



BRIDGESTONE CORPORATION,
Opposer,

-versus-

JIANXIN RUBBER (FUJIAN) CO., LTD.,
Respondent-Applicant.

} **IPC No. 14-2013-00428**
}
} Opposition to:
} Application No.4-2013-501492
} Date filed: 20 June 2013
} **TM: "R-STONE"**
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NOTICE OF DECISION

FEDERIS AND ASSOCIATES
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GREETINGS:

Please be informed that Decision No. 2015 - 28 dated March 12, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, March 12, 2015.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



BRIDGESTONE CORPORATION,

Opposer,

-versus-

JIANXIN RUBBER (FUJIAN) CO., LTD.,

Respondent-Applicant.

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IPC No. 14-2013-00428

Opposition to Trademark

Application No. 4-2013-501492

Date Filed: 20 June 2013

Trademark: **R-STONE**

Decision No. 2015- 28

DECISION

Bridgestone Corporation¹ (Opposer) filed an opposition to Application No. 4-2013-501492. The contested application, filed by Jianxin Rubber (Fujian) Co., Ltd.² ("Respondent-Applicant"), covers the mark "R-STONE" for use on *"inner tubes for pneumatic tires [tyres]; cars; flanges for railway wheel tires [tyres]; freewheels for land vehicles; bicycles; aerial conveyors; luggage trucks; sack-barrows; omnibuses; locomotives; wheels for bicycles, cycles; motorcycles; air vehicles; vehicle wheels; hubs for vehicle wheels; rims for vehicle wheels; automobile tires [tyres]; vehicle wheel tires [tyres]; as far as included in Class 12 and not in other classes"* under Class 12 of the International Classification of Goods³.

The Opposer anchors its opposition on the provisions of paragraphs (d), (e) and (f) of Section 123 of the Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It maintains that it is the first to use and register "BRIDGESTONE" in connection with the design, manufacture and technology of tires. It avers that the very first "BRIDGESTONE" tire was produced on 09 April 1930 by the company Japan "Tabi" Socks Tire Division and then on 01 March 1931, the founder Mr. Shojiro Ishibashi made the division independent and established Bridgestone Tire Co., Ltd. in the City of Kurume, Fukuoka Prefecture. It claims that the ownership and association of the word "STONE" as a distinctive word element of the Opposer's house mark "BRIDGESTONE" was strengthened through the acquisition of Firestone Tire & Rubber together with the mark "FIRESTONE" in 1998. It claims to have consistently ranked as top company in the global tire market.

According to the Opposer, its mark "BRIDGESTONE" is a declared well-known mark in view of the approximately five hundred (500) trademark applications and/or registrations and approximately two hundred forty three (243) domain name

¹ A corporation organized and existing under the laws of Japan with principal office at 10-1 Kyobashi 1-chome, Cho-ku Tokyo, Japan.

² With address of record at Xiawutng Industrial Area, Lingyuan Street Office, Jinjiang City, Fujian, People's Republic of China.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

registrations in numerous countries including the Philippines. Together with its related companies, it owns approximately twenty four (24) trademarks, some of which are for "BRIDGESTONE" and "FIRESTONE" and variations thereof. It alleges that its products are available in its website <http://www.bridgestone.com> and that it has invested enormous resources in advertising and popularizing its "BRIDGESTONE" mark and that the same has been featured and advertised in numerous newspapers and magazines. Also, although it has diversified to include products such as sporting goods, chemical and industrial products and bicycles, its major product remains tires boasting its control of 80% of the original equipment market and 250% of the local tire market in the Philippines. Furthermore, it has opened a one thousand three hundred (1,300) square meter Bridgestone Tire Showroom and service center in Bonifacio Global City and that its products are sold locally through its Philippines representative office and local distributor, Philippines Allied Enterprises Corporation, which also maintains a website <http://www.bridgestonetires.com.ph/about-us/>; and online through Tire Center Philippines and ebay.com.ph.

The Opposer points out that the Respondent-Applicant's mark contains the word "STONE", which has been declared as the prominent element of "BRIDGESTONE" in Decision No. 2008-48. Also, "R-STONE" contains the letter "R" which is also found in the Opposer's mark.

In support of its Opposition, the Opposer submitted the following:⁴

1. certified true copy of Decision No. 2008-48 issued by the Bureau of Legal Affairs (BLA) and the corresponding Entry of Judgment;
2. certified true copy of the Decision No. 2009-106 issued by the BLA;
3. affidavit of Masahiko Yamamoto;
4. database listing as of 14 October 2013 of all of Opposer's trademark registrations for "BRIDGESTONE";
5. database listing as of 14 October 2014 of all of Opposer's trademark registrations for "FIRESTONE"
6. affidavit of Jan Abigail L. Ponce;
7. Special Power of Attorney (SPA) with Certification of Authority;
8. certified true copies of Philippine certificates of trademark registrations under the name of Opposer;
9. certified copy of the Verified Opposition filed in IPC No. 14-2006-00199 entitled "Bridgestone Corporation vs. Richard D. Uy" which was an opposition against the trademark "RIVERSTONE";
10. list of all trademark applications and registrations filed and/or issued for the trademark "FIRESTONE" from many countries around the world;
11. list of all trademark applications and registrations filed and/or issued for the trademark "BRIDGESTONE" from many countries around the world;

⁴ Marked as Exhibits "B" to "TT-2", inclusive.

12. list of all domain names owned by Opposer or related companies which contains the word BRIDGESTONE or BRIDGESTONE derivative domain names;
13. sample certificates of trademark registrations issued for the mark "BRIDGESTONE" in various countries;
14. printouts of various website all demonstrating advertising and promotions of Opposer's BRIDGESTONE trademark;
15. copy of the Affidavit of Use evidencing that Opposer was the first to use the "BRIDGESTONE" trademark in the Philippines;
16. copy of Invoice No. 6B92PHI, 27 September 2006, for 5,250 tires and 1,900 tire tube and flap;
17. copy of Invoice No. 62AXK63, 10 October 2006, for 4,320 tires and 95 tire tube and flap;
18. copy of 6L2137, 11 October 2006, for 1,110 tires and 1,200 tire tube and flap;
19. copy of the representative sample of promotional materials published in Philippine magazines and newspapers;
20. printouts of the Bridgestone search results from www.ebay.ph and www.ebay.com;
21. certified copy of the affidavit of Atty. Jan Abigail Ponce;
22. printout of the company's website;
23. newspaper articles featuring the launching of "BRIDGESTONE" products;
24. certified copy of the affidavit of Mr. Masao Kobayashi;
25. photographs of Opposer's Bridgestone products;
26. copies of some of the registrations issued for "BRIDGESTONE" from different countries;
27. photographs of the Bridgestone Tire Showroom in Fort Bonifacio;
28. Opposer's Annual Reports for the years 2000 to 2005;
29. news reports, articles and magazines relating to Opposer and its "BRIDGESTONE" mark and products;
30. Bridgestone's Corporate Data for the year 2006;
31. photographs of Bridgestone outlets in the Philippines;
32. list of Bridgestone stores in the Philippines;
33. printouts of search results of the www.ebay.ph and www.ebay.com for "Bridgestone";
34. certified copy of the Opposer's certificates of registrations for "BRIDGESTONE" in Class 12;
35. certified copy of a database list of all of the Opposer's "BRIDGESTONE" trademark registrations and applications worldwide;
36. certified copy of the Opposer's certificates of registrations for "FIRESTONE" in Class 12;
37. certified copy of a database list of all of the Opposer's "FIRESTONE" trademark registrations and applications worldwide;

38. printouts of the Decisions in "Bridgestone Corporation vs. Jim Trader" (D2003-0798) and "Bridgestone Corporations vs. Bridgestone Hones" (D2004-0736) issued by the World Intellectual Property Office (WIPO) taken from the latter's website;
39. certificate of recognition of a well-known trademark issued for "BRIDGESTONE" and the Opposer with Registration No. KorChorpor. 75;
40. certificate of recognition of a well-known trademark for "BRIDGESTONE" issued by the Russian Agency for Patents and Trademarks of Russian Federation;
41. printouts of the website pages posted at <http://www.bridgestonetires.com.ph/page/get/23/About>;
42. affidavit of the Affidavit of Mr. Kazuto Maehara;
43. certified true copy of a database list of all of Opposer's "BRIDGESTONE" and "FIRESTONE" registrations in different countries; and
44. Certified true copies of the Opposer's Annual Reports for the years 2010-2012.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 13 December 2013. The Respondent-Applicant did not file an Answer prompting the Hearing Officer to issue Order No. 2014-457 on 07 April 2014 declaring it in default and the case submitted for decision.

The issue to be resolved is whether the trademark application of Respondent-Applicant for the mark "R-STONE" should be allowed registration.

Records reveal that at the time Respondent-Applicant filed an application for registration of the mark "R-STONE" on 17 August 2013, the Opposer has valid and existing registrations of the marks "BRIDGESTONE" and "FIRESTONE" issued as early as 27 June 1988⁵ and 24 March 1966, respectively.

To determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the competing marks are shown hereafter for comparison:

BRIDGESTONE Firestone

Opposer's marks

R-STONE

Respondent-Applicant's mark

⁵ Exhibit "H-3".

The Opposer's mark consistently used the word "STONE" in its marks. The term "stone", although a common English word, is not descriptive or generic vis-à-vis tire products and hence, considered distinctive therefore. Thus, the Respondent-Applicant cannot be allowed to use the same element as the prevalent feature of its own mark. While the preceding words and/or letters are different in the competing marks, this shall not eradicate the probability of confusion and/or deception on the purchasing public. As the Supreme Court held in **Acoje Mining Co., Inc. vs. The Director of Patents**⁶:

"In the language of Justice J. B. L. Reyes, who spoke for the Court in American Wire & Cable Co. v. Director of Patents: 'It is clear from the above-quoted provision that the determinative factor in a contest involving registration of trade mark is not whether the challenging mark would actually cause confusion or deception of the purchasers but whether the use of such mark would likely cause confusion or mistake on the part of the buying public. xxx'"

That the Opposer's marks begin with either the words "FIRE" or "BRIDGE" while that of the Respondent-Applicant's with a mere "R-" is of no consequence. There is the likelihood of the consumers being confused. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.⁷

The likelihood of confusion is underscored by the fact that the competing marks pertain to the same goods, i.e. tires. Thus, it is highly probable that the purchasers would be led to believe that Respondent-Applicant's mark is a mere variation of Opposer's mark. Succinctly, the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. Callman notes two types of confusion. The first is the *confusion of goods* "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the *confusion of business*: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."⁸

⁶ G.R. No. L-28744, 29 April 1971.

⁷ Societe des Produits Nestle, S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁸ Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 1772276, 08 August 2010.

Furthermore, this Bureau has previously sustained the Oppositions for registration of trademarks also appropriating the word "STONE". In Inter Partes Case No. 14-2006-00199 entitled "**Bridgestone Corporation vs. Richard D. Uy**", this Bureau held that:⁹

"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 STONE component. As such, Respondent-Applicant's use and application of RIVERTSONE in connection with tire 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".

This Bureau is consistent when in Inter Partes Case No. 14-2008-00068 entitled "Bridgestone Corporation vs. Shandong Chengsan Tyre Co., Ltd." it sustained the opposition to the registration of the mark "AUSTONE".¹⁰

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.¹¹ Based on the above discussion, Respondent-Applicant's trademark fell short in meeting this function. The latter was given ample opportunity to defend his trademark application but Respondent-Applicant failed to do so.

Accordingly, this Bureau finds and concludes that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1(d) of the IP Code, which provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor with an earlier filing or priority date, with respect to the same or closely related goods or services, or has a near resemblance to such mark as to likely deceive or cause confusion.¹²

⁹ Decision No. 2008-48, 24 March 2008.

¹⁰ Decision No. 2009-106 dated 29 July 2009.

¹¹ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.

¹² Great White Shark Enterprises vs. Danilo M. Caralde, Jr., G.R. No. 192294, 21 November 2012.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-501492 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 12 March 2015.



ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs