

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark No. 40201501932U

Hearing Date: 9 January 2018

IN THE MATTER OF TRADE MARK APPLICATION BY

DEESTONE LIMITED

AND

OPPOSITION THERETO BY

**BRIDGESTONE CORPORATION AND BRIDGESTONE LICENSING
SERVICES, INC.**

Hearing Officer: Ms Tan Mei Lin
Principal Assistant Registrar of Trade Marks

Representation:

Mrs Murgiana Haq and Ms Ferzana Haq (hslegal LLP) for the Applicant

Mr Lim Ren Jun and Mr Kong Xie Shern (Wong & Leow LLC) for the Opponents

GROUND OF DECISION

Introduction

1 A family of marks is a group of marks (e.g. McChicken, McNuggets, McMuffin) sharing a common characteristic (e.g. Mc) which have been used in such a way that the public associates not only the individual marks, but the common characteristic of that group of marks, with the trade mark owner (e.g. McDonalds Corp). 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 case¹. This case raises some interesting issues pertaining to the doctrine of family of marks such as whether it may be said that there exists a family of marks when the marks are not owned by the same entity and what needs to be proven in order to qualify for protection as a family of marks. Is mere use sufficient?

2 Deestone Limited (“the Applicant”) applied to register the following trade mark in Singapore:

Trade Mark No.	Trade Mark	Application Date	Class No.	Specification
40201501932U (the “Application Mark”)	 	3 February 2015 (the “Application Date”)	12	Automobile tires; Motorcycle tires; Bicycle tires; Inner tubes for automobile tires; Inner tubes for motorcycle tires; Inner tubes for bicycle tires; Automobile wheel covers.

4 The application was accepted and published on 5 June 2015 for opposition purposes. Bridgestone Corporation (“the First Opponent”) and Bridgestone Licensing Services, Inc. (“the Second Opponent”), collectively “the Opponents”, jointly filed their Notice of Opposition to oppose the registration of the Application Mark on 29 July 2015. On 27 November 2015, the Applicant filed its Counter-Statement.

5 The Opponents filed evidence in support of the opposition on 12 October 2016. The Applicant filed evidence in support of the application on 10 November 2016. The Opponents filed evidence in reply on 8 February 2017. Following the close of evidence, the Pre-Hearing Review was held on 6 March 2017, where leave was granted to the Opponents to file supplementary evidence. The Opponents filed their supplementary evidence on 6 April 2017. On 7 June 2017, leave was granted to the Applicant to file evidence in reply to the Opponents’ supplementary evidence, which it did on 6 July 2017. Leave was also granted to the Opponents to reply to the Applicant’s evidence in reply and this was filed by the Opponents on 9 October 2017. The Opponents and the Applicant both filed their written submissions (respectively, “Opponents’ Written Submissions” and “Applicant’s Written Submissions”) on 11 December 2017. The opposition was heard on 9 January 2018.

Grounds of Opposition

6 The Opponents rely on the following grounds in this opposition:

- (a) Section 8(2)(b);

¹ IPOS Trade Marks Registry’s Trade Mark Work Manual (Version 5 of June 2017), Chapter 7, Relative Grounds for Refusal of Registration, page 39.

- (b) Section 8(4)(a) read with 8(4)(b)(i);
- (c) Section 8(4)(b)(ii)(B); and
- (d) Section 8(7)(a),

of the Trade Marks Act (Cap. 332, Rev. Ed. 2005) (“the Act”).

7 Although Section 8(4)(b)(ii)(A) of the Act was initially pleaded, the Opponents indicated in the Opponents’ Written Submissions that they were not proceeding with it.

Opponent’s Evidence

8 The Opponents’ evidence comprises the following:

- (a) A Statutory Declaration made by Mitsuru Araki, Director of Bridgestone Corporation, dated 7 October 2016 (“the Opponents’ 1st SD”);
- (b) A Statutory Declaration in Reply made by the same Mitsuru Araki dated 6 February 2017 (“the Opponents’ 2nd SD”);
- (c) A Supplementary Statutory Declaration made by the same Mitsuru Araki dated 4 April 2017 (“the Opponents’ 3rd SD”); and
- (d) A Further Statutory Declaration in Reply made by Michinobu Matsumoto, General Manager of Bridgestone Corporation and the Vice-President of Bridgestone Licensing Services, Inc., dated 2 October 2017 (“the Opponents’ 4th SD”).

Applicant’s Evidence

9 The Applicant’s evidence comprises the following:

- (a) A Statutory Declaration made by Krirk Wongsariyawanich, Managing Director of the Applicant, dated 19 October 2016 (“the Applicant’s 1st SD”);
- (b) A Statutory Declaration made by Teng Kin Lan, Manager of HLH Tyre Pte Ltd, dated 27 October 2016 (“the Applicant’s 2nd SD”); and
- (c) A Statutory Declaration in Reply made by the same Krirk Wongsariyawanich dated 15 June 2017 (“the Applicant’s 3rd SD”).

Applicable Law and Burden of Proof

10 As the applicable law is the Act, there is no overall onus on the Applicant either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponents.

Background

11 The First Opponent, Bridgestone Corporation, is a multinational auto and truck parts manufacturer based in Japan. It was founded more than 80 years ago in 1931 as Bridgestone Tyre Co., Ltd and changed its name to Bridgestone Corporation in 1984. It is the registered proprietor of the following registered trade marks in Singapore:

Trade Mark No.	Trade Mark	Application Date	Class No.	Specification in Class 12
T8403927G	BRIDGESTONE	24 July 1984	12	Tires and tubes, vehicle wheels, bicycles and their parts.
T1202431A	BRIDGESTONE	27 July 2011	1, 6, 7, 9, 12, 17, 18, 19, 20, 24, 25, 28, 35, 37	Automobiles and their parts and fittings; tires for passenger cars; tires for trucks; tires for buses; tires for racing cars; tires for automobiles; retreaded tires for passenger cars; retreaded tires for trucks; retreaded tires for buses; retreaded tires for racing cars; retreaded tires; retreaded tires for automobiles; inner tubes for passenger cars; inner tubes for trucks; inner tubes for buses; inner tubes for racing cars; inner tubes for automobiles; wheels and rims for passenger cars; wheels and rims for trucks; wheels and rims for buses; wheels and rims for racing cars; wheels and rims for automobiles; tread rubber for retreading tires for the above-mentioned vehicles; two-wheeled motor vehicles and their parts and fittings; tires for two-wheeled motor vehicles; inner tubes for two-wheeled motor vehicles; wheels and rims for two-wheeled motor vehicles; bicycles and their parts and fittings; tires for bicycles; inner tubes for bicycles; wheels and rims for bicycles; aircraft and their parts and fittings; tires and inner tubes for aircraft; adhesive rubber patches for repairing tubes or tires; tread rubber for retreading tires for two-wheeled motor vehicles or bicycles; tread rubber for retreading tires for aircraft; tread used to retread tires for tires of automobiles, two-wheeled motor vehicles,

Trade Mark No.	Trade Mark	Application Date	Class No.	Specification in Class 12
				bicycles, aircrafts and the aforementioned vehicles; preformed tire treads for tires of automobiles, two-wheeled motor vehicles, bicycles, aircrafts and the aforementioned vehicles; rubber patches for repairing the aforementioned vehicle tire tread; shock absorbers (for land vehicles); air springs for land vehicles; shaft couplings or connectors (for land vehicles); fenders for vessels (boat side protectors); seat cushions for vehicles; air springs for railway cars; vehicle bumpers; suspension shock absorbers for vehicles; suspension springs for vehicles; four-wheeled go-carts; tricycles for infants; tires for off-the-road automobiles, two-wheeled motor vehicles and bicycles; tires for scrapers; tires for motor graders; tires for shovel loaders; tires for tire rollers; tires for wheeled cranes; tires for cranes; tires for snow plows; tires for pavers; tires for mining machinery.

(collectively, “the Bridgestone Mark”).

12 In 1988, the First Opponent purchased a company known as The Firestone Tire & Rubber Company which owned the following registered trade mark in Singapore:

Trade Mark No.	Trade Mark	Application Date	Class No.	Specification
T4707798E	FIRESTONE	1 April 1947	12	Tyres included in Class 12

(“the Firestone Mark”).

13 The Firestone Tire & Rubber Company changed its name to Bridgestone/Firestone Inc in 1990 and the Firestone Mark was recorded as being owned by Bridgestone/Firestone Inc. In 2001, the Firestone Mark was assigned by Bridgestone/Firestone Inc to the Second Opponent, Bridgestone Licensing Services, Inc., a company incorporated in the United States of America in 2001, for the main purpose of managing the Firestone trade mark. The Second Opponent is a wholly owned subsidiary of the First Opponent and the current registered proprietor of the Firestone Mark.

14 The Bridgestone Mark and the Firestone Mark, which the Opponents have defined collectively as the “STONE marks” are relied upon as the earlier trade marks in this case. It is also the Opponents’ case that the earlier trade marks form a family of STONE marks. This was strongly disputed by the Applicant and will be dealt with in more detail below.

The Opponents and their operations in Singapore

15 The First Opponent is a manufacturer of tyre and rubber products with a business presence in more than 150 countries, including Singapore. It is often ranked as the world's largest tyre and rubber company. As of October 2016, the First Opponent has major tyre manufacturing plants in over 26 countries in the world including over 180 manufacturing plants and R&D facilities.

16 The tyre business accounts for about 80% of the First Opponent's group sales. In addition to the manufacture of tyre products, the First Opponent's operations also include the design, manufacture, marketing and sales of a broad range of industrial and consumer products and services. This includes diversified products such as automotive components, parts and materials for electronic equipment, bicycles and sporting goods.

17 The First Opponent has obtained several global awards and recognition. Examples of recent accolades received by the First Opponent are:

- (a) Listed by Global Tire Company Rankings as having the top tyre sales figure worldwide for three years from 2013 - 2015 holding a tyre sales figure of USD 26 billion;
- (b) Listed by Forbes as a Fortune 500 company in 2015 with revenue of over USD 37 billion and profits of over USD 2.8 billion;
- (c) Recognised by General Motors as the 2015 Supplier of The Year;
- (d) Earned recognition as a Partner-level supplier for 2015 in the John Deere & Company Achieving Excellent Program. This is the highest supplier rating which recognises the First Opponent's dedication to providing products and services of outstanding quality, and its commitment to continuous improvement; and
- (e) Received an Environmental Award from Honda Motor Co. Ltd in February 2016 which is presented to Honda Motor suppliers that perform remarkable initiatives in certain fields, including quality.

18 The First Opponent has three subsidiaries in Singapore. They are:

- (a) Bridgestone Asia Pacific Pte Ltd, incorporated on 10 July 2006;
- (b) Bridgestone Tyre Sales Singapore Pte Ltd, incorporated on 17 February 2001; and
- (c) Bridgestone Singapore Pte Ltd, incorporated on 1 October 1919 as Bridgestone/Firestone Singapore Pte Ltd,

(collectively known as "Bridgestone Singapore").

19 The Bridgestone Mark and the Firestone Mark have been used in Singapore since 1984 and 1947 respectively. As of October 2016, Bridgestone Singapore has authorised dealers in

over 85 locations in Singapore. As for tyres bearing the Firestone mark, they are solely distributed by Binter & Co. Pte Ltd, a company incorporated in Singapore with over 101 authorised dealers in Singapore.

20 The revenue of the Opponents as reflected in Bridgestone Tyre Sales Singapore Pte Ltd.'s Directors' Statement and Financial Statements is as follows²:

Year	Revenue (USD)
2012	37.36 million
2013	38.28 million
2014	33.91 million
2015	28.65 million

However, it is not clear if the sales figures are solely attributable to the sale of "Bridgestone" tyres or also include revenue from the sale of other goods and services offered by the Opponents. Furthermore, it is also not clear if the sales figures relate to sales in Singapore only.

21 The Opponents state that their "*Singapore-specific advertising figures*" are as follows³:

Year	Advertising Expenses (USD)
2012	263,739.47
2013	185,329.19
2014	180,250.97
2015	167,220.42

22 In support of their use of the STONE marks in Singapore, the Opponents produced some sample invoices showing the "*import and export of goods bearing the STONE marks*"⁴ but I note that they relate only to the Bridgestone Mark. Furthermore, the goods concerned in the invoices do not appear to be imported into, or exported from, Singapore. They were exported from Japan and bound for other overseas markets and not Singapore. As such, the exact extent of use of the STONE marks in Singapore is not clear on the face of the evidence.

23 The Opponents further state that they have advertised their goods and services via various means, including media advertising, online advertising, product placements, press advertising, billboard and mobile billboard advertising, in-store advertising, outdoor advertising and sponsored events. Sample advertising materials were produced⁵. However, similar to the sample invoices, they appear to relate only to the Bridgestone Mark. Furthermore, many of the advertising materials were for the period after the Application Date.

24 The Opponents also submitted extracts obtained from various Singapore-based car forums showing consumers discussing about the performance of "Firestone" and "Bridgestone" tyres. These show that tyres bearing the STONE marks are available in Singapore and that consumers in Singapore are aware of the STONE marks.

² Opponents' 1st SD at [25].

³ Opponents' 1st SD at [25].

⁴ Opponents' 1st SD at [25] and MA-18 of Opponents' 1st SD.

⁵ Opponents' 1st SD at [26] and MA-19 of Opponents' 1st SD.

The Applicant

25 The Applicant is a company incorporated in Thailand in 1978 and its main line of business is the production of tyres. While maintaining its headquarters, operations and manufacturing facilities in Thailand, the Applicant has also expanded its business into the rest of Asia, the Middle East, the USA, South America and Europe. The Applicant currently has approximately 396 distributors worldwide.

26 The Applicant first began exporting its tyres to Singapore under the Application Mark in 2008. As such, there has been about 7 years of use in Singapore before the Application Date.

27 The Applicant's overall sales revenue in Singapore for each year commencing 2009 up to 2014 and between January and July 2015 is set out below:

Year	Revenue (USD)
2009	2,564,032.15
2010	3,961,105.25
2011	4,230,005.24
2012	3,105,699.99
2013	1,539,326.46
2014	1,525,591.88
Jan – July 2015	650,234.85

PRELIMINARY DECISION

28 As mentioned earlier, it is the Opponents' case that it has a family of STONE marks. This was strongly denied and disputed by the Applicant. The Applicant argued essentially as follows:

- (a) The Bridgestone Mark and the Firestone Mark are not owned by the same legal entity and therefore do not qualify as a family of marks;
- (b) Mere registration of a number of marks bearing a common element does not give rise to a presumption that the common element constitutes a family of marks;
- (c) In order to establish a family of marks, a proprietor must prove that the marks have been used and promoted in such a way that the public associates the common element between the marks with the proprietor. The Applicant submits that the Opponents have not demonstrated this based on the evidence lodged.

29 I will address each of these points in turn.

Do the marks need to be owned by the same legal entity in order to be protected as a family of marks?

30 The Applicant stressed that the Bridgestone Mark is owned by Bridgestone Corporation while the Firestone Mark is owned by Bridgestone Licensing Services Inc. They are two separate legal entities and therefore cannot be said to be a "single proprietor". The question I

have to decide is thus whether marks need to be owned by the same legal entity in order to be protected as a family of marks. This issue does not appear to have been discussed in any case in Singapore or any leading textbook on trade marks such as *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2014) by Professor Ng-Loy Wee Loon or *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 15th Ed, 2011) (“*Kerly's Law of Trade Marks and Trade Names*”).

31 I will therefore attempt to give my view but before that, I should consider the purpose of the trade marks regime. The trade marks regime and indeed, the family of marks doctrine, exists in order to prevent confusion or deception to the public as to the source of a particular product or service. For this objective to be achieved, protection should be accorded to prevent consumers associating marks as coming from the same source when in fact they do not. As consumers are unlikely to have knowledge of who is the legal owner of trade marks on the trade marks register, I do not think that this is something that would have a bearing on the state of the consumer's confusion. Put another way, whether consumers are likely to associate marks as coming from the same source or not is not influenced by who is reflected as the legal owner of the marks on the trade marks register. Therefore, the lack of common ownership by a single entity should not stand as a barrier to the protection over a family of marks that should otherwise be granted.

32 Furthermore, it is also to be borne in mind that trade marks are not necessarily always used by the proprietor of the trade mark himself in the marketplace. They may be used by licensees and other third parties with the proprietor's consent. Consumers are therefore quite accustomed to trade marks being used by persons other than the entity reflected as trade mark owner on the trade marks register and hence this should not be used as the yardstick to determine consumer confusion.

33 I therefore come to the conclusion that it is not necessary for trade marks to be owned by the same legal entity in order to be protected as a family of marks. It is possible for corporate family members to be regarded as a single source.

Does registration of a number of marks bearing a common element give rise to a presumption that the common element constitutes a family of marks?

34 The next question relates to what needs to be proven in order to establish a family of marks. Would registration of a number of marks bearing a common element give rise to a presumption that the common element constitutes a family of marks? In my view, the answer to this question is obviously a “no”. The mere fact that a mark is registered does not mean that it is used in the marketplace. Without use it cannot be established that consumers are aware that there is a common element within the marks owned by a single source which constitutes a family.

35 This position is clearly stated in *Kerly's Law of Trade Marks and Trade Names* at para 9–081:

Use of a family of marks may support the contention that a mark or a particular element of a mark is distinctive. But evidence of entries in the register of trade marks will not be of assistance. Such entries do not necessarily reflect the position in the marketplace or affect the way in which marks are perceived or remembered.

36 A proprietor therefore needs to submit proof of use of a number of marks bearing a common element such that it may be said that consumers are aware that the common element constitutes a family of marks.

Is use per se sufficient to establish a family of marks? If not, what else needs to be established?

37 This then leads me to the question whether use alone is sufficient to establish a family of marks or whether the use has to achieve a certain effect on consumers before protection as a family of marks will be accorded.

38 As stated at [19], the Bridgestone Mark and the Firestone Mark have been used in Singapore since 1984 and 1947 respectively. Is this then sufficient for the Opponents to claim protection as a family of marks?

39 I do not think so. Ultimately the issue is not just whether the marks have been in use but whether consumers associate the marks which bear a common element as originating from a single source such that if there is another mark in the marketplace bearing that common element, the consumer is likely to be confused. This point was made by the learned Assistant Registrar in *Lacoste v Carolina Herrera, Ltd* [2014] SGIPOS 3 at [39] where she said:

The relevant audience to consider when deciding whether a family or series of marks is in existence in the marketplace is the consumer or the public (see *Il Ponte* (at [63] and [64], paragraph 34 above) and *Infamous Nut* (at [37], see paragraph 37 above)). This follows from the principle that at the end of the day, the query goes towards establishing whether there is a likelihood of confusion as a result of the applicant's use of a common element in the registered proprietor's trade marks....

40 If consumers do not associate the common element as belonging to a family, there would be no reason to extend protection to that common element on the basis that consumers are likely to be mistaken as to the origin of goods or services covered by the mark applied for, or consider erroneously that the mark applied for is part of that family. The need to adopt a cautious approach was pertinently stated by the High Court in *The Polo /Lauren Co, LP v Shop In Department Store Pte Ltd* [2005] 4 SLR(R) 816 at [19]:

The ambit of (trade mark) protection should be guided by the underlying aim of a trade marks regime, which is to ensure that consumers do not confuse the trade source of one product with another. For instance where the consideration of other matters can assist the court in drawing the line at cases where the likelihood of confusion is merely imaginary, there is no reason not to do so. Otherwise, the law will end up extending protection where none is needed.

41 Therefore, in order for the existence of a 'family' of STONE marks to affect the relevant consumer's reaction to the Application Mark, that 'family' must have been evident to Singapore consumers.

42 As far as I can see, the Opponents' evidence does not support a finding that the Bridgestone Mark and Firestone Mark are used and recognised by the average consumer as a family of marks. On the contrary, the evidence seems to show that Bridgestone and Firestone

have been used and promoted as separate and independent brands. Further, no evidence has been adduced to show that there were attempts to educate consumers that the two brands come from the same corporate family.

- (a) Firstly, the two brands maintain their own separate and independent websites, namely, www.bridgestone.com and www.firestone.com respectively. Firestone products are not featured on www.bridgestone.com and neither are Bridgestone products featured on www.firestone.com. While there may be a mention in the respective websites that Bridgestone and Firestone were merged into a single corporation⁶, this mention is brief and furthermore, it cannot be assumed that the average consumer would visit these websites or read this information;
- (b) Even if this fact is known to the average consumer, it is not clear to what extent consumers conclude from this that the Opponents have a family of STONE marks;
- (c) “Bridgestone” and “Firestone” tyres are distributed through separate distribution channels in Singapore. “Bridgestone” tyres are distributed by Bridgestone Tyre Sales Singapore Pte Ltd while “Firestone” tyres are distributed by Binter & Co Ltd⁷. The manner in which the tyres are distributed and sold do not help consumers to recognise that marks with a “STONE” suffix belong to the same family;
- (d) There is no reference in invoices or advertising and promotional materials that the two brands come from the same corporate family.

43 Another reason for rejecting the Opponents’ claim that they have a family of STONE marks is that there are only two trade marks in use by the Opponents with the common element “STONE”. This does not mean that use of only two trade marks can never be sufficient to substantiate the existence of a family of marks but that if only two marks are in use, it is less likely that consumers will detect a common element between them and to assume that all marks containing that common element must come from the same family. The evidence that needs to be produced to show that this is likely would need to be quite substantial and on the facts, I do not think that this has been made out.

44 For the reasons stated above, I find that the Opponents have not established that they had a family of STONE marks present on the market at the relevant date. In my analysis below I will therefore compare the Application Mark against the Bridgestone Mark and the Firestone Mark separately and individually.

MAIN DECISION

Ground of Opposition under Section 8(2)(b)

45 Section 8(2)(b) of the Act reads:

⁶ MA-22 of Opponents’ 2nd SD.

⁷ Opponents’ 1st SD at [11].

8.—(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.

Decision on Section 8(2)(b)

46 The law in relation to Section 8(2)(b) is well-established: the leading case is the Court of Appeal’s decision in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide* [2014] 1 SLR 911 (“*Staywell*”). In *Staywell* the court reaffirmed the “*step-by-step*” approach which may be summarised as follows. The first element is to assess whether the respective marks are similar. The second element is to assess whether there is identity or similarity between the goods or services for which registration is sought as against the goods or services for which the earlier trade mark is protected. The third element is to consider whether there exists a likelihood of confusion arising from (or to use the words of the section: *because of*) the two similarities. The court made it clear that “*the first two elements are assessed individually before the final element which is assessed in the round*” (*Staywell* at [15]). If, for any one step, the answer is in the negative, the inquiry ends, and the opposition will fail.

Comparison of Marks

47 In assessing the marks for similarity, I have taken the following principles into account:

- (a) The assessment of marks similarity is mark-for-mark, without consideration of any external matter. (*Staywell* at [20].)
- (b) The marks are to be compared for visual, aural and conceptual similarities. There is no requirement that all three aspects of similarity must be made out before the marks can be found to be similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry. The three aspects of similarity are but signposts meant to guide the inquiry and I must ultimately come to a conclusion whether the marks, when observed in their totality, are similar rather than dissimilar. This is inevitably a matter of impression. (*Staywell* at [17]–[18].)
- (c) When assessing two contesting marks, I should bear in mind that the average consumer has imperfect recollection. Therefore, the two marks should not be compared side by side and examined in detail because the person who is confused often makes a comparison from memory removed in time and space from the marks. (*Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 (“*Hai Tong*”) at [62(a)]). That said, I am entitled to have special regard to the distinctive or dominant components of a mark, even while assessing the similarity of the two marks as composite wholes, since those (distinctive or dominant components) tend to stand out in the consumer’s imperfect recollection. (*Staywell* at [23].)
- (d) The signs/marks are considered from the viewpoint of the average consumer – *not* an unthinking person in a hurry, but rather, a person who would exercise some

care and good sense in making his purchases. (*The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690 (“*Polo (CA)*”) at [34].)

Distinctiveness

48 I am mindful of the Court’s guidance in *Staywell* at [30] that distinctiveness is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar and it is not a separate step within the marks-similarity inquiry. However, following the approach of the Court of Appeal in *Hai Tong* at [26], for the purpose of elucidating the analytical process, I will highlight it here as a separate step first before applying my findings within the context of the marks-similarity analysis.

49 There are two aspects to the distinctiveness assessment. One is to look at the distinctiveness of components (or elements) of the marks in comparison (both the earlier trade mark and the contested mark), and the other is to look at the distinctiveness of the earlier mark as a whole.

50 The purpose of analysing the distinctiveness of the components of the marks in question is to determine the ability of each of these components to dominate the consumer’s overall impression of the mark. In this regard, it has to be assessed whether the signs in conflict coincide in a component that is distinctive (and therefore important) or non-distinctive or weak (therefore being of less importance in the trade mark comparison). However, “*the finding of distinctiveness of the separate components of the mark must ultimately be related back to the impression given by the mark as a whole. The distinctiveness of a particular component of a mark is but one factor feeding into the ultimate question of whether the mark, in the form it is registered and/or used, has strength as an indicator of origin to the exclusion of other trade sources. This latter question clearly must be considered by looking at the mark as a whole, because it is the entire mark, and not only a component of it, that must function as the badge of origin*” (*Staywell* at [29]).

51 The assessment of the distinctiveness of the earlier mark as a whole, on the other hand, is important “*in order to determine the extent of the latitude that will be allowed to a user of features that appear in that mark*” (*Hai Tong* at [27]). Further, the Court of Appeal in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA* [2012] SGCA 56 said at [20]:

...the “distinctiveness” of the registered trade mark is a factor to be considered in the visual, aural and conceptual analysis to determine whether the allegedly infringing sign and the trade mark are similar. It stands to reason that the more distinctive the registered trade mark, the more it is necessary to show sufficient alterations to, or difference in, the sign in order that it may not be held to be similar to the trade mark ...

Distinctiveness of the components of the Opponents’ earlier marks and the Application Mark

52 The Opponents’ earlier marks are compound words made up of two ordinary English words, namely, “BRIDGE” and “STONE”, and “FIRE” and “STONE”, respectively. In addition, the Bridgestone Mark is presented in a particular font with the top left corner of the letter “B” slightly detached so that a gap is revealed in between. However, I would say that the font and the stylisation of the “B” are unremarkable and unlikely to stand out in the consumers’ imperfect recollection.

53 The Opponents claim that the “STONE” component in the Bridgestone Mark and the Firestone Mark should “*enjoy a high level of protection given its distinctiveness and non-descriptiveness in relation to the goods and services*”⁸. Further, the “STONE” component is “*the essential or dominant feature of the competing marks*”⁹.

54 While I acknowledge that the element “STONE” is distinctive and not descriptive in relation to the goods and services, I do not see why that element should be singled out to receive a higher level of protection than the other elements of the STONE marks. The elements “BRIDGE” and “FIRE”, respectively, of the STONE marks are as distinctive as the element STONE in that they also do not describe any of the characteristics of the goods and services in question. Further, given my finding earlier that there is no family of STONE marks, the element “STONE” does not stand out for that reason either.

55 Coming to the Opponents’ point that the “STONE” component is “*the essential or dominant feature of the competing marks*”, I also see no basis to permit me to come to this conclusion. The components, “BRIDGE” and “STONE”, and “FIRE” and “STONE”, respectively, are equal in size, in the same font and of the same colour. There is nothing in the element “STONE” that causes it to stand out or catch the eye any more than the elements “BRIDGE” or “FIRE”. Considered overall, I am of the view that the impression of the Opponents’ earlier marks is not materially dominated by either of its components and its distinctiveness rests in the combination of “BRIDGE” and “STONE”, and “FIRE” and “STONE”, and in the manner in which these components are conjoined.

56 I turn now to the Application Mark. The Opponents say that the “STONE” component is “*the essential or dominant feature*” of the mark while the Applicant submits that the dominant element is “DEE” as that is the word that is first seen and remembered¹⁰. In my view, given that the Application Mark consists of a single word with letters of equal size and prominence and the fact that there is no rigid principle that the first syllable of a word mark is more important (*Polo (CA)* at [23]), I do not see how it may be said that one component dominates the other. I am of the view that both elements equally contribute to the overall impression of the mark.

Distinctiveness of the Opponents’ earlier marks

57 The Opponents tried to rely on the “STONE” element’s distinctiveness by virtue of its “*longstanding use, sales figures and advertising expenditure in Singapore*”¹¹. However, given my finding that the distinctiveness of the Opponents’ earlier marks does not lie in the “STONE” element alone but in the marks as a whole, I do not see how the distinctiveness of the Opponents’ earlier marks (whether inherent or enhanced through use) would assist the Opponents’ case.

Visual Similarity

58 For ease of reference, the marks to be compared are:

⁸ Opponents’ 1st SD at [28].

⁹ Opponents’ Written Submissions at [71(a)].

¹⁰ Applicant’s 1st SD at [30].

¹¹ Opponents’ Written Submissions at [67].

<i>Opponents' Earlier Marks</i>	<i>Application Mark</i>
BRIDGESTONE	DEESTONE
FIRESTONE	DEESTONE

59 The Application Mark is applied for as a series of two marks. The first mark in the series is shown in colour while the second mark in the series is in black and white. For the purposes of mark comparison, I will refer only to the black and white mark since colour is not part of the subject matter of either of the Opponents' earlier marks and the coloured version of the Application Mark would not increase their visual similarity in so far as these marks are concerned.

60 The marks to be compared in this analysis are all compound word marks. Whilst the visual similarity of the marks must be assessed and compared as wholes, the starting point of this analysis is usually to consider the components the marks are made up of. This is because the overall impression conveyed to the public by a trade mark may, in certain circumstances, be dominated by one or more of its components (*Hai Tong* at [62(c)]).

61 Having said that, it cannot and must not be assumed that there will always be a feature of the mark which dominates the mark's landscape. In many cases, no particular feature will stand out. Microanalysing a mark for particular distinctive features in such cases is unhelpful (*Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SpA* [2016] 2 SLR 1129 ("*Caesarstone (HC)*") at [30]).

62 Bearing in mind my analysis earlier, I come to the conclusion that none of the elements in either of the Opponents' earlier marks or in the Application Mark are visually more dominant or distinctive than the other. As such I must compare the marks as wholes without giving special regard to any particular element.

63 The Opponents submit that the marks are visually similar as that the "STONE" element is in common between the marks. However, having found earlier that the consumer's imperfect recollection of the respective marks is unlikely to be dominated by any particular component but by the marks as a whole, I should not compare the marks based on the "STONE" element in isolation.

64 As wholes, I do not find it likely that consumers will fail to notice that the marks in comparison have very different beginnings: "DEE", in the Application Mark, and "BRIDGE" and "FIRE", respectively, in the Opponents' earlier marks, and yet notice that they all end with the suffix "STONE". Since the differences appear at the beginning of the marks in question, in my view, they would not be something that is easily missed when the marks are seen.

65 I am aware of the caution by the Court of Appeal in *Polo (CA)* at [23] that there is no rigid principle that the first syllable of a word mark is more important but in the present case, given that the prefixes are inherently distinctive and visually prominent, I am of the view that they would feature in the consumer's imperfect recollection of the marks.

66 In conducting this visual analysis, I have taken into account that both the Application Mark and the Opponents' earlier marks are all "single word" marks. I am also aware that the Application Mark has 6 letters, "E-S-T-O-N-E", in common out of the 11 letters in BRIDGESTONE, and out of the 9 letters in FIRESTONE. However, the fact that there are more letters in common than not does not necessarily lead to a conclusion that the marks are therefore similar. This is because consumers do not analyse marks in such a manner.

67 The Opponents also submitted in addition, that the Bridgestone Mark is visually similar to the Application Mark for the following reasons:

- (a) Both marks are slanted at a 45-degrees angle to the right;
- (b) The half arrow device in **BRIDGESTONE** merges the gap in the letter "B" which results in it looking almost like the stylised "D" in the Application Mark; and
- (c) The font in both marks is exactly the same, with the "STONE" element being identical or close to identical in both marks.

68 These are, to me, minor stylistic differences which are only noticeable if one compares the marks side-by-side. Given that the average consumer is one who has imperfect recollection of the marks, details like these are likely to go unnoticed by the average consumer.

69 In conclusion, while it is true that the competing marks each contain the same ending "STONE" and are thus visually similar to that extent, overall the marks are visually more dissimilar than similar, having regard to the fact that the difference in the appearance of the letters at the beginning of the marks, which are the first to hit the eye, creates a notable and striking point of visual contrast.

Aural Similarity

70 The Opponents' case on aural similarity rests primarily on the point that "STONE" which is in common is the dominant component of the marks. However, again I do not see why "STONE" would be dominant from the aural perspective. All the marks consist of conjoined elements so consumers are likely to vocalise the marks in full. 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 i.e. the prefixes "DEE", "BRIDGE" and "FIRE". These prefixes are simple to pronounce and consist of sounds which are familiar to the public in Singapore. The fact that they appear right at the beginning also means that they will be audibly enunciated and not diminished in speech. Furthermore, in view that the first sound to hit the ear is the component that is different, the difference is not likely to go unnoticed.

71 In light of all of the above, I am of the view that the Application Mark is aurally more dissimilar than similar to the Opponents' earlier marks.

Conceptual Similarity

72 With regard to conceptual similarity, the inquiry is to "*uncover the ideas that lie behind and inform the understanding of the mark as a whole*" (*Staywell* at [35]).

73 The Opponents contended that the marks are conceptually similar as the element “STONE”, which is in common among the marks, connotes the idea of strength and this idea is not altered by the prefix “BRIDGE”, “FIRE” or “DEE”. The Applicant on the other hand submits that word “Bridgestone”, is more likely to convey the image of a bridge made of stone. The dominant idea is thus that of a bridge.

74 I am unable to agree with either the Opponents or the Applicant. The Court of Appeal in *Staywell* at [35] clearly cautioned that greater care is needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts. In my view, “Bridgestone” as a whole is an invented word with no specific meaning in relation to tyres. The average consumer will not dissect the mark into “BRIDGE” and “STONE” and conceptualise the mark on the basis of the separate meanings of the words.

75 As for the Application Mark, **DEESTONE**, while it naturally breaks into the prefix “DEE” and the suffix “STONE”, it is as a whole, a coined word and is likely to be perceived by the average consumer as such. It does not convey any particular idea¹². I therefore find that there is no conceptual similarity between the Bridgestone Mark and the Application Mark.

76 Moving on to the Firestone Mark, “Firestone” is an English word defined in <https://en.oxforddictionaries.com> as a “stone that can withstand fire and great heat, used especially for lining furnaces and ovens”. The dominant idea behind the Firestone Mark is thus that of a stone. Even if it may be said that this dictionary meaning may not be known to the average consumer, it would nevertheless still connote the idea of a stone on fire and again this idea has no similarity with the Application Mark which is invented and has no meaning.

77 Accordingly, in my view neither of the Opponents’ earlier marks are conceptually similar to the Application Mark.

Conclusion on Similarity of Marks

78 I now consider whether the respective marks, “*when observed in their totality, are similar rather than dissimilar*”, noting the Court of Appeal’s rejection of the suggestion that “*any modicum of similarity would compel the court to make a finding of marks-similarity*” at [19] of *Staywell*.

79 I have found that the respective marks are (a) visually more dissimilar than similar; (b) aurally more dissimilar than similar and (c) conceptually dissimilar. While bearing in mind that “*trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry*” ([18] of *Staywell*), I find that overall when observed in their totality, the Application Mark is more dissimilar rather than similar to either of the Opponents’ earlier marks.

¹² I am aware that the word “Dee” is defined in <https://en.oxforddictionaries.com> as:

“1 A river in north-eastern Scotland that rises in Grampian Mountains and flows east past Balmoral Castle to the North Sea at Aberdeen.

2 A river that rises in North Wales and flows into England past Chester and on into the Irish Sea.

However, I do not think that the average consumer in Singapore would understand it according to its meaning in the dictionary. They would more likely perceive DEE simply as an invented word.

80 The similarity of the competing marks is a “*threshold requirement that had to be satisfied before the confusion inquiry is undertaken*” (*Staywell* at [15]). Given that the threshold requirement has not been met, this is enough to dispose of the matter in favour of the Applicant.

81 Before I conclude, I should mention that the Opponents pointed me to the fact that the STONE marks were found to be similar to the Application Mark in the Philippines, Cambodia, China, Guatemala and Turkey. However, I did not find it useful to refer to these foreign decisions on this point. The full facts of the cases and the litigation are not known. This point was made by the learned Principal Assistant Registrar in the case of *Kabushiki Kaisha World v Wolverine World Wide, Inc.* [2007] SGIPOS 2 at [44] where she said:

I have not taken into consideration the co-existence of the marks in Japan and the Applicant’s success in opposition proceedings in Korea, in coming to a decision that there is no likelihood of confusion. As the co-existence and litigation occur in different jurisdictions and the full facts for the co-existence and litigation were not made known in this hearing, it will bear no weight in the assessment of the likelihood of confusion in our context.

82 Moreover, the decisions relied upon by the Opponents emanate from non-common law jurisdictions which may apply very different laws and standards to Singapore. Even decisions from common-law jurisdictions should be treated with care as explained by the learned George Wei J in the High Court decision of *Caesarstone (HC)*. In that case, in the context of considering the relevance of the opponent’s successful opposition proceedings in Australia and Canada, the learned judge held at [138]:

Whilst the litigation between the parties in respect of the CAESARSTONE Mark in Australia and Canada raised similar issues to those that have arisen in Singapore, this court is reminded that the facts, evidence and statutory framework, including the burden of proof, are not the same. Notwithstanding the substantive outcome of the Australian and Canadian proceedings, and with due respect to these decisions, I am of the view that the opposition fails in Singapore.

Conclusion on Section 8(2)(b)

83 In light of my finding that the competing marks are more dissimilar than similar, the opposition under Section 8(2)(b) TMA fails at this first step.

84 The ground of opposition under Section 8(2)(b) therefore fails.

Ground of Opposition under Section 8(7)(a)

85 Section 8(7)(a) of the Act reads:

8.—(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

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

Decision on Section 8(7)(a)

86 It is trite law that there are three elements known as the "classical trinity" in the tort of passing off: (a) goodwill, (b) misrepresentation, and (c) damage (*The Audience Motivation Company Asia Pte Ltd v AMC Live Group China (S) Pte Ltd* [2016] SGCA 25 at [80]).

Goodwill

87 The Court of Appeal in *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as L S Electrical Trading)* [2016] SGCA 33 ("*Singsung*") clarified the nature of goodwill at [33]-[34] as follows:

The goodwill relevant to a passing off action is not goodwill in the mark, logo or get-up (*CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 ("*CDL Hotels*") at [45]). Instead, the tort of passing off protects a trader's relationship with his customers. As was stated by Lord Parker of Waddington in *AG Spalding & Bros v A W Gamage Ltd* (1915) 32 RPC 273 at 284:

There appears to be considerable diversity of opinion as to the nature of the right, the invasion of which is the subject of what are known as passing off actions. The more general opinion appears to be that the right is a right of property. This view naturally demands an answer to the question – property in what? Some authorities say property in the mark, name, or get-up improperly used by the defendant. Others say, property in the business or goodwill likely to be injured by the misrepresentation. Lord Herschell in *Reddaway v Banham* (LR (1906) AC 139) expressly dissents from the former view; and if the right invaded is a right of property at all, there are, I think strong reasons for preferring the latter view. ...

In our judgment, goodwill, in the context of passing off, is concerned with goodwill in the business *as a whole*, and not specifically in its constituent elements, such as the mark, logo or get-up that it uses (see *Lifestyle 1.99 Pte Ltd v S\$1.99 Pte Ltd* [2000] 1 SLR(R) 687 ("*Lifestyle 1.99*") at [20]–[24]; *Wadlow on Passing Off* at paras 3–003 and 3–004; James Mellor QC et al, *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 15th Ed, 2011) ("*Kerly's Law of Trade Marks and Trade Names*") at para 18–100). Goodwill does not exist on its own, but attaches to a business in the jurisdiction and is manifested in the custom that the business enjoys: *CDL Hotels* at [46]. Goodwill may be proved by evidence of sales or of expenses incurred in promoting the goods and services in association with the mark, brand or get-up which they bear (see *SPGA* at [22]).

88 The Applicant in this case disputes that the Opponents have shown that they enjoy goodwill in Singapore. They submit that there is little evidence of sales or promotions of "Firestone" tyres, and as for "Bridgestone" tyres, the sample invoices adduced by the Opponents do not show that the goods were brought into Singapore. In fact, the invoices show that the tyres were shipped from Japan to overseas markets such as Pakistan, India, Cambodia, Brunei and Vietnam, and the buyer named on the invoices is Bridgestone Asia Pacific Pte Ltd, their own subsidiary.

89 While I agree that the evidence could have been better presented, I nevertheless accept that this element has been made out. The Opponents have tendered extracts from various

Singapore-based car forums dating back to as early as 2002, and these show that the Opponents' "Bridgestone" and "Firestone" tyres are available in Singapore, and have been bought and used by customers in Singapore.

Misrepresentation

90 Under this element, the Opponents must show that the use of the Application Mark, in a normal and fair manner in respect of the goods and services for which registration is sought, amounts to a misrepresentation. The misrepresentation (whether intentional or not) must be such that would lead or be likely to lead the public into believing that the goods or services (in respect of which registration is sought) are the goods or services of the Opponents or from a commercially related trade source.

91 The Court of Appeal in *The Singapore Professional Golfers' Association v Chen Eng Waye and others* [2013] SGCA 18 provided a helpful summary of misrepresentation at [20] as follows:

... It will then be necessary to consider, amongst other factors, whether there is such a similarity between the corresponding element that is being used by the defendant on the one hand and by the claimant on the other such that in all the circumstances, it is sufficiently likely to result in the relevant segment of the public being deceived or confused into thinking that the defendant's goods or services are, or emanate from a source that is linked to, the claimant's...

92 I have earlier found, in the context of the claim under Section 8(2)(b) of the Act, that both the Opponents' earlier marks are dissimilar rather than similar to the Application Mark ([79] above). It thus follows that there cannot be any misrepresentation that is sufficiently likely to deceive the public into thinking that the Applicant's goods are those of the Opponents, or that the Opponents are otherwise responsible for the quality of the goods offered under the Application Mark.

93 As misrepresentation has not been established, and misrepresentation is an essential component of the tort of passing off, it follows that the Opponents' ground of opposition under passing off fails. It is not necessary for me to comment further on the final element of damage.

Conclusion on Section 8(7)(a)

94 The ground of opposition under Section 8(7)(a) therefore fails.

Grounds of Opposition under Section 8(4)(a) read with 8(4)(b)(i) and Section 8(4)(b)(ii)(B)

95 The Opponents rely on both Section 8(4)(b)(i) as well as 8(4)(b)(ii)(B) of the Act. The former relates to marks that are well known in Singapore, whereas the latter relates to marks that are well known to the public at large in Singapore.

96 The relevant provisions of Section 8(4) of the Act reads:

8.—(4) Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or

(ii) if the earlier trade mark is well known to the public at large in Singapore —

...

(B) would take unfair advantage of the distinctive character of the earlier trade mark.”

Decision on Section 8(4)(a) read with 8(4)(b)(i) and Section 8(4)(b)(ii)(B)

97 To succeed on the grounds under Section 8(4)(b)(i) and Section 8(4)(b)(ii)(B), a common element which needs to be established is the requirement that "*the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark*". If this element is not established, the opposition must necessarily fail under both grounds.

98 Although Section 8(4) makes reference to an "*essential part*" of the trade mark while Section 8(2) does not, it was held in ***Rovio Entertainment Ltd v Kimanis Food Industries Sdn Bhd*** [2015] SGHC 216 at [146] that this made no difference to the similarity of marks analysis since even under Section 8(2)(b) where the phrase "*essential part*" does not appear, it is clear that in making the mark-for-mark comparison, the court (or tribunal) is entitled (where relevant) to take into account the dominant features of the trade mark.

99 I have dealt with the issue of marks-similarity earlier under Section 8(2)(b) and found that the both the Opponents' earlier marks are dissimilar rather than similar to the Application Mark ([79] above). Accordingly, for the same reasons, I find that the whole or essential part of the Application Mark is not identical with or similar to either of the Opponents' earlier marks.

Conclusion on Section 8(4)(a) read with 8(4)(b)(i) and Section 8(4)(b)(ii)(B)

100 The grounds of opposition under Section 8(4)(a) read with 8(4)(b)(i) and Section 8(4)(b)(ii)(B) therefore fail.

Conclusion

101 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on all grounds. Accordingly, the

Application Mark shall proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

Date of Issue: 27 March 2018