

O/025/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2568762
BY SAM ROACH TO REGISTER THE TRADE MARK**



IN CLASSES 7, 12, 25 AND 37

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 101839
BY RENAULT S.A.S**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2568762
By Sam Roach to register the trade mark**



and

IN THE MATTER OF opposition thereto under No 101839 by Renault s.a.s

BACKGROUND

1. On 11th January 2011, Sam Roach applied to register the mark as above in classes 7, 12, 25 and 37. The goods and services, the subject of this partial opposition, are as follows:

Class 7

Exhausts and starters.

Class 12

Vehicles; apparatus for locomotion by land, air or water; wheelchairs; motors and engines for land vehicles; vehicle body parts and transmissions. .

Class 37

Motor vehicle servicing; inspection, repair, restoration, maintenance and reconditioning services for vehicles; motor vehicle cleaning and lubricating services; diagnostic tuning; motor tuning; tyre fitting and repair services; exhaust fitting and repair services; advice and consultancy services relating to all the aforesaid goods

2. The application was allocated number 2568762 and was published in the Trade Marks Journal on 28th January 2011, and on 27th April 2011 Renault s.a.s lodged an opposition against the goods and services specified above.

3. Renault has opposed on the sole basis of section 5(2)(b) of The Trade Marks Act 1994 ('the Act'), citing the following earlier trade mark:

Mark. Relevant dates	Goods and services relied upon under section 5(2)(b)
<p data-bbox="237 449 620 485">International (EC) 1008900</p>  <p data-bbox="237 764 699 831">Date of international registration: 10th June 2009</p> <p data-bbox="237 873 711 940">Date of protection in the EC (UK): 10th June 2009</p>	<p data-bbox="756 457 899 489">Class 12:</p> <p data-bbox="756 510 1382 615">Motor vehicles, engines, bodies for vehicles, spare parts and replacement parts for motor vehicles, engines and bodies for vehicles.</p>

4. Renault says the goods in Mr Roach's application are either identical or similar to its own goods and that the services are complementary to its goods. It says Mr Roach's mark contains a device reminiscent of the numeral '4' and that the respective marks are similar. All factors considered, Renault says there is a likelihood of confusion under section 5(2)(b) of The Trade Marks Act 1994 ('the Act').
5. Mr Roach filed a counterstatement denying that there is any likelihood of confusion. Specifically, he says his mark is for a heavily stylised letter 'R' and the device element is not reminiscent of the numeral '4'. The respective marks are different visually, phonetically and conceptually. In relation to conceptual differences, Mr Roach notes that the combination of a letter and numeral commonly refers to a product range and/or model. Mr Roach also notes that the relevant public in the motor vehicle market, where goods and services are expensive and specialised, pays a very high degree of attention when making a purchase.
6. Both parties filed written submissions at the conclusion of the proceedings which I shall take into account. Neither party wished to be heard and consequently this decision is made after a careful reading of the papers. Both parties sought costs.

DECISION

Section 5(2)(b)

7. The opposition is founded upon Section 5(2)(b) of the Act. This reads:

5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a)

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

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

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

9. By virtue of the Act and The Trade Marks (International Registration) Order 2008 (as amended) (hereafter, “the Order”), Renault’s mark is a protected international trade mark (EC). Protection of this mark, within, of course the UK as part of the EC, was within 5 years of the publication of the subject application, and accordingly the earlier mark is not subject to proof of use requirements.

10. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-*

120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods and services

11. In assessing the similarity of the goods and services, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the goods and services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the Judgment:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature and their method of use and whether they are in competition with each other or are complementary.’

12. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

13. The respective goods and services read as follows:

Renault’s goods	Mr Roach’s goods and services
<p>Class 12: Motor vehicles, engines, bodies for vehicles, spare parts and replacement parts for motor vehicles, engines and bodies for vehicles.</p>	<p>Class 7 Exhausts and starters.</p> <p>Class 12 Vehicles; apparatus for locomotion by land, air or water; wheelchairs; motors and engines for land vehicles; vehicle body parts and transmissions. .</p> <p>Class 37 Motor vehicle servicing; inspection, repair, restoration, maintenance and</p>

	reconditioning services for vehicles; motor vehicle cleaning and lubricating services; diagnostic tuning; motor tuning; tyre fitting and repair services; exhaust fitting and repair services; advice and consultancy services relating to all the aforesaid goods
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Class 7

14. According to the Ninth Edition of the International Classification of Goods and Services (as amended) under the Nice Agreement exhausts and starters are not classified under class 12 but under class 7¹. But the fact that Renault's motor parts are in class 12 and Mr Roach's exhaust and starters are in class 7 does not mean that an overall finding of dissimilarity is inevitable.² Whilst the classification of goods and services adopted by the applicant is relevant to what goods and services may be covered this is not decisive of the question of similarity, in respect of which guidance should be sought from the case law to which I have referred, in the light of, as appropriate, my own knowledge, relevant dictionaries and any evidence (of which there is none in this case) filed.

15. Proceeding on that basis, exhausts and starters are, in their nature, spare parts of cars; they are available as such to be fitted by mechanics in garages (including specialised garages such as KWIK FIT or HALFORDS), or for the competent and confident DIY mechanic who can source them as spares, for example from garages or motor factors. They are therefore available through the same trade channels and alongside other spares. I find, then, that exhausts and starters are, if not identical to Renault's goods in class 12, then highly similar.

Class 12

16. It is self-evident the respective goods are identical.

Class 37

17. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ('Boston')* Case T- 325/06 the General Court stated:

¹ See <http://www.wipo.int/classifications/nivilo/nice/index.htm?lang=EN#>

² See eg the discussion at paras 47-52 of BL O-004-11 'Tao Asian Bisto' – a decision of the Appointed Person

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).”

18. Renault’s specification covers the type of automotive components which would be essential for the repair services covered by the applicant. Evidence on this point is superfluous; vehicle spare parts are essential to the repair and maintenance of vehicles. The consumer is also used to the close links between vehicle and parts manufacturers, such as FORD, RENUALT and so forth, and dealerships, garages or centres offering, amongst other things, repairs and servicing. Unless it is obvious they are not economically ‘linked’, those responsible for a service or repair are inclined to be considered by the average consumer to be responsible (including being authorised by) the vehicle and parts manufacturer. In my opinion, this leads to the kind of complementary relationship spoken of in the *Boston* case and on that basis, I find that the services in Mr Roach’s specification are highly similar to the goods covered by Renault.³

19. I have paused slightly over, “motor vehicle cleaning and lubricating services;” and “tyre fitting and repair services”. This is because I am aware these services can be offered as discrete stand alone services outside a normal garage environment. That said, a ‘car wash’ would not normally also provide car lubrication. Moreover, car cleaning is not confined to the common rinse and shampoo offered in a car wash and may include specialised cleaning, such as steam cleaning, offered only by a garage. Similarly, garages also offer tyre fitting and repair services. The result of this is that I find the boundaries insufficiently clear to be able to distinguish these services from the remainder of those listed in Mr Roach’s specification and make the same finding of ‘highly similar’ for these services also.

The average consumer and nature of the purchase

20. I need to assess who exactly the average consumer is and the nature of acquisition and purchase.

³ A finding consistent with, eg OHIM Board of Appeal case R 326/2008-1 and UK Registry case BL O-078-10.

21. The average consumer for Renault's goods is likely to be, primarily, the general public, either directly or, the case of spares, indirectly, through a garage or specialised fitting centre. Even in the case of an 'indirect' purchase, by which I mean the consumer may not even see the part before fitting, the garage or specialised fitter will, nevertheless, often provide information as to the source of the part(s) being fitted. Likewise for Mr Roach, his goods and services will be bought also in this way by the general public
22. The nature of the purchase will, in both parties' cases, be extremely well considered. Given its expense and running costs, by its nature, a vehicle is an extremely careful and considered purchase. It follows from this that the consumer will be highly circumspect in the purchase of both parties' goods and services. Even if the parts may be much less than the vehicle itself, concern over compatibility and authenticity issues will be uppermost in the consumers' mind.
23. I will need to factor in these observations into my final analysis of likelihood of confusion.

Comparison of the marks

24. The case law makes it clear I must undertake a full comparison of the marks, taking account of visual, phonetic and conceptual similarities and dissimilarities, from the perspective of the average consumer. Marks need to be considered in their totalities and taking account of overall impression, giving recognition to any distinctive and dominant elements.
25. The marks to be compared are as follows:

Renault's mark	Mr Roach's mark
	

26. Visually, Renault's mark comprises the instantly recognisable letter 'R' and numeral '4' in upper case, block type. There is very slight stylisation in these elements which present in almost pixelated form. Mr Roach's mark also comprises the letter 'R' in upper case but in italicised script preceded by the device of three parallelograms. Although I have observed there are slight variations in the way the respective marks present the letter 'R', in this case

it does not detract from the principle that word marks (by which I include letter marks) protect the word or letter within a range of formats.⁴

27. I do not agree with Renault that the device in Mr Roach's mark resembles the number '4' and would be recognised as such by the average consumer. It is a three parallelogram device which is not reminiscent of anything in particular.
28. Taking the visual similarities and dissimilarities into account I find there is a low to moderate degree of visual similarity between the respective marks.
29. Aurally, Renault's mark will be pronounced 'are four' and Mr Roach's simply 'are'. Taking the aural similarities and dissimilarities into account I find there is a low to moderate degree of aural similarity between the respective marks.
30. Conceptually, there is no clear semantic concept behind Renault's mark, beyond the single letter and number combination. This combination has no particular meaning, concealed or obvious. Mr Roach's mark is also bereft of semantic meaning, beyond the simple letter 'R'. In particular, as I have said, the additional abstract device element confers no meaning. Insofar *only* as the respective marks share the single letter 'R' (which in Renault's mark is part of a combination) then they may be said to be similar, but not otherwise. On that basis I find that the respective marks are, conceptually, similar to a low degree.

Overall finding of similarity of marks, including distinctive and dominant elements

31. I need to bring my individual findings together in an overall assessment of similarity, bearing in mind any distinctive and dominant elements. At this point, Renault contends that the letter 'R' is the dominant element within its mark by virtue of the fact that, (a) it appears before the number '4', and (b) that the number '4' is in any event a 'weak element' as it could simply designate a 'model or serial number on the one hand and a meaningless device on the other.' Unsurprisingly, Mr Roach puts his own slant on the question. He says the overall differences in the marks cannot be ignored and his mark contains a dominant device before the letter 'R' which would not, as I have already found, be reminiscent of the number '4'. In summary, Mr Roach urges me to take account of case law, such as OHIM Board of Appeal Case R 1301/2010-4 *Incase Designs Corp v PR Electronics A/S (Incase)* which observes:

"In short signs like the present ones, every single part is important and differences have a higher impact on the overall impression than in longer

⁴ See the discussion in, eg BL O-387-11 'Boo Boo', a recent decision of the Appointed Person

marks and can modify the perception of those marks, even if the difference is in just one letter or numeral. In such a case, the fact that some of their letters are in common, even if in identical order, becomes of minor importance.”

32. Of course, there is always a danger in extracting a particular legal principle where there is none and each case is factually different, but as the *Incase* case makes clear, what matters is *overall impression*. With that in mind I do not think the Renault approach which asserts that the letter ‘R’ is ‘dominant’ in its mark is a proper reflection of the correct assessment. That is to say, its mark is a letter and number *combination*, and as such the number ‘4’ is impossible to ignore or downplay.
33. Moreover, and without agreeing with Mr Roach’s argument that his parallelogram device is the ‘dominant’ element in his mark, that element in Mr Roach’s mark cannot be ignored or downplayed either. His mark is the *combination* of a parallelogram device and the single letter ‘R’.
34. So, there is an inevitable point of commonality in the shared letter ‘R’ but both marks have additional elements which contribute to overall impression. And where the common element is so minimalist, those additional elements (especially the recognisable numeral ‘4’) are apt to affect overall impression more decisively than they would in more complex marks.
35. Taking all factors into account, I find that, overall, and notwithstanding the common element ‘R’, I find the respective marks are similar only to a low to moderate degree.
36. I may just add at this point that I would have arrived at the same finding of similarity even if I had been persuaded by Renault that the device in Mr Roach’s mark resembles the number ‘4’. As is clear from my assessment I have not been persuaded and do not believe the average consumer would see the number ‘4’ at all, but even if they did, the simple inversion of the numeral and letter in the respective marks has a decisive effect on overall impression within minimalist marks, such that the similarity would still, in my view, be low. At first sight this may seem odd as an additional point of visual similarity would be present, but my point is that the effect of an inversion of minimalist elements on *overall impression* can be much more dramatic and decisive than it would be with more complex or even recognisable elements.

Distinctiveness of the earlier mark

37. My discussion above leads me into a final assessment which must be done prior to an assessment of likelihood of confusion, namely, the distinctiveness of the earlier mark. A mark comprising an invented word, such as KODAK for example, will inevitably be very high on the scale of distinctiveness,

whereas a known word which has a more obvious connection with the relevant goods or services will be lower on the scale of distinctiveness.

38. It is true to say the earlier mark is minimalist in nature; that is to say it is a simple single letter and numeral combination. Such marks tend to be categorised as having, at best, a low level of inherent distinctiveness. There is no question but that the earlier mark has a level of distinctiveness; it is registered and by virtue of that fact alone, I must assume that in the process of registration it has undergone the required 'stringent' examination as to its distinctiveness⁵. Such an examination does not however and as a rule involve assessing a particular level of distinctiveness and such an assessment is left to adversarial proceedings in an opposition such as this.
39. Given the minimalist nature of the earlier mark and my own common knowledge that in the motor trade single letters and numeral combinations are quite common, eg to designate classes of cars, catalogue numbers and codes, all by reference to such designations, I find that the earlier mark has a low to moderate level of inherent distinctiveness.
40. In its submissions Renault make the point that the RENAULT brand is well established in the market place, and by virtue of that fact the 'R' of the 'R4' mark may well be associated with RENAULT. This is conjecture and there is no evidence to support such a contention. Accordingly, I give it no weight in my assessment.
41. Renault has provided no evidence at all of its use of the R4 mark and accordingly I have no alternative but to find that the low level of inherent distinctiveness in its earlier mark has not been enhanced through use.

Global assessment under section 5(2)(b) - likelihood of confusion

42. At this point I need to remind myself of my various findings and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.
43. I have found the earlier mark has a low to moderate level of inherent distinctiveness. I have found the respective goods and services to be highly similar or identical. I have found the respective marks to be similar, overall, to a low to moderate degree. I have observed that the nature of the purchases and acquisitions will be well considered, a fact which somewhat mitigates against likelihood of confusion. I also remind myself that the nature of 'confusion', whether it be direct or indirect, for the purposes of section 5(2)

⁵ CJEU authorities have consistently stressed the need for stringent examination of all marks submitted for registration and in the case, eg of C-265/09P OHIM v BORCO GmbH & Co KG considered marks specifically consisting of single letters (see paras 36-39 especially).

does not include mere association in the sense of 'bringing to mind'.
Bearing all these factors in mind I am not convinced there will be a likelihood of confusion in this case.

44. The opposition under section 5(2)(b) accordingly fails.

Costs

45. Mr Roach has been successful in defending against the opposition and is entitled to a contribution towards his costs. Neither party sought costs off the normal scale and I am of course mindful that neither party sought a hearing. In the circumstances I award Mr Roach the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Filing counterstatement and considering statement- £300

Filing submissions £300

Total £600

46. I order Renault s.a.s to pay Sam Roach the sum of £600. The sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of January 2012

**Edward Smith
For the Registrar,
the Comptroller-General**