Despite receipt of the Notice to Answer, Respondent-Applicant did not file the required Answer, together with the affidavit of its witness and other documents in support of its application, hence the same is considered WAIVED.

Section 11 of the Summary Rules (Office Order No. 79, Series of 2005) provides:

Section 11. Effect of Failure to file an Answer. – In case the Respondent-Applicant fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the Petition or Opposition, the Affidavit of the witnesses and documentary evidence submitted by the Petitioner or Opposer.

The Opposer submitted the following as its evidence.

Annex	Description
Annex "A"	Certification issued by the United States Patent Trademark Office for the trademark "INDIAN" under Registration No. 421,459, registered under Indian Motorcycle International, LCC.
Annex "B"	Morrison Forester Status Report for trademark application for Indian Motorcycle International, LCC as of January 17, 2007.
Annex "C"	Certification of Authentication issued by the United States Philippine Embassy, USPTO for the Trademark INDIAN SPIRIT under Registration No. 3,038,715 in the name of Indian Motorcycle International, LCC.
Annex "E"	Certification of Authentication issued by the United States Philippine Embassy, USPTO for the Trademark INDIAN under Registration No. 2,486,405 in the name of Indian Motorcycle International, LCC
Annex "F"	Certification of Authentication issued by the United States Philippine Embassy, USPTO for the Trademark INDIAN under Registration No. 2,511,305 in the name of Indian Motorcycle International, LCC
Annex "G"	Certification of Authentication issued by the United States Philippine Embassy, USPTO for the Trademark KIWI INDIAN PARTS under Registration No. 2,813,224 in the name of Indian Motorcycle International, LCC
Annex "H"	Certification of Authentication issued by the United States Philippine Embassy, USPTO for the Trademark INDIAN under Registration No. 2,635,537 in the name of Indian Motorcycle International, LCC
Annex "I"	Certificate of Authentication issued by the Singapore Philippine Embassy, Registrar of Trademarks INDIAN WITH CHIEF HEAD DESIGN under No. T95/01895J in the name of Indian Motorcycle International, LCC.
Annex "J"	Certificate of Authentication issued by the

	Singapore Philippine Embassy, Registrar of Trademarks INDIAN WITH CHIEF HEAD DESIGN under No. T04/16750H in the name of Indian Motorcycle International, LCC.
Annex "K"	Certificate of Authentication issued by Republic of South Africa – Philippine Embassy, Registrar of Trademarks Republic of South Africa for the Trademark INDIAN WITH CHIEF HEAD DESIGN in the name of Indian Motorcycle International, LCC.
Annex "L"	Certificate of Authentication issued by Israel - Philippine Embassy, Registrar of Trademarks Tel Aviv, and Israel for the Trademark INDIAN WITH CHIEF HEAD DESIGN in the name of Indian Motorcycle International, LCC.
Annex "M"	Certificate of Authentication issued by Israel - Philippine Embassy, Registrar of Trademarks Tel Aviv, and Israel for the Trademark INDIAN WITH CHIEF HEAD DESIGN in the name of Indian Motorcycle International, LCC.
Annex "N"	Certificate of Authentication issued by New Zealand – Philippine Embassy, Intellectual Property Office of New Zealand for the Trademark INDIAN WITH CHIEF HEAD DESIGN in the name of Indian Motorcycle International, LCC.
Annex "O"	Certificate of Authentication issued by New Zealand – Philippine Embassy, Intellectual Property Office of New Zealand for the Trademark INDIAN WITH CHIEF HEAD DESIGN (Left and Right) in the name of Indian Motorcycle International, LCC.
Annex "P"	Certificate of Authentication issued by New South Wales, Australia – Philippine Embassy, Trademark Office of Australia for the Trademark INDIAN in the name of Indian Motorcycle International, LCC.
Annex "Q"	Certificate of Authentication issued by New South Wales, Australia – Philippine Embassy, Trademark Office of Australia for the Trademark INDIAN WITH CHIEF HEAD DESIGN in the name of Indian Motorcycle International, LCC.
Annex "R"	Certificate of Authentication issued by the United of States Philippine Embassy, and the Department of State of Florida for the commissioned of Marsha Merrell as a Notary Public in the State of Florida.

On the other hand, Respondent-Applicant failed to file the required Answer so with the affidavits of its witnesses and the documents in support of its application subject of the instant opposition.

The issue to be resolved in this particular case is:

WHETHER OR NOT THE RESPONDENT-APPLICANT IS

ENTITLED TO THE REGISTRATION OF THE MARK "INDIANA (STYLIZED)".

The applicable provision of the law is, Section 123 (d) of Republic Act No. 8293, which provides:

Sec. 123. Registrability – 123.1. A mark cannot be registered if it:

- (d) Is identical with a registered mark belonging to a different proprietor or mark with an earlier filing or priority date, in respect of:
 - a. The same goods or services, or
 - b. Closely related goods or services, or
 - c. If it nearly resemble such a mark as to be likely to deceive or cause confusion;

Records will show that the "INDIAN" Motorcycle was originally manufactured in 1901 by the Handle Manufacturing Company which was based in Springfield, Massachusetts. The company was the first United States manufacturer of motorcycles and was the primary supplier to the United States Army of Military Motorcycles for use during World War I and II. (Page 2 of the affidavit of Stephen Heese) the president of Indian International, LCC.

The trademark "INDIAN" of the Opposer was registered in the United States of Patent and Trademark Office on October 5, 1971 bearing Registration No. 921,459 covering the goods motorcycle Class 12 of the international Classification of goods and the alleged first use is October 28, 1968.

Likewise Opposer has registered and applied for the registration of the "INDIAN Trademarks" and the trade name in many other countries worldwide outside the United States of America.

In order to determine whether the Opposer's mark "INDIAN" is confusingly similar to the Respondent-Applicant's mark "INDIANA (Stylized)", the two competing marks are reproduced below for comparison and scrutiny.

An examination of the conflicting marks as presented in their labels show that the only distinction they have is the presence of the letter "A" or the last alphabet in the Respondent-Applicant's mark.

In the case of Societe Des Produits Nestle S.A. et. al. vs. Court of Appeals, et. Al., 356 SCRA 207, the Supreme Court reiterated that:

"The likelihood of confusion is a relative concept, to be determined only according to the particulars, and sometimes peculiar circumstances of each case. In trademarks cases, even more than in any other litigation, precedent must be studied in 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 attendant to an accurate assessment of likelihood of confusion required that the entire panoply of elements consulting the relevant factual landscape be comprehensively gained."

In ascertaining whether one product is confusingly similar to or is a colorable imitation of another, two kinds of test have been developed. The dominancy test applied in *Asia Brewery, Inc., vs. Court of Appeals*, 224 SCRA 437; *Co Tiong vs. Director of Patents*, 95 Phil. 1; *Lim Hao vs. Director of Patents*, 100 Phil. 214; *American Wire and Cable Co., vs. Director of Patents*, 31 SCRA 544; *Philippine Nut Industry, Inc., Standards Brands, Inc.*, 65 SCRA 575; *Converse Rubber Corporation vs. Universal Rubber Products, Inc.*, 147 SCRA 154; and the Holistic Test

developed in *Del Monte Corporation vs. Court of Appeals*, 181 SCRA 410; *Mead Johnson & Co., vs. N.V.J. van Dorp, Ltd.*, 7 SCRA 771; *Bristol Myers Co., vs. Director of Patents*, 17 SCRA 128

As it implies, the test of dominancy focuses on the similarity of the prevalent, essential or dominant features of the competing trademarks, which might cause confusion or deception. On the other side of the spectrum, the holistic test mandates that the entirety of the mark in question must be considered in determining confusing similarity.

In the case at bar, the dominant feature of the Opposer's mark is the "INDIAN" which is exactly the same with the Respondent-Applicant's mark except the last syllable which is the letter "A".

When the two words are pronounced, they are almost exactly the same. The unavoidable circumstances in the fact that, the Opposer's mark "INDIAN" should always come first when it comes to pronunciation before: "INDIANA".

It is unthinkable and truly difficult to understand why, of the million of terms and combination of letters and designs available the Respondent-Applicant had to choose exactly the same dominant feature of the Opposer's mark, if there was no intent to take advantage of the goodwill of the Opposer's mark which was in used during the first World War and the Second World War.

It must be noted that the goods/products covered by the competing trademarks are the same "MOTORCYCLE" and belong to the same class 12 of the International Classification of goods.

In the case *Co Tiong SA vs. Director of Patents, Saw Woo Chiong & Co.*, (G.R. No. 15378, May 24, 1954) the Supreme Court ruled that:

"Differences or variations in details of one trademark and of another are not the legally accepted tests of similarity in the trademarks. The question of infringement of trademarks is to be determined by the test of dominancy. Similarity, size, form and color, while relevant are not conclusive. Duplication or imitation is not necessary, not it is necessary that the infringing label should suggest an effort to imitate. There is infringement of trademark when the use of the mark involved would be likely to cause conclusion or mistake in the public or to deceive purchaser."

In the present case, there is no doubt that the first impression coming in the minds of the public is to the word "INDIAN" which is the dominant feature of the competing marks and the same word easily attracts and catches the eye of the purchasing and it is that very word and none other sticks in the mind when he thinks of "MOTORCYCL".

In the case of the *Philippine Nut Industry, Inc., vs. Standard Brands, Inc.*, (65 SCRA 575) the Supreme Court ruled that:

"There is infringement of trademarks when the use of the mark involved would be likely to cause confusion or mistake in the mind of the public or to deceive purchasers as to the origin or source of the commodity. Whether or not a trademark causes confusion and is likely to deceive the public is a question of fact which is to be resolved by applying the "test of dominancy", meaning, if the competing trademarks contains the main or essential or dominant features of another by reason of which confusion or deception are likely to result, then infringement takes place; that duplication or imitation is not necessary, a similarity in the dominant features of the trademark would be sufficient.

WHEREFORE, viewed in the light of all foregoing, the Bureau of Legal Affairs, finds and so holds that Respondent-Applicant's mark "INDIANA (Stylized)" is confusingly similar to Opposer's mark "INDIAN" and as such, the Opposition is hereby SUSTAINED. Consequently, Application No. 4-2005-005659 filed on June 20, 2005 for the mark "INDIANA (Stylized)" on goods "motorcycle" in class 12 is hereby REJECTED.

Let the filewrapper of the trademark "INDIANA (Stylized)", 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, 27 June 2007

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