

**O/235/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3277374 BY  
YANTAI MEFINE MACHINE CO., LTD  
TO REGISTER:**

**PANSTONE**

**AS A TRADE MARK IN CLASS 12**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 411921 BY  
BRIDGESTONE CORPORATION**

## Background and pleadings

1. Yantai Mefine Machine Co., Ltd (“the applicant”) applied to register the following trade mark in the United Kingdom on 15 December 2017:

# PANSTONE

It was accepted and published in the Trade Marks Journal on 12 January 2018 in respect of the following goods and services:

### Class 12

*Brake pads for automobiles; Shock absorbing springs for vehicles; Non-skid devices for vehicle tires [tyres]; Brakes for vehicles; Brake shoes for vehicles; Brake segments for vehicles; Brake discs for vehicles; Upholstery for vehicles; Non-skid devices for vehicle tires; Non-skid devices for vehicle tyres; Brake linings for vehicles; Suspension shock absorbers for vehicles.*

2. The application was opposed by Bridgestone Corporation (“the opponent”). The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opposition concerns all goods in the application.
3. The opponent is relying upon the following Trade Marks:

<b>Marks</b>	<b>Goods on which the opponent is relying</b>
EUTM 13316161 (“the 161 mark”)  STONE  Filing date: 1 October 2014 Registration date: 11 February 2015	<u>Class 12</u> <i>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.</i>

Marks	Goods on which the opponent is relying
<p>IR 1105946 (“the 946 mark”)</p>  <p>Priority date: 23 February 2011 Date of designation of the EU: 27 July 2011 Date protection granted in the EU: 4 January 2013</p>	<p><u>Class 12</u></p> <p><i>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; tread rubber for retreading tires for the above-mentioned vehicles; tires for two-wheeled motor vehicles; inner tubes for two-wheeled motor vehicles; adhesive rubber patches for repairing tubes or tires; tread rubber for retreading tires for two-wheeled motor vehicles or bicycles; preformed tire treads for tires of automobiles; 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); suspension shock absorbers for vehicles; suspension springs for vehicles.</i></p>
<p>EUTM 3574274 (“the 274 mark”)</p> <p>BRIDGESTONE</p> <p>Filing date: 8 December 2003 Registration date: 15 March 2005</p>	<p><u>Class 12</u></p> <p><i>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</i></p>

<b>Marks</b>	<b>Goods on which the opponent is relying</b>
	<i>vehicle wheels; inner tubes 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.</i>

4. The opponent claims that the marks are similar and that the goods covered by the applicant's specification are the same as, or similar or complementary to, goods covered by the earlier marks, leading to a likelihood of confusion on the part of the public. Therefore, registration of the contested mark should be refused under section 5(2)(b) of the Act.
  
5. Additionally, or alternatively, the opponent claims that use of the applicant's mark for all the goods of the application would take unfair advantage of the reputation of the 946 and 274 marks and cause detriment to the distinctive character of those marks. It claims that dilution of the distinctive character of the earlier mark will alter the perception of the mark and have an impact on the economic behaviour of the relevant public. Therefore, registration of the contested mark should be refused under section 5(3) of the Act.
  
6. The applicant filed a defence and counterstatement, denying all the grounds. It contended that there is no likelihood of confusion between its mark and the opponent's earlier marks, and that use of its mark would not take advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks. It did not request that the opponent provide evidence of proof of use of the 946 and 274 marks for the goods on which the opponent is relying.
  
7. Both the opponent and the applicant filed evidence in these proceedings. This will be summarised to the extent that I consider necessary.

8. The opponent and applicant also filed written submissions in lieu of a hearing, on 28 December 2018 and 27 December 2018 respectively. These will not be summarised but will be referred to as and where appropriate during this decision, which has been taken following a careful perusal of the papers.
9. In these proceedings, the opponent is represented by Marks & Clerk LLP and the applicant by The Trade Marks Bureau.

### **Relevant date**

10. The relevant date for the purposes of sections 5(2)(b) and 5(3) is the date the application was filed: 15 December 2017.

### **Evidence**

#### *Opponent's evidence-in-chief*

11. The opponent's evidence-in-chief comes from Michinobu Matsumoto, General Manager of Intellectual Property Department 2 of Bridgestone Corporation. It is dated 2 July 2018.
12. Bridgestone Tyre Co., Ltd was founded in 1931 by Shojiro Ishibashi in Fukuoka Prefecture in Japan. It was renamed Bridgestone Corporation in 1984. The name is an English translation of the founder's surname: in Japanese, "ishi" means "stone" and "bashi" "bridge".<sup>1</sup> Mr Matsumoto states that the opponent is the world's largest manufacturer of tyre and rubber products, and that it is estimated that approximately 1 in 5 vehicles around the world are fitted with its tyres. The firm employs over 140,000 people worldwide and has a business presence in over 150 countries. The company entered Europe in 1972, opening a branch in Belgium.
13. Exhibit 3 contains sales figures for Bridgestone-branded tyre products in the EU and UK by numbers of units sold:

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<sup>1</sup> Exhibit 1.

<b>Year</b>	<b>Units sold in EU</b>	<b>Units sold in UK</b>
2013	Over 32 million	Over 2.8 million
2014	Over 32 million	Over 2.6 million
2015	Over 34 million	Over 2.7 million
2016	Over 35 million	Over 2.8 million
2017	Over 36 million	Over 2.9 million

14. Mr Matsumoto states that it is estimated that market share in the UK for car tyres has grown from 11% to 13% between 2013 and 2017, while for truck tyres and off the road (OTR) tyres it has grown from 19% to 22% and 44% to 50% respectively over the same period. These estimates are derived from the company's market intelligence and data on the size of the tyre market in the UK.
15. The opponent's products are sold in the UK, and EU as a whole, through third party distributors, including vehicle repair and servicing outlets such as Kwik Fit and retailers such as Halfords, and by car manufacturers who have the opponent's tyres fitted to their new cars. Exhibit 5 is an extract from the opponent's website that lists all the towns and cities in the UK where Bridgestone tyres can be bought. This list is 16 pages long and was printed on 22 January 2018.
16. Exhibit 9 contains UK and EU marketing and advertising expenditure for all BRIDGESTONE branded products:

<b>Year</b>	<b>UK Spend (€ '000)</b>	<b>Rest of EU Spend (€ '000)</b>	<b>Total EU Spend (€ '000)</b>
2012	3,500	40,550	44,050
2013	3,250	42,850	46,100
2014	4,750	64,050	68,800
2015	5,750	56,450	62,200
2016	5,250	87,900	93,150
2017	6,000	75,600	81,600

The opponent appeared at several motor shows at Paris, Frankfurt and Geneva between 2011 and 2016.<sup>2</sup> The company has also sponsored sporting events and athletes, for example Formula One (between 1997 and 2010), FIS Alpine Ski World Cup and motorcycle riders, and is an official International Olympic Committee Partner through to the 2024 Games.<sup>3</sup> Its sponsorship activities, along with company results and plans, feature in a collection of articles from UK national media provided in Exhibit 10. Sources include the BBC News and Sport websites, the Sky News website, *Daily Mail*, *Daily Telegraph*, *Daily Express*, *The Guardian*, and *Which?*.

17. Mr Matsumoto states that:

“My Company is particularly known for its commitment to innovation and new technology in its field”.

Examples of the company’s innovations include run-flat technology, retread technology, more fuel-efficient tyres, and “air free” bicycle tyres.<sup>4</sup> A retread service is provided in the UK by Bandag. Its 2017 product brochure makes clear that Bandag is part of the Bridgestone Group.<sup>5</sup>

18. Bridgestone has received awards in Germany, Poland, and the UK, including the (UK) National Tyre Distributors Association’s Tyre Manufacturer of the Year Award in 2015 and 2016. In 2017, its new tyre building system won an award for “Tire Manufacturing Innovation of the Year”, presented at the Tire Technology Expo in Hanover, Germany.<sup>6</sup>

19. A connected company, Bridgestone Licensing Services LLC, owns the Firestone tyre brand. Mr Matsumoto says that this brand

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<sup>2</sup> Exhibit 11.

<sup>3</sup> Exhibits 16, 17 and 18.

<sup>4</sup> Exhibit 1.

<sup>5</sup> Exhibit 7.

<sup>6</sup> Exhibit 21.

“... is also used extensively in the UK and EU and well-known by UK and EU consumers ... Consumers are aware of the commercial connection between the FIRESTONE and BRIDGESTONE brands.”

The evidence adduced to demonstrate this is a print out from the website of Firestone Complete Auto Care, with prices in dollars and an invitation to the user to enter their zip code to find a local store. There is a single print out from www.firestone.eu, printed on 25 January 2018, and one from UK-based National Tyres and Autocare, printed on the same date, which states that Firestone is part of the Bridgestone group.<sup>7</sup>

20. Both the 946 and 274 marks are used in the opponent’s brochures and on its website. In addition, images in the evidence show that the 946 mark also appears on tyres and bicycle frames.

#### *Applicant’s evidence*

21. The applicant’s evidence comes from Mr Matthew Gardner, partner of The Trade Marks Bureau. It is dated 27 August 2018. Attached to Mr Gardner’s witness statement are the results of a search of UK and EU Trade Mark Registers for marks that include the word “STONE” and printouts from owners’ websites. Thirteen marks are listed, all of whose specifications include goods in Class 12.

#### *Opponent’s evidence-in-reply*

22. The opponent’s evidence-in-reply consists of a second witness statement from Mr Matsumoto. It is dated 8 November 2018.
23. Mr Matsumoto’s statement has two purposes. First, it seeks to rebut the applicant’s allegation that there has been coexistence in the market between the opponent’s marks and other marks containing the word “STONE”. To that end,

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<sup>7</sup> Exhibit 6.



Exhibits MM22-24 contain details of marks that answer to this description and have been challenged by the opponent.

24. Secondly, the statement seeks to demonstrate that UK customers are aware of the FIRESTONE brand and are likely to associate this brand with the applicant's mark. I note, however, that the opponent has not sought to rely on any FIRESTONE mark in these proceedings.
25. Exhibit MM26 contains winter 2017 and summer 2018 Firestone product catalogues and brochures for specific tyres. It is not clear what markets the catalogues are aimed at, and there appears only one reference to Bridgestone in very small print. Mr Matsumoto states that these products are available to consumers in the UK. The more specific product information is clearly labelled as coming from Bridgestone UK Ltd. Firestone tyres are available from suppliers such as Asda Tyres, Formula One Autocentres, Halfords and Kwik Fit.<sup>8</sup> Market share in the UK was approximately 14% in 2015, 11% in 2016 and 12% in 2017.<sup>9</sup>

## **Decision**

### **Section 5(2)(b) ground**

26. Section 5(2)(b) of the Act states that:

“A trade mark shall not be registered if because –

...

(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,

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<sup>8</sup> Exhibit MM27.

<sup>9</sup> Exhibit MM28.

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

27. An “earlier trade mark” is defined in section 6(1) of the Act:

“In this Act an ‘earlier trade mark’ means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.”

28. The registrations upon which the opponent rely qualify as earlier trade marks under the above provision. In this opposition, the opponent is relying upon the Class 12 goods for which this earlier mark is registered. As the 161 mark was registered within the five years before the date on which the applicant’s mark was published, it is not subject to proof of use and the opponent is therefore entitled to rely on all the goods on which it is seeking to rely. The 946 and 274 marks are subject to the proof of use requirements, but the applicant has not asked the opponent to provide this. The opponent may therefore rely on all the Class 12 goods on which it is seeking to rely.

29. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *SABEL BV v Puma AG* (C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (C-425/98), *Matratzen Concord GmbH v OHIM* (C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (C-334/05 P) and *Bimbo SA v OHIM* (C-519/12 P):

(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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone 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 greater 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.

### **Comparison of goods**

30. When comparing the goods, all relevant factors should be taken into account, per *Canon Kabushiki Kaisha*:

“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 complementary.”<sup>10</sup>

31. In *Kurt Hesse v OHIM*, C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, T-325/06:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”<sup>11</sup>

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<sup>10</sup> Paragraph 23

<sup>11</sup> Paragraph 82.

32. A further factor to be considered is the channels of trade of the respective goods or services: see the guidance given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281.

33. When construing the words in the specifications, I take account of the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

34. The goods to be compared are shown in the table below:

Applicant’s goods	Opponent’s goods
<i>Brake pads for automobiles; Shock absorbing springs for vehicles; Non-skid devices for vehicle tires [tyres]; Brakes for vehicles; Brake shoes for vehicles; Brake segments for vehicles; Brake discs for vehicles; Upholstery for vehicles; Non-skid devices for vehicle tires; Non-skid devices for vehicle tyres; Brake linings for vehicles; Suspension shock absorbers for vehicles.</i>	<u><i>The 161 mark</i></u> <i>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.</i>

Applicant's goods	Opponent's goods
	<p data-bbox="834 253 1026 286"><u>The 946 mark</u></p> <p data-bbox="834 304 1393 1597"><i>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; tread rubber for retreading tires for the above-mentioned vehicles; tires for two-wheeled motor vehicles; inner tubes for two-wheeled motor vehicles; adhesive rubber patches for repairing tubes or tires; tread rubber for retreading tires for two-wheeled motor vehicles or bicycles; preformed tire treads for tires of automobiles; 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); suspension shock absorbers for vehicles; suspension springs for vehicles.</i></p> <p data-bbox="834 1664 1026 1697"><u>The 274 mark</u></p> <p data-bbox="834 1715 1393 2000"><i>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</i></p>

Applicant's goods	Opponent's goods
	<i>vehicle wheels; inner tubes 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.</i>

*The 274 mark*

35. The General Court said in *Gérard Meric v OHIM*, T-133/05, that:

“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.”<sup>12</sup>

All the applicant's goods are included in the more general categories of the opponent's *vehicles and parts and fittings for vehicles* and *apparatus for tyres*. Consequently, I find them to be identical.

*The 946 mark*

36. The applicant's *shock absorbing springs for vehicles* and *suspension shock absorbers for vehicles* are identical to the opponent's *shock absorbers (for land vehicles)*; *suspension shock absorbers for vehicles* and *suspension springs for vehicles*.

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<sup>12</sup> Paragraph 29.

37. The applicant's *non-skid devices for vehicle tires/tyres* are items that are placed on vehicle tyres to improve their safety during winter weather. Their users will all use the opponent's *tires for passenger cars; tires for trucks; tires for buses; tires for racing cars; tires for automobiles*. In my view, these goods are complementary: they are used together, and the average consumer is likely to think that a tyre manufacturer will also produce devices to help them be used more safely. They also share the same trade channels. I find these goods to be similar to a medium degree.
38. *Brake pads for automobiles, brakes for vehicles, brake shoes for vehicles, brake segments for vehicles and brake linings for vehicles* are mechanical parts used in vehicles, specifically in connection with the wheels, as are *tyres*. The users will be the same, namely people who repair vehicles, belonging either to themselves or others. The purpose of the applicant's goods is to allow the vehicle to slow or stop safely, and this is also one of the purposes of *tyres*. The trade channels are likely to be the same: suppliers of vehicle parts. They are not in competition, as both *tyres* and braking systems are necessary for safe driving. Neither, to my mind, are they complementary. While the goods would be used together, I remind myself that this is neither necessary nor sufficient for a finding of similarity: see *Sandra Amalia Mary Elliot v LRC Holdings*, BL O/255/13, paragraph 20. Given the differences in nature, it seems to me that the average consumer would not necessarily believe that the goods were produced by the same, or connected, undertakings. Consequently, I find there to be a low degree of similarity between these goods.
39. *Upholstery for vehicles* is to my mind different from the goods protected by the 946 mark, as those goods are either *tyres* or mechanical parts. The nature of the goods is different, as the opponent's will be rubber or metal, while *upholstery* is the soft, cushioned textiles used in car seats. The purpose is also different: the opponent's goods are related to the act of driving, while the *upholstery* will make the journey more comfortable for the driver and any passengers. Some large suppliers of vehicle parts may supply all these goods, but they are not in competition and in my view are not complementary either.



*The 161 mark*

40. The applicant's *brake pads for automobiles* are identical to the opponent's *automobiles and their parts and fittings*, per *Meric*.
41. An "automobile" is a car.<sup>13</sup> Consequently, I find that there is some identity between the opponent's *automobiles and their parts and fittings* and the applicant's *shock absorbing springs for vehicles, brakes for vehicles, brake shoes for vehicles, brake segments for vehicles, upholstery for vehicles, brake linings for vehicles* and *suspension shock absorbers for vehicles*. Some of the applicant's goods – namely, those intended for vehicles such as trucks or buses – would not be included in this category. In these circumstances, I find that these goods are highly similar to automobile parts.
42. I have discussed *non-skid devices for vehicle tires/tyres* in paragraph 37 above. For the reasons I have already set out, I find these goods to be similar to the opponent's *tires*.

**Average consumer and the purchasing act**

43. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.
44. 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:

"The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is

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<sup>13</sup> This is the definition in the *Oxford Dictionary of English*.

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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."<sup>14</sup>

45. The average consumer of the goods at issue will be a member of the general public or a professional user (a vehicle manufacturer or repairer). In the case of tyres, the split is relatively even, and where the end consumer visits a professional tyre fitter they may be invited to choose from tyres made by different manufacturers. The other goods will primarily be purchased by trade users and the end consumer is unlikely to be aware of which brand of, say, brake segments their mechanic has used.
46. The purchase will be made largely on a visual basis in a bricks-and-mortar store or online. However, the aural element cannot be ignored, as the selection process could also involve word-of-mouth recommendation or sales staff discussing options on the telephone. The goods will be an infrequent purchase for the individual and a regular purchase for business in the trade. Many of the goods are technical, and most will be relatively costly. Considering the use of the goods, the safety implications of the choice, and the infrequent nature of the purchasing, the average consumer will, in my view, be paying a higher than average level of attention, although perhaps not the highest.

### **Comparison of marks**

47. 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

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<sup>14</sup> Paragraph 60.

impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, C-591/12 P, that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”<sup>15</sup>

48. It would be wrong, therefore, artificially to dissect the 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 the marks.

49. As I found that all the applicant’s goods were identical to goods covered by the opponent’s 274 mark (the plain word “BRIDGESTONE”), I shall compare the applicant’s mark to this and the 161 mark. The 946 mark (the stylised word “BRIDGESTONE”) gives the opponent no better a chance under section 5(2)(b) than the 274 mark.

50. The respective marks are shown below:

Earlier mark	Contested mark
<u>The 161 mark</u>  STONE	<b>PANSTONE</b>
<u>The 274 mark</u>  BRIDGESTONE	

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<sup>15</sup> Paragraph 34.

51. The opponent's 161 and 274 marks consist of the words "STONE" and "BRIDGESTONE" respectively presented in capitals in a standard font with no stylisation.<sup>16</sup> The overall impression of the 161 mark lies in the word itself. The overall impression of the 274 mark lies in the juxtaposition of the words "BRIDGE" and "STONE". Neither element is more dominant than the other.
52. The applicant's mark consists of the word "PANSTONE" presented in capitals in a standard, sans serif font with no stylisation. The overall impression of this mark lies in the juxtaposition of the words "PAN" and "STONE". Neither element is more dominant than the other.

#### *Visual comparison*

53. The applicant's mark is an 8-letter word. It is presented in a particular font, rather than as a plain word mark, but this is, as I have already found, a standard font. The whole of the 5-letter 161 mark is contained at the end of the applicant's mark. I find that these marks are similar to a medium degree.
54. The opponent's 274 mark is 11 letters long and shares its final 5 letters with the applicant's mark. I find that these marks also have a medium level of similarity.

#### *Aural comparison*

55. The applicant's mark has two syllables and will be pronounced "PAN-STOHN". The opponent's 161 and 274 marks will be pronounced "STOHN" and "BRIJ-STOHN" respectively.
56. The opponent submits that:

"Such obvious and clear phonetic similarities would not go unnoticed by the relevant public in the UK especially if goods were ordered over the

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<sup>16</sup> Registration of a trade mark in capital letters covers use in lower case, as stated by Professor Ruth Annand, sitting as the Appointed Person, in *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.

telephone for example and since consumers are liable to slur the beginnings of words.”

57. I do not accept that consumers are likely to slur the beginnings of the words at issue. In the English language, the first syllable is often the one that is stressed, making a slur less likely. In the present case, it is not certain which syllable would be stressed, but in my view the default would be to stress the first syllable. I find that there is a medium degree of similarity between the applicant’s mark and the opponent’s marks.

### *Conceptual comparison*

58. The opponent’s 161 mark has a clear conceptual meaning. As the opponent explains, it is a “hard solid non-metallic mineral of which rock is made.” It may also bring to mind the idea of strength and durability. Turning to the 274 mark, I note that it is established case-law that the average consumer, while normally perceiving a mark as a whole, “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” (*Usinor SA v OHIM*, T-189/05, paragraph 62). I consider that some consumers will see it as meaning “a stone that forms part of a bridge”. For others, it will have no real conceptual content.

59. The applicant submits that the term “PANSTONE” may be seen as referring to “a pan made from stone”. The opponent, on the other hand, submits that “PAN” would be seen as a prefix, as in “panorama” or “pandemic”, deriving from the Greek word for “all”. It is possible that some consumers will take this view, but I think it more likely that the average consumer will attribute no particular concept to the word, and that it will be conceptually neutral. Any conceptual similarity will be down to the common element “STONE”, and this similarity will be low.

## **Distinctiveness of the earlier mark**

60. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*:

“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).”

61. The opponent submits that its marks have a high degree of inherent distinctiveness and that in the case of the 274 mark this distinctiveness has been enhanced through use. The word “STONE” is in common English usage and does not describe the goods in respect of which it is registered. However, as I have noted, it may evoke in the minds of some consumers the notion of strength or durability, which may allude to the characteristics of the goods, although this will

be to a very mild extent. I find that this mark has a no more than medium level of distinctiveness.

62. I turn now to the 274 mark. Its inherent distinctiveness lies in the juxtaposition of “BRIDGE” and “STONE”. The applicant submits that the existence of a number of other trade marks which end in “STONE” must have an impact on the distinctiveness of the earlier mark. In *Zero Industry Srl v OHIM*, T-400/06, the General Court found that the existence of other trade marks containing the same word “was not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned.”<sup>17</sup>

63. The volume of sales achieved in the UK, the amounts spent on marketing and advertising its goods, and the wide availability of these goods throughout the UK persuade me that, in respect of *tyres*, the distinctiveness of the 274 mark has been enhanced through use. I consider that it has a high level of distinctiveness for *tyres* and a lower degree of distinctiveness for other goods, although I would still find this to be in the higher half of the spectrum.

### **Conclusions on likelihood of confusion**

64. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 29. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa.<sup>18</sup> The distinctiveness of the earlier mark must also be taken into account.

65. Such a global assessment does not imply an arithmetical exercise, where the factors are given a score and the result of a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the goods and the nature of the purchasing process. I note that it is generally

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<sup>17</sup> Paragraph 73.

<sup>18</sup> *Canon Kabushiki Kaisa*, paragraph 17.

accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture he has kept in his mind.<sup>19</sup>

66. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, noted that:

“81.3 ... when a tribunal is considering whether a likelihood of confusion exists, it should recognise that there are four options:

81.3.1 The average consumer mistakes one mark for the other (direct confusion);

81.3.2 The average consumer makes a connection between the marks and assumes that the goods or services in question are from the same or economically linked undertakings (indirect confusion);

81.3.3 The various factors considered in the global assessment lead to the conclusion that, in the mind of the average consumer, the later mark merely calls to mind the earlier mark (mere association);

81.3.4 For completeness, the conclusion that the various factors result in the average consumer making no link at all between the marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods or services.

81.3.5 Accordingly, in most cases, it is not necessary to explicitly set out this fourth option, but I would regard it as a good discipline to set out the first three options, particularly in a case where a likelihood of indirect confusion is under consideration.”

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<sup>19</sup> *Lloyd Schuhfabrik Meyer*, paragraph 27.



67. I shall first consider the likelihood of direct confusion. I found the contested mark to be visually and aurally similar to the opponent's marks. The 161 mark is the second, and last, element of both the 274 and the contested mark. While it is often the case that the beginnings of words have more visual and aural impact than the ends (see *El Corte Inglés SA v OHIM*, Joined Cases T-183/02 and T-184/02), this is not a universal rule. The General Court noted in *Bristol Global* that:

“... the fact that it [the difference in the marks] is at the beginning of the mark applied for is not capable of precluding the relevant public from noticing the similarity resulting from the inclusion of the earlier mark in the mark applied for.”<sup>20</sup>

68. It seems to me unlikely that the average consumer will be directly confused, even taking account of imperfect recollection and my finding that the applicant's goods are either identical or similar to the opponent's goods. “PANSTONE” is clearly longer than “STONE”, and “BRIDGESTONE” has a quite different beginning. In my view, the average consumer will notice the differences between the marks, notwithstanding the high level of distinctiveness for types in respect of the BRIDGESTONE mark.

69. Having found that there is no likelihood of direct confusion between the marks, I shall consider the likelihood of indirect confusion. I bear in mind the comments of Mr Mellor in *Duebros*:

“... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis [in *L.A. Sugar*] was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”<sup>21</sup>

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<sup>20</sup> Paragraph 108.

<sup>21</sup> Paragraph 81.4.

70. I remind myself that what I must consider here is the fair and notional use of the opponent's marks, as they are not subject to the proof of use requirements. My assessment should, in the words of Mr Mellor in *Duebros*, be:

“an emulation of an instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier mark in mind”.<sup>22</sup>

71. Earlier in my decision, I found that the goods covered by the applicant's mark and the opponent's 274 mark are identical. Even so, it seems to me that whilst the later mark might possibly call to mind the earlier mark (but only in relation to non-skid devices for tyres), the average consumer would not assume that the same, or connected, undertakings were responsible for them. The common element is not so strikingly distinctive to lead to the consumer to come to the alternate view, neither would they strike the consumer as an obvious variant or sub-brand, particularly bearing in mind that in neither mark does the word “STONE” play an independent distinctive role. Whilst there may be other ways in which indirect confusion could arise, I see no reason in the case before me to make such a finding. I consider that the same applies in the case of the 161 mark. It is unlikely that “STONE” or “PAN” will be seen as a house mark or sub-brand respectively within “PANSTONE”. “STONE” has a medium level of distinctiveness for the goods at issue and its inherent distinctiveness has not been shown to have been enhanced through use. Overall, I find there to be no likelihood of indirect confusion.

### **Outcome of Section 5(2)(b) ground**

72. The opposition under section 5(2)(b) fails.

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<sup>22</sup> Paragraph 81.

## **Section 5(3) ground**

73. Section 5(3) of the Act states that a trade mark which 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 Community trade mark or international trade mark (EC), in the European Community) 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”.

74. The conditions of section 5(3) are cumulative:

- 1) The opponent must show that the earlier mark has a reputation.
- 2) The level of reputation and the similarities between the marks must be such as to cause the public to make a link between the marks.
- 3) One or more of three types of damage (unfair advantage, detriment to distinctive character or repute) will occur.

It is not necessary for the goods to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

75. The applicant accepts that the opponent has established a reputation in respect of tyres. The opponent has been operating in the EU since 1972 and has provided figures for the number of tyres sold and expenditure made on marketing and advertising its products. I am satisfied that it has shown a strong reputation in the EU in respect of tyres, but not vehicle parts more generally. The evidence supplied does not indicate that the opponent has been using these marks for anything other than tyres or tyre-related services.

76. My assessment of whether the public will make the required mental link between the marks must take account of all relevant factors. The factors identified by the CJEU in *Intel Corporation Inc v CPM United Kingdom Limited (C-252/07)* are:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks are registered, or proposed to be 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; and
- the existence of the likelihood of confusion on the part of the public.<sup>23</sup>

77. I shall confine my consideration to the 274 mark. I find this mark to be more similar to the applicant's mark, as it lacks the stylised elements of the 946 mark. Both these earlier marks are registered in respect of *tyres*, the goods for which I found the opponent to have a strong reputation. I shall not repeat in full my assessment under section 5(2)(b), but note that I found the 274 and the applicant's marks to have a medium degree of similarity, and the 274 mark to be highly distinctive for *tyres*.

78. Earlier in my decision, I found that the applicant's *non-skid devices for vehicle tyres/tires* are similar to the opponent's *tyres*, while *brake pads for automobiles; brakes for vehicles; brake shoes for vehicles; brake segments for vehicles; brake discs for vehicles; brake linings for vehicles* had a low level of similarity (paragraphs 37 and 38). I note, however, that it is not necessary for the goods to have the same degree of similarity as may be required to create a likelihood of

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<sup>23</sup> Paragraph 42.

confusion under section 5(2)(b), as the CJEU confirmed in *Intra-Press SAS v OHIM*, Joined Cases C-581/13 P and C-582/13 P.<sup>24</sup>

79. I will now make a comparison between the remaining goods and *tyres*. I find that the relevant section of the public for *shock absorbing springs for vehicles; upholstery for vehicles; and suspension shock absorbers for vehicles* would be the same: manufacturers or repairers of vehicles. Some of these repairers will be members of the general public, but it is more likely that the relevant public for the applicant's goods would be a specialist in the trade. In many cases, the trade channels will be the same. Weighing up all these factors, I find that a link will be established between the marks by the relevant consumer in relation to the applied for goods.
80. I now turn to a consideration of damage. In its Statement of Grounds, the opponent pleads that:

“use of the mark applied for by the Applicant will take unfair advantage of the distinctive character and/or repute of the Opponent's earlier marks. In view of the similarities between the marks and the extensive reputation enjoyed by the Opponent in the UK, the consumer may make a connection or establish a link which could result in the consumer wrongly believing that the Applicant's goods originate from the Opponent or there is some sort of economic affiliation between the parties when this is not the case.”

In other words, the opponent's pleading appears to be predicated on the likelihood of confusion. Under section 5(2)(b), I found there to be no likelihood of confusion and consequently such unfair advantage will not arise. In any event, I struggle to see what advantage the applicant would gain in relation to the goods covered by the contested mark.

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<sup>24</sup> See paragraph 72.

81. The opponent's claim relating to detriment to reputation is based, essentially, on injurious association, which, in my view, is simply a hypothetical claim. There is nothing to show that the applicant's goods are of a lower quality. Neither is there anything inherent in the goods that would have a negative impact on the opponent's reputation.

82. Finally, in terms of detriment to distinctive character, the ability of BRIDGESTONE to distinguish its goods from those of others is unlikely to be affected. The mark will continue to be as distinctive as it has been.

83. The opposition under section 5(3) fails.

### **Conclusion**

84. The opposition has failed and, subject any successful appeal, the application may proceed to registration.

### **Costs**

85. The applicant has been successful and is entitled to a contribution towards its costs. I award the applicant the sum of £1150 as a contribution towards its costs. The sum is calculated as follows:

*Preparing a statement and considering the other side's statement: £250*

*Preparing evidence and considering and commenting on the other side's evidence: £500*

*Preparation of written submissions: £400*

***Total: £1150***

86. I therefore order Bridgestone Corporation to pay Yantai Mefine Machine Co., Ltd the sum of £1150. The above sum should 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 this 08<sup>th</sup> day of May 2019**

**Clare Boucher  
For the Registrar,  
The Comptroller-General**