



BRIDGESTONE CORPORATION,
Opposer,

-versus-

DEESTONE LIMITED,
Respondent-Applicant.

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IPC No. 14-2010-00088
Opposition to:
Application No.4-2008-011665
Date filed: 23 September 2008
TM: “ **DS DEESTONE &
DEVICE**”

X-----X

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2015 - 93 dated May 19, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, May 19, 2015.

For the Director:


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



BRIDGESTONE CORPORATION,
Opposer,

IPC No. 14-2010-00088

-versus-

Opposition to Trademark
Application No. 4-2008-011665
Date Filed: 23 September 2008

DEESTONE LIMITED,
Respondent-Applicant.

Trademark: **DS DEESTONE & DEVICE**

X ----- X

Decision No. 2015- 93

DECISION

Bridgestone Corporation¹ ("Opposer") filed an opposition to Application No. 4-2008-011665. The contested application, filed by Deestone Limited² ("Respondent-Applicant"), covers the mark "DS DEESTONE & DEVICE" for use on "*automobile tyres; motorcycle tyres; bicycle tyres; inner tubes for automobile tyres; inner tubes for motorcycle tyres; inner tubes for bicycle tyres; automobile wheel covers*" under Class 12 of the International Classification of Goods³.

The Opposer alleges that its company is a world-leading tire manufacturer having been manufacturing, selling and distributing tires for almost eighty (80) years. It traces its ownership and right to use the "BRIDGESTONE" marks for more than seventy (70) years prior the filing of the subject application by the Respondent-Applicant. Its first "BRIDGESTONE" tire was produced on 09 April 1930 by the company Japan "Tabi" Socks Tire Division. On 01 March 1931, the founder, Mr. Shojiro Ishibashi, made the division independent and established the Bridgestine Tire Co., Ltd. in the City of Kurume, Fukuoka Prefecture.

The Opposer claims that "DEESTONE" is confusingly similar to "BRIDGESTONE". It claims that its mark is well known by reason of, among others, the long and continuous use of the mark for almost a century and the worldwide registrations and applications thereof. It asserts that it has been declared well-known by this Bureau in the latter's Decision No. 2008-48 resolving IPC Case No. 14-2006-00199. It points out that its mark is also registered in Thailand, the home country of Respondent-Applicant, and that the latter is deemed aware of the existence and goodwill of its mark. In the Philippines, it owns approximately twenty-four (24) registrations for "BRIDGESTONE" and "FIRESTONE" and its products has been featured and advertised in newspapers and magazines. It alleges that locally,

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 84 Soi Sinprasong, Moo 7, Petchksaem Rd., Oamnoi, Krathumban, Samutsakorn, 74130 Thailand.

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.

its company controls about eighty percent (80%) of the original equipment market and fifty percent (50%) of the tire market. It avers that it maintains a showroom and service center in Bonifacio Global City, Taguig and that its products are sold through its Philippine representative in Pasong Tamo, Makati, its local distributor, Philippine Allied Enterprises Corporation, and online at www.tirecenter.om.ph and ebay.

In support of its opposition, the Opposer presented the following:⁴

1. Certified true copy of Decision No. 2008-48 (IPC Case No. 14-2006-00199) issued by the Bureau of Legal Affairs (BLA) and the corresponding Entry of Judgment;
2. Certified true copy of the Decision No. 2009-106 (IPC Case No. 14-2008-00068) issued by the BLA;
3. Affidavit of Amando S. Aumento Jr.;
4. Special Power of Attorney (SPA);
5. Certified true copies of Philippine certificates of trademark registrations for Bridgestone under the name of the Opposer;
6. 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";
7. Certified copy of the Affidavit of Mr. Masao Kobayashi, General Manager of the Philippine Representative Office of Opposer, submitted in IPC Case No. 14-2006-00199;
8. Certified copy of the Affidavit of Atty. Jan Abigail Ponce, an associate of Federis & Associates Law Offices, submitted in IPC Case No. 14-2006-00199;
9. List of all trademark applications and registrations filed and/or issued for the trademark "FIRESTONE" from many countries around the world;
10. List of all trademark applications and registrations filed and/or issued for the trademark "BRIDGESTONE" from many countries around the world;
11. List of all domain names owned by the Opposer or related companies which contains the word BRIDGESTONE or BRIDGESTONE derivative domain names;
12. Printouts of various website all demonstrating advertising and promotions of the Opposer's BRIDGESTONE trademark;
13. Copy of the Affidavit of Use evidencing that the Opposer was the first to use the BRIDGESTONE trademark in the Philippines;
14. Copy of Invoice No. 6B92PHI, 27 September 2006, for 5,250 tires and 1,900 tire tube and flap;
15. Copy of Invoice No. 62AXK63, 10 October 2006, for 4.320 tires and 95 tire tube and flap;
16. Copy of the representative sample of promotional materials published in Philippine magazines and newspapers;

⁴ Marked as Exhibits "A" to "JJ", inclusive.

17. Printouts of the Bridgestone search results from www.ebay.ph and www.ebay.com;
18. Photographs of the Opposer's Bridgestone products;
19. Copies of some of the registrations issued for BRIDGESTONE from different countries;
20. Photographs of the Bridgestone Tire Showroom in Fort Bonifacio;
21. Opposer's Annual Reports for the years 2000 to 2005;
22. News reports, articles and magazines relating to the Opposer and its BRIDGESTONE mark and products;
23. Bridgestone's Corporate Data for the year 2006;
24. Photographs of Bridgestone outlets in the Philippines;
25. List of Bridgestone stored in the Philippines;
26. Printouts of search results of the www.ebay.ph and www.ebay.com for "Bridgestone";
27. Printout of the website www.bridgestone.com;
28. Newspaper articles featuring the launching of Opposer's products;
29. Certified copy of the Affidavit of Mr. Yusuhiro Takeda;
30. Certified true copy of database list of all "BRIDGESTONE" and "FIRESTONE" registrations and applications worldwide;
31. Certified true copies of the "BRIDGESTONE" and "FIRESTONE" registrations in Class 12;
32. Printouts of the Decisions in "Bridgestone Corporation vs. Jim Trader" (D2003-0798) and "Bridgestone Corporation vs. Bridgestone Homes" (D2004-0736) issued by the World Intellectual Property Office (WIPO); and
33. Certificate of Recognition of a well-known trademark for "BRIDGESTONE" and the Opposer with Reg. No. KorChorpor. 75.

The Respondent-Applicant filed its Answer alleging that it is the owner of the marks "DS DEESTONE & DEVICE" and "DEESTONE" and a legitimate corporation established since 1977. According to the Respondent-Applicant, it has built its own goodwill coupled with quality products compliant with quality standards. It also manufactures and sells radial tires for tires, bias tires for agricultural, go-kart, industrial, off-road, passenger car, trailer, truck and bus vehicles, motorcycle tires and bicycle tires in Thailand, Philippines, United States of America (USA), Malaysia, United Arab Emirates (UAE), European Union (EU) countries, South Africa and Indonesia, among others. It claims to have made substantial sales and numerous distributors in the Philippines.

The Respondent-Applicant denies that there is likelihood of confusion. It asserts purchasers of tires are well-discerning and not susceptible to confusion by mere presence of the word "STONE". It emphasizes that it already registered its "DEESTONE" mark under Registration No. 4-2002-008942. It also cites the Thai decision ruling that there can be no likelihood of confusion between "DEESTONE" and "BRIDGESTONE". It alleges that the Opposer is not a real party in interest for

failing to allege that it will be damaged by the registration of "DS DEESTONE & DEVICE." It also maintains that the decisions rendered by his Bureau never declared the Opposer's marks well-known.

The Respondent-Applicant's evidence consists of the affidavit of Ms. Vanlaya and Kornwika Vongsariyavanich, with annexes.⁵ It also filed a Supplemental Answer attaching copies of the decision of the Office of the Intellectual Property of Vietnam.

Subsequently, the Opposer filed a Reply followed by a Rejoinder from the Respondent-Applicant. The Preliminary conference was conducted and thereafter the parties submitted their respective position papers.

Should the mark "DS DEESTONE & DEVICE" be registered?

Records reveal that at the time Respondent-Applicant filed the application for registration of the mark "DS DEESTONE & DEVICE" on 23 September 2008, the Opposer has valid and existing registrations for the marks "BRIDGESTONE" and "FIRESTONE", issued on 27 June 1988 and 24 March 1996, respectively.

The competing marks are shown below for comparison:

BRIDGESTONE

FIRESTONE

Opposer's Trademarks



Respondent-Applicant's Trademark

⁵ Marked as Exhibit "A", inclusive.

The Opposer's mark consistently used the word "STONE" in its marks. The word "stone", although a common English word, is not descriptive or generic in relation to tire or tube products. Together with the word "BRIDGE", which also has no relation to the goods, the mark "BRIDGESTONE" is a highly distinctive and unique mark. Thus, the Respondent-Registrant should not be allowed to register the mark "DEESTONE". While there are words and/or letters that are different in the competing marks, this cannot eradicate the likelihood of confusion and/or deception on the purchasing public. The Supreme Court in **Acoje Mining Co., Inc. vs. The Director of Patents**⁶ held:

"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. x x x'"

That the Opposer's marks begin with either the words "FIRE" or "BRIDGE" while that of the Respondent-Applicant's with the word "DS DEE" 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 purchasers 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 and tubes. 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, It is likely that the consumers will have the impression that these goods or products originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:⁸

"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. Hence, though the goods of the parties are different, the defendant's product is such as might reasonably

⁶ G.R. No. L-28744, 29 April 1971.

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

⁸ Converse Rubber Corporation v. Universal Rubber Products Inc., et al., G.R. No. L-27906, 08 Jan. 1987.

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."

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

"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 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-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 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 in Inter Partes Case No. 14-2008-00068 entitled "Bridgestone Corporation vs. Shandong Chengsan Tyre Co., Ltd." and in Inter Partes Case No. 14-2013-00428 entitled "Bridgestone Corporation vs. Jianxin Rubber (Fujian) Co., Ltd.", wherein it sustained the oppositions to the registration of the marks "AUSTONE" and "R-STONE", respectively.

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 out into the market a superior 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.¹⁰ Based on the foregoing, Respondent-Applicant's trademark fell short in meeting this function.

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

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

¹⁰ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

or closely related goods or services, or has a near resemblance to such mark as to likely deceive or cause confusion.¹¹

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2008-011665 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 May 2015.


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

¹¹ Great White Shark Enterprise vs. Danilo M. Caralde, Jr., G.R. No. 192294, 21 November 2012.