

**BRIDGESTONE CORPORATION,**  
*Opposer,*

**-versus-**

**ANDREW ARQUIZA SY,**  
*Respondent-Applicant.*

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**IPC No. 14-2013-00158**  
Opposition to:  
  
Appln. Serial No. 4-2012-012675  
Date Filed: 15 October 2012  
  
**TM: KOBBLEISTONE**

**NOTICE OF DECISION**

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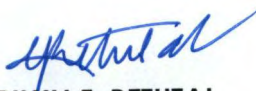
**ANDREW ARQUIZA SY**  
*Respondent- Applicant*  
312-B 10<sup>th</sup> Avenue corner 4<sup>th</sup> Street,  
Brgy. 108, Caloocan City

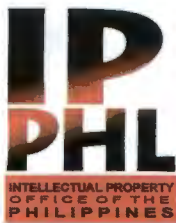
**GREETINGS:**

Please be informed that Decision No. 2017 - 82 dated 17 March 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPPL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 20 March 2017.

  
**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs



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TM: KOBBLEISTONE

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Decision No. 2017- 82

**DECISION**

BRIDGESTONE CORPORATION<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-012675. The application, filed by ANDREW ARQUIZA SY <sup>2</sup> ("Respondent-Applicant"), covers the mark "KOBBLEISTONE" for use on " *motorcycle spare parts, namely, tube, tire, cable, shifter, spokes, chain set (sprocket set), knuckle bearing, battery*" under Class 12 of the International Classification of Goods. <sup>3</sup>

The Opposer alleges, among others, the following:

"a. Opposer is the owner of the registered trademark BRIDGESTONE declared as well-known in Decision No. 2008-48 and Decision 2009-106, which decisions specifically declare the STONE element as protected for exclusive use of Opposer, and thus, no longer allowed to be copied and registered by another, such as in the opposed KOBBLEISTONE for reason of confusing similarity under Sec. 123.1 (d) of the IP Code, notwithstanding even if KOBBLEISTONE is used on goods not related or similar to the goods for which BRIDGESTONE, pursuant to Sec. 123.1 (f).

"b. BRIDGESTONE, including the -STONE element are already identified in the public mind as the mark used on Opposer's popular line of quality tires, and hence, they are therefore, entitled to protection as against the confusingly similar KOBBLEISTONE pursuant to Section 168.1.

"c. BRIDGESTONE is the corporate name of the Opposer and hence, it must be protected as against KOBBLEISTONE under Section 165 of the IP Code."

Opposer's evidence consists of the following:

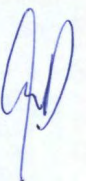
1. Certified copy of Decision No. 2008-48 in IPC No. 14-2006-00199 and the corresponding Entry of Judgment;

<sup>1</sup> A foreign corporation organized and existing under the laws of Japan with principal office at 10-1 Kyobashi 1-Chome, Chuo-ku, Tokyo, Japan.

<sup>2</sup> A Filipino citizen with address at 312-B 10th Ave. Cor. 4th St., Brgy. 108 Caloocan City.

<sup>3</sup>The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

2. Certified copy of Decision No. 2009-106 in IPC No. 14-2008-00068 and the corresponding Entry of Judgment;
3. Affidavit and Special Power of Attorney executed by Kazuto Maehara;
4. Database listing of as of May 24, 2013 of Opposer's trademark registrations for BRIDGESTONE under Class 12;
5. Database listing of as of May 27, 2013 of Opposer's trademark registrations for FIRESTONE in different jurisdictions;
6. Opposer's Annual Report from 2010-2012;
7. Affidavit of Diana Rabanal;
8. Certified copies of Opposer's trademark registrations in the Philippines;
9. Copy of Verified Notice of Opposition filed in IPC No. 14-2006-00199;
10. Certified copy of the Affidavit of Masao Kobayashi in IPC No. 14-2006-00199;
11. Certified copy of the Affidavit of Atty Jan Abigail Ponce;
12. A List of all trademark applications and registrations for the mark FIRESTONE in many countries;
13. A List of all trademark applications and registrations for the mark BRIDGESTONE in many countries;
14. List of all domain names owned by Opposer;
15. Printout of various websites where advertisement or promotions of BRIDGESTONE can be found;
16. Copy of Affidavit of Use;
17. Representative samples of invoices;
18. Copy of representative samples of promotional materials published in the Philippines;
19. Printout of BRIDGESTONE search result from [www.ebay.ph](http://www.ebay.ph) and [www.ebay.com](http://www.ebay.com);
20. Photographs of Opposer's BRIDGESTONE products;
21. Copies of some registrations for BRIDGESTONE issued in other countries;
22. Photographs of BRIDGESTONE showroom in BGC;
23. Copies Annual Report from 2000-2005;
24. News reports, articles and magazines relating to BRIDGESTONE;
25. Bridgestone Corporate Data for 2006;
26. Photographs of Bridgestone outlets in the Philippines;
27. Printout of Opposer's website [www.bridgestone.com](http://www.bridgestone.com);
28. Newspaper articles featuring the launching of Opposer's products;
29. Certified copy of the Affidavit of Mr. Yusuhiro Takeda;
30. Printouts of Decisions in *Bridgestone Corp. v. Jim Trader* (D2003-0798) and *Bridgestone Corp. v. Bridgestone Homes* (D2004-0736) from [www.wipo.org](http://www.wipo.org);
31. Certificate of Recognition of well-known mark issued for Bridgestone under Reg. No. KorChorpor. 75;
32. Certificate of Recognition of well-known mark by Russian Agency for Patents and Trademarks of Russian Federation;





33. Printout of the relevant pages of the website [www.bridgestonetires.com.ph/about-us/](http://www.bridgestonetires.com.ph/about-us/); and
34. Legalized Certificate to prove the authority of Mr. Kazuto Machara.

This Bureau issued on 03 July 2013 a Notice to Answer and served a copy thereof to the Respondent-Applicant on 06 July 2013. Despite receipt of the notice, Respondent-Applicant failed to file the answer. On 17 December 2013, this Bureau issued an order declaring Respondent-Applicant in default. Hence, the case is now deemed submitted for resolution.

Should Respondent-Applicant's mark **KOBBLEISTONE** be allowed registration?

Section 123.1 (d) and (f) of Republic Act No. 8293, otherwise known as the "Intellectual Property Code of the Philippines", as amended, provides for the grounds for registration of a mark, to wit:

**Section 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

(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided further*, That the interests of the owner of the registered mark are likely to be damaged by such use.

Explicit from the afore-cited provision of the IP Code that whenever a mark subject of an application for registration resembles another mark which has been registered or has an earlier filing or priority date, or resembles a well-known mark, said mark cannot be registered.

Records will show that at the time Respondent-Applicant applied for registration of its mark **KOBBLEISTONE** on 15 October 2012, Opposer already obtained a registration for its mark **BRIDGESTONE** in 27 June 1988 for goods under Class 12, which is still registered and continuously used by Opposer up to the present. Opposer also has registered the its **BRIDGESTONE** mark in other classes. Further, Opposer has also registered the mark **FIRESTONE** particularly under Class 12, among others. As such, pursuant to Section 138 of the IP Code, being a holder of a certificate of registration, such "certificate of registration is a prima facie evidence of the registrant's ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto."

But are the marks of the parties confusingly similar as to likely cause confusion, mistake or deception on the part of the buying public?

The marks of the parties are herein reproduced for comparison:

**BRIDGESTONE**

**KOBBLEISTONE**

Opposer's Mark

Respondent-Applicant's Mark

Undernably, the similarity of the competing marks is in the use of the suffix "STONE". Incidentally, this Bureau, in various oppositions filed by Opposer involving its marks BRIDGESTONE and FIRESTONE, has ruled that the distinctive feature of the Opposer's trademarks is the "STONE" component such that the presence of other words attached to the word "stone" is of no moment.

In *Bridgestone Corporation v. Richard D. Uy*<sup>4</sup>, involving the mark RIVERSTONE, this Bureau sustained the opposition and ruled, to wit:

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 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-a-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 R the same goods which passed through the same channels of trade and mark 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.

Again in the case of *Bridgestone Corporation v. Shandong Chengsan Tyre Co., Ltd.*<sup>5</sup>, involving the mark AUSTONE, this Bureau likewise sustained the opposition and disallowed the registration of the mark AUSTONE.

Indeed, confusion cannot be avoided by merely adding, removing or changing the words or 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 purchaser as to cause him to purchase the one supposing it to be

<sup>4</sup> IPC No. 14-2006-00199, promulgated on 24 March 2008

<sup>5</sup> IPC No. 14-2008-00068, promulgated on 29 July 2009



the other<sup>6</sup>. Colorable imitation does not mean such similitude as amounts to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or trade name with that of the other mark or trade name in their over-all presentation or in their essential, substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article<sup>7</sup>.

The determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.<sup>8</sup> The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:<sup>9</sup>

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 belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

In this case, the adoption of Respondent-Applicant of the distinctive feature of Opposer's mark will likely cause confusion, mistake or deception on the part of the public that the into believing that the goods of the Respondent-Applicant originated from or sourced from Opposer or that any perception on the goods of the Respondent-Applicant will be attributed to Opposer as if there is a connection between them. Furthermore, the goods upon which the respective marks of the parties are used, all the more makes confusion possible. It must be noted that Respondent-Applicant's mark is used on "*motorcycle spare parts, namely, tube, tire, cable, shifter, spokes, chain set (sprocket set), knuckle bearing, battery*" under Class 12 while Opposer's mark is used on "*tires and tubes, vehicle wheels, bicycles and their parts, namely shock absorbers, rims and covers for vehicle wheels, inner tubes for vehicle tires, saddles for bicycles, rearview mirrors for bicycles, stands for bicycles, mudguards for bicycles, pedals for bicycles, chains for bicycles, and other goods included in class 12, namely baskets or panniers for bicycles, carriers for bicycles, pumps for bicycles, saddle covers for bicycles, covers for bicycles, safety seats for children for bicycles, windscreen for bicycles, chain cases for bicycles*" under Class 12 also.

Prescinding from the above-findings of this Bureau that the marks of the parties are confusingly similar, the registration of Respondent-Applicant's mark is proscribed under Section 123.1 (d) of the IP Code.

<sup>6</sup> *Societe Des Produits Nestle, S.A v. Court of Appeals*, G.R. No.112012, 4 Apr. 2001, 356 SCRA 207, 217.

<sup>7</sup> *Emerald Garment Manufacturing Corp. v. Court of Appeals*. G.R. No. 100098, 29 Dec. 1995.

<sup>8</sup> *American Wire and Cable Co. v. Director of Patents et al.*, G.R. No. L-26557, 18 Feb. 1970.

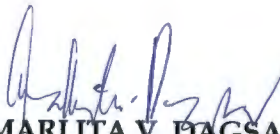
<sup>9</sup> *Converse Rubber Corporation v. Universal Rubber Products, Inc., et al.*, G.R. No. L-27906, 08 Jan. 1987.

The protection of trademarks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trademark is a merchandising shortcut, which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, due aim is the same – to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trademark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.<sup>10</sup>

WHEREFORE, premises considered, the instant Opposition is hereby *SUSTAINED*. Let the filewrapper of Trademark Application No. 4-2012-012675 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 17 MAR 2017.

  
**MARLITA V. DAGOSA**  
Adjudication Officer  
Bureau of Legal Affairs

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<sup>10</sup> *Societe Des Produits Nestle, Et. Al. vs. Court of Appeals. G.R. No. 112012. April 4, 2001*