

O-274-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2347844  
BY MARSHALLS MONO LIMITED  
TO REGISTER THE TRADE MARK  
FIRESTONE  
IN CLASS 19**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 92438  
BY BRIDGESTONE LICENSING SERVICES INC.**

## BACKGROUND

1) On 5 November 2003, Marshalls Mono Limited of Landscape House, Premier Way, Lowfields Business Park, Elland, West Yorkshire, HX5 9HT applied under the Trade Marks Act 1994 for registration of the trade mark “FIRESTONE” in respect of “Paving materials; paving and walling blocks and bricks; parts and fittings for all the aforesaid goods” in Class 19.

2) On 22 April 2004 Bridgestone Licensing Services Inc. of 535 Marriott Drive, Nashville, Tennessee, 37214, USA filed notice of opposition to the application. The ground of opposition is in summary:

a) The opponent is the proprietor of the following earlier trade marks:

Mark	Number	Effective Date	Class	Specification
<b>Firestone</b>	UK 2046378	24.11.95	19	Rubber roofing membrane.
			37	Roofing construction and repair services.
FIRESTONE	UK 370224A	15.11.15	12	Saddles for bicycles; air tubes for vehicle tyres; tyres, brake blocks, brake rubbers and brake linings, for land vehicles; all made from rubber or gutta-percha; rubber parts for vehicles; all included in class 12.
FIRESTONE	CTM 367946	04.10.96	7	Machine parts; spark plugs; fan belts for motors; actuators consisting of pneumatic rubber bellows for initiating and controlling the motion of mechanical apparatus.
			12	Vehicle wheels and rims therefor and their parts and accessories; transmissions and parts therefor; motors and engines for land vehicles and components thereof and parts therefor; vehicle tires, inner tubes for vehicle tires, tire accessories, tire repair parts, tire covers; rubber articles included in this class; pneumatic brake actuators for land vehicles and for aircraft.
			17	Rubber, gutta-percha, gum and goods made from these materials and not included in other classes; packing, stopping and insulating materials; flexible pipes, not of metal.
			19	Rubber roofing membrane, sealer and adhesive (sold as a unit).
			37	Roofing construction and repair services. Maintenance repair and cleaning of motor vehicles.
<b>Firestone</b>	CTM 368043	04.10.96	7	Machine parts; spark plugs; fan belts for motors; actuators consisting of pneumatic rubber bellows for initiating and controlling the motion of mechanical apparatus.

			12	Vehicle wheels and rims therefor and their parts and accessories; transmissions and parts therefor; motors and engines for land vehicles and components thereof and parts therefor; vehicle tires, inner tubes for vehicle tires, tire accessories, tire repair parts, tire covers; rubber articles included in this class; pneumatic brake actuators for land vehicles and for aircraft.
			17	Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
			19	Rubber roofing membrane, sealer and adhesive (sold as a unit).
			37	Roofing construction and repair services. Maintenance repair and cleaning of motor vehicles.

- b) The mark in suit is similar to the opponent's marks and the goods in Class 19, which the applicant is seeking to register its mark for, are similar to the goods in Class 19 and services in Class 37 of the opponent's marks.
- c) The opponent has made significant and substantial use of the above trade marks in relation to the goods specified in its registrations. In particular the opponent has acquired substantial goodwill and reputation in its trade marks with regard to goods in Classes 7, 12 & 17. The mark in suit offends against sections 5(2)(b) and 5(3) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the grounds of opposition but accepting that the opponent enjoyed substantial reputation and goodwill in the marks in relation to goods in Classes 7, 12 & 17.

4) Only the opponent filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard although both provided written submissions which I will refer to as relevant in my decision.

#### **OPPONENT'S EVIDENCE**

5) The opponent filed three witness statements. The first, dated 5 April 2005, is by Desmond Collins the Vice President, Sales & Marketing Europe for Bridgestone Europe NV/SA. He states that through his company subsidiary, Bridgestone UK Ltd, his company sells vehicle tyres in the UK under the Firestone trade mark. The use of the mark is under license from Bridgestone Licensing Services Inc.

6) Mr Collins states that between January 1997 and November 2003 sales of tyres under the Firestone mark in the UK totalled in excess of £214 million, a figure which he claims should be increased by 40% to arrive at the retail sales value. These sales have taken place throughout the UK. During this same period he states that the

opponent spent over £6 million promoting and advertising the products via Yellow Pages, trade newspapers and London Buses. He provides examples of these at exhibit DC1. At exhibit DC2 he provides copies of four invoices to customers for Firestone tyres, although only two mention the mark. At exhibit DC3 he provides copies of catalogues from 1999 and 2000 for merchandising items which bear the mark Firestone. Lastly at exhibit DC4 he provides examples of brochures and other literature published for the promotion of Firestone tyres.

7) The second witness statement, dated 13 April 2005, is by James Cave the Manager (UK and Ireland) of Firestone Building Products Europe. He states that his company uses the mark FIRESTONE under license from Bridgestone Licensing Services Inc. He states that his field is in relation to EPDM Rubber Roofing and associated accessories. Mr Cave states that sales and expenditure on promotions in the UK have been as follows:

Year	Sales £	Promotion £
2000	1,139,044	18,609
2001	1,074,431	39,282
2002	1,001,478	15,562
2003	877,225	17,944
2004	1,401,311	26,150

8) Mr Cave states that the mark is used throughout the UK. At exhibit JC1 he provides copies of PR articles relating to the Firestone roofing business and promoting the trade mark which are taken from 1999 which he states represents a typical year for such activities. These items describe usage of the opponent's "Rubberguard EPDM single ply roofing". At exhibit JC2 he provides copies of advertisements featuring the Firestone mark which have appeared in publications. The earliest is dated 1991 whilst others are after the relevant date. All refer to the "Firestone Rubberguard" system. At exhibit JC3 he provides examples of brochures issued in 1999 and also a copy of the Firestone EPDM Roofing Systems Pocket Guide issued in the same year. These all feature the Firestone mark prominently.

9) Mr Cave states that periodically his company has published a newsletter which is circulated to the organisations customers. At exhibit JC4 he provides copies of the first seven issues of Firestone Building Products Europe News which features the Firestone mark prominently. These date from September 1996-January 2003. At exhibit JC5 he also provides a selection of prints from the web site run by his company which features the Firestone mark. All of the exhibits show use of the mark "Firestone" both in plain letters, block capitals and in the slightly stylised versions used in two of the marks relied upon by the opponent in this opposition. The main product referred to in all the literature is the "Rubberguard EPDM" system of roofing using a membrane. Other products featured referred to items to be used with the membrane such as flashing etc. The product is shown being used on several large scale projects such as factories, schools, hospitals, museums and hotels. In issue 7 (in exhibit JC4) dated January 2003, there is a mention of the residential roofing market. It states that at this date there are four distributors in the UK of the product for use on residential roofs. These distributors will, it states carry out training sessions with roofing contractors.

10) The third witness statement, dated 13 April 2005, is by John M Vasuta the Chief Intellectual Property Counsel for Bridgestone Americas and Attorney for the parent company Bridgestone Corporation. He states that the mark “Firestone” has been used for over a century. At exhibit JMV1 he provides a copy of a book “Firestone: A Legend. A Century. A Celebration.”. This book shows that in addition to tyres the company has made a number of products, mostly, but not exclusively from rubber. Amongst the non-rubber items which stand out are missiles, anti-aircraft guns and garden rakes. Mr Vasuta states that the opposition is based on four registered marks and at exhibit JMV2 he provides print outs detailing the marks. This information is the same as that shown in paragraph 2 above.

11) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

12) I will first consider the ground of opposition under Section 5(2)(b) which reads:

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

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

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

13) An “earlier trade mark” is defined in Section 6, the relevant parts of which state:

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

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

14) The opponent’s four trade marks have effective dates ranging between 15 November 1915 and 4 October 1996 and are plainly “earlier trade marks”.

15) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* ;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG*;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG*;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG*;

(h) further, 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; *Marca Mode CV v Adidas AG*;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*.

16) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's marks on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

17) The opponent's marks are inherently distinctive when used on the goods and services for which they are registered. However, I must also consider the use of the marks and consider whether the marks have acquired distinctiveness as a result of this use. The applicant accepts that the opponent's marks enjoy substantial reputation and

goodwill in respect of rubber products, particularly tyres. The opponent has provided sales figures for its tyres sold in the UK. Although not providing market share I am prepared to accept that the average consumer of tyres, those who have a valid driving license, would know the opponent's trade marks. They also provided figures for sales of its roofing products which averaged just over £1million per annum. However, the opponent provided no evidence of market share or the extent of the market for rubber roofing or roofing products in general. Nor was it clear if the product was sold only to roofing contractors or was more widely available to the DIY market. Therefore I do not accept that the opponent's trade marks have acquired a reputation in relation to rubber roofing or roofing products in general.

18) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

19) I now turn to the comparison of the specifications of the two parties and take into account the factors referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. 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 end users and their method of use and whether they are in competition with each other or are complementary.”

20) The opponent, in its statement of grounds claimed that the goods sought to be registered were similar to the goods and services it has registered in Classes 19 & 37. For ease of reference the relevant parts of the two parties specifications are reproduced below:

Opponent's specifications		Applicant's specification
2046378	Class 19: Rubber roofing membrane	Class 19: Paving materials; paving and walling blocks and bricks; parts and fittings for all the aforesaid goods
367946 & 368043	Class 19: Rubber roofing membrane, sealer and adhesive (sold as a unit).	
2046378	Class 37: Roofing construction and repair services.	
367946 & 368043	Class 37: Roofing construction and repair services. Maintenance repair and cleaning of motor vehicles.	

21) The opponent contends that its products would be sold through the same trade channels and to the same type of consumer. They claim that "Paving and roofing will go hand in hand in relation to building and development and such products should be regarded as being similar". Whilst I accept that builders merchants will sell general roofing products as well as bricks, blocks and paving materials it has not been established that the opponent's product is sold via these channels. In the evidence it is stated that in January 2003 there were four distributors of the product in the UK dealing with the domestic or residential market as opposed to the commercial market. The opponent's evidence states that its distributors will carry out training of roofing contractors which suggests that its product is aimed at a specific type of consumer (the roofing contractor) rather than the average consumer of building products such as general builders and the DIY market. However, even if I were to accept that the product was stocked by the average builders merchants it does not follow that the average consumer of roofing products also will purchase the applicant's products.

22) The uses of the products of the two parties can be said to be similar in that they are both used on buildings, but this is far too unspecific. To my mind the uses are quite different. They cannot be said to always be complementary as if paving materials are purchased it does not follow that roofing products will also be required. The same could be said with regard to the other products in the applicant's specification. Nor are they in competition. To my mind the goods of the two parties products are not similar and nor for the same reasons are the opponent's services similar to the applicant's goods.

23) I now turn to the marks of the two parties which are "Firestone" and "Firedstone". In making the comparison between the marks of the two parties I am regarding the opponent's mark as the single word in normal type as I do not believe that the slightly gothic script used in two of the marks alters the fundamental distinctive element of the mark. Clearly, the marks are similar in that they are different only in so far as the applicant's mark contains in its middle the letter "d". This does emphasise that the mark is the two words "Fired" and "Stone" conjoined. The applicant's mark alludes to the fact that the products are, traditionally, stone based mixtures which have been heated or fired. However, the marks are similar.

24) I have regard to the comments of Mr Hobbs Q.C. sitting as the Appointed Person in *Raleigh International* (BL O/253/00) where he stated:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences.”

25) Although the marks are similar, to my mind this is not enough to overcome the differences between the goods and services of the two parties. I would not discount the possibility that some consumers may, on seeing the applicant’s trade mark in use call to mind the opponent’s earlier trade marks. This is not sufficient for a finding of confusion under section 5(2) (*Sabel v Puma*). The requirements of section 5(2) require a likelihood of confusion or an association in that the public wrongly believe that the respective goods and services come from the same or economically linked undertakings. Mere association in the sense that the later mark brings the earlier trade mark to mind is not sufficient for the purpose of section 5(2)(b). Therefore the ground of opposition under section 5(2)(b) is not made out. In so finding, I note the guidance of the ECJ in *Marca Mode* where the ECJ found that the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association.

26) I now turn to the ground of opposition under Section 5(3), which in its original form reads:

"5-(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

27) By virtue of regulation 7 of the Trade Mark (Proof of Use, etc) Regulations 2004, Section 5(3)(b) has now been repealed. The equivalent provision in Section 10 of the Act dealing with infringement has also been amended. As the explanatory note indicates:

"These amendments implement the decision of the European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* of 9th January 2003 (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* of 23rd October 2003 (C-408/01). Those decisions determined that Article 5(2) of the Directive, which on the face of it, grants a right to the proprietor of a trade mark to prevent third parties from using an identical or similar trade mark in relation to goods or

services which are *not similar* where the earlier trade mark has a reputation and use of that sign takes unfair advantage or is detrimental to the distinctive character of that earlier trade mark, also applies to goods or services which are similar or identical to those for which the earlier trade mark is registered."

28) Notwithstanding the broader interpretation of Section 5(3) (Article 5(2)) that has now been confirmed by the ECJ, the opponent's claim here is based on the fact that the respective goods and services are dissimilar.

29) I note the following based on the *Rare trade mark* case (BL O/470/01), the purpose and scope of Section 5(3) of the Act being considered in *General Motors Corp. v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bh's TM Application (Visa)* [2000] RPC 484 and *Davidoff & Cie SA v Gofkid Ltd (Davidoff)* [2003] ETMR 42. The points that come out of these case are as follows:

- a) "Reputation" for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned by the products and services covered by that trade mark (paragraph 26 of the ECJ's judgement in *Chevy*);
- b) Protection is available where the respective goods or services are similar or not similar (paragraph 29 of the Advocate General's opinion in *Chevy* and *Davidoff*);
- c) The provision is not intended to give marks "an unduly extensive protection" – there must be actual detriment or unfair advantage (not merely risks) which must be substantiated to the satisfaction of the national court or tribunal (paragraph 43 of the Advocate General's opinion in *Chevy* and paragraph 88 of Pumfrey J's judgment in the *Merc* case);
- d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J in the *Typhoon* case);
- e) The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (paragraph 30 of the ECJ's judgment in the *Chevy* case);
- f) Confusion as to the trade source of the goods or services offered for sale under the later mark is not a necessary condition before there can be detriment; but is one form of detriment (paragraph 88 of Pumfrey J's judgment in the *Merc* Case);
- g) Detriment can take the form of either making the earlier mark less attractive (tarnishing) or less distinctive (blurring) (paragraph 88 of Pumfrey J's judgment in the *Merc* Case);

h) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in *Visa* at page 505. lines 10-17).

30) In the present case it is accepted that the opponent enjoys substantial reputation and goodwill in respect of rubber products, particularly tyres and I accept that the opponent's "FIRESTONE" mark is known by a significant part of the public concerned given the size of the potential market for such goods.

31) The opponent contends that:

"Having established that the opponent enjoys a trade mark with a reputation, we believe that it would follow that the adoption of a mark which is practically identical to that registration would take unfair advantage of, or be detrimental to the distinctive character or the repute of that trade mark". And

"The applicants sign is really very similar so the public will either consider that the goods are associated with the opponent in this case thereby taking an unfair advantage of the opponents mark or there will be detriment in their minds to the distinctive character of the opponents mark. Even if we are wrong about this and the public are not actually confused, the use of the sign by the applicant would be likely to have that effect. There has been no evidence submitted on behalf of the applicant that the use of its mark is with due cause."

32) I note the following comment from Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) in *Electrocoin Automatics Limited and Coinworld Limited and Others* [2004] EWCH 1498 (Ch):

" 102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, 'the link' established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose."

33) It seems to me that the opponent has singularly failed to show that the use of the mark in suit on the goods which are dissimilar to its own would cause detriment. I believe that this is a case where use of the mark in suit on items such as "paving, bricks and blocks" will not call to mind the opponent's marks and its reputation for tyres and rubber goods. However, even if the opponent's marks were called to mind I do not believe that it will affect the consumers economic behaviour or damage the opponent's marks by tarnishing or blurring. The opposition under Section 5(3) of the Act fails.

34) As the applicant has been successful it is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12<sup>th</sup> day of October 2005**

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