

Intellectual Property Office of Singapore Case Summary: Bridgestone Corporation and Bridgestone Licensing Services, Inc. v Deestone Limited [2018] SGIPOS 5

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The First Opponent (Bridgestone Corporation) is the owner of the “**BRIDGESTONE**” trade mark, registered in respect of a wide range of goods and services in Singapore, including “Tires and tubes, vehicle wheels, bicycles and their parts” (in Class 12). The Second Opponent (Bridgestone Licensing Services, Inc.), a wholly owned subsidiary of the First Opponent, is the owner of the “**FIRESTONE**” trade mark registered in Singapore in respect of “Tyres included in Class 12”.

Deestone Limited (“the Applicant”), a company incorporated in Thailand in 1978, applied on 3 February 2015 to register **DEESTONE**

“**DEESTONE**” (as a series of two marks) in Class 12 for “Automobile tires; Motorcycle tires; Bicycle tires” and various other goods (“the Application Mark”).

The First Opponent and the Second Opponent (collectively, “the Opponents”) opposed the registration of the Application Mark. The Opponents relied on four grounds under the Trade Marks Act (Cap. 332, Rev Ed 2005), namely: (a) Section 8(2)(b); (b) Section 8(4)(b)(i); (c) Section 8(4)(b)(ii)(B); and (d) Section 8(7)(a).

Family of STONE marks

The Opponents tried to argue that **BRIDGESTONE** and **FIRESTONE** constitute a family of STONE marks. The family of marks doctrine is important because it provides that where another party also applies for registration of a mark incorporating the common characteristic of that family, the public may assume that the new mark originates from the same undertaking as an addition to the family of marks, and be confused or deceived if that is not the case.

The Hearing Officer held that while the marks were owned by two separate legal entities, this was not necessarily fatal to the Opponents’ case that they owned a family of marks. As corporate family members could be regarded as a single source to consumers, it was not necessary for trade marks to be owned by the same legal entity in order to be protected as a family of marks. However, the Hearing Officer found that the Opponents’ evidence tendered in this case fell short of supporting a finding that **BRIDGESTONE** and **FIRESTONE** were used and recognised by consumers as a family of marks. The evidence showed that **BRIDGESTONE** and **FIRESTONE** had been used and promoted as separate and independent brands. Further, no evidence was adduced to show that there were attempts to educate consumers that the two brands come from the same corporate family.

Distinctiveness

The Hearing Officer found that the distinctiveness of **BRIDGESTONE** and **FIRESTONE** lay in the marks as wholes; the average consumer’s overall impression of either of the marks would not be materially dominated by any one or more of its components. The marks must therefore be compared to the Application Mark as wholes without giving special regard to any particular element.

As for the Application Mark **DEESTONE**, which consists of a single word with letters of equal size and prominence, the Hearing Officer found that both elements (i.e. “DEE” and “STONE”) equally contribute to the overall impression of the mark.

Similarity of marks

When compared as wholes, the Hearing Officer found that **DEESTONE** was visually more dissimilar than similar to either of the Opponents’ marks. **DEESTONE** has a very different beginning from **BRIDGESTONE** and **FIRESTONE**, and that was not something that would be easily missed when the marks are seen. On aural similarity, the Hearing Officer also found that the Application Mark was aurally more dissimilar than similar to the Opponents’ marks. Whilst the last syllable of the marks is identical in sound, there is no question that the marks have striking phonetic differences at the beginning. The fact that the first sound to hit the ear is the component that is different also meant that they are not likely to go unnoticed. Conceptually, it was found that the competing marks were not conceptually similar. **BRIDGESTONE** and **DEESTONE** are not conceptually similar as they are both words which have no meaning as wholes. As for **FIRESTONE** (a stone that can withstand fire and great heat, used especially for lining furnaces and ovens), it also has no similarity to **DEESTONE** which has no meaning.

Overall, the Hearing Officer concluded that the Application Mark was more dissimilar rather than similar to either of the Opponents’ marks.

As marks-similarity is a necessary requirement for all the grounds of opposition, the fact that the Application Mark was found to be more dissimilar than similar to the Opponents' marks meant that the opposition failed on all grounds.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2018/bridgestone-corporation-and-bridgestone-licensing-services-v-deestone-2018-sqipos-5.pdf?sfvrsn=0>.