

O/001/01

IN THE MATTER OF THE TRADE MARKS ACT 1994

-and-

IN THE MATTER OF TRADE MARK APPLICATION No. 3343260

in the name of TERENCE PATRICK O'HALLORAN

to register the trade mark

Multibus

in class 12

-and-

OPPOSITION No. 414492

by VOLKSWAGEN AKTIENGESELLSCHAFT

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF LEISA
DAVIES, HEARING OFFICER, ACTING ON BEHALF OF THE REGISTRAR OF
TRADE MARKS DATED 20 DECEMBER 2019**

DECISION OF THE APPOINTED PERSON

1. This is an Appeal by the Applicant, Mr O'Halloran, who appeared remotely at a hearing before me, acting in person, against the decision of the Hearing Officer to uphold the Opposition brought against his Application for the trade mark

Multibus

('the Trade Mark') in respect of the following goods in class 12:

*Vehicle bodies, Vehicles, Vehicles and conveyances, Vehicles (Electric),
Vehicles for locomotion by land.*

2. The Opponent (who did not attend the hearing but filed a Skeleton Argument) opposed the application under s5(2)(b) of the Trade Marks Act 1994 relying on its International Registration (IR)

MULTIVAN

3. The Opponent relied on the IR registration as registered for the following goods in in class 12:

*Motorized land vehicles, vehicle bodies, motorbuses, trucks, caravans,
tractors, motorcycles, omnibuses, electric motors for land vehicles*

4. Since the IR was registered more than 5 years before the date of publication of the Application, the Opponent was required by s6A of the Act to prove genuine use in the European Community within that 5 year period. Although the evidence presented was inadequate in many respects, the Hearing Officer took the view that the Opponent had managed to establish genuine use within the EC in respect of the following categories of goods within the scope of the registration:

*Vans, transporters, people carriers, cargo carriers, minibuses, omnibuses,
motorbuses and campervans.*

5. This finding was not appealed by the Applicant, and seems generally correct to me on the evidence, although I consider the finding in relation to 'cargo carriers, omnibuses and motorbuses' to be very generous to the Opponent. So far as I can see the mark seems to have been used in relation to vans of the kind which are converted to campervans and small minibuses. But the terms 'omnibuses' and 'motorbuses' would generally be considered to define, or at least include, very different categories of

vehicles such as large buses and coaches for mass transport. 'Cargo carriers' would also include large lorries and trucks. In the end, however, the point probably does not matter.

6. It is worth pointing out at this stage that the evidence did not establish any use of MULTIVAN in the UK. So far as one can tell, the use of the brand by the Opponent was limited to mainland Europe or certain parts of it, and a different brand was used in the UK for the same products. There was therefore, as the Hearing Officer correctly found, no basis for asserting any acquired distinctiveness of the MULTIVAN trade mark in the UK.
7. Having made her findings on genuine use, the Hearing Officer concluded correctly that the goods which were the subject of the Application were essentially identical to the goods on which the Opponent was entitled to rely within the scope of the specification of the IR.
8. Turning to the average consumer, the Hearing Officer considered that they included both professional buyers and the general public. Either would be expected to display a *'particularly high level of attention at the time of purchase of the goods'* because of the high value of the goods and the importance of assessing reliability and quality. The purchasing process would inevitably involve both visual and aural exposure to the Marks. These findings are plainly correct.
9. The Hearing Officer considered, again correctly, that both Marks would be seen as conjoining two words: MULTI VAN and MULTI BUS. The word MULTI in both would be understood as conveying the idea of multiple or many. As she concluded in paragraph 83:

'Conceptually both marks will be perceived as a reference to a multipurpose vehicle/mode of transport or a multiple fleet of vehicles.'

10. In relation to the distinctive character of the Opponent's Mark, the Hearing Officer repeated this conclusion, noting that the word MULTI would be recognized as a shortening of the word multiple whilst the VAN element would be seen as descriptive. She concluded in paragraph 86 that

'The inherent distinctive character of the mark as a whole resides with the two words in combination, albeit weighted in favour of the MULTI element as opposed to the VAN element and which I place at no higher than an average degree'.

11. Here I disagree with the Hearing Officer's conclusion. It seems to me that whilst MULTIVAN is an invented word, the highly descriptive nature of its component parts in relation to the goods for which it is registered, and the commonplace nature of its structure (the word MULTI being used as a prefix to characterize the primary subject of a composite noun) put it at the lowest end of the spectrum of distinctiveness within which valid trade marks may exist.

12. Turning to the question of likelihood of confusion, the Hearing Officer held that the average consumer would not be likely to mistake one mark for the other. This was plainly correct. Given the high level of attention which would be paid when considering the purchase of goods of this character, and the low level of distinctive character of the marks in question, it is not conceivable that a reasonably observant and circumspect consumer would mistake MULTIVAN for MULTIBUS.

13. The Hearing Officer then turned to consider the question of so-called 'indirect confusion', namely the conclusion by the average consumer that although the two marks are recognizably different, the similarities are such that the later mark must be another brand of the owner of the earlier mark.

14. She concluded as follows:

'The shared presence of the Multi element at the beginning of the mark in combination with the second descriptive element is such to create a perception in the mind of the average consumer that the vehicles sold under the marks are part of the same undertaking's range of vehicles. In my view the average consumer even paying a high degree of attention will perceive the application to be a sub brand of the earlier mark and that the respective goods which are identical or highly similar originate from the same or economically linked undertaking.'

15. I consider this conclusion to be wrong.
16. The mark MULTIVAN comprises the use of a familiar and highly descriptive prefix MULTI to convey the impression of a number of vans or a variety of vans or a multipurpose van. The average consumer can be expected to have come across the word MULTI used as a prefix to a noun in hundreds of words, including in trade marks, for the same or similar purposes.
17. In the circumstances, it may be doubted whether the mark MULTIVAN (lacking any reputation in the market) would necessarily come to the mind of a consumer seeing the mark MULTIBUS at all. However, even if it did, it would not be in the least surprising that two different traders, one involved in vans and the other in buses, may independently be using MULTI as a prefix to the noun which describes their products. It would therefore be folly for a consumer to conclude simply from this similarity that the marks indicate a common trade origin.
18. The Hearing Officer quite rightly identified the average consumer as someone who would display a particularly high degree of attention when considering the purchase of goods of this kind. But it is not merely a matter of attention. The average consumer is deemed to be reasonably 'circumspect'. Circumspection includes not leaping to conclusions which are not justified by the known facts and taking reasonable precautions

(bearing in mind the nature of the goods and the importance of the purchase) to resolve uncertainties.

19. I can see that the position might be different if the mark MULTIVAN had a high degree of reputation as one of a series of marks from the same stable (MULTILORRY, MULTIPICKUP, MULTICOACH etc.). In such a case one could see how the average consumer might have learnt to associate this structure (MULTI followed by the name of a type of vehicle) as designating goods from one particular source.¹ But here there is no such reputation and no other good reason to make the assumption required for confusion to occur.

20. It is of course well-established, as the Opponent has pointed out, that an appellate tribunal will not interfere with the decision of a Hearing Officer on the issue of likelihood of confusion save where there has been a clear error of principle or where the decision is plainly wrong. In my mind this is a case which falls into the latter category. It may be that the Hearing Officer's error on likelihood of indirect confusion was due to her earlier overestimate of the distinctive character of the earlier mark, or it may be that it was due to an underestimate of the circumspection and care to be expected from the average consumer. Either way (or both) I believe that the decision was well outside the bounds of what a reasonable tribunal acting reasonably could have decided on the facts of this case.

21. I therefore direct that the Applicant's mark shall proceed to grant and that the award of costs be set aside.

22. I shall direct payment by the Respondent of £500 towards the Appellant's costs and expenses of the Opposition and the Appeal.

**IAIN PURVIS QC
THE APPOINTED PERSON**

¹ See Il Ponte Finanziaria C-234/06 at 61-64

3 January 2021