

**BL O/735/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3231342**

**BY**

**GSR TRADING LTD**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 12, 35 AND 37:**



**AND**

**OPPOSITION THERETO (NO. 410126)**

**BY**

**BRIDGESTONE CORPORATION**

## **Background and pleadings**

1. GSR TRADING LTD (the applicant) applied to register the trade mark:



in the UK on 16 May 2017. It was accepted and published in the Trade Marks Journal on 26 May 2017, in respect of a wide range of goods and services in classes 12, 35 and 37. The full list of goods and services in the application is set out below in an annex.

2. Bridgestone Corporation (the opponent) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of two earlier European (EU) Trade Marks, namely:

EU TM 013316203, filed on 01 October 2014 and registered on 11 February 2015 for the mark:

***STONE***

And:

EU TM 013316161, filed on 01 October 2014 and registered on 11 February 2015 for the mark:

**STONE**

3. Both EUTMs are registered only in class 12, and for the same goods, namely:

**Class 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.

4. The opponent relies on all of the goods of its two earlier EUTMs.
5. The opponent also opposes the application on the basis of Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (the Act), on the basis of its earlier EU designation of International Registration (IR) No. 1105946, for the following mark:

**BRIDGESTONE**

6. The opponent's IR was filed and registered on 27 July 2011 and claims a priority date of 23 February 2011.
7. The opponent's IR designating the EU is protected in several different classes, however the opponent relies only on the goods and services protected in classes 12, 35 and 37, namely:

**Class 12:** 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; 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.

**Class 35:** retail services or wholesale services for automobiles, tires and parts and fittings for automobiles.

**Class 37:** Repair and maintenance of automobiles and their parts; repair and maintenance of tires for automobiles; retreading of tires; repair and maintenance of two-wheeled motor vehicles and their parts; repair and maintenance of tires for two-wheeled motor vehicles; tire repair and recapping services.

8. The opposition is directed against all of the goods and services filed under the application.
9. In its statement of grounds, the opponent claims:
  - the marks at issue are visually similar to a high degree, due to the suffix 'STONE' appearing in the applied for mark. The opponent's two earlier EUTMs are comprised only of the word 'STONE', which is wholly contained within the applied for mark. That element is also entirely shared with the opponent's earlier IR. Such clear and obvious visual similarities will not go unnoticed by the UK public and, as such, there is a likelihood of confusion and association.

- Due to the coincidence in the element 'STONE' in all of the marks at issue, the marks share a high degree of phonetic similarity. As all four marks at issue contain the word 'STONE' they are conceptually similar. The word 'TREAD' in the applied for mark, is devoid of distinctive character and descriptive, as it refers to the rubber on the circumference of tyres.
- The applicant's mark and the opponent's earlier marks are therefore visually, phonetically and conceptually similar.
- The applied for goods are identical to the opponent's earlier goods in the two EUTMs, and complementary to the class 35 and class 37 services contained in the opponent's earlier IR. The opponent's services in the IR are identical, similar or complementary to the applied for services in classes 35 and 37.
- The IR has a high degree of inherent distinctive character, and it has also acquired an enhanced level of distinctive character due to the use made of, it in relation to the goods and services it relies on in classes 12, 35 and 37.
- As the element 'TREAD' in the applicant's mark is devoid of distinctive character and is descriptive, the element 'STONE' will operate as the most dominant and distinctive component, thereby increasing the likelihood of confusion between the marks at issue.

10. Under the ground of Section 5(3), the opponent claims a reputation in its EU Designation of International Registration No. 1105946, due to its longstanding and extensive use in the UK and the EU.

11. In its counterstatement the applicant claims:

- the opponent has failed to consider the applied for mark in its entirety and has focussed solely on the word elements 'TREAD' and 'STONE', which it treats separately.

- The marks are entirely different when all of the additional matter in their mark is taken into account, namely the stylisation in the lettering, the use of colour and the words 'MORE MILES...MORE SMILES'.
- The opponent's claim that the element 'STONE' in the applied for mark wholly encompasses the earlier EUTMs which comprise solely of the word 'STONE' is inaccurate, as the letter 'O' in the applied for mark has been replaced with a tyre, and therefore the word 'STONE' is not, strictly speaking, present in the mark.

12. The opponent filed written submissions and evidence. The evidence is comprised of a witness statement of Mr Michinobu Matsumoto and seventeen exhibits. The written submissions, dated 11 June 2018, are provided by Mr Jason Chester of Marks & Clerk LLP and will be referred to where appropriate in the decision.

13. The applicant filed a witness statement of Mr Raza Hassan, director of GSR Trading Ltd, dated 13 March 2018. In Mr Hassan's witness statement, he claims that the applied for mark is not similar to the opponent's earlier marks and that it does not take unfair advantage or benefit, through the use of its TREADSTONE mark.

14. No hearing was requested and so this decision is taken following a careful perusal of the papers.

15. The applicant has represented itself throughout the proceedings. The opponent has been professionally represented by Marks & Clerk LLP.

### **Evidence**

The opponent submitted evidence, which comprises a Witness Statement of Mr Michinobu Matsumoto, the General Manager of Intellectual Property Department 2, of Bridgestone Corporation, the opponent company, along with 17 exhibits.

In his witness statement Mr Matsumoto provides the following information:

- A brief history of the opponent company, Bridgestone Corporation. Bridgestone Corporation was founded in 1931 and is now the world's largest manufacturer of tyre and rubber products. It is estimated that 1 in 5 vehicles globally are fitted with Bridgestone tyres.
- Bridgestone has a number of subsidiaries, collectively referred to as the 'Bridgestone Group'. The Bridgestone Group has a business presence in more than 150 countries and employs more than 140,000 people. Recent operating income stood at approximately 450 billion Yen.
- Exhibit 1 is a copy of Bridgestone Europe's 2013 corporate brochure, which provides information on the history of the company and includes details of new innovations such as the development of 'air-free' bicycle and automobile tyres. The exhibit contains information on this new developing product in the form of coverage in UK press publications.
- Bridgestone Europe, a subsidiary of the opponent company, first opened in Belgium in 1972, and now has around 12,500 employees spread across Europe.
- European products are developed and tested at an R&D facility near Rome and manufacturing then takes place in 9 plants across Belgium, France, Italy, Poland, Hungary and Spain. Exhibit 2 contains further information from the Corporate Brochure and printouts from the company website [www.bridgestone.eu](http://www.bridgestone.eu), with more company history provided.
- Exhibit 2 also illustrates, by way of website and brochure extracts, the range of products in respect of which the BRIDGESTONE mark is used in the UK.
- Mr Matsumoto states that the opponent has "sold tyres and related products under the BRIDGESTONE mark in the UK and EU for decades on an impressive scale". In paragraph 7 of his witness statement Mr Matsumoto provides a list of approximate sale figures for BRIDGESTONE branded tyre

products in the EU. In 2013, more than 32 million units were sold, in 2014 more than 32 million units, in 2015 more than 34 million units and in 2016 more than 34 million units.

- Mr Matsumoto states that “a significant proportion of the sales volumes listed relate to the UK only” he also claims that, based on his company’s market intelligence and data on the size of the tyre market in the UK, “it is estimated that my company’s market share for car tyres has grown from 11% to 13% between 2013 and 2017. Equivalent figures for truck tyres are 19% to 22% and for off the road (OTR) tyres, 44% to 50% over the same period.
- BRIDGESTONE products are available in the UK and EU through two main channels, third party distributors of tyre products including vehicle repair and servicing outlets, and car manufacturers who have BRIDGESTONE tyres fitted to their new cars when sold to customers. Third-party distributors in the UK include Kwik-Fit and Halfords, which between them have hundreds of outlets.
- Exhibit 3 comprises printouts from official and third-party websites showing BRIDGESTONE tyres available for sale in the UK and EU.
- Exhibit 4 includes an extract from the opponent’s website which, as an illustration, indicates the number of locations in the UK in which it is possible to buy BRIDGESTONE tyres.
- The opponent supplies BRIDGESTONE tyres directly to major automobile manufacturers including Honda, BMW, VW, GM, Daimler, Audi, Renault, Ford, Fiat, Mercedes and Aston Martin.
- The opponent also owns the FIRESTONE tyre brand which is also used extensively in the UK. Information on this activity is enclosed in Exhibit 4A. Mr Matsumoto claims that consumers are aware of the commercial connection between the BRIDGESTONE and FIRESTONE brands.



- The opponent also provides related services including, in conjunction with an affiliated company called Bandag, tyre repair and re-treading services in the UK. Information on these and other services is set out in Exhibit 5 in the form of website extracts and brochures and leaflets circulated to UK customers. Whilst these services are presented as Bandag services, it is clear from documentation provided under Exhibit 5, that Bandag is part of the Bridgestone Group, and the Bridgestone mark is shown on much of the evidence.
- The opponent company also has links with the bicycle industry and has an affiliated company named Bridgestone Cycle Co. Ltd. The affiliate company manufactures and supplies bicycles and their parts and, as referenced above, the opponent company is working on development of an air-free bicycle tyre. Exhibit 6 provides information on this activity by way of the opponent's website and from UK facing online retail sites, illustrating the fact that the opponent's bicycles are available for sale in the UK.
- Mr Matsumoto states that the opponent company undertakes significant marketing and promotional activities in the EU and the UK. He provides expenditure figures for all such activities in the UK relating to all BRIDGESTONE branded products. In 2013, advertising and marketing expenditure in the UK was 3 million euros. In 2014 it was 3.25 million euros, in 2015 and 2016 the expenditure was 3.5 million euros per year and, in 2017, marketing and advertising was 3.6 million euros.
- Exhibit 7 contains a selection of press articles about or referring to the opponent and its products, from major media outlets, publications and newspapers in the UK, including the BBC, the Daily Mail, the Telegraph, the Sun, the Express and the Guardian, as well as the consumer magazine/website Which?.

- Exhibit 8 contains details of a selection of corporate press releases regarding Motor Shows between 2011 and 2015. The opponent's products are promoted and displayed at a number of such Motor Shows across the EU.
- Exhibit 9 contains results of impact studies prepared by Road Transport Media, which assesses the impact of trade press advertising, from 2014-2016. The reports in this exhibit show that the opponent company's advertisements compare favourably with the advertising activity of other major tyre manufacturers in the UK.
- Exhibit 10 contains a selection of sample materials such as posters and advertisements which the opponent used to advertise the BRIDGESTONE brand to customers. The examples shown in the exhibit are from 2010 to 2016 and were directed at UK customers.
- Mr Matsumoto states that his company has also run a series of TV advertisements to raise awareness of the BRIDGESTONE brand. A listing of examples of these advertisements on the opponent's YouTube account is provided in Exhibit 11. The date and country of publication of these advertisements is also given. The exhibit also gives information on the opponent's sponsorship of TV Channel Four's weather news from 2015-2016.
- Mr Matsumoto states that his company's reputation has been enhanced and increased due to sponsorship and support of a number of high-profile sporting events globally. As an example of this, Mr Matsumoto states that his company sponsored Formula One racing events between 1997 and 2010.
- Exhibit 12 contains printouts from corporate and third-party websites detailing the history of the opponent's involvement in Formula One, including press articles and photographs.
- Exhibit 13 contains printouts showing the opponent's sponsorship of other sporting events, sporting bodies and individual athletes, including the National

Football League, FIS Alpine Ski World Cup and the British Schoolboy Motorcycle Association.

- Bridgestone Corporation is also an official International Olympic Committee (IOC) partner, through to the 2024 Olympic Games. Under the Olympic TOP program, only one company is selected from a specific industrial sector. The opponent launched a national advertising campaign in 2017 in the UK, featuring three British Olympians. Exhibit 14 contains information relating to the opponent's various sponsorship arrangements prior to the date of filing of the application under opposition.
- As previously stated, the opponent supplies tyres to a number of major car manufacturers. In 1999 Bridgestone Corporation was named sole supplier of Run Flat Tyres for BMW's Z8 sports car, a car that was prominent in the James Bond film 'The World is Not Enough'. Information about this is provided under Exhibit 15.
- Exhibit 16 provides information about a similar relationship between the opponent and Aston Martin, who have chosen Bridgestone Corporation as their official tyre partner for the new V8 Vantage S sports car.
- In paragraph 25 of his witness statement, Mr Matsumoto lists a number of awards that his company's products have won between 2010 and 2016.
- Exhibit 17 comprises a selection of press releases from the opponent's website and articles written by third-parties, confirming details of the above information, as set out by Mr Matsumoto in his witness statement dated 26 January 2018.

16. Whilst the witness statement goes into significantly more detail than I have so far summarised, I do not consider that it is necessary, at this stage, to say anymore. Although the earlier BRIDGESTONE mark is subject to the proof of use provisions, the applicant did not put the opponent to proof of use so it is able to rely on all of the goods and services covered by that registration, without evidence having to be

considered. In terms of the claimed reputation, it is clear from the evidence that the BRIDGESTONE mark is a well-known brand in both the UK and EU. I accept that the applicant has not expressly accepted this, but I note that it does refer to it as being a large player and describes it as the Goliath in a 'David v Goliath' type of dispute. The reputation certainly extends to the tyres it produces, which are clearly at the premium (as opposed to budget) range. If I need to come back to any of the other aspects of the evidence in more detail, I will do so later.

## **Decision**

### **Section 5(2)(b) of the Act**

17.5(2)(b) of the Act states:

“(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.”

18. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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.

## **The principles**

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

19. I will begin by comparing the opponent's earlier EUTMs. I will move on to compare the opponent's IR later in my decision.

### **Comparison of goods**

20. In the judgment of the Court of Justice of the European Union 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”.

21. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

22. In *Kurt Hesse v OHIM, Case 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. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Case T-325/06*, the General Court stated that “complementary” means:

“...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”.

23. In *Sanco SA v OHIM, Case T-249/11*, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited BL-0-255-13*:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

24. The opponent's goods under EUTMs 013316203 & 013316161 are:

**Class 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.

25. The application covers goods and services in classes 12, 35 and 37.

26. In class 12 the applied for goods: 'Tyres for the wheels of forestry vehicles; Pneumatic tyres and inner tubes for motorcycles; Tubeless tires [tyres] for bicycles, cycles; Tubeless tyres for bicycles; Tubeless tyres for cycles; Tyres for agricultural vehicles; Solid rubber tyres for vehicle wheels; Spare tyre covers; Inner tubes for bicycle tyres; Tyres for bicycles, cycles; Cycle tires [tyres]; Bicycle tyres; Non-skid devices for vehicle tires [tyres]; Tyres (Non-skid devices for vehicle -); Tyre casings; Casings for pneumatic tires [tyres]; Tyre cases; Tyre treads; Tyres for buses; Tyres for land vehicles; Treads for retreading tires [tyres]; Treads for retreading tyres; Wheels, tyres and continuous tracks; Rubber tread patterns for use in retreading vehicle tyres; Pneumatic tires [tyres]; Pneumatic tyres; Tyres for vehicle wheels; Wheel tyres (Vehicle -); Vehicle wheel tires [tyres]; Vehicle tyres; Tyres for trucks; Tyre treads of rubber; Tyres for aircraft; Retreaded tyres; Remoulded tyres; Inner tubes for pneumatic tyres for vehicle wheels; Valves for vehicle tires [tyres]; Tyres for two-wheeled vehicles; Tyres for commercial vehicles; Inner tubes for pneumatic tires [tyres]; Inner tubes for pneumatic tyres; Tubular tyres; Covers for tyres; Tyres for motor vehicles; Tyres for automobiles; Tyres for motor vehicle wheels; Automobile



tires [tyres]; Automobile tyres; Tyres for motorcycles; Tyre mounts; Spikes for tires [tyres]; Spikes for tyres; Solid tyres for vehicle wheels; Tyres, solid, for vehicle wheels; Wheels and tyres, and continuous tracks for vehicles; Automobile tires [tyres]; Automobile wheels; Pneumatic tires [tyres]; Remoulded tyres; Retreaded tyres; Rubber tread patterns for use in retreading recycled tyres; Rubber tread patterns for use in retreading tyres; Rubber tread patterns for use in retreading vehicle tyres; Rubber treads for tires; Tire valves for vehicle tires; Tires for aircraft landing gear wheels; Tires [for automobiles]; Tires for bicycles, cycles; Tires for children's bicycles; Tires for land vehicles; Tires for landing gear wheels of aircraft; Tires for two-wheeled motor vehicles; Tires for vehicle wheels; Tires for wheels of aircraft; Tires (Non-skid devices for vehicle -); Tires, solid, for vehicle wheels; Tyre grips; Tyre treads; Tyres for automobiles; Tyres for bicycles, cycles; Tyres for buses; Tyres for commercial vehicles; Tyres for land vehicles; Tyres for motor vehicle wheels; Tyres for motor vehicles; Tyres for motorcycles; Tyres for the wheels of forestry vehicles; Tyres for trucks; Tyres for two-wheeled vehicles; Tyres for vehicle wheels; Tyres for wheelchairs; Tyres, solid, for vehicle wheels; Vehicle tires; Vehicle tyres; Vehicle wheel tires; Vehicle wheel tires [tyres]; Vehicle wheels; Wheel hubs; Wheel hubs (Vehicle -); Wheel hubs (Vehicles -); Wheel tires (Vehicle -); Wheel tyres (Vehicle -); Wheels; Wheels and tyres, and continuous tracks for vehicles; Wheels being parts of bicycles; Wheels for automobiles; Wheels for bicycles, cycles; Wheels for motor vehicles; Wheels for motorcycles; Wheels for racing karts; Wheels for vehicles; Wheels, tyres and continuous tracks; Wheels (Vehicle -); are all wheels and tyres, or parts of wheels and tyres.

27. These applied for goods all fall within the opponent's earlier goods: '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', as the term '...and their parts and fittings' includes wheels and tires/tyres, and their parts and fittings. These goods are identical.

28. The remaining applied for goods: 'Tyre repair outfits; Repair outfits for tyres; Patches for tyres; Patching materials for tyres; Tyre repair patches; Patching materials for inner tubes for tyres; Patches for inner tubes of tyres; Repair outfits for tyres; Rubber

patches for repairing vehicle tyres; Tyre repair outfits; Tyre repair patches' are all goods that are used to repair punctures and damage to tyres and inner tubes of tyres. These goods are often produced by manufacturers of tyres and innertubes and are purchased by the same end-user. Whilst not similar in nature or use to tyres and innertubes, they can share channels of trade and are complementary. These goods are similar to a low degree to the earlier goods.

29. The applied for goods have been found to be identical or similar to a low degree to the opponent's earlier goods.

30. In class 35, the applied for services; Electronic Retail and wholesale services connected with tyres, provided via a global computer network; Retail services connected with the sale of tyres; Retail and wholesale services in the field of vehicles tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with industrial tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with tyres, Retail services, retail store services, online retail store services and wholesale services relating to tyre, vehicle tires, tire accessories and parts; promotion and business mediation with regard to the purchase and sale and import and export of wheels, tyres and vehicle wheel rims; Promotion services related to tyres; Wholesale services and retail services connected to wheels, tyres for vehicles'; are all services wholly related to the marketing and retailing/wholesaling of vehicle wheels, tyres and their respective parts.

31. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

32. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

33. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>1</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>2</sup>, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*<sup>3</sup>, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

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<sup>1</sup> Case C-411/13P

<sup>2</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>3</sup> Case C-398/07P

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

34. In this instance, it is clear as to the nature and extent of the retail, wholesale and promotional activities to which the applicant engages, or intends to engage in, namely those services applied specifically to the field of vehicle wheels and tyres, and parts and fittings of vehicle wheels and tyres.

35. Vehicle tyres and wheels are provided for sale in a number of ways. Automobile service providers who specialise in wheels, tyres and the tracking and balancing of those goods, in conjunction with suspension and engine performance, often retail these goods alongside the services provided. The consumer may pay to have existing wheels or tyres balanced, re-grooved or tracked as part of a broader 'service' offering. At that point, the consumer may be faced with the option of new tyres or wheels, from a range on offer at that outlet. These goods are also provided directly from the manufacturer to such specialist outlets. Wholesale outlets will operate in a similar way.

36. The manufacturer of vehicle wheels and tyres will engage in promotional and marketing activities to raise awareness of their brand and goods. This activity will generally take the form of a marketing or advertising campaign developed and created by a specialist agency, however, marketing and promotion can be provided via the manufacturer through internal channels and via their website, although a sophisticated campaign presented in this way will still have been created with the use of specialist advertising expertise.

37. In respect of retail of vehicle wheels and tyres, I find that there is a degree of complementarity between these services and the goods at issue. There is clearly a close connection between the goods and the services and whilst it may often be the case that a third party brings the respective goods of others together, it is also

possible that the retailer's own products are sold. I consider there to be at least a low level of similarity.

38. In respect of wholesale services, I also find there to be similarity to the same degree with the opponent's goods. Wholesale is defined as "the selling of goods in large quantities to be retailed by others" (Oxford English Dictionaries.com). In this regard, the relevant public will be in the trade, acting as a middle man between the manufacturer of the goods and the general public. There will, though, still be that close connection between the goods and services in such a way that the relevant public may believe that the responsibility for those goods/services lies with the same undertaking.

39. In respect of 'Promotion and business mediation with regard to the purchase and sale and import and export of wheels, tyres and vehicle wheel rims; Promotion services related to tyres', I do not find a similarity with the opponent's goods. These services, whilst involved in the area of wheels and tyres, are of a specialist business nature and the closeness of the connection is not great (in the sense of being important for each other) and it is unlikely that the average consumer will believe that the responsibility for the goods/services lies with the same undertaking.

40. For the reasons set out above, the following services applied for in class 35 are found to be similar to a low degree to the opponent's goods in class 12:

'Electronic Retail and wholesale services connected with tyres, provided via a global computer network; Retail services connected with the sale of tyres; Retail and wholesale services in the field of vehicles tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with industrial tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with tyres, Retail services, retail store services, online retail store services and wholesale services relating to tyre, vehicle tires, tire accessories and parts; Wholesale services and retail services connect to wheels, tyres for vehicles'

41. The following services applied for in class 35 are found to be dissimilar to the opponent's goods in class 12:

'Promotion and business mediation with regard to the purchase and sale and import and export of wheels, tyres and vehicle wheel rims; Promotion services related to tyres'.

43. The remaining applied for services in class 35, namely:

'Office functions; Organisation, operation and supervision of loyalty schemes and incentive schemes; Advertising services provided via the Internet; Radio and television advertising; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; Provision of business information; Advertising; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; On-line auctioneering services via the Internet; Advertising; Online advertisements; Advertising by mail order; Advertising analysis; Direct marketing; Compilation of statistics relating to advertising; Computerized file management; Compilation of computer databases; Compilation of information into computer databases; Collating of data in computer databases; Systematization of information into computer databases; Advertising services relating to data bases; Management and compilation of computerized databases; Market research by means of a computer data base; Business management; Business administration; Clerical services; Direct mail advertising; Business management and organization consultancy; Document reproduction; Computerized file management; Web site traffic optimization; Organization of exhibitions for commercial or advertising purposes; On-line advertising on a computer network; Rental of advertising time on communication media; Publication of advertising literature; Presentation of goods and services; Rental of advertising space; Dissemination of advertising matter; Consultancy regarding advertising communications strategy; Public relations services; Consultancy regarding public relations communications strategy; Business auditing; Dissemination of advertisements; Dissemination of commercial information; business management assistance; publicity'

are, broadly speaking, business services offering a range of services covering e.g. office functions and clerical services, advertising and computerized file management, to a consumer requiring assistance, consultancy and advice in business activities or in the promotion of an undertaking. These services are not restricted to any particular business sector, although these services may notionally encompass activities with a connection to vehicle wheels and tyres. There is no obvious link between nature and use, channels of trade or end user. There is also no reason to find that a degree of complementarity may exist between these services and the goods at issue.

44. I find therefore that these applied for services in class 35 are dissimilar to the opponent's goods.

45. In class 37, the applied for services: 'Tyres (Vulcanization of -) [repair]; Retracking [alignment] of tyres; Tyre maintenance and repair; Regrooving of tyres; Tyre regrooving; Vehicle tyre fitting and repair; Tyre balancing; Replacement of tyres; Tyre fitting; Tyre repair; Retreading of tires [tyres]; Tyres (Retreading of -); Re-treading of tyres; Repair of tyres; Retreading of tyres' cover the repair, maintenance, re-treading, re-tracking, regrooving, balancing and fitting of tyres/tires.

46. The opponent's earlier goods 'Automobiles and their parts and fittings; tires; retreaded tires; bicycles and their parts and fittings' cover vehicles and their parts and fittings and specifically 'tires' and 'retreaded tires'.

47. Whilst the nature and end use of the goods and services clearly differ, the user and channels of trade of the respective goods and services may be the same. These goods and services can be said to be complementary given the link and relationship between them and, I consider that this type of relationship is of the type whereby the average consumer is likely to believe that responsibility for the goods and services lies with the same undertaking or economically linked undertaking.

48. The applied for services in class 37 are found to be similar to the opponent's earlier goods in class 12, to a low degree.

## Average consumer and the purchasing act

49. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

50. 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.”

51. The average consumer of vehicles, vehicle parts and fittings; tyres/tires, wheels and their parts and fittings, including the maintenance and repair of those goods, will be both the general public and a professional consumer. The purchase of these goods will be made largely on a visual basis in a retail setting, however I do not dismiss the potential impact of an aural process via word of mouth recommendations or sales persons discussing options face to face or over the telephone. The goods at issue are infrequent purchases, technical in nature and often likely to be of a reasonable cost. The level of attention and awareness displayed in the selection and purchase of the vehicles, by both types of consumer, will be high as these goods are generally quite expensive and are an infrequent purchase. The level of attention and awareness displayed in the selection and purchase of tires, wheels and their parts and fittings, will also be higher than normal (although not of the highest level) as these goods are also purchased infrequently and must be fit for purpose.



52. The average consumer of wholesale services in the area of vehicles, vehicles parts and fittings, tyres/tires, wheels and their parts and fittings, will be a professional consumer utilising those services in order to purchase goods, normally in large quantities. The selection of these services will generally be made on a visual basis, but may also be made over the telephone, by word of mouth recommendation, or via the internet, meaning that the impact of an aural process cannot be discounted. These services are likely to be technical in nature and likely to involve a reasonable cost, therefore the level of attention and awareness displayed in the selection and purchase of a service provider by the professional consumer, will be higher than normal.
53. The average consumer of retail services relating to vehicles, vehicle tyres, wheels and parts and fittings of tyres and wheels will be both the general public and a professional consumer. The selection of these services will be made largely on a visual basis however I do not dismiss the potential impact of an aural process via word of mouth recommendations or over the telephone. The level of attention and awareness displayed in the selection of these services, by both types of consumer, will be higher than normal as the goods being retailed are generally quite expensive, technical in nature and are an infrequent purchase.
54. The average consumer of retreading, maintenance, regrooving and fitting of tyres and retracking/alignment of vehicle wheels will also be both a professional and the general public. The level of attention paid to the selection of these services will be higher than normal as both sets of consumers will be careful to ensure that a quality service is provided. The potential for accident and damage occurring, when the services chosen are of a low quality is obvious, and will serve to ensure that the average consumer will be diligent when purchasing these services. The services will be selected largely on a visual basis, but may also be made aurally, following word of mouth recommendation.

### **Comparison of marks**

55. 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 the marks, 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.”

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

57. The respective trade marks are shown below:

Earlier marks	Contested trade mark
<p>EUTM 013316203</p> <p><b><i>STONE</i></b></p> <p>EUTM 013316161</p> <p><b>STONE</b></p>	

58. The opponent’s marks are comprised of the single word ‘STONE’ in plain type face and in a slightly stylised font. The overall impression in the mark lies in the totality of

the word 'STONE', even in the stylised mark the stylisation plays only a very minor role.

59. The applicant's mark is a complex mark comprised of the words 'TREAD' and 'STONE' conjoined. The font used in the word 'TREAD' has been designed to imitate the tread on a tyre. The letter 'O' in the word 'STONE' has been replaced by an image of a tyre, but it will still be read as STONE. The applied for mark also contains the word string 'More miles ... More smiles' in smaller lettering and in orange. Whilst the figurative aspects in the mark and the word string 'More Miles ... More Smiles' play a part in the mark and cannot be overlooked, the overall impression in the mark lies in the more dominant element 'TREADSTONE', which is the much larger, eye-catching part of the applied for mark; it is also noteworthy that the presentation of this element has been designed in such a way that the words TREAD and STONE contrast with other.

### **Visual similarity**

60. Visually, the respective marks are similar in that both share the word 'STONE'. They differ in the stylisation and figurative elements in the applied for mark, namely the tyre pattern in the letters of the word 'TREAD', in the image of a tyre in the word 'STONE', in the word string 'More miles ... More smiles', presented in orange, in the use of a black rectangular background behind the word 'TREAD' and a white background behind the word 'STONE', and in the orange underlining of the word 'TREAD'. However, due to the dominance of the verbal element 'TREADSTONE' and the use of black and white backgrounds, that serve to separate the elements 'TREAD' and 'STONE', the marks are considered to be visually similar to a medium degree.

### **Aural similarity**

61. Aurally, the opponent's marks will be enunciated as the single syllable /STOHN/. The applicant's mark will be articulated in the conventional manner, with the enunciation of each of the verbal elements in turn, however, for the part of the relevant public that would not automatically enunciate the word string 'More Miles ... More Smiles'

(which I consider to be most people), the applied for mark will articulated as */TRED/STOHN/* and the marks can be said to be aurally similar to a medium degree. For the public that articulates all of the verbal elements in the later mark, the marks are aurally similar to a lower degree.

### **Conceptual similarity**

62. The marks at issue both share the concept of the word 'stone' which has a clear and obvious meaning, albeit one which has no meaning or association to the goods or services concerned. The additional elements (particularly the strapline) in the applicant's mark convey a message that the goods concerned are long lasting tyres, however the more dominant element in the mark is the word 'TREADSTONE'. As the more dominant element in the later mark conveys, in part, the stone image, the marks at issue are found to be conceptually similar to a medium degree.

63. In conclusion, the marks are found to be visually similar to a medium degree, aurally similar to either a low or medium degree depending on the perception of the relevant public and conceptually similar to a medium degree.

### **Distinctive character of the earlier trade mark**

64. 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).”

65. The opponent has made no claim that its earlier EUTMs have acquired an enhanced degree of distinctive character. I must therefore assess the marks purely on their inherent distinctive character. The marks are comprised of the word ‘STONE’ in plain type face and in a fairly standard font.

66. ‘STONE’ has no particular link or association with the goods or services at issue. However, it is a fairly common English word. I find the earlier marks to have an average degree of inherent distinctive character.

### **Likelihood of Confusion**

67. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

68. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).

69. The visual differences between the marks at issue are clear and will be perceived immediately by the relevant public. The opponent's earlier EUTM's comprise the single plain word 'STONE', albeit one of those marks is not entirely standard typeface, whereas the applied for mark contains several verbal elements, in combination with a number of stylised and figurative elements. Therefore, in terms of direct confusion, I do not consider it likely that the average consumer will mistake the applicant's mark for the opponent's, even having found that some of the goods and services are identical, and even taking into account imperfect recollection.

70. Having found that there is no direct confusion between the marks, I must consider the possibility of indirect confusion.

71. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

"16. ...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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even

where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

72. These examples are not exhaustive, but provide helpful focus.

73. In the present case, the commonalities between the marks at issue lie in the word ‘STONE’.

74. In my comparison of the marks, I found the element ‘TREADSTONE’ to be the more dominant element in the applied for mark, due to its size and presentation.

75. In my opinion, the use of black and white rectangular backgrounds behind the words ‘TREAD’ and ‘STONE’ in the later mark, serve to clearly set these elements apart. Even though they may be read through, the perception of the words ‘TREAD’ and ‘STONE’ as individual verbal elements in the mark is immediate and obvious and one which catches the eye.

76. I note that the word ‘TREAD’ is meaningful and descriptive (or at the very least highly suggestive) in respect of the goods and services at issue. In support of this conclusion, it is noted that the list of applied for goods and services includes the terms ‘rubber treads for tires’ in class 12 and ‘retreading of tires’ in class 37.

77. Taking all of these considerations together, I find that the applied for mark will be considered as a brand extension or evolution of the opponent’s earlier ‘STONE’ marks (or vice versa) and, as a consequence, indirect confusion will occur. This is down to the combination of the primary point of difference (the word TREAD) being descriptive and the point of similarity (the word STONE) being a more arbitrary word, such that the combination would indicate to the average consumer that the

responsible undertakings are the same or related. This is certainly the case for the identical goods I have identified. In relation to the services, some of which have only a low degree of similarity to the goods, I come to the same view. Notwithstanding the interdependency principle (see paragraph 18(g)), the similarity between the marks, coupled with the relationship between the goods is still sufficient.

78. Consequently, the opposition partially succeeds under Section 5(2)(b) in respect of the opponent's two earlier EUTM's. The opposition succeeds in respect of all of the applied for goods in Class 12 which have been found to be identical or similar to the applicant's goods in the same class. The opposition is also successful against all of the applied for services in Class 37 and some of the services in class 35, namely:

**Class 35:** Electronic Retail and wholesale services connected with tyres, provided via a global computer network; Retail services connected with the sale of tyres; Retail and wholesale services in the field of vehicles tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with industrial tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with tyres, Retail services, retail store services, online retail store services and wholesale services relating to tyre, vehicle tires, tire accessories and parts; Wholesale services and retail services connect to wheels, tyres for vehicles.

79. The opposition fails in respect of those class 35 services that were found to be dissimilar to the opponent's goods, namely:

**Class 35:** Promotion services related to tyres; office functions; Organisation, operation and supervision of loyalty schemes and incentive schemes; Advertising services provided via the Internet; Radio and television advertising; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; Provision of business information; Advertising; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; On-line auctioneering services via the Internet; Advertising; Online advertisements; Advertising by mail order; Advertising analysis; Direct



marketing; Compilation of statistics relating to advertising; Computerized file management; Compilation of computer databases; Compilation of information into computer databases; Collating of data in computer databases; Systematization of information into computer databases; Advertising services relating to data bases; Management and compilation of computerized databases; Market research by means of a computer data base; Business management; Business administration; Clerical services; Direct mail advertising; Business management and organization consultancy; Document reproduction; Computerized file management; Web site traffic optimization; Organization of exhibitions for commercial or advertising purposes; On-line advertising on a computer network; Rental of advertising time on communication media; Publication of advertising literature; Presentation of goods and services; Rental of advertising space; Dissemination of advertising matter; Consultancy regarding advertising communications strategy; Public relations services; Consultancy regarding public relations communications strategy; Business auditing; Dissemination of advertisements; Dissemination of commercial information; Promotion and business mediation with regard to the purchase and sale and import and export of wheels, tyres and vehicle wheel rims; business management assistance; publicity.

80. I now move on to consider the matter in respect of the opponent's earlier EU designation of International Registration (IR) No. 1105946.

81. The opponent opposes the application on the basis of Section 5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act), on the basis of its earlier IR, for the following mark:

***BRIDGESTONE***

82. The opponent's IR was filed and registered on 27 July 2011 and claims a priority date of 23 February 2011.

83. The goods and services on which the opponent relies under the IR have been set out above in paragraph 7 of this decision.

84. The opponent has submitted evidence in support of a claim of enhanced distinctiveness and reputation. The summary of that evidence has been set out above, following paragraph 15.

## **Decision**

### **Section 5(2)(b) of the Act**

The legal principles have been established earlier, in paragraph 18 of this decision. I see no need to replicate them here.

### **Comparison of goods and services**

85. The application covers goods and services in classes 12, 35 and 37. The applied for goods and services are listed in full at the end of this decision in the annex.

86. The goods and services protected under the IR are:

**Class 12:** 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; 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.

**Class 35:** retail services or wholesale services for automobiles, tires and parts and fittings for automobiles.

**Class 37:** Repair and maintenance of automobiles and their parts; repair and maintenance of tires for automobiles; retreading of tires; repair and maintenance of two-wheeled motor vehicles and their parts; repair and maintenance of tires for two-wheeled motor vehicles; tire repair and recapping services.

87. In class 12, the applied for goods: Tyres for the wheels of forestry vehicles; Pneumatic tyres and inner tubes for motorcycles; Tubeless tires [tyres] for bicycles, cycles; Tubeless tyres for bicycles; Tubeless tyres for cycles; Tyres for agricultural vehicles; Solid rubber tyres for vehicle wheels; Spare tyre covers; Inner tubes for bicycle tyres; Tyres for bicycles, cycles; Cycle tires [tyres]; Bicycle tyres; Tyre repair outfits; Repair outfits for tyres; Non-skid devices for vehicle tires [tyres]; Tyres (Non-skid devices for vehicle -); Tyre casings; Casings for pneumatic tires [tyres]; Tyre cases; Tyre treads; Tyres for buses; Tyres for land vehicles; Treads for retreading tires [tyres]; Treads for retreading tyres; Wheels, tyres and continuous tracks; Rubber tread patterns for use in retreading vehicle tyres; Pneumatic tires [tyres]; Pneumatic tyres; Tyres for vehicle wheels; Wheel tyres (Vehicle -); Vehicle wheel tires [tyres]; Vehicle tyres; Tyres for trucks; Tyre treads of rubber; Tyres for aircraft; Retreaded tyres; Remoulded tyres; Patches for tyres; Patching materials for tyres; Tyre repair patches; Inner tubes for pneumatic tyres for vehicle wheels; Valves for vehicle tires [tyres]; Tyres for two-wheeled vehicles; Tyres for commercial vehicles; Inner tubes for pneumatic tires [tyres]; Inner tubes for pneumatic tyres; Tubular tyres; Covers for tyres; Tyres for motor vehicles; Tyres for automobiles; Tyres for motor vehicle wheels; Automobile tires [tyres]; Automobile tyres; Tyres for motorcycles;

Tyre mounts; Patching materials for inner tubes for tyres; Patches for inner tubes of tyres; Spikes for tires [tyres];Spikes for tyres; Solid tyres for vehicle wheels; Tyres, solid, for vehicle wheels; Wheels and tyres, and continuous tracks for vehicles; Automobile tires [tyres];Automobile wheels; Pneumatic tires [tyres];Remoulded tyres; Repair outfits for tyres; Retreaded tyres; Rubber patches for repairing vehicle tyres; Rubber tread patterns for use in retreading recycled tyres; Rubber tread patterns for use in retreading tyres; Rubber tread patterns for use in retreading vehicle tyres; Rubber treads for tires; Tire valves for vehicle tires; Tires for aircraft landing gear wheels; Tires [for automobiles];Tires for bicycles, cycles; Tires for children's bicycles; Tires for land vehicles; Tires for landing gear wheels of aircraft; Tires for two-wheeled motor vehicles; Tires for vehicle wheels; Tires for wheels of aircraft; Tires (Non-skid devices for vehicle -);Tires, solid, for vehicle wheels; Tyre grips; Tyre repair outfits; Tyre repair patches; Tyre treads; Tyres for automobiles; Tyres for bicycles, cycles; Tyres for buses; Tyres for commercial vehicles; Tyres for land vehicles; Tyres for motor vehicle wheels; Tyres for motor vehicles; Tyres for motorcycles; Tyres for the wheels of forestry vehicles; Tyres for trucks; Tyres for two-wheeled vehicles; Tyres for vehicle wheels; Tyres for wheelchairs; Tyres, solid, for vehicle wheels; Vehicle tires; Vehicle tyres; Vehicle wheel tires; Vehicle wheel tires [tyres];Vehicle wheels; Wheel hubs; Wheel hubs (Vehicle -);Wheel hubs (Vehicles -);Wheel tires (Vehicle -);Wheel tyres (Vehicle -);Wheels; Wheels and tyres, and continuous tracks for vehicles; Wheels being parts of bicycles; Wheels for automobiles; Wheels for bicycles, cycles; Wheels for motor vehicles; Wheels for motorcycles; Wheels for racing karts; Wheels for vehicles; Wheels, tyres and continuous tracks; Wheels (Vehicle -); are all tyres, wheels and parts and fittings of those goods, and repair products to be used on tyres, wheels and inner tubes.

88. All of the applied for goods are encompassed within the terms 'automobiles and their parts and fittings; tires for automobiles; retreaded tires for automobiles; inner tubes for automobiles; wheels and rims for automobiles; tread rubber for retreading tires; aircraft and their parts and fittings; tires and inner tubes for aircraft; tires for bicycles; bicycles and their parts and fittings; innertubes, wheels and rims for bicycles; four-wheeled go-carts; tricycles for infants; adhesive rubber patches for repairing tubes or tires; rubber patches for repairing vehicle tread'; which are protected under the class 12 specification of the opponent's IR. These goods are identical.

89. In class 35, the applied for services 'electronic Retail and wholesale services connected with tyres, provided via a global computer network; Retail services connected with the sale of tyres; Retail and wholesale services in the field of vehicles tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with industrial tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with tyres, Retail services, retail store services, online retail store services and wholesale services relating to tyre, vehicle tires, tire accessories and parts; Wholesale services and retail services connected to wheels, tyres for vehicles'; are all services wholly related to the retailing and wholesaling of vehicle wheels, tyres and their respective parts.

90. The class 35 element of the earlier IR covers 'retail services or wholesale services for automobiles, tires and parts and fittings for automobiles'. These services are identical to the applied for services listed above.

91. In class 35, the applied for services 'Promotion services related to tyres; promotion and business mediation with regard to the purchase and sale and import and export of wheels, tyres and vehicle wheel rims'; are all promotional and business services wholly related to the marketing of vehicle wheels, tyres and their respective parts. Whilst there is a link to the relevant goods provided by the opponent, namely 'tyres, wheels and vehicle wheel rims', promotional and business mediation services are technical, professional services provided by specialist companies and agencies who develop promotional materials and marketing strategies, but have no involvement in the production or retailing of the goods at issue.

92. The nature, purpose, channels of trade, use and end-user are all quite different with respect to 'promotion services related to tyres; promotion and business mediation with regard to the purchase and sale and import and export of wheels, tyres and vehicle wheel rims' and 'retail services or wholesale services for automobiles, tires and parts and fittings for automobiles'. These services are considered to be dissimilar.

93. The remaining class 35 services in the application, namely:

'office functions; Organisation, operation and supervision of loyalty schemes and incentive schemes; Advertising services provided via the Internet; Radio and television advertising; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; Provision of business information; Advertising; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; On-line auctioneering services via the Internet; Advertising; Online advertisements; Advertising by mail order; Advertising analysis; Direct marketing; Compilation of statistics relating to advertising; Computerized file management; Compilation of computer databases; Compilation of information into computer databases; Collating of data in computer databases; Systematization of information into computer databases; Advertising services relating to data bases; Management and compilation of computerized databases; Market research by means of a computer data base; Business management; Business administration; Clerical services; Direct mail advertising; Business management and organization consultancy; Document reproduction; Computerized file management; Web site traffic optimization; Organization of exhibitions for commercial or advertising purposes; On-line advertising on a computer network; Rental of advertising time on communication media; Publication of advertising literature; Rental of advertising space; Dissemination of advertising matter; Consultancy regarding advertising communications strategy; Public relations services; Consultancy regarding public relations communications strategy; Business auditing; Dissemination of advertisements; Dissemination of commercial information; business management assistance; publicity; Presentation of goods and services'.

are, broadly speaking, business services offering a range of services covering e.g. office functions and clerical services, advertising and computerized file management, to a consumer requiring assistance, consultancy and advice in business activities or in the promotion of an undertaking. These services are not restricted to any particular business sector, although they notionally encompass activities with a connection to vehicle wheels and tyres. There is no obvious link between nature and

use, channels of trade or end user. There is also no reason to find that a degree of complementarity may exist between these services. These services are considered to be dissimilar.

94. In class 37, the applied for services: 'Tyres (Vulcanization of -) [repair]; Retracking [alignment] of tyres; Tyre maintenance and repair; Regrooving of tyres; Tyre regrooving; Vehicle tyre fitting and repair; Tyre balancing; Replacement of tyres; Tyre fitting; Tyre repair; Retreading of tires [tyres]; Tyres (Retreading of -); Re-treading of tyres; Repair of tyres; Retreading of tyres' all cover the repair, maintenance, re-treading, re-tracking, regrooving, balancing and fitting of tyres.

95. The class 37 element of the opponent's IR covers 'Repair and maintenance of automobiles and their parts; repair and maintenance of tires for automobiles; retreading of tires; repair and maintenance of two-wheeled motor vehicles and their parts; repair and maintenance of tires for two-wheeled motor vehicles; tire repair and recapping services'. These services wholly encompass the services applied for in class 37 and therefore they are considered to be identical.

96. In conclusion, all of the class 12 goods applied for are found to be identical to the class 12 goods protected under the earlier IR. Some of the class 35 services applied for are found to be identical to the class 35 element of the IR and some are found to be dissimilar. All of the class 37 services applied for have been found to be identical to the class 37 services protected under the class 37 element of the IR.

#### **Average consumer and the purchasing act**

97. I have already considered the average consumer and the purchasing act earlier in this decision. As the goods and services at issue are, to all intents and purposes, the same as in my earlier assessment of the opponent's EUTMs, I will not repeat myself, other to affirm the conclusions I came to in paragraphs 49-54 above.

#### **Comparison of marks**

98. The opponent's earlier mark is the following:

# **BRIDGESTONE**

99. The applicant's mark is the following:



100. The opponent's mark is comprised of the word 'BRIDGESTONE' in a fairly standard bold typeface. The initial letter 'B' in the word is somewhat stylised and has what may be perceived as an arrow head or hook, placed within it. The overall impression in the mark lies in the totality of the word 'BRIDGESTONE', although the stylisation still plays a role, albeit a lesser one than the word itself.

101. An assessment of the applicant's mark has been made previously (see paragraph 57 above) and need not be repeated here.

### **Visual similarity**

102. Visually, the respective marks are similar in that both share the word 'STONE'. They differ in the typeface of the lettering in each mark and they differ in the stylisation and figurative elements in the applied for mark, namely the tyre design in the letters of the word 'TREAD', in the image of a tyre in the word 'STONE', in the word string 'More miles ... More smiles', presented in orange, in the use of a black rectangular background behind the word 'TREAD' and a white background behind the word 'STONE', and in the orange underlining of the word 'TREAD'. They also differ in the word 'BRIDGE' of the earlier mark and in the figurative design of the letter 'B' of that word. These marks are considered to be visually similar to only a low degree.



### **Aural similarity**

103. Aurally, the opponents' earlier mark will be enunciated as /BRIJ/STOHN/. For the part of the relevant public that would not enunciate the word string 'More Miles ... More Smiles', due to its size and placement in the applicant's mark, the later mark will be enunciated as /TRED/STOHN/. In that instance the marks can be said to be aurally similar to a medium degree. For the public that articulates all of the verbal elements in the later mark, the marks are aurally similar only to a low degree.

### **Conceptual similarity**

104. The marks at issue both share the concept of the word 'stone' which has a clear and obvious meaning, albeit one which has no meaning or association to the goods or services concerned. The additional elements (particularly the strapline) in the applicant's mark convey a message that the goods concerned are long lasting tyres, however the more dominant element in the mark is the word 'TREADSTONE'. As the more dominant element in the later mark conveys, in part, the stone image, the marks at issue are found to be conceptually similar to a medium degree.

105. In conclusion, the marks are found to be visually and conceptually low in similarity and either low or medium in aural similarity, depending on the possibility that the verbal element 'More Miles ... More Smiles' in the applicant's mark may or may not be articulated by the average consumer.

### **Distinctive character of the earlier trade mark**

106. 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).”

107. The word ‘BRIDGESTONE’ has no obvious link or association with the goods or services at issue. It cannot, however, be said that the mark, even with the stylisation present in the initial letter ‘B’ is sufficiently unusual to support a claim that inherently, it will be considered to be highly distinctive. I find the earlier mark to have a normal degree of inherent distinctive character. However, taking into account my findings regarding the evidence filed by the opponent, I have concluded that the opponent’s mark has acquired an enhanced degree of distinctiveness due to the use made of it prior to the date of filing of the application, particularly in relation to tyres.

### **Likelihood of Confusion**

108. Legal principles underlying an assessment of likelihood of confusion have been set out above in paragraphs 65, and so will not be repeated here.

109. At this point I refer to the written submissions of Mr Chester, on behalf of the opponent, dated 11 June 2018. I note the reference in that submission to the findings in the EUIPO Board of Appeal (Case R 2209/2010-1), in respect of the mark CURBSTONE and opposition to that mark by the opponent company. In that

decision, the EUIPO Board of Appeal found the mark CURBSTONE to be similar to the opponent's earlier BRIDGESTONE mark and rejected the application. I note this decision and have considered the findings carefully. Whilst of interest, I am not bound by this case. I also note reference to the opponent's action regarding the application for the mark AEROSTONE, and the decision of the General Court (Case T194/14). I have considered the conclusions in both of these cases very carefully.

110. The marks have been found to be visually and conceptually low in similarity. Aurally, where the relevant public would enunciate all of the verbal elements in the later mark, the marks are considered to be lowly similar. Where the relevant public would not place any emphasis on the strap line 'More Miles ... More Smiles' due to its size and presentation in the mark, but would articulate only the element 'TREADSTONE', the marks could be considered to be aurally similar to a medium degree.
111. The goods and services at issue in classes 12 and 37 have been found to be identical. The services at issue in class 35 have been found to be identical, similar and dissimilar.
112. Regardless of whether the average consumer would articulate the word string 'More Miles ... More Smiles' in the later mark, I find the visual differences between the earlier mark and the element 'TREADSTONE' in the later mark to be so clear and obvious that there is no likelihood of direct confusion. Once the additional figurative elements in the later mark and the word string 'More Miles ... More Smiles' are taken into account, the visual differences between the two marks at issue are quite striking and there is no likelihood that the average consumer, taking a normal or higher than normal degree of care and attention in its selection of the goods and services at issue, would directly confuse one of these marks as being the other.
113. With no likelihood of direct confusion occurring, I must consider the possibility of indirect confusion. As set out above in paragraph 70, Mr Purvis, acting as the Appointed Person, established useful guidance in the assessment of the likelihood of indirect confusion arising between two marks.

114. In this instance I do not believe that indirect confusion would occur between the marks at issue. The earlier mark will be perceived as the single verbal element 'Bridgestone'. The font and typeface used is consistent throughout the mark and subsequently there will be no visual distinction drawn between BRIDGE and STONE in the same way that I believe the element 'TREADSTONE' in the later mark will be. As I have found above in paragraph 57, the dominant element 'TREADSTONE' in the applicant's mark will be readily perceived as two words conjoined.

115. Both marks share the common element 'STONE', however the marks at issue must be assessed in their entireties. The fact that both marks share a component is not sufficient to find that the average consumer would be confused. Whilst a reputation in the earlier mark may give rise to a reminiscence on the part of the average consumer, this is not enough for that consumer to assume that the responsible undertakings are the same or related economically. This is so even in relation to the identical goods for which the opponent has a reputation; consequently, it is in no better position with regard to the other goods and services.

116. Therefore, the opposition in respect of EU designation of International Registration (IR) No. 1105946, on the grounds of Section 5(2)(b), fails.

117. The opponent also invoked Section 5(3) in respect of the earlier IR.

### **Section 5(3) of the Act**

Section 5(3) states:

“(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.”

118. I remind myself of the basis of the opponent's section 5(3) of the Act claim. The opponent states that it has a reputation in its EU designation of International Registration (IR) No. 1105946 in classes 12, 35 and 37.

119. The relevant date at which reputation must be proven is the date of the application, namely 16 May 2017.

120. 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 on 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*).

121. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its mark has a reputation. Secondly, it must be established that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the three types of damage (unfair advantage and detriment to distinctive character and repute) will occur. It is unnecessary for the purposes of section 5(3) that the goods 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. In this case, the goods at issue are identical, similar at least to some degree and dissimilar.

### **Reputation**

122. The first condition is reputation. In *General Motors*, Case C-375/97, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

123. His Honour Judge Hacon, in *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) stated “Reputation constitutes a knowledge threshold”. It is a question of how many of the potential consumer of the goods know of the earlier mark.

124. As stated earlier, the opponent has shown in evidence that the earlier IR has acquired a reputation at least in respect of tires. The evidence shows that its reputation is in the field of premium as opposed to budget tyres.

### Link

125. The list of factors set out by the CJEU in *Intel*, to be taken into account in determining whether there is a link, includes, as separate factors, the strength of the earlier mark’s reputation and the degree of distinctive character, whether inherent or acquired by use.

126. In *Intra-Press SAS v OHIM*<sup>4</sup> the CJEU stated that:

“72...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).”

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<sup>4</sup> *Joined cases C-581/13P & C-582/13P*



127. Accepting that the opponent possesses the requisite reputation, I find that the identity between the goods at issue and some of the services at issue, in combination with the 'STONE' suffix found in both marks, will lead the average consumer to bring to mind the earlier mark when faced with the applied for mark. However, and bearing in mind the reputation (primarily in relation to tyres) enjoyed by the opponent, this will only be the case for the glass 12 goods, the class 37 services and the retailing and wholesaling services in class 35.

128. As such I conclude that a link will be established between the marks by the relevant consumer in relation to certain of the applied for goods and services.

129. Consequently, I now go on to consider the rest of the ground.

130. Firstly, the pleading in relation to unfair advantage appears to be predicated on the basis of confusion. At paragraph 16 of its statement of case the opponent refers to the making of a link "...which could result in the consumer wrongly believing that the Applicant's goods and services originate from the Opponent, or there is some sort of economic affiliation between the parties when this is not the case". As I have found no likelihood of confusion, such unfair advantage will not arise. Secondly, the claim relating to tarnishing 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/services are of a lower quality. Neither is there anything inherent in the goods/services (some of which are in any event identical) that would have a negative impact upon the opponent's reputation.

131. Finally, in terms of dilution, the ability of BRIDGESTONE to distinguish its goods from those of others is not affected. The mark will continue to be as distinctive as it has been.

132. Even if I am wrong in my findings regarding the heads of damage, I bear in mind that the goods and services for which I have found a link are those for which the opponent has already succeeded in respect of its EUTMs and, as such, the

ground is, strictly speaking, academic. In relation to the remaining services for which the opposition has not succeeded thus far, I have found no link, but even if I am wrong on that then I still struggle to see why any of the heads of damage will arise in relation to those services.

133. The opposition, so far as it is based on Section 5(3) of the Act and in respect of the opponent's earlier IR, fails entirely.

### **Conclusion**

134. The opposition, so far as it is based on the opponent's earlier IR, is rejected entirely. The opposition, based on the opponent's earlier EUTM's and Section 5(2)(b), has succeeded in respect of all of the applied for goods in class 12 and all of the applied for services in class 37. The opposition has also been partially successful in respect of some of the applied for services in class 35, namely:

**Class 35:** Electronic Retail and wholesale services connected with tyres, provided via a global computer network; Retail services connected with the sale of tyres; Retail and wholesale services in the field of vehicles tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with industrial tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with tyres, Retail services, retail store services, online retail store services and wholesale services relating to tyre, vehicle tires, tire accessories and parts; Wholesale services and retail services connect to wheels, tyres for vehicles'

135. The opposition fails in respect of all of the remaining applicant's services in class 35 and the application can, subject to appeal, proceed to registration in respect of:

**Class 35:** Promotion services related to tyres; office functions; Organisation, operation and supervision of loyalty schemes and incentive schemes; Advertising services provided via the Internet; Radio and television

advertising; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; Provision of business information; Advertising; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; On-line auctioneering services via the Internet; Advertising; Online advertisements; Advertising by mail order; Advertising analysis; Direct marketing; Compilation of statistics relating to advertising; Computerized file management; Compilation of computer databases; Compilation of information into computer databases; Collating of data in computer databases; Systematization of information into computer databases; Advertising services relating to data bases; Management and compilation of computerized databases; Market research by means of a computer data base; Business management; Business administration; Clerical services; Direct mail advertising; Business management and organization consultancy; Document reproduction; Computerized file management; Web site traffic optimization; Organization of exhibitions for commercial or advertising purposes; On-line advertising on a computer network; Rental of advertising time on communication media; Publication of advertising literature; Presentation of goods and services; Rental of advertising space; Dissemination of advertising matter; Consultancy regarding advertising communications strategy; Public relations services; Consultancy regarding public relations communications strategy; Business auditing; Dissemination of advertisements; Dissemination of commercial information; Promotion and business mediation with regard to the purchase and sale and import and export of wheels, tyres and vehicle wheel rims; business management assistance; publicity.

### **Costs**

136. I have determined these proceedings largely in favour of the opponent. It is, therefore, entitled to an award of costs, although reduced slightly to take account of the partial nature of the success. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016, and I keep this in mind when awarding costs as follows:

Official fee for opposition	£200
Preparing a statement and considering the other side's statement	£300
Preparing evidence	£800
Total:	£1300

137. I therefore order GSR Trading Ltd to pay Bridgestone Corporation the sum of £1300. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 16<sup>th</sup> day of November 2018**

**Andrew Feldon  
For the Registrar  
The Comptroller-General**

# Annex

## Goods and services of the applicant:

**Class 12:** Tyres for the wheels of forestry vehicles; Pneumatic tyres and inner tubes for motorcycles; Tubeless tires [tyres] for bicycles, cycles; Tubeless tyres for bicycles; Tubeless tyres for cycles; Tyres for agricultural vehicles; Solid rubber tyres for vehicle wheels; Spare tyre covers; Inner tubes for bicycle tyres; Tyres for bicycles, cycles; Cycle tires [tyres];Bicycle tyres; Tyre repair outfits; Repair outfits for tyres; Non-skid devices for vehicle tires [tyres];Tyres (Non-skid devices for vehicle - );Tyre casings; Casings for pneumatic tires [tyres];Tyre cases; Tyre treads; Tyres for buses; Tyres for land vehicles; Treads for retreading tires [tyres];Treads for retreading tyres; Wheels, tyres and continuous tracks; Rubber tread patterns for use in retreading vehicle tyres; Pneumatic tires [tyres];Pneumatic tyres; Tyres for vehicle wheels; Wheel tyres (Vehicle -);Vehicle wheel tires [tyres];Vehicle tyres; Tyres for trucks; Tyre treads of rubber; Tyres for aircraft; Retreaded tyres; Remoulded tyres; Patches for tyres; Patching materials for tyres; Tyre repair patches; Inner tubes for pneumatic tyres for vehicle wheels; Valves for vehicle tires [tyres];Tyres for two-wheeled vehicles; Tyres for commercial vehicles; Inner tubes for pneumatic tires [tyres];Inner tubes for pneumatic tyres; Tubular tyres; Covers for tyres; Tyres for motor vehicles; Tyres for automobiles; Tyres for motor vehicle wheels; Automobile tires [tyres];Automobile tyres; Tyres for motorcycles; Tyre mounts; Patching materials for inner tubes for tyres; Patches for inner tubes of tyres; Spikes for tires [tyres];Spikes for tyres; Solid tyres for vehicle wheels; Tyres, solid, for vehicle wheels; Wheels and tyres, and continuous tracks for vehicles; Automobile tires [tyres];Automobile wheels; Pneumatic tires [tyres];Remoulded tyres; Repair outfits for tyres; Retreaded tyres; Rubber patches for repairing vehicle tyres; Rubber tread patterns for use in retreading recycled tyres; Rubber tread patterns for use in retreading tyres; Rubber tread patterns for use in retreading vehicle tyres; Rubber treads for tires; Tire valves for vehicle tires; Tires for aircraft landing gear wheels; Tires [for automobiles];Tires for bicycles, cycles; Tires for children's bicycles; Tires for land vehicles; Tires for landing gear wheels of aircraft; Tires for two-wheeled motor vehicles; Tires for vehicle wheels; Tires for wheels of aircraft; Tires (Non-skid

devices for vehicle -);Tires, solid, for vehicle wheels; Tyre grips; Tyre repair outfits; Tyre repair patches; Tyre treads; Tyres for automobiles; Tyres for bicycles, cycles; Tyres for buses; Tyres for commercial vehicles; Tyres for land vehicles; Tyres for motor vehicle wheels; Tyres for motor vehicles; Tyres for motorcycles; Tyres for the wheels of forestry vehicles; Tyres for trucks; Tyres for two-wheeled vehicles; Tyres for vehicle wheels; Tyres for wheelchairs; Tyres, solid, for vehicle wheels; Vehicle tires; Vehicle tyres; Vehicle wheel tires; Vehicle wheel tires [tyres];Vehicle wheels; Wheel hubs; Wheel hubs (Vehicle -);Wheel hubs (Vehicles -);Wheel tires (Vehicle -);Wheel tyres (Vehicle -);Wheels; Wheels and tyres, and continuous tracks for vehicles; Wheels being parts of bicycles; Wheels for automobiles; Wheels for bicycles, cycles; Wheels for motor vehicles; Wheels for motorcycles; Wheels for racing karts; Wheels for vehicles; Wheels, tyres and continuous tracks; Wheels (Vehicle -).

**Class 35:** Promotion services related to tyres; electronic Retail and wholesale services connected with tyres, provided via a global computer network; office functions; Organisation, operation and supervision of loyalty schemes and incentive schemes; Advertising services provided via the Internet; Radio and television advertising; Conducting, arranging and organizing trade shows and trade fairs for commercial and advertising purposes; Provision of business information; Retail services connected with the sale of tyres; Retail and wholesale services in the field of vehicles tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with industrial tires and solid tires, tyres, tires, automobile tyres, tyres for trucks; electronic shopping retail services connected with tyres, Retail services, retail store services, online retail store services and wholesale services relating to tyre, vehicle tires, tire accessories and parts; Advertising; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; On-line auctioneering services via the Internet; Advertising; Online advertisements; Advertising by mail order; Advertising analysis; Direct marketing; Compilation of statistics relating to advertising; Computerized file management; Compilation of computer databases; Compilation of information into computer databases; Collating of data in computer databases; Systematization of information into computer databases; Advertising services relating to data bases; Management and compilation

of computerized databases; Market research by means of a computer data base; Business management; Business administration; Clerical services; Direct mail advertising; Presentation of goods and services; Business management and organization consultancy; Document reproduction; Computerized file management; Web site traffic optimization; Organization of exhibitions for commercial or advertising purposes; On-line advertising on a computer network; Rental of advertising time on communication media; Publication of advertising literature; Rental of advertising space; Dissemination of advertising matter; Consultancy regarding advertising communications strategy; Public relations services; Consultancy regarding public relations communications strategy; Business auditing; Dissemination of advertisements; Dissemination of commercial information; promotion and business mediation with regard to the purchase and sale and import and export of wheels, tyres and vehicle wheel rims; Wholesale services and retail services connect to wheels, tyres for vehicles; business management assistance; publicity.

**Class 37:** Tyres (Vulcanization of -) [repair]; Retracking [alignment] of tyres; Tyre maintenance and repair; Regrooving of tyres; Tyre regrooving; Vehicle tyre fitting and repair; Tyre balancing; Replacement of tyres; Tyre fitting; Tyre repair; Retreading of tires [tyres]; Tyres (Retreading of -); Re-treading of tyres; Repair of tyres; Retreading of tyres.

**Goods and services of the opponent:**

**EUTM 013316203**

Class 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.

**EUTM 013316161**

Class 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.

**EU designation of International Registration (IR) No. 1105946**

**Class 12:** 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; 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.

**Class 35:** retail services or wholesale services for automobiles, tires and parts and fittings for automobiles.

**Class 37:** Repair and maintenance of automobiles and their parts; repair and maintenance of tires for automobiles; retreading of tires; repair and maintenance of two-wheeled motor vehicles and their parts; repair and maintenance of tires for two-wheeled motor vehicles; tire repair and recapping services.