

O-169-19

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 1365624
AND THE REQUEST BY XINGYUAN TIRE GROUP CO. LIMITED
TO PROTECT THE TRADE MARK**

AMBERSTONE

IN CLASS 12

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 411085
BY BRIDGESTONE CORPORATION**


BACKGROUND

1) Xingyuan Tire Group Co. Ltd (hereinafter the applicant), on the basis of its international registration based upon its registration held in China, requested protection in the United Kingdom of the trade mark shown above. Protection was sought for the following goods:

- In Class 12: Inner tubes for vehicles; vehicle tires; treads for vehicles, namely, roller belts; casings for pneumatic tires; treads for retreading tires; pneumatic tires; solid tires for vehicles; automobile tires; adhesive rubber patches for repairing inner tubes; repair outfits for inner tubes.

2) The United Kingdom Trade Marks Registry was published in the usual way in accordance with the Trade Marks (International Registration) Order 2008 (SI 2008/2206 as amended) (“the 2008 Order”).

3) On 15 December 2017 Bridgestone Corporation filed notice of opposition to the conferring of protection on this international registration. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
STONE	EU 13316161	01.10.14 11.02.15	12	Automobiles and their parts and fittings; tires; retreaded tires; two-wheeled motor vehicles and their parts and fittings; bicycles and their parts and fittings; electric bicycles and their parts and fittings; aircrafts and their parts and fittings.
BRIDGESTONE	EU 3574274	08.12.03 15.03.05	12	Vehicles and parts and fittings for vehicles; apparatus for vehicles and tyres; treads for vehicles; brake pads and brake linings; tracks for vehicles; rubber goods for vehicles and tyres; tyres; wheels for vehicles; inner tubes, rims and covers for vehicle wheels; inner tubes for vehicle tyres; repair materials of rubber for tyres and inner tubes; repair outfits for tyres; non-skid apparatus and devices for vehicle tyres; golf carts and golf trolleys; non-metallic hoses for use in hydraulic systems in vehicles; fenders for ships; parts and fittings for all the aforesaid goods.
	M 1105946	International registration date & EU designation: 27.07.11 Office of origin: Japan. Priority date 27.02.11		Automobiles and their parts and fittings; tires for passenger cars; tires for trucks; tires for buses; tires for racing cars; tires for automobiles; retreaded tires for passenger cars; retreaded tires for trucks; retreaded tires for buses; retreaded tires for racing cars; retreaded tires; retreaded tires for automobiles; inner tubes for passenger cars; inner tubes for trucks; inner tubes for buses; inner tubes for racing cars; inner tubes for automobiles; wheels and rims for passenger cars; wheels and rims for trucks; wheels and rims for buses; wheels and rims for racing cars; wheels and rims for automobiles; tread rubber for retreading tires for the above-mentioned vehicles; two-wheeled motor vehicles and their parts and fittings; tires for two-

			<p>wheeled motor vehicles; inner tubes for two-wheeled motor vehicles; wheels and rims for two-wheeled motor vehicles; bicycles and their parts and fittings; tires for bicycles; inner tubes for bicycles; wheels and rims for bicycles; aircraft and their parts and fittings; tires and inner tubes for aircraft; adhesive rubber patches for repairing tubes or tires; tread rubber for retreading tires for two-wheeled motor vehicles or bicycles; tread rubber for retreading tires for aircraft; tread used to retread tires; preformed tire tread; rubber patches for repairing vehicle tread; shock absorbers (for land vehicles); air springs for land vehicles; shaft couplings or connectors (for land vehicles); fenders for vessels (boat side protectors); seat cushions for vehicles; air springs for railway cars; vehicle bumpers; suspension shock absorbers for vehicles; suspension springs for vehicles; four-wheeled go-carts; tricycles for infants; tires for off-the-road vehicles; tires for scrapers; tires for motor graders; tires for shovel loaders; tires for tire rollers; tires for wheeled cranes; tires for cranes; tires for snow plows; tires for pavers; tires for mining machinery. Goods and services limited to: Automobiles and their parts and fittings; tires for passenger cars; tires for trucks; tires for buses; tires for racing cars; tires for automobiles; retreaded tires for passenger cars; retreaded tires for trucks; retreaded tires for buses; retreaded tires for racing cars; retreaded tires; retreaded tires for automobiles; inner tubes for passenger cars; inner tubes for trucks; inner tubes for buses; inner tubes for racing cars; inner tubes for automobiles; wheels and rims for passenger cars; wheels and rims for trucks; wheels and rims for buses; wheels and rims for racing cars; wheels and rims for automobiles; tread rubber for retreading tires for the above-mentioned vehicles; two-wheeled motor vehicles and their parts and fittings; tires for two-wheeled motor vehicles; inner tubes for two-wheeled motor vehicles; wheels and rims for two-wheeled motor vehicles; bicycles and their parts and fittings; tires for bicycles; inner tubes for bicycles; wheels and rims for bicycles; aircraft and their parts and fittings; tires and inner tubes for aircraft; adhesive rubber patches for repairing tubes or tires; tread rubber for retreading tires for two-wheeled motor vehicles or bicycles; tread rubber for retreading tires for aircraft; tread used to retread tires for tires of automobiles, two-wheeled motor vehicles, bicycles, aircrafts and the aforementioned vehicles; preformed tire treads for tires of automobiles, two-wheeled motor vehicles, bicycles, aircrafts and the aforementioned vehicles; rubber patches for repairing the aforementioned vehicle tire tread; shock absorbers (for land vehicles); air springs for land vehicles; shaft couplings or connectors (for land vehicles); fenders for vessels (boat side protectors); seat cushions for vehicles; air springs for railway cars; vehicle bumpers; suspension shock absorbers for vehicles; suspension springs for vehicles; four-wheeled go-carts; tricycles for infants; tires for off-the-road automobiles, two-wheeled motor vehicles and bicycles; tires for scrapers; tires for motor graders; tires for shovel loaders; tires for tire rollers; tires for wheeled cranes; tires for cranes; tires for snow plows; tires for pavers; tires for mining machinery.</p>
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4) The grounds of opposition are, in summary:

a) the mark in suit is similar to the opponent's three earlier marks as all contain the suffix element "stone". There are obvious visual and aural similarities. The word STONE is well understood as a hard solid non-metallic mineral of which rock is made; it would also be seen as alluding to qualities such as strength, reliability, durability and versatility. The goods applied for are similar to those for which the opponent's earlier marks are registered. There is therefore a likelihood of confusion which offends against section 5(2)(b) of the Act.

b) The opponent has reputation in the mark BRIDGESTONE such that use of the mark in suit will take unfair advantage of the distinctive character and repute of the opponent; consumers will assume an economic link between the parties which will affect the economic decisions of consumers causing damage to the opponent. As such the mark in suit offends against section 5(3) of the Act.

c) The opponent has used its BRIDGESTONE mark in the UK and EU since 1976 and has considerable reputation and goodwill in its mark such that use of the mark in suit will cause a misrepresentation which will cause the opponent damage. As such the mark in suit offends against section 5(4)(a).

5) The applicant filed a counterstatement on 9 March 2018. The applicant basically denies all the grounds. It put the opponent to proof of use of its marks in relation to specific goods as follows:

- EU 13316161 STONE: Full specification.
- EU 3574274 & M 1105946: BRIDGESTONE: All goods in class 12 except tyres.

6) Both parties filed evidence in these proceedings and both ask for an award of costs. Neither party wished to be heard, although the opponent filed written submissions which will be referred to as and when necessary.

OPPONENT'S EVIDENCE

7) The opponent filed a witness statement, dated 14 May 2018, by Michinobu Matsumoto the general manager of the Intellectual Property Department of the opponent, a position he has held since 2017, having worked for the opponent since at least 2010. He provides a great deal of detail regarding the use of the BRIDGESTONE mark in relation to tyres, despite the applicant effectively accepting that the mark has goodwill in respect of tyres for a wide range of vehicles in the UK and EU. The company (as of 2017) enjoys, in the UK, a 13% share of the market for car tyres, 22% of

the truck tyre market and 50% of the market for off-road tyres. The tyres are sold throughout the UK. In the UK it sold almost 3million tyres in 2017, and a further 36 Million in the EU. Both the stylised version and the plain capitals version of the word BRIDGESTONE are used in its marketing. The company also owns the FIRESTONE brand and some use of this mark on car tyres has been shown in the UK in 2018. It also provides a re-treading service under the mark BANDAG. The company also sells bicycles and bicycle tyres under the BRIDGESTONE mark in the UK. The company has carried out extensive advertising of its tyres in the UK and has also received considerable attention from the UK press. It is clear that the company has considerable goodwill and reputation for its BRIDGESTONE tyres in the UK and EU.

APPLICANT'S EVIDENCE

8) The applicant filed a witness statement, dated 18 July 2018, by Timothy Paul Cadman, the applicant's Trade Mark Attorney. He contends that in a number of continental countries the marks of the two parties co-exist, and also that an opposition based on the same marks failed in France and China. He states that the applicant has applied to have the opponent's mark EU 13316161 declared invalid at OHIM. None of the above assists my decision.

OPPONENT'S EVIDENCE IN REPLY

9) The opponent filed a witness statement, dated 14 September 2018, by Mr Matsumoto who has provided evidence earlier in this case. He states that in 1988 his company purchased the FIRESTONE tyre business. It is clear from his evidence that FIRESTONE car tyres are sold throughout the UK and that in 2017 the brand enjoyed a 10% market-share of the UK car tyre market [I note this is lower than the claim made in paragraph 7 above]. The FIRESTONE brand has been advertised in various ways and has achieved UK press coverage as well as social media mentions. Mr Matsumoto challenges the assertion by the applicant that the two marks co-exist pointing out that "there is no evidence provided to indicate the consumer's actual perception based on exposure in the marketplace to the two brands side by side". He also points out that his company has won against the applicant's mark in the Philippines and Mexico. He contends that the use in his company's marks of the suffix "STONE" is likely to cause the consumer to make a link between the two parties goods.

10) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

11) I shall first consider the ground of opposition under section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because -

- (a)
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

12) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

13) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The applicant has requested that all three marks provide proof of use for the goods for which they are registered excluding tyres in the case of 3574274 & 1105946. Section 6A reads:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

14) Two of the marks (3574274 & 1105946) are clearly subject to the proof of use requirements, whilst mark 13316161 is not. However, whilst the applicant accepts that the opponent’s mark EU 13316161 has been registered for less than five years, it contends the opponent should be required to provide proof of use as:

“5. Prima facie EU 13316161 is less than five years old and, as such, no proof of use is required. However, the Opponent is also the proprietor of EU006912711, a copy of which is enclosed with this counterstatement. EU006912711 is also an EU registration of the plain word STONE. This registration was filed on 14 May 2008, registered on 14 January 2009, and covers the following goods in class 12: *“Vehicle parts, namely, shock absorbers: tires: wheels for vehicles; inner tubes, rims and covers for vehicle wheels; inner tubes for vehicle tires: bicycles; ports and fittings for all the aforesaid goods.”* That is, the Opponent has an earlier EU registration of the identical trade mark in class 12 that covers at least some goods identical to those covered by the later registration.

6. In Case R 1785/2008-4 of the fourth Board of Appeal of the EurPO, [Anja Holzapfel v, Jose Domingo Lopez-Palacios Gonzalez] found that if a re-filing of an earlier identical trade mark registration is relied on in an opposition and is for identical goods and/or services to the earlier registration then the re-filing should be treated simply as an extension of the earlier right in relation to those goods and/or services, In that situation it is necessary for the owner of the re-filing to provide proof of use if the earlier registration is more than five years old, even if the re-filing is less than five years old.”

15) I have a degree of sympathy with the views expressed as refiling marks every five years is potentially an abuse of the system and designed to undermine the proof of use requirements. However, in the instant case the mark is registered at the EUIPO and an invalidity action has not yet succeeded to the registration of 13316161. As such the mark is deemed to be validly registered and the normal rules apply to the proof of use requirements. In the instant case the opponent does not have to provide proof of use for its mark 13316161 and can rely upon the whole specification for which it is registered. Although not required to provide proof of use upon tyres for its other two marks, this is the only evidence that has been provided. The opponent can only rely upon “tyres for vehicles” in respect of its marks 3574274 & 1105946.

16) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

17) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

18) The products of both parties are effectively tyres. The average consumer will be the general public, including businesses. Such goods are generally sold through retail outlets such as garages and tyre depots, as well as on-line, although I must also consider the purchasing of tyres by vehicle manufacturers who will probably deal with a salesperson. The initial choice will be mainly visual from advertisements in newspapers, magazines and on-line, however there will also be a discussion in the depot/garage. Considered overall, the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. Turning now to the level of attention the average consumer will play when selecting the goods. The goods are likely to be chosen after some research as the size, aspect ratio and speed rating all have to be correct for the particular vehicle. Often consumers will follow the vehicle manufacturers recommendation with regard to make. Other consumers will read comparison tests regarding performance of tyres in wet/dry conditions, braking/cornering ability, comfort and durability. Given that the tyres are the only point of contact between the vehicle and the road they **are usually chosen with at least a medium degree of attention.**

Comparison of goods

19) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

20) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

21) The goods and services to be compared are as follows:

Applicant's specification	Opponent's specification
In Class 12: Inner tubes for vehicles; vehicle tires; treads for vehicles, namely, roller belts; casings for pneumatic tires; treads for retreading tires; pneumatic tires; solid tires for vehicles; automobile tires; adhesive rubber patches for repairing inner tubes; repair outfits for inner tubes.	EU 3574274 & M 1105946: Tyres for vehicles. EU13316161: Automobiles and their parts and fittings; tires; retreaded tires; two-wheeled motor vehicles and their parts and fittings; bicycles and their parts and fittings; electric bicycles and their parts and fittings; aircrafts and their parts and fittings. Automobiles and their parts and fittings; tires; retreaded tires; two-wheeled motor vehicles and their parts and fittings; bicycles and their parts and fittings; electric bicycles and their parts and fittings; aircrafts and their parts and fittings.

22) All three of the opponent's marks have the specification of tyres which would encompass the bulk of the applicant's goods (vehicle tires; treads for vehicles, namely, roller belts; casings for pneumatic tires; treads for retreading tires; pneumatic tires; solid tires for vehicles; automobile

tires;) the balance (Inner tubes for vehicles; adhesive rubber patches for repairing inner tubes; repair outfits for inner tubes) would be regarded as being highly similar. **The goods of the two parties are therefore identical or at least highly similar.**

Comparison of trade marks

23) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

24) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

Opponent's trade marks		Applicant's trade mark
EU 13316161	STONE	<i>AMBERSTONE</i>
EU 3574274	BRIDGESTONE	
M1105946	<i>BRIDGESTONE</i>	

25) The opponent contends:

“29. Firstly, the Applicant's mark is visually similar to the Opponent's earlier marks because ***AMBERSTONE*** contains the suffix element " ... STONE" which is identical to the suffix element contained in the Opponent's EU and International registrations BRIDGESTONE and ***BRIDGESTONE***. The suffix element " ... STONE" is identical to Applicant's STONE registration and the Opponent's mark is consequently contained in the Applicant's mark in its entirety. ***AMBERSTONE*** and BRIDGESTONE / ***BRIDGESTONE*** are of similar lengths, with the mark applied for being composed of ten (10) Latin characters and the Opponent's

marks being composed of eleven (11) Latin characters. The marks further coincide in eight (8) out of ten/eleven (10/11) characters respectively as both contain the Latin characters B, R, E, S, T, O, N and are separated only by the additional characters A and M in **AMBERSTONE** and I, D and G in **BRIDGESTONE/BRIDGESTONE**. Furthermore, **BRIDGESTONE** and **AMBERSTONE** are both presented in a similar black, bold and italicised typeface.

30. In view of the coincidence of the identical element "STONE", the marks in question also share a high degree of phonetic similarity. The respective marks would be pronounced as "BRIDGE-STONE", "STONE" and "AM-BER-STONE".

31. The marks in question are conceptually similar as they all contain the word element "STONE" and "AMBERSTONE" and "BRIDGESTONE" both evoke the image of objects which are made of STONE. The word "STONE" would be understood by the relevant public as referring to a hard solid non-metallic mineral of which rock is made. "AMBER" is a hard transparent substance which forms over millions of years and is fossilized from tree resin and in the UK can also be understood as referring to the warm orange-yellow coloured traffic light that indicates to drivers that lights are about to change. Accordingly the element "AMBER" could be seen both as a reference to a colour which would describe and be subordinate to the second element of the mark "STONE" and also as a reference to a material similar to "STONE". As such, and particularly since its use is unusual in connection with the goods in question (which are not made of stone) the element "STONE" is the prominent part of the Applicant's mark and conceptually the impression created by both marks is accordingly highly similar and would form the basis confusion between the marks.

32. The Applicant states in its Counterstatement that the relevant public "would no longer" have an understanding of the word STONE as referring to a mineral from which rock is made when used as a suffix on the basis that "there are many words in the English language ending with the suffix "stone" that do not directly relate to rock ... ". However, it is submitted that this is incorrect and that the relevant public would still understand the connotations of the word STONE in the respective marks. Furthermore, the examples provided by the Applicant, including but not limited to the English words "hailstone", "milestone" and phrase "rolling stone", are indeed intimately connected with the concept of stone or rock. For example, "hailstone" is derived from the Old English *hagolstan* or *hay/estone* which is from the Proto-Germanic *hag/astainaz*, equivalent to hail + stone. A "milestone" is one of a series of markers placed alongside roads at intervals of usually one mile and historically were made of stone materials. The phrase "rolling stone" is etymologically derived from the common

proverb "a rolling stone gathers no moss" which literally refers to a stone which is moving and can also refer to a geological phenomenon which involves rocks moving without human or animal intervention. Even the place names cited by the Applicant do not contradict the Opponent's arguments as many of these names are merely a combination of the word STONE as defined above with another element, e.g. Maidstone evolved from *de maeides stana* and *maegdan stane* meaning "stone of the maidens" or "stone of the people".

33. As set out in the case law cited above, in making a comparison of the marks in question the marks should be compared as a whole. However as indicated in the reasoning of the Decision in *Median*, determining the overall impression created by a mark may involve assessing whether the marks comprise any dominant components. In reaching that conclusion it is appropriate to consider whether any of the elements of a complex mark are descriptive or non-distinctive in relation to the goods (which would diminish their importance in the overall impression created by the mark). It is also the case following the reasoning in the *Selenium-Ace* decision (and those in many other previous cases) that, in marks comprised of verbal and figurative elements, verbal elements will create a stronger impression because consumers would tend to focus on the verbal parts of marks when referring to them rather than their figurative components. Finally it is importantly the case, going back to the reasoning of the *Medion* Decision, that even where an earlier mark of normal distinctiveness is used as part of a complex mark does not dominate that mark but plays an "independent distinctive role" in the impression created by that mark, the similarity between the marks may be sufficient for confusion to arise. Clearly the Applicant's mark comprises the word STONE and we submit that in applying these principles from established case law in the instant case, the overall impression created by the mark is dominated by this verbal element and it clearly plays an independent distinctive role in the impression created by the Applicant's mark."

26) In making the comparison I will take into account the views expressed in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

"81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division

and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

27) Although I also note that in *Bristol Global Co Ltd v EUIPO*, T-194/14, the General Court held that there was a likelihood of confusion between AEROSTONE (slightly stylised) and STONE if both marks were used by different undertakings in relation to identical goods (land vehicles and automobile tyres). This was despite the fact that the beginnings of the marks were different. The common element – STONE – was sufficient to create the necessary degree of similarity between the marks as wholes for the opposition before the EUIPO to succeed.

28) I also take account of *The Picasso Estate v OHIM*, Case C-361/04 P, where the Court of Justice of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

29) Conversely in *Nokia Oyj v OHIM*, Case T-460/07, the General Court stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

30) I also note that in *Usinor SA v OHIM*, Case T-189/05, the General Court found that:

“62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).

63. In the present case, the Board of Appeal correctly found that the signs at issue have a common prefix, ‘galva’, which evokes the technique of galvanisation, that is, the act of fixing an electrolytic layer to a metal to protect it from oxidation.

64. By contrast, the Board of Appeal incorrectly took the view that a conceptual comparison of the second part of the signs was not possible, because the suffixes ‘llia’ and ‘lloy’ were meaningless.

65. That conclusion is based on an artificial division of the signs at issue, which fails to have regard to the overall perception of those signs. As stated in paragraph 59 above, the relevant public, which is French-speaking but has knowledge of the English language, will recognise in the mark applied for the presence of the English word ‘alloy’, corresponding to ‘alliage’ in French, even if the first letter of that word (‘a’) has merged with the last letter of the prefix ‘galva’, according to the usual process of haplology. That mark will therefore be perceived as referring to the concepts of galvanisation and alloy.

66. As far as the earlier mark is concerned, the suffix ‘allia’ is combined with the prefix ‘galva’ in the same way. The evocative force of the suffix ‘allia’ will enable the relevant public – on account of its knowledge and experience – to understand that that is a reference to the word ‘alliage’. That process of identification is facilitated still further by the association of the idea of ‘alliage’ (alloy) with that of galvanisation, the suffix ‘allia’ being attached to the prefix ‘galva’.

67. By breaking down the signs at issue, the relevant public will therefore interpret both signs as referring to the concepts of galvanisation and alloy.

68. Consequently, the conclusion to be drawn is, as the applicant correctly maintains, that the signs at issue are conceptually very similar, inasmuch as they both evoke the idea of

galvanisation and of an alloy of metals, although that idea is conveyed more directly by the mark applied for than by the earlier mark”.

31) I shall first compare the opponent’s mark EU 13316161 STONE to the mark in suit. Clearly, the opponent’s mark is wholly contained within the mark in suit. However, it appears as the second part of the mark and is preceded by the word AMBER. There are therefore clear visual and aural similarities and differences. The opponent’s mark consists of a well-known English word which has a number of meanings. It can either mean a hard, solid non-metallic mineral matter of which rock is made; a hard seed found in a cherry, plum or peach for example or a unit of weight equal to 14 lbs. None of which has any meaning in relation to tyres. Back in the depths of history wheels were made of stone, but it is most likely that the average consumer will assume that the word alludes to the tyre being hard or durable. To my mind, the mark in suit does not have two independent words as I believe that the term “AMBER” forms a unit with the word “STONE” and affects the way the second word is perceived. Whilst Amber is technically resin, when used in jewellery it is commonly called a gemstone, and amber stones are used in bracelets, rings etc. It is well known that amber is not formed by pressure in the way that precious stones such as diamonds are and it is, relatively speaking, very soft and easily crafted. Such a meaning has absolutely no meaning in relation to tyres. **To my mind, the visual, aural and conceptual differences far outweigh any visual or aural similarities. The marks are similar to a low degree.**

32) I next turn to consider the opponent’s marks EU 3574274 & M1105946 to the mark in suit. The opponent’s marks consist of the same word BRIDGESTONE, the only difference being the slight stylisation (particularly on the first letter “B” of the International mark). Whilst the word “BRIDGESTONE” will be recognised as comprising two words “BRIDGE” and “STONE” I do not accept that the word “STONE” is the dominant element or even an independent element. I believe that the first word “BRIDGE” forms a unit with the word “STONE” and that most consumers will conjure up an image of a bridge built of stone or perhaps even the keystone of a bridge. Given the way that the mark in suit will be viewed (see previous paragraph), whilst there are undoubtedly visual and aural similarities **there are considerable visual and aural differences as well as considerable conceptual differences which to my mind far outweigh the similarities. The marks are similar to a low degree.**

Distinctive character of the earlier trade mark

33) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

34) The opponent’s marks have no meaning for the goods in question (tyres). As I stated earlier in this decision, the word STONE is a dictionary term and a well-known word. The word BRIDGESTONE is not a dictionary word but it consists of two well-known English words. The average consumer will consider the opponent’s marks to be allusive in respect of the tyres being durable, and so both marks must be regarded as **inherently distinctive to at least a medium degree**. The opponent has shown considerable use of its mark BRIDGESTONE in the UK where it enjoys a considerable market share in regard to tyres, and **so can benefit from enhanced distinctiveness. It has shown no use of the mark STONE and so it cannot benefit from enhanced distinctiveness.**

Likelihood of confusion

35) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the

opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods is a member of the general public including businesses who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay at least a medium degree of attention to the selection of said goods.
- the marks of the two parties have a low degree of similarity.
- the opponent's marks both have a medium level of inherent distinctiveness, only marks EU 3574274 & M1105946 can benefit from an enhanced distinctiveness through use.
- the goods of the two parties are identical or at least highly similar.

36) It is necessary to consider the likelihood of both direct and indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

37) I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

38) In its written submissions the opponent contended that:

“53. As such, it is the case that, where marks comprise the same elements such that consumers may perceive there to be a not completely direct but related commercial connection between the origin of the goods in question, there may be indirect confusion or association. This may arise in an instance where a consumer might consider there to be some licensing, co-operation, cobranding or endorsement of the product by an earlier trade mark owner. We submit that the shared STONE element in the parties' marks is a particularly persuasive cause for indirect confusion because the element is highly distinctive in relation to the goods. In this regard it is appropriate to refer to all relevant circumstances in assessing a likelihood of confusion and while it is not a party to the proceedings we refer to the Opponent's affiliate in the Bridgestone Group, Bridgestone Licensing Services LLC, and its use of the FIRESTONE tyre brand which is used extensively In the UK and well-known by UK consumers (as stated in the Second Witness Statement of Michinobu Matsumoto outlining information on this activity and the level of market share enjoyed by the mark attesting to its notoriety and well-known connection to the BRIDGESTONE mark). Consumers will therefore clearly be aware of the fact another well-known "STONE" suffix tyre brand mark is associated with the Opponent and this will serve to increase the likelihood of indirect confusion with the Applicant's mark.

54. There is some interdependence between the relevant factors, including the similarity of the respective trade marks and goods or services. According to established case law, a lesser degree of similarity between goods or services may be offset by a greater degree of similarity between the marks, and vice versa. It is submitted that in this case, the greater degree of similarity between the goods covered by the respective marks is a relevant factor and that this should be taken into account for the purposes of assessing whether there is a likelihood of confusion.”

39) The opponent is therefore seeking to run a “family of marks” contention despite not entering the “FIRESTONE” mark it now relies upon into pleadings. If considered on just the marks pleaded this case does not get past the first hurdle as it has shown no use of the “STONE” mark merely use of the “BRIDGESTONE” mark albeit in two versions, in plain capitals and in a slightly stylised font; and one mark does not a family make. I accept that the evidence does show use of the “FIRESTONE” mark and so despite this mark not being pleaded I shall for the sake of completeness consider this submission. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66. It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to ‘marks in a series’.”

40) The opponent has not provided any evidence which shows that the average consumer in the UK would see the marks “BRIDGESTONE” and FIRESTONE” and regard the presence of the word “STONE” as identifying them as a family of marks. As I have said earlier in this decision I

regard the presence of the word “BRIDGE” to have a qualifying effect on the word “STONE” and I believe the true is same of the word “FIRE”. I believe that the average UK consumer will immediately conjure an image of volcanic rocks and believe this to be allusive to the durability of the goods. Earlier in the decision I determined that the goods in question would be chosen with at least a medium degree of care by the average consumer given the need to ensure that the tyres were correct for their particular vehicle. In view of all of the above, and allowing for the concept of imperfect recollection there is no likelihood of consumers being confused, directly or indirectly, into believing that the all the goods applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore fails in respect of all the goods applied for by the applicant.**

41) I next turn to the ground of opposition under section 5(3) which reads:

“5. (3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

42) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the

goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

43) The first hurdle is the issue of reputation as set out at points (a) and (b) above. The onus is upon the opponent to prove that its trade marks enjoy a reputation or public recognition. Earlier in this decision I accepted that the opponent did have a reputation for tyres under its BRIDGESTONE marks (both plain capitals and in the stylised form).

44) I next have to consider whether the public will make a link. In Case C-408/01, *Adidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

45) The level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser

degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

46) In C-252/07 *Intel Corp* [2008] ECR I-8823 at paragraph 42 the court set out the factors used to assess a link. Those factors include:

the degree of similarity between the conflicting marks;

the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

the strength of the earlier mark’s reputation;

the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;

the existence of the likelihood of confusion on the part of the public.

47) Earlier in this decision I found that the opponent’s BRIDGESTONE marks are similar only to a low degree to the mark sought to be registered by the applicant. I also found that the opponent’s goods were identical to the goods of the applicant. The opponent has not shown that the average consumer regards the word STONE as independent or distinctive, I have stated my view that the use of a prefix “BRIDGE” will qualify the suffix “STONE” in the minds of most consumers such that it becomes secondary and an image is formed of a bridge albeit made of stone. To my mind, despite the fact that the users and goods are the same and the opponent’s reputation, if a member of the public saw the applicant’s mark they would not immediately make the link to the opponent.

The ground of opposition under section 5(3) fails.

48) The last ground of opposition is under section 5(4)(a) which reads:

“5.(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

49) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

50) Whilst Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

51) The opponent is relying upon its signs BRIDGESTONE and ***BRIDGESTONE*** which have been used in relation to tyres in the UK. Earlier in this decision I found that use of the mark in suit, actual or on a fair and notional basis, would not result in confusion with the opponent’s marks EU 3574274 BRIDGESTONE and M1105946 ***BRIDGESTONE***. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. **The opposition under Section 5(4)(a) of the Act must fail.**

COSTS

52) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Considering the other sides evidence	£550
Providing submissions	£800
TOTAL	£1,650

53) I order Bridgestone Corporation to pay Xingyuan Tire Group Co. Ltd the sum of £1,650. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 2 April 2019

**George W Salthouse
For the Registrar,
the Comptroller-General**