THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
December 5, 2002

Mailed: March 21,2003
Paper No. 103
csl

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Bridgestone/Firestone North American Tire, LLC and BFS Brands, LLC, successors to Bridgestone/Firestone, Inc.[1]

v.

Silverstone Berhad, by change of name from Silverstone Tire & Rubber Co., SDN. BHD.

Opposition Nos. 94,177, 94,757 and 100,956
to applications Serial Nos. 74/322,251, 74/324,711 and 74/524,188

Peter G. Mack of Foley & Lardner for Bridgestone/Firestone North American Tire, LLC and BFS Brands, LLC.

Michael E. Sobel of Squire, Sanders & Dempsey, LLP for Silverstone Berhad.

Before Simms, Bottorff and Rogers, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

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[1] In view of the stipulated motion to amend, Bridgestone/Firestone North American Tire, LLC and BFS Brands, LLC are substituted for Bridgestone/Firestone, Inc., the original opposer. See Rules 3.71(d) and 3.73, and Fed.R.Civ.P. 17, 19 and 25(c). The Office has charged a fee for the added party.

Bridgestone/Firestone North American Tire, LLC and BFS Brands, LLC (hereafter "opposers"), successors in interest to Bridgestone/Firestone, Inc., have opposed the applications of Silverstone Berhad (hereafter "applicant"), by change of name from Silverstone Tire & Rubber Co., SDN. BHD., to register the mark SILVERSTONE for tires,[2] for inner tubes for vehicle tires,[3] and the mark shown below for tires and inner tubes for vehicle tires.[4]

After answer was filed, the oppositions against the first two applications were consolidated on January 31, 1995, and Opposition No. 100,956 brought against the mark shown above was consolidated on April 23, 1996. A trial was conducted, briefs have been filed and an oral hearing was held.

In their third amended consolidated opposition, opposers assert that applicant's marks so resemble

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[2] Serial No. 74/322,251, filed Oct. 13, 1992, based on an allegation of a bona fide intention to use the mark in commerce.
[3] Serial No. 74/324,711, filed Oct. 22, 1992, based on an allegation of a bona fide intention to use the mark in commerce.
[4] Serial No. 74/524,188, filed May 12, 1994, based on an allegation of a bona fide intention to use the mark in commerce.

opposers' previously used (since January 1896) and registered mark FIRESTONE for tires and tubes as well as for other goods and services as to be likely to cause confusion, to cause mistake or to deceive. Opposers also allege that applicant's marks are likely to cause confusion with the trade name Bridgestone/Firestone Inc., used since July 31, 1989. Finally, opposers allege that applicant's marks are primarily merely a surname which has not become distinctive of applicant's goods.

In its answer, applicant has denied these allegations and has asserted that there are numerous third-party uses of similar marks containing the word "STONE" in the automotive industry and that consumers have learned to distinguish among them.[5]

The voluminous record of this case consists of testimony (and exhibits) submitted by both parties; official records, printed publications, and discovery responses relied upon by notices of reliance filed by both parties; and the application files.

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[5] As an affirmative defense, applicant has asserted that opposers are estopped from bringing these oppositions because they have not objected to a third party's mark (SILVERSTONE) for various automotive products such as spark plugs and ignition parts. Because applicant may not rely upon opposers' failure to object to a third party's mark, no further consideration will be given to this so-called affirmative defense. *Gastown Inc. of Delaware v. Gas City Ltd.*, 187 USPQ 760 (TTAB 1975) (equitable defense that a third party may have does not inure to applicant's benefit in the absence of a showing of privity).

Opposers' Record

The Firestone Tire & Rubber Co. was founded in 1900 by Harvey S. Firestone in Akron, Ohio. Mr. Firestone was the president of this company and later chairman of the board. In 1988, the Bridgestone Corporation of Japan acquired the Firestone company, and the resulting company was called Bridgestone/Firestone, Inc., a wholly owned subsidiary of the Bridgestone Corporation. Later, Bridgestone/Firestone, Inc. was merged into Bridgestone/Firestone North American Tire, LLC, a Delaware corporation. That entity uses the marks FIRESTONE and BRIDGESTONE in this country while ownership of these marks now resides in BFS Brands, LLC. Opposers are wholly owned subsidiaries of Bridgestone/Firestone Americas Holding, Inc., whose ultimate parent company is Bridgestone Corporation.

According to the record, FIRESTONE tires have been sold in this country for over a century. After the acquisition of the Firestone company by Bridgestone Corporation in 1988, opposers' FIRESTONE and BRIDGESTONE tires were marketed under a multi-tiered branding strategy of "good" (DAYTON), "better" (FIRESTONE), and "best" (BRIDGESTONE), designed to minimize competition between the brands. However, both names (BRIDGESTONE and FIRESTONE) are exposed to the public together (the so-called "stacked

logo") by such means as business cards, stationery, calendars, tire gauges, store signs, advertising, brochures, and at opposers' Web site. The following illustrations show examples of such use.

The mark FIRESTONE (stylized) has been registered for rubber tires, among other goods (Reg. No. 140,804, issued March 29, 1921, alleging use since 1900, renewed for the fourth time in 2001). That registration is now owned by opposer BFS Brands. That entity owns a number of other registrations for this mark as well. BFS Brands also owns a registration for the mark STONES for vehicle tires (Reg. No. 1,113,091, issued February 13, 1979, renewed). In use, as shown by the record, this mark appears on a sticker with the words "I LOVE MY 'STONES'", beneath which appears the FIRESTONE mark and the word "tires."

Opposers sell their tires through about 1,500 company-owned stores as well as approximately 8,000 independent dealers. Also, opposers' goods are sold at truck stops and to fleets as well as in the construction and mining industries.

Opposers' FIRESTONE tires have been extensively advertised. Opposers have promoted their FIRESTONE tires at racing events such as the Indianapolis 500, by way of decals on racing cars and on racers' uniforms and, more recently, as the official tire of the Indianapolis 500 (Pacsi dep., 110), where the mark is exposed to millions of television viewers. On 52 occasions during the entire history of the Indianapolis 500 race, the winning car had

FIRESTONE tires. Pacsi dep., 47-48. The winning driver wears a FIRESTONE hat in the winner's circle. Pacsi dep., 111. Opposers are also the title sponsors of racing events and the FIRESTONE mark has been the subject of product placement in various movies. Opposers advertise their brands in newspapers and magazines as well as on television and by way of co-operative advertising, which involves advertising by dealers in connection with their own businesses. Opposers realize billions of dollars in sales revenue from the FIRESTONE brand of tires, and now spend about $8 to 10 million in advertising per year. Pacsi dep., 85. These costs do not include the co-operative advertising or the expense of opposers' participation in motor sports, which is a significant sum.[6]

FIRESTONE tires have about 8 or 9 percent of the replacement market share for passenger and light truck tires. Ramsey dep., 15, 49. Approximately 14 million of these tires were sold in 2000 while about 18 million were sold to the original equipment market (OEM). Pacsi dep., 81. The FIRESTONE brand plays a major role in other segments of the tire industry, such as agricultural and off-the-road tires. For example, FIRESTONE farm tires are

[6] Pursuant to stipulated testimony, opposers have made of record (under seal) annual sales of BRIDGESTONE and FIRESTONE tires as well as annual advertising and promotional expenditures.

the leading brand of agricultural tires, comprising about 50 percent of the OEM and about 45 percent of the replacement tire market. Ramsey dep., 16, 26. FIRESTONE tires comprise about 45 percent of the off-the-road market share. Ramsey dep., 16.

About 6 1/2 million FIRESTONE tires were the subject of a widely publicized recall in August 2000. In connection with this recall, not only was the FIRESTONE name exposed to the public but also opposers' Bridgestone/Firestone corporate or trade name frequently appeared as well. There was about a 40 percent drop in sales during the period of publicity about the tires subject to this recall. After the recall, opposers began their "Making It Right" advertising campaign in an attempt to restore consumer confidence in the FIRESTONE brand.

On rebuttal, Mr. Pacsi testified that opposers have not lost any dealers as a result of the recall but have, in fact, signed up new dealers. After the recall, opposers' sales volume rebounded and the FIRESTONE brand showed increases in positive brand awareness. Pacsi rebuttal dep., 22-23, 25. An agreement was signed towards the end of 2001 whereby opposers became the sole tire supplier of the Indianapolis 500 race. The FIRESTONE brand also took

top honors in the 2001 Commercial Brands study conducted by Tire Review magazine. Pacsi rebuttal dep., 60.

Opposers' BRIDGESTONE tires also occupy a considerable market share. Approximately 6 million BRIDGESTONE passenger and light truck replacement tires were sold in 2000 and 2 million BRIDGESTONE tires were distributed in the OEM in the same year. BRIDGESTONE truck tires have over a 30 percent OEM share and a 17 percent replacement tire market share. BRIDGESTONE small off-the-road tires comprise about 15 percent of that market and about 50 percent of the large mining and radial off-the-road market. Opposers spend about $2 million in advertising and promoting the BRIDGESTONE brand per year. The BRIDGESTONE brand is promoted in connection with Formula 1 racing.

Opposers' president of the U.S. commercial tire group testified that if a new tire were introduced with a multi-syllable mark ending in the word "-STONE," a likelihood of confusion would result.

> I think that in my responsibilities, as well as my own opinion, it would add confusion in the marketplace with another stone related brand name that would, in essence, tie that brand name to Bridgestone/Firestone because of the tie that we have with our Bridgestone and Firestone brand products and almost act as a third level or a third product in our multi-branded strategy.

> ...Again, from my standpoint, as the director of marketing, it would add confusion in the marketplace with another stone related product. In essence, leading people to believe that it is another entity or offering from Bridgestone/Firestone.

Pacsi dep., 32-33, 106.

Other witnesses that opposers called testified in a similar vein. For example, Dr. Jasper Neel, a Professor of English at Southern Methodist University, a specialist in rhetorical theory, testified that the word "Firestone" has become synonymous with the manufacture and sale of vehicle tires in this country, and that the use of another "STONE"-suffixed mark would likely be attributed to opposers. He testified at 26-27, 32 and 36, as follows:

> I don't think somebody who decided to sell tires in North America would ever have thought to name his or her corporation or his or her product Silverstone had Firestone not been so woven into the consciousness of North Americans as a tire industry. It wouldn't ever occur to anybody to name a tire company Silverstone in the United States or Canada except for the history of the Firestone name. That would what you--would be trying to make a connection between a polysyllabic word ending in stone and the manufacture and sale of tires as a way to more quickly bring your brand into the consciousness of the consumer. ...When you bring the names Firestone and Bridgestone together, and especially repeat them over and over and over again, basically, you have the sort of

> deep semiotic structure that a polysyllabic word ending in stone associated with tires is all tied up with the history of the Firestone Corporation.
> ...As a result, if someone else were to try--were to come into the market selling tires under a name that is polysyllabic name ending in stone, the likelihood that people would make a connection to Firestone is extremely high, in fact, almost unavoidable.

However, on cross examination, Dr. Neel did testify, at 86, that if there had been other "-STONE" marks in the tire field for as long a time as the FIRESTONE brand, "it would be a different world all together."

Opposers' chief intellectual property attorney, Mr. John Hornickel, testified that opposers have challenged in the U.S. Patent and Trademark Office such third-party marks as MARSTONE, ROADSTONE (multiple applications), KINGSTONE (multiple applications), GOODSTONE and BLACKSTONE, all sought to be registered for tires.[7] In addition, Mr. Ramsey testified, at 53, that he knows of no company other than opposers selling tires in the U.S. under a "STONE"-suffixed mark.

[7] Exhibits made of record show oppositions or cancellation proceedings against the following marks, all for tires: MARSTONE, ROADSTONE, ROAD STONE, KINGSTONE, BLACKSTONE, PI-STONE, SUPERSTONE, YELLOW STONE, POWERSTONE, GOODSTONE and POLYSTONE. Most of these cases resulted in default judgments, or withdrawn or abandoned applications and stipulated dismissals. The BLACKSTONE registration was cancelled under Section 8 of the Act.

Concerning the degree of care in the purchasing of vehicle tires, Mr. David A. Thomas, former general counsel and executive vice president of opposers, testified during discovery as follows:

> ...Consumers could be all over the lot on that. Some could be careful, some could just buy on price and, so I don't know if I could give you a definite answer other than to say that, yes, some probably do, but some buy on price.

Opposers also took the testimony of Ms. Lori Johnson, who conducted an informal pilot survey or pre-test containing admittedly "anecdotal evidence" at various locations in Port Huron, Michigan, in the fall of 1996. She conducted about 62 interviews which asked the survey respondents if they knew who made the SILVERSTONE tire shown in a photograph. Only a few indicated that they believed the opposers made the SILVERSTONE tire. Opposers acknowledge in their brief, however, that these results do not lend themselves to statistical conclusions favoring one side or the other (brief, 36).

Applicant's Record

Applicant, a Malaysian company, states that its initial manufacturing occurred in the Malaysian state of "Perak," which word means "silver" in English. Also, the

state of Perak has a great deal of limestone, from which the "-STONE" part of applicant's mark is allegedly derived.

Applicant did not take the testimony of any of its officers or employees but did call one of opposers' witnesses as an adverse witness.

Applicant also made of record stipulated testimony that ROADSTONE and KINGSTONE brand tires were being offered for sale in California.[8]

Applicant has made of record numerous third-party registrations, some beginning with the prefix "STONE" and some ending in the suffix "STONE," for a variety of goods, some in the automotive field. Other evidence shows use of such marks as PRESTONE (for automotive fluids and other goods), YELLOWSTONE for travel trailers, and GREYSTONE for a variety of tools.

Pursuant to stipulation, the parties made of record a variety of materials concerning the surname significance of the mark SILVERSTONE. For example, one witness (Ms. Katrina A. Carroll), after eliminating duplicate references, compiled a listing of 294 separate persons having the Silverstone surname in this country. Among other materials, copies of printed publications concerning

[8] Opposers have made of record a copy of their complaint for trademark infringement, dilution and other claims against the owner of these marks filed in the Central District of California in January 2002.

the actress Alicia Silverstone were made of record, including copies of the covers of such publications as Parade, Rolling Stone, Seventeen and Vanity Fair magazines on which this actress appeared. Copies of obituaries of Rabbi Harry Silverstone, lawyer and social worker Howard Jay Silverstone and photographer Marilyn Silverstone were also made of record. Copies of pertinent pages of telephone directories reveal that there are, for example, two persons in the Boston area bearing this surname, two in the Baltimore area, one in Atlanta, one in Denver, one in San Francisco, none in Los Angeles or San Diego, two in Chicago, two in Miami, none in Newark, New Jersey, eight in Manhattan, five in Fort Lauderdale, ten in Montgomery County, Maryland and three in the District of Columbia. According to the U.S. Census Bureau, Silverstone is the 49,384th most prevalent surname in the United States.

According to amended interrogatory responses, applicant became aware of opposers' marks no later than July 1986.

Arguments of the Parties

Opposers argue that applicant's mark SILVERSTONE is likely to be confused with the FIRESTONE mark and the Bridgestone/Firestone corporate name or identifier because they are all polysyllabic words ending with the word

"STONE" used for tires. Opposers argue that for the last 14 years the Bridgestone/Firestone corporate name has re-enforced the link between the FIRESTONE and BRIDGESTONE brands of tires and has increased the strength and the fame of the common suffix "STONE." The extensive use of this corporate name since the acquisition of the Firestone company in 1988 has, according to opposers' attorney, educated consumers to recognize these marks as identifying opposers and their products.

It is opposers' position that a century's use of the FIRESTONE mark, the widespread use since 1988 of the Bridgestone/Firestone corporate name and the extensive sales and advertising of opposers' FIRESTONE tires have "long ago engendered universal public recognition to the point that FIRESTONE and 'Bridgestone/Firestone' are household names known to virtually everyone." Brief, 20.

Opposers also point to the diligence and success in enforcing their trademark rights by consistently challenging "STONE"-suffixed marks that others attempt to register for tires. According to opposers, no one has succeeded in registering a "STONE"-suffixed mark for tires on the Principal Register since the 1988 merger.

Opposers also note that the goods in applicant's applications and opposers' registrations are identical and

that, in the absence of a limitation in these descriptions of goods, the channels of trade of the parties' vehicle tires and inner tubes must be presumed to be identical, and the parties' goods must be considered to be offered to all classes of potential purchasers. Because the goods of the parties are identical, opposers argue that the degree of similarity between the marks needed to establish a likelihood of confusion is less than if the goods were dissimilar.

Essentially, it is opposers' position that because of the identity of the goods, applicant's tires bearing the mark SILVERSTONE are likely to be viewed as a variation denoting a different product line from opposers.

> Relevant consumers and members of the general public, who have long been educated to recognize FIRESTONE brand tires and BRIDGESTONE brand tires as related multiple brand product offerings, are likely to believe, contrary to fact, that SILVERSTONE brand tires would represent a third option in Opposers' "good, better, best" product tiers... Indeed, the prefix "SILVER" in the SILVERSTONE marks suggests a lower tier status, and will only increase the likelihood of confusion and subvert the overall marketing by Opposers of their tires by causing consumers to mistakenly believe that SILVERSTONE brand tires are the third tier in the Bridgestone/Firestone multi-tiered branding strategy...
>
> In view of the fame and wide-spread public recognition of the distinctive

> FIRESTONE mark and name and Bridgestone/Firestone moniker as indicating a particular tire brand and tire maker, it is all but inevitable that Applicant's SILVERSTONE mark would be mistakenly associated with Opposers' one hundred year history of making and selling tires…

Brief, 31-32. According to opposers, the only reason for a new company to adopt a "STONE"-suffixed mark for tires is to trade on opposers' goodwill and brand recognition of their famous FIRESTONE brand and the Bridgestone/Firestone corporate name. Opposers ask us to resolve any doubt in favor of the longstanding user and registrant of a famous mark and against the newcomer.

With respect to the issue of whether applicant's mark SILVERSTONE is primarily merely a surname, opposers argue that the evidence of record demonstrates that this name would be recognized as a surname by a substantial number of relevant consumers. Opposers point to the popular actress Alicia Silverstone, who starred in the movies Clueless and Batman and Robin, and whose name appears frequently and prominently in various newspaper and magazine articles made of record. The name Silverstone has the structure, pronunciation and "look and sound" of a surname, according to opposers. Opposers also contend that applicant has not shown SILVERSTONE to have non-surname significance, and

that the absence of this surname from some telephone directories is not sufficient evidence to rebut opposers' *prima facie* case of surname significance. Opposers argue that even a rare surname is unregistrable if the primary significance of that name is that of a surname. Finally, with respect to applicant's S SILVERSTONE design mark, opposers argue that the addition of an initial to the surname Silverstone does not avoid a surname refusal.

On the issue of likelihood of confusion, applicant argues that its mark SILVERSTONE is different in sound, appearance and meaning (a silver-colored stone) from the mark FIRESTONE (meaning a fire-resistant stone) and from the names Bridgestone/Firestone. Applicant maintains that any fame in opposers' mark and name is not a dispositive factor, and that opposers' mark FIRESTONE exists in a "crowded field" due the widespread third-party use and registration of marks containing the word "STONE" in the automotive industry, which uses and registrations have been acquiesced in and allowed by opposers. Applicant cites, for example, such registered marks as STONE GARD for tires, KEYSTONE for vehicle accessories and wheels, MILESTONE for break linings, PRESTONE for automotive fluids, VISTONE for chemical additives and lubricating oils, TOUCHSTONE for off-the-road vehicle radiators, BLACKSTONE for automobile

radiators and YELLOWSTONE for travel trailers. Applicant has made of record some evidence of third-party use of such marks as KINGSTONE and ROADSTONE for tires,[9] YELLOWSTONE and KEYSTONE for recreational vehicles, PRESTONE for automotive fluids, GLADSTONE AUTO for service centers, KEYSTONE MOTORS for an automobile dealership, BLACKSTONE AUTO, FIELDSTONE TIRE AND AUTO SERVICE and CORNERSTONE AUTOMOTIVE. It is applicant's position that opposers cannot now object to applicant's mark SILVERSTONE in view of these marks, and that consumers have been able to distinguish between these marks and have not been confused.

Applicant also points to the fact that, before the acquisition of the Firestone company by Bridgestone Corporation, both parties stated in their respective applications to register the FIRESTONE and BRIDGESTONE marks in the 1970s and '80s that there was no likelihood of confusion at a time when each knew of the existence of the other in the tire market. Moreover, neither party filed oppositions against the other party's applications.

Applicant also contends that because consumers are concerned with tire product safety and cost issues,[10] consumers exercise a degree of care in their purchases of

[9] As noted above, opposers have filed a lawsuit in the Central District of California against the owner of these marks.

[10] Applicant points to an advertisement in the record of opposers' FIRESTONE tires being offered for between $36 to $47.

tires. Applicant also points to the fact that there has been no actual confusion in the worldwide market in which both parties sell tires and with respect to applicant's limited U.S. sales. Finally, applicant argues that its mark was adopted in good faith, being derived from the name of the Malaysian state where applicant's initial manufacturing operations were located, and from the fact that that state has a large number of limestone hills.

On the issue of whether SILVERSTONE is primarily merely a surname, applicant maintains that no one in its organization has this surname, that the name is not used in a surname fashion, and that it does not have the structure, pronunciation or "look and sound" of a surname. Applicant also notes that Silverstone is a relatively rare surname, even more rare than other names which have previously been held not to be primarily merely surnames, such as Rivera and Douglas. Applicant also notes that the Patent and Trademark Office has registered other SILVERSTONE marks and has allowed these applications without surname objections. Applicant also points to the independent derivation of the SILVERSTONE mark as well as the ordinary English-language meaning of the words forming its mark (a silver-colored stone). Finally, applicant points to the design element

("S" design) in one of its marks resulting in a mark which has additional non-surname significance.

In reply, opposers maintain that there is no competent evidence to show any use by applicant of the SILVERSTONE mark in this country. In this regard, applicant has admitted in a discovery response that it has not advertised its goods bearing the mark in this country. Opposers' witnesses have also testified that they have not seen applicant's SILVERSTONE tires in the U.S. marketplace. Applicant's applications are based upon an intent to use the marks.

Concerning applicant's telephone directory listings of businesses with the word "STONE" in their names, opposers contend that those listings do not show that those businesses actually exist or that the public is aware of them. Moreover, opposers argue that there is no evidence of the extent of use of those names or the public's familiarity with them. Finally, third-party uses on unrelated goods and services are irrelevant, according to opposers.

Opinion and Decision

Evidentiary Objections

Before discussing the substantive issues in this case, we first rule on some of applicant's evidentiary

objections. Unless mentioned below, we have considered all of the testimony and evidence of record for whatever probative value it may have.

Applicant has objected to Dr. Neel's testimony on the grounds that he did not conduct a survey or study, that his opinions were not based on identifiable facts and data or reliable principles and methods, and that his opinions were not tested or otherwise subjected to peer review. Suffice it to say that we have given little weight to Dr. Neel's testimony based upon his linguistic analysis. As applicant has pointed out, likelihood of confusion depends on how purchasers perceive marks and not on the opinions of linguistic experts or those familiar with the meaning and derivation of words. See *Visual Information Institute, Inc. v. Vicon Industries, Inc.*, 209 USPQ 179, 189 (TTAB 1980); and *Fero Corp. v. Nicofibers, Inc.*, 196 USPQ 41, 45 (TTAB 1977). Furthermore, we have given relatively little weight to the opinion testimony of Messrs. Ramsey and Pacsi concerning the impact of another "STONE"-suffixed mark for tires in the market. We have also given little weight to the testimony of Mr. Hornickel concerning the share price of Bridgestone Corporation's stock on the Japanese stock exchange, offered as some evidence of the U.S. public's attitude toward opposers herein after the tire recall.

Applicant's objections, brief, 31-33, concerning the pre-test or pilot survey conducted by Ms. Johnson are well taken. We have given no weight to this survey.

Finally, opposers' ninth notice of reliance is admissible because it serves either to clarify, to make those portions of the discovery deposition relied on by applicant not misleading, or to otherwise place that testimony in context.

Likelihood of Confusion

Because opposers are the owners and users of marks in valid registrations, priority is not an issue in this case. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods

[or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering first the goods of the parties, applicant is seeking to register its marks for vehicle tires and inner tubes while opposers' registrations cover the same goods as well as a number of other goods. Because opposers' FIRESTONE registrations cover the identical goods, we shall focus our analysis of likelihood of confusion on those goods. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group,* 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)("[L]ikelihood of confusion must be found if the public, being familiar with [opposer's] use of MONOPOLY for board games and seeing the mark on *any item* that comes within the description of goods set forth by appellant in its application..." Emphasis in original). Also, as opposers have noted, in the absence of any limitation in applicant's applications and opposers' registrations, we must consider that applicant's tires and inner tubes travel in the same channels of trade and to the same class of purchasers as opposers' tires and inner tubes.

As opposers have pointed out, "[i]f the [goods] are identical, 'the degree of similarity necessary to support a conclusion of likelihood of confusion declines.'" *In re*

Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1334 (Fed. Cir. 1997), quoting, *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Turning, therefore, to the marks of the parties, there is no question that applicant's SILVERSTONE marks and opposers' FIRESTONE mark and the Bridgestone/Firestone trade name are specifically different in sound, appearance and possible connotation, containing only the common suffix "-STONE." However, under the circumstances of this case, where opposers are essentially asserting a family of "STONE"-suffixed marks, these dissimilarities do not end the inquiry. See, for example, *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1311 (Fed. Cir. 2002)("The presence of the root element WAVE, upon this court's review, introduces a strong similarity in all three marks."); and *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989)(VITTORIO RICCI found likely to cause confusion with NINA RICCI, MADEMOISELLE RICCI, SEGNORICCI and CAPRICCI, the Court stating, 12 USPQ2d at 1903: "The Board stated that the different first names, VITTORIO and NINA, incorporated into the respective marks have obvious differences in sound, appearance and connotation, although

it recognized that the surname, RICCI, is identical. However, the Board failed to consider the other marks of opposer and their effect on the similarity or dissimilarity of ETF's mark. These marks, MADEMOISELLE RICCI, SIGNORICCI and CAPRICCI, according to Nina Ricci, indicate that the RICCI surname is a unifying name in opposer's marks and is the dominant and significant part of opposer's marks in identifying its goods... Furthermore, the Board accorded little or no importance to the increasing sales in many lines under opposer's marks since the date of the district court decision... As this court said in Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 675, 223 USPQ 1281, 1284 (Fed. Cir. 1984)...: 'When an opposer's trademark is a strong, famous mark, it can never be 'of little consequence'. The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.' These factors argue against according controlling weight to the differences in the marks based solely on the use by the parties of dissimilar first names." (Citations omitted).

As just indicated, our analysis of the similarities of the marks must take account of the fame of opposers' FIRESTONE mark and Bridgestone/Firestone trade name. Our

primary reviewing Court has made it clear that "the fifth duPont factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection." *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). The Court noted that there is "no excuse for even approaching the well-known trademark of a competitor … and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially when the established mark is one which is famous." *Kenner Parker Toys v. Rose Art Industries, supra,* 22 USPQ2d at 1456. See also *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897-98 (Fed. Cir. 2000).

There can be no doubt on this record that opposers' FIRESTONE mark is a famous one for tires. Applicant does not appear to seriously dispute this fact. The FIRESTONE mark has been in use on or in connection with tires for over a century and FIRESTONE tires have been the subject of extensive sales and advertising over the years. They enjoy about 8-9% of the passenger and light truck replacement tire market. And, since 1988, the Bridgestone/Firestone trade name has also been widely used and exposed to the general public, including during the recall of FIRESTONE

tires in 2000. This trade name must also, therefore, be considered a famous one in the field of tires. We agree with opposers that the use of this corporate name has reinforced the link between the FIRESTONE and BRIDGESTONE brands of tires, and has tended to educate the purchasing public to recognize both of these marks as identifying tires produced by a single entity. Further, this record shows that opposers position their tires so as not to compete in the marketplace under their "good, better, best" multi-brand marketing strategy. This market positioning has increased the likelihood that purchasers encountering a new brand of tires with a "STONE" suffix will associate that new brand with the pre-existing FIRESTONE and BRIDGESTONE tires and the Bridgestone/Firestone trade name.

This likelihood is increased by opposers' success in opposing third parties' attempts to register "STONE"-suffixed marks for tires, as well as their challenge to other uses of "STONE"-suffixed marks, such as the ROADSTONE and KINGSTONE marks in the California trademark and dilution lawsuit.

Upon careful consideration of this record and the arguments of the parties, therefore, we agree with opposers that the purchasing public, aware of opposers' FIRESTONE and BRIDGESTONE tires as well as the Bridgestone/Firestone

corporate name used in connection with tires, who then encounter applicant's SILVERSTONE tires, are likely to believe that the SILVERSTONE tires are produced or sponsored by the same source that produces the FIRESTONE and BRIDGESTONE tires under the Bridgestone/Firestone trade name. Moreover, those purchasers aware of opposers' multi-brand marketing strategy who encounter applicant's SILVERSTONE tires are likely to believe that this is a new brand in opposers' multi-brand offering.

Applicant maintains that opposers' "STONE"-suffixed marks are in a "crowded field" and has cited numerous third-party registrations and uses of marks containing the word "STONE." It is noteworthy that applicant's illustrations of third-party use and registration are, for the most part, for goods and services related to the general automotive field and not specifically for tires. While applicant has gone to great lengths to find and recite every conceivable mark containing this word in the automotive field, applicant's brief is remarkably silent with respect to opposers' diligence in policing and enforcing their trademark rights in the very field of tires and inner tubes which most concerns opposers. See, for example, *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., supra,* 12 USPQ2d at 1904, where the Court commented that

appellant had been vigilant in protecting its marks from encroachment by others, and *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991)(third-party use on unrelated goods is irrelevant, the Court noting: "None of the third party marks and uses of ACE made of record are nearly as closely related to the activities of the parties as the virtually identical uses of the parties are to each other."); and *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2043 (TTAB 1989). Moreover, in order to maintain enforceable trademark rights, one is not required to challenge every conceivable arguably similar mark in the marketplace. See *Playboy Enterprises, Inc. v. Chuckleberry Publishing, Inc.*, 486 F.Supp. 414, 206 USPQ 70, 77-78 (SDNY 1980) and *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899, 1900 (TTAB 1989)("Thus, it is entirely reasonable for the opposer to object to the use of certain marks in use on some goods which it believes would conflict with the use of its marks on its goods and services while not objecting to use of a similar mark on other goods which it does not believe would conflict with its own use."). Furthermore, whether opposers, by apparent inaction with regard to certain other users of "-STONE" marks, may now be barred from challenging one or more such

uses, is not a question before us. Applicant cannot, in these oppositions, rely on purported rights of others to establish that it has the right to obtain a federal registration for a mark when there is a likelihood of confusion. See, e.g., *The Procter & Gamble Company v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976)(laches and estoppel are personal defenses which may not be asserted by a third party not in privity with the party that may have the right to assert the defense); and *Gastown Inc. of Delaware v. Gas City Ltd., supra.*

Moreover, there is no evidence with respect to the extent of the third-party uses which applicant has made of record. Accordingly, we cannot assume that the general public is aware of them. We also note that many of those marks are readily distinguishable from opposers' marks and trade name.

While applicant has argued that there has been no actual confusion, we note that applicant's applications are based upon intention to use, and, further, that applicant has acknowledged that it has not advertised its SILVERSTONE tires in this country. Although it appears that applicant has sold its tires in countries other than United States, any lack of actual confusion abroad is, of course,

irrelevant to the question of likelihood of confusion in this country.

Finally, as noted above, if there were any doubt about likelihood of confusion we would, of course, resolve such doubt in favor of opposers, as the long prior users and registrants. *Century 21 Real Estate Corp. v. Century Life of America,* supra, 23 USPQ2d at 1707; and *Kenner Parker Toys v. Rose Art Industries, supra,* 22 USPQ2d at 1458. Out of an entire universe of trademarks from which to choose, applicant chose, with full knowledge of opposers' mark, one which is similar to the marks and trade name used by opposers for many years. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.,* supra, 223 USPQ at 1285, quoting from *Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.,* 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962)("[T]here is therefore no excuse for even approaching the well-known trademark of a competitor, that to do so raises 'but one inference - that of gaining advantage from the wide reputation established by [the prior user] in the goods bearing its mark,' and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous and applied to an inexpensive product bought by all kinds of people without

much care"). See, also, *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1633 (TTAB 1988); and *Roger & Gallet S.A. v. Venice Trading Co., Inc.*, 1 USPQ2d 1829, 1832 (TTAB 1987).

Primarily Merely a Surname

In deciding whether a term is or is not primarily merely a surname, we must determine the primary significance of the term to the purchasing public. See *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975); *In re Hutchison Technology, Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988); and *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988). Opposers bear the burden of establishing a *prima facie* case in support of the conclusion that the primary significance of the term to the purchasing public would be that of a surname. If the *prima facie* case is made, then the burden of rebutting that case, i.e., the burden of showing that the primary significance of the term to the purchasing public is other than as a surname, shifts to the applicant. *In re Harris-Intertype Corp., supra; In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975); *In re Pyro-Spectaculars, Inc.*, 62 USPQ 355 (TTAB 2002); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990).

Factors to be considered in determining whether a term is primarily a surname include: (i) the rarity of use of the term as a surname; (ii) whether anyone connected with applicant has the surname; (iii) whether the term in question has any recognized meaning other than that of a surname; (iv) whether the term has the "look and sound" of a surname; and, if applicable, (v) whether the stylization of the term is so great as to create a separate commercial impression sufficient to render the term more than merely a surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995).

Upon careful consideration of the evidence and arguments on this issue, we conclude that opposers have demonstrated that SILVERSTONE is primarily merely a surname, and that it would be so perceived by at least a substantial number of relevant consumers. There is no question that Silverstone is a surname, albeit a relatively rare one. However, even though it is relatively rare, the surname Silverstone is shared by the popular actress Alicia Silverstone, which fact, we believe, serves to reinforce the surname significance of Silverstone to a significant segment of the general public. Also, this surname has the "look and sound" of a surname, similar to the perhaps more familiar surnames such as Blackstone and Gladstone. While

the separate words "silver" and "stone" may have the meaning of a silver-colored stone, we do not believe that this significance would be perceived when the mark SILVERSTONE is applied to tires. That is to say, we see no reason why purchasers would think of a silver-colored stone when seeing the mark SILVERSTONE on tires. Compare *In re Pickett Hotel Co.*, 229 USPQ 76061 (TTAB 1986)["We reject the appellant's argument that because the surname PICKETT is the phonetic equivalent of the word "picket," a word describing a type of fence or a labor demonstrator, a prima facie case has not been made out."]

Finally, with respect to applicant's "S" SILVERSTONE mark, we do not believe that this slight design element detracts from the primary significance of that mark as a surname. That mark retains its primary significance as a surname.

Decision: The oppositions are sustained because of likelihood of confusion and because applicant's marks are primarily merely surnames.