

O/0749/23

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION

NOS. 3720978 & 3720982

BY GREAT WALL MOTOR COMPANY LIMITED

TO REGISTER:

FUNKY CAT 

AND

FUNKY CAT

AS TRADE MARKS IN CLASSES 9, 12, 35 & 37

AND

IN THE MATTER OF THE OPPOSITIONS THERETO

UNDER NOS. 431383 & 431384 BY

COMPAGNIE D'AFFRÈTEMENT ET DE TRANSPORT C.A.T.

BACKGROUND AND PLEADINGS

1. On 12 November 2021, Great Wall Motor Company Limited (“the applicant”) applied to register the trade marks shown on the front cover of this decision in the United Kingdom in respect of the following goods and services:

Class 9

Computer programs, recorded; computer operating programs, recorded; monitors [computer programs]; computer programs, downloadable; downloadable image files; computer software applications, downloadable; computer screen saver software, recorded or downloadable; Smartphone software applications, downloadable; Face recognition equipment; reflective articles for wear, for the prevention of accidents; digital signs; rescue laser signaling flares; intercommunication apparatus; mobile telephones; satellite finder meters; phonograph records; accumulators, electric for vehicles; batteries, electric, for vehicles; accumulator jars; battery jars; none of the foregoing items for use with bicycles; all the goods being exclusively used for vehicles for the transport of passengers.

Class 12

Vehicle; cars; camping cars; Driverless cars [autonomous cars]; electric cars; electric bicycles; engines for land vehicles; motors for land vehicles; gear boxes for land vehicles; automobile bodies; automobile chassis; wheels for automobiles; automobile wheel tires; upholstery for vehicles; air bags [safety devices for automobiles]; bumpers for automobiles; freewheels for land vehicles; clutches for land vehicles; brakes for land vehicles; hoods for land vehicle engines; windscreens for automobile; rearview mirrors; shock absorbers for automobiles; doors for vehicles; safety belts for vehicle seats; steering wheels for vehicles; windows for vehicles; Car pedals on both sides; Car sun shield; spare wheel covers; none of the foregoing items for use with bicycles; all the goods being exclusively used for vehicles for the transport of passengers.


Class 35

Import-export agency services; sales promotion for others; procurement services for others [purchasing goods and services for other businesses]; marketing management; advertising; presentation of goods, for retail purposes; provision of an online marketplace for buyers and sellers of goods and services; business management consultancy; business organization consultancy; all the services being exclusively used for vehicles for the transport of passengers.

Class 37

Vehicle service stations [refueling and maintenance]; motor vehicle maintenance and repair; vehicle maintenance; anti-rust treatment for vehicles; land vehicle breakdown repair services; vehicle greasing; vehicle cleaning; vehicle washing; vehicle polishing; varnishing services for vehicle; machinery installation, maintenance and repair; rustproofing; Retreading of tires for vehicles; vehicle wheel rubber tire repair; tire balancing for vehicles; all the services being exclusively used for vehicles for the transport of passengers.

2. On 28 February 2022, the applications were opposed by Compagnie d’Affrètement et de Transport C.A.T. (“the opponent”). The oppositions are based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concern all the goods and services for which registration is sought. The opponent is relying on the following two marks:

Earlier mark	Goods and services relied on
<p>UKTM No. 904270716 (“earlier logo mark”)</p>  <p>Filing date: 3 February 2005 Registration date: 1 July 2010</p>	<p><u>Class 12</u> <i>Vehicles; apparatus for locomotion by land, air or water.</i></p> <p><u>Class 39</u> <i>Transportation and storage; Transporting of people and/or goods from one place to another; Freighting; Freight brokerage [forwarding]; Transport of passengers and/or goods by rail, by road, by air, by water or by</i></p>

Earlier mark	Goods and services relied on
<p>Seniority claimed from UK Application Number 1272980, with filing date of 1 October 1986</p>	<p><i>pipeline; Storage of goods; Rental of transport vehicles, warehouses and garages; Inspection of vehicles or goods before transport; Provision of information relating to the transport and storage of goods; All the aforesaid services being exclusively offered in relation to logistical services for the motor industry.</i></p>
<p>UKTM No. 909769696 (“earlier word mark”)</p> <p>CAT</p> <p>Filing date: 28 February 2011 Registration date: 5 August 2011 Priority date: 25 February 2011, claimed from French trade mark no. 11/3809733.</p>	<p><u>Class 37</u></p> <p><i>Maintenance and repair for automobiles and motorcycles; Finishing and preparation of automobiles and motorcycles; Assembly and fitting of parts and fittings for automobiles and motorcycles; Vehicle and car wash; Cleaning of automobiles and motorcycles; vehicle repair; tuning stations for automobiles and motorcycles; all the aforesaid services being exclusively offered in relation to logistical for automobiles industry.</i></p> <p><u>Class 39</u></p> <p><i>Logistics for the automobiles industry (vehicles, motorcycles, spare parts and fittings therefore and goods) including in particular railway, road, air or water transport; vehicle storage of spare parts and fittings for automobiles, transit services, warehousing services; Garaging of automobiles and motorcycles, inspection of vehicles, spare parts and components of automobiles prior to the transport thereof;</i></p>

Earlier mark	Goods and services relied on
	<p data-bbox="756 255 1396 1003"><i>Freighting and freight brokerage of automobiles and motorcycles, spare parts and fittings therefore and goods; hiring of transport vehicles, for the requirements of automobiles logistical services, and more particularly the transport of vehicles, motorcycles, spare parts and components of automobiles and motorcycles; Information services in connection with storage and transportation of vehicles, spare parts, components of automobiles and goods; All the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.</i></p> <p data-bbox="756 1077 1396 1391"><u>Class 42</u> <i>Diagnostic stations and testing of automobiles and motorcycles, the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.</i></p>

3. The above marks qualify as earlier marks under section 6(1) of the Act. As the registration processes for both were completed more than five years before the date of application for the contested marks, the opponent has stated that it has used both marks for all the goods and services relied upon.

4. The opponent claims that the marks are highly similar, as the word “Cat” is the dominant and distinctive element of the contested marks, and that the goods and services covered by the marks are either identical or highly similar. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK, which is increased by the enhanced distinctive character of the marks.

5. The applicant filed defences and counterstatements denying the claims made and putting the opponent to proof of use of the earlier marks and its claims of enhanced distinctive character.

6. Neither side requested a hearing and the opponent filed written submissions in lieu of a hearing on 24 March 2023. I have taken this decision following a careful consideration of the papers.

7. In these proceedings, the opponent is represented by Sipara Limited and the applicant by Reddie & Grose LLP.

EVIDENCE

8. The opponent filed two witness statements. The first comes from Stuart Warren, Managing Director of CAT-UK, a wholly owned subsidiary of the opponent, and is dated 14 October 2022. The second comes from Nathalie Huet, the Legal Director of the opponent, and is dated 17 October 2022. Both go to the use made of the earlier marks in the EU and the UK.

DECISION

Proof of Use

9. Section 6A of the Act is as follows:

“(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section '*the relevant period*' means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[(5) Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

...”

10. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act applies. It is as follows:

“(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the ‘five-year period’) has expired before IP completion day-

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day-

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union.”

11. Section 100 of the Act is also relevant. It reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):¹

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

¹ Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to refer to the trade mark case-law of EU courts, although the UK has left the EU.

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

13. In its written submissions, the opponent admitted that use had not been shown for some of the goods and services. It submits that use has been shown for all the services for which the earlier word mark stands registered and the following services for which the earlier logo mark stands registered:

Class 39

Transportation and storage; Transporting of ... goods from one place to another; Freightage; Freight brokerage [forwarding]; Transport of ... goods by rail, by road, by air, by water ...; Storage of goods; Rental of transport vehicles, warehouses and garages; Inspection of vehicles or goods before transport; Provision of information relating to the transport and storage of goods; All the aforesaid services being exclusively offered in relation to logistical services for the motor industry.

14. The period in which use must be shown is the five years ending with the date of application for the contested marks, i.e. 12 November 2021. Therefore, the relevant period is 13 November 2016 to 12 November 2021. For the part of this period up to IP Completion Day (30 December 2020), the relevant territory is the EU (which included the UK); for the period thereafter, it is the UK.

15. Ms Huet states that the opponent was founded in 1957 by the car manufacturer Renault to provide it with shipping and logistics services. By 2001, the opponent had become independent and was offering such services to the automotive industry as a whole.² A survey of vehicle logistics in Europe for the period 2020/2021 conducted by the Association of European Vehicle Logistics describes the opponent as “*one of the European independent leaders in automotive logistics services including transport, distribution, preparation, customisation.*”³ Ms Huet states that:

“In 2019 the Opponent employed around 8,800 people in 27 countries, and delivered around 7.3 million vehicles using a fleet of 1600 trucks and 2300 rail wagons. Our cargo logistics division, which includes delivery of motorcycles, delivered around 33 million parcels and 100,000 motorcycles around the EU in 2019.”⁴

16. Ms Huet does not say whether the figures in the first sentence quoted above relate to the EU or cover the whole world. An undated screenshot from the opponent’s

² Paragraph 4.

³ Exhibit NH1, page 3.

⁴ Paragraph 2.

website suggests that a significant proportion of services is likely to have been provided in Europe (which, I accept, is larger than the EU). The 2020/2021 survey states that services are provided in the United Kingdom and the following EU countries: Austria, Belgium, Bulgaria, Croatia, Czech Republic, Estonia, France, Germany, Greece, Hungary, Italy, Latvia, Lithuania, Luxembourg, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia and Spain. However, it also shows services being provided in Russia, Serbia, Turkey, Ukraine, the Middle East and Latin America. A map taken from the opponent's website shows sites in the UK, France, Germany, Poland, Lithuania, Austria, Italy, Slovenia, Romania, Bulgaria, Spain and Portugal, although I note that the website print-out is undated.⁵ The opponent provides services in different countries through operating companies, such as CAT UK Services Ltd and C.A.T. España Fletamentos y Transportes SA in Spain. Ms Huet confirms that the operating companies use the earlier marks with the opponent's permission and in compliance with branding guidelines.⁶

17. Ms Huet does not provide turnover figures for the EU, but there is a collection of sample invoices relating to sales in France and Spain.⁷ 16 of these fall within the period 13 November 2016 to 31 December 2020, with the earliest dated 12 January 2017 and the latest 31 October 2020. The invoices bear the logo mark in the variant form shown below:



The financial information has been redacted. The invoices are in French and Spanish and not all the terms have been translated. Consequently, it is not straightforward to determine which individual services have been supplied. However, Ms Huet confirms in her witness statement, under a statement of truth, that the invoices relate to the provision of the services listed below. This statement has not been challenged by the applicant. The services are:

⁵ Exhibit NH2.

⁶ Paragraph 5.

⁷ She gives global turnover figures.

“i) ‘Vehicle logistics’:

- a) Working with vehicle manufacturers to plan logistical management and vehicle movements.
- b) Vehicle quality – ensuring safe transportation, inspection, cleaning, mechanical functioning and overall quality of all vehicles.
- c) Import – dealing with all import, customs requirements and registration of transported vehicles.
- d) Technical servicing of vehicles – providing vehicle repair and servicing of vehicles.

ii) Supplier management:

- a) The Opponent operates as a logistic provider of third party goods (eg spare parts) and services to clients, and provides management of those services and goods to clients.

iii) Distribution/transportation/storage:

- a) The Opponent provides transportation and distribution of vehicles nationally and internationally.
- b) This means moving vehicles from point of import or from place of manufacture to either the opponent’s own secure storage compounds, or to the client’s storage compounds or elsewhere as required. The Opponent also provides vehicle delivery for dealer and retail networks.
- c) As mentioned above, the Opponent provides storage compounds where vehicles can be safely stored for onward transportation. These storage compounds also provide a range of other vehicle services, including washing, protection, preparation, maintenance, repair and fitting of accessories.

I confirm that these services are supplied not only in relation to new vehicles, but are also supplied in relation to used or resale vehicles.

iv) Cargo services:

- a) The Opponent also supplies cargo distribution and transportation services both nationally and internationally. The majority of these services are provided by road, but the Opponent also offers transport by rail and sea.
- b) The Opponent also provides associated logistical services such as warehousing and customs agency services, and advising on transport schemes for particular client needs.

As a result of the Opponent's historical connection with the automotive industry, a majority of the cargo services relate to transportation of automotive parts and components, as well as motorbikes. However the cargo services can be used for the transportation of any kind of good.”⁸

18. Ms Huet adds that the opponent has set up a number of specialist sub-brands: NIGHT CAT (spare part transportation); GLASS CAT (transportation of windscreens); BIKE CAT (transportation of motorcycles); TOP CAT (emergency spare part and component delivery); and SUPPLY CAT (logistical management for component delivery). Further details of these sub-brands can be found in the website extracts in Exhibit NH4, but these are undated. I have nothing to tell me when these were established or the extent of their use.

19. Turning to the UK, I note that Mr Warren does give turnover figures, which I reproduce in the table below:⁹

Period	UK Turnover (£)
Financial Year – December 2018	16,577,000
Financial Year – December 2019	12,282,000
Financial Year – December 2020	11,022,000
Financial Year – December 2021	12,004,000

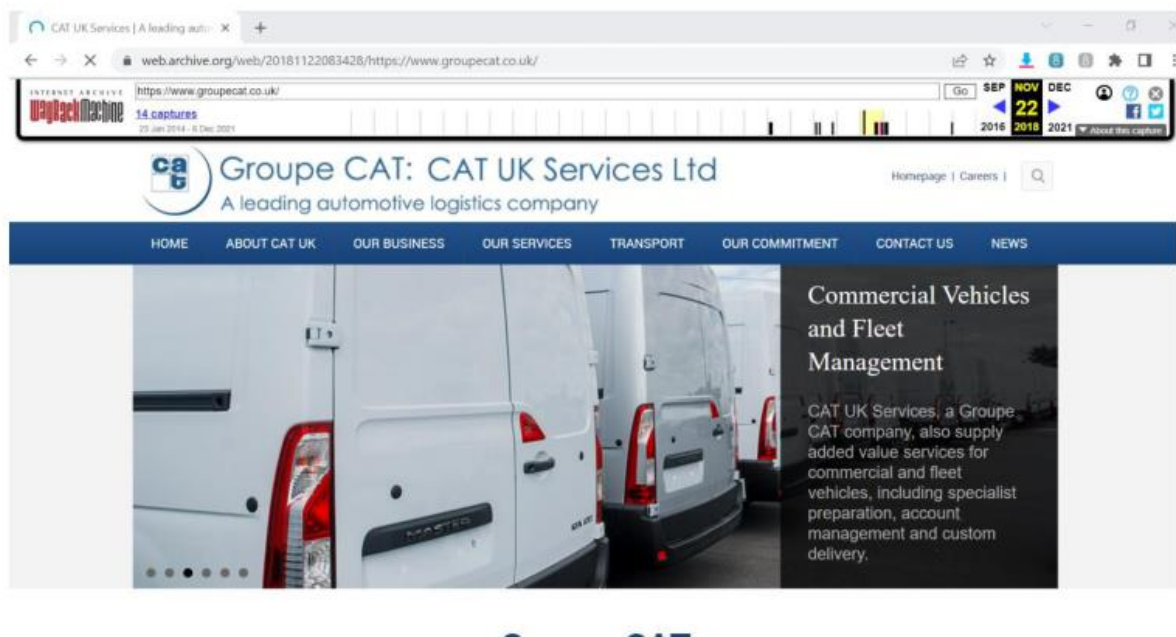
⁸ Paragraph 6.

⁹ Paragraph 9.

20. He confirms that these figures relate to services provided under the earlier marks.

21. Exhibit SMW6 contains 12 sample invoices relating to services provided in the UK. These also bear the logo mark shown in paragraph 17 above. The earliest of these is dated 8 May 2017 and the latest 31 December 2020. As with the invoices exhibited by Ms Huet, the financial value of the services has been redacted. The items invoiced are “Storage & Port Rates”, “Vehicle Storage”, “Fuel”, “Storage”, “Delivery”, “PDI No Plates/Parts” (Mr Warren states that “PDI” stands for “Pre-delivery inspection”¹⁰), “Plylining”, “PDI Labour”, “Handling”, “Hire”, “Batteries”, “Distrib Kill-Transport”,¹¹ “Distrib Pur-Transport”¹² and “Land Rent”.

22. Much of the evidence focuses on cars, but screenshots from the website dated 22 November 2018 and 8 February 2019 indicate that services relating to commercial and fleet vehicles were also offered in the UK. The website shows how the marks are used:¹³



¹⁰ Paragraph 11.

¹¹ This is potentially a reference to one of the UK compounds, Killingholme. A map showing the compounds can be found at page 14 of Exhibit SMW1.

¹² This is potentially a reference to another of the UK compounds, Purfleet.

¹³ Exhibit SMW3.

23. Ms Huet states that the websites are “an important way in which existing and new clients recognise and contact the Opponent”.¹⁴ She adds that the marks are also used on the invoices, the livery of vehicles, facility signage, company uniforms and promotional materials such as pens and calendars. The image below is taken from a 2021 client presentation and so is likely to fall within the relevant period.¹⁵



24. Much of the remaining evidence adduced to support Ms Huet’s claim is undated, although I note that there appears to be some promotional printed items from 2017 and 2019.¹⁶ There are no examples of advertising, but Ms Huet states that the opponent largely relies on its existing reputation to attract new clients.¹⁷ There are some screenshots from Facebook and LinkedIn, showing use of the logo mark with the additional matter, alongside the word mark as “Groupe CAT” or “Groupe CAT France”.¹⁸ These indicate some use of social media but are undated.

25. I shall now consider whether use of the variant logo mark is acceptable use of the mark as registered. For ease of comparison, I reproduce them in the table below:



¹⁴ Paragraph 7.

¹⁵ Exhibit SMW1, page 8.

¹⁶ Exhibit NH7, page 6.

¹⁷ Paragraph 12.

¹⁸ Exhibit NH9.

Mark as registered	Mark as used
	

26. The mark is registered in black and white, which means that fair and notional use of that mark would include its use in colour. The differences between the marks come down to a square border around the logo and an incomplete circle extending from just above the top right corner of the border to the bottom left corner.

27. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Mr Phillip Johnson, sitting as the Appointed Person, set out the correct approach to considering whether a mark used in a different form was an acceptable variant of the mark as registered:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This

suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word 'MEDIA' would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still".

28. The additions to the mark are borders which do not alter the distinctive character of the mark as registered, which lies in the letters "C-A-T" and their arrangement. I also note that registration of a mark in black and white covers its use in colour: see see *Specsavers International Healthcare Ltd & Ors v Asda Stores Ltd* [2014] EWCA Civ 1294, paragraph 5, and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, paragraph 47. Therefore, a black and white mark should be considered on the basis that it could be used in any colour. The blue logo mark is therefore an acceptable variant of the registered logo.

29. The opponent submits that use of this blue logo mark also supports the use of the word mark, as

“the letters are clear within the logo and it differs from the word mark only by the addition of a simple geometric cross. This logo element is of a non-distinctive character and does not substantially affect the identity of the overall trade mark.”¹⁹

30. I agree that the letters are clear within the logo. To a speaker of English, they form a recognisable word, while to someone who does not speak English they are likely to be seen as a three-letter abbreviation. The presentation in three out of four quadrants around a cross is not a common way of representing either a word or an abbreviation and so I found that this arrangement of the letters made a contribution to the distinctive character of the logo mark. Therefore, it is my view that the distinctive character of the word mark is altered by the presentation and I find that use of the blue logo mark does not support use of the word mark.

31. The word mark is used with additional verbal matter, namely as “Groupe CAT” and “CAT UK Services Ltd” in the website extract shown in paragraph 22 above. The opponent is also referred to as “Groupe CAT” in the two news articles in Exhibit SMW7 that fall within the relevant period and in the 2021 client presentation to which I have already referred. In addition, the word “CAT” can be seen vertically on the vehicle transporter shown in paragraph 23 above. I agree with the opponent that the additional words are non-distinctive as they point to the corporate structure of the opponent, the fact that services are being provided or the location in which those services are provided. Consequently, I find that these are acceptable variants of the word mark.

32. On the basis of the evidence before me, I find that the opponent has made genuine use of both earlier marks for services relating to vehicle logistics, transportation and storage. However, I must now decide on a fair specification.

¹⁹ Written submissions, paragraph 12.

33. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as follows:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”²⁰

34. In *Property Renaissance t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool & Ors* [2016] EWHC 3103 (Ch), Carr J summed up the law relating to partial revocation as follows. It applies also to the framing of a fair specification for the purposes of a proof of use assessment.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme*

²⁰ Pages 10-11.

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”²¹

35. I shall consider the logo mark first and remind myself that the specification is already subject to the following limitation: “*All the aforesaid services being exclusively offered in relation to logistical services for the motor industry.*” I am satisfied that the evidence shows that the logo mark has been genuinely used for transportation and storage services in relation to motor vehicles (automobiles, motorcycles) and spare parts. Transportation appears from the evidence to be primarily by road, although the client presentation states that automobiles are delivered by rail as well as road, with the opponent having delivered 125,000 vehicles by rail in the UK, and owning 185 specialist rail wagons, in 2019. (480,000 were delivered by road.) The opponent globally owned 2,300 specialist rail wagons that year. I find no evidence of use of the

²¹ Paragraph 47.

mark in relation to transport by air. The only reference I can find to transportation by water is in paragraph 6 of the witness statement of Ms Huet that I have quoted in paragraph 17 above. There is no other evidence that enables me to assess the likely scale of such use. It is my view that the average consumer is likely to consider that rail, road, air and water transportation services represent separate subcategories and so use in relation to rail and road transportation services should not be taken to constitute use in relation to all transportation services.

36. The specification of the logo mark includes the term *Freight brokerage [forwarding]*. I have been given no definition of this term but I understand it to refer to intermediary activities between a client who wishes to transport goods from one place to another and a provider of such services. The service is likely to involve negotiating the best deal for a client from a range of different providers. There is no firm evidence that this is a service that the opponent offers. I note that on page 13 of the client presentation there is a list of the actions that the opponent undertakes in the UK to manage resources and volumes. The fourth of these is to “*Engage in the chartered services of UK carriers*”. This may fit within the definition of *Freight brokerage [forwarding]* but I cannot tell how frequently this has been done. Therefore, I do not consider that the opponent may rely on *Freight brokerage [forwarding]*.

37. The specification also includes *Rental of transport vehicles, warehouses and garages*. The client presentation states that a company owned by CAT-UK, namely CVT, provides managed contract hire vehicles.²² There is no indication, though, that this service is offered under the logo mark. I accept that *Rental of ... warehouses and garages* are included in the opponent’s rental of storage space or, if not, belong to the same group or category as those services.

38. On this basis, I consider that a fair specification for the logo mark is as follows:

Class 39

Transportation, by road or rail, and storage; Transporting by road or rail of ... goods from one place to another; Freightling [road or rail]; Transport of goods by

²² Exhibit SMW1, page 10.

rail, by road ...; Storage of goods; Rental of ... warehouses and garages; Inspection of vehicles or goods before transport; Provision of information relating to the transport and storage of goods; All the aforesaid services being exclusively offered in relation to logistical services for the motor industry.

39. The services covered by the word mark are subject to the same limitation as those of the logo mark. I am satisfied that the opponent has shown use of the word mark in relation to services for the refurbishment and preparation of vehicles but the services shown in the evidence relate to bodywork. For example, the client presentation refers to vehicle washing, paint booths and wheel refurbishment equipment. The range of repair and maintenance services offered leads me to find that a fair specification would include such general terms as *Maintenance and repair for automobiles and motorcycles* and *Finishing and preparation of automobiles and motorcycles*. I pause at the term *Tuning stations for automobiles and motorcycles*. This term has not been defined by the opponent, but I understand that it refers to the tuning of engines, i.e. adjusting or modifying the engine or its control unit to increase its performance or fuel economy. There is no evidence that such services are provided by the opponent.

40. My findings on a fair specification for the Class 39 services follow from my earlier findings in relation to the logo mark. I accept that these relate to automobiles, motorcycles and spare parts. The opponent will not be able to rely on *freight brokerage* or *hiring of transport vehicles* for the reasons I have already given.

41. The sole service in Class 42 is *Diagnostic stations and testing of automobiles and motorcycles*. I can see no evidence of the provision of these services.

42. The opponent can rely on the word mark in relation to the following services:

Class 37

Maintenance and repair for automobiles and motorcycles; Finishing and preparation of automobiles and motorcycles; Assembly and fitting of parts and fittings for automobiles and motorcycles; Vehicle and car wash; Cleaning of automobiles and motorcycles; vehicle repair; all the aforesaid services being exclusively offered in relation to logistical for automobiles industry.

Class 39

Logistics for the automobiles industry (vehicles, motorcycles, spare parts and fittings therefore and goods) including in particular railway [or] road ... transport; Vehicle storage of spare parts and fittings for automobiles, transit services by rail or road, warehousing services; Garaging of automobiles and motorcycles; Inspection of vehicles, spare parts and components of automobiles prior to the transport thereof; Freighting ... by road or rail of automobiles and motorcycles, spare parts and fittings therefore and goods; Information services in connection with storage and transportation of vehicles, spare parts, components of automobiles and goods; all the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.

Section 5(2)(b)

43. Section 5(2)(b) of the Act is as follows:

“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, which includes the likelihood of association with the earlier trade mark.”

44. In considering the opposition, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs (OHIM))* (Case C-3/03), *Medion AG v Thomson Multimedia Sales*

Germany & Austria GmbH (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 be dominated by one or more of its components;
- f) however, it is also 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 greater 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; and

k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

45. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when

“... 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.”²³

46. The goods and services to be compared are shown in the table below:

²³ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

Contested goods/services	Earlier goods/services
<p><u>Class 9</u></p> <p><i>Computer programs, recorded; computer operating programs, recorded; monitors [computer programs]; computer programs, downloadable; downloadable image files; computer software applications, downloadable; computer screen saver software, recorded or downloadable; Smartphone software applications, downloadable; Face recognition equipment; reflective articles for wear, for the prevention of accidents; digital signs; rescue laser signaling flares; intercommunication apparatus; mobile telephones; satellite finder meters; phonograph records; accumulators, electric for vehicles; batteries, electric, for vehicles; accumulator jars; battery jars; none of the foregoing items for use with bicycles; all the goods being exclusively used for vehicles for the transport of passengers.</i></p>	
<p><u>Class 12</u></p> <p><i>Vehicle; cars; camping cars; Driverless cars [autonomous cars]; electric cars; electric bicycles; engines for land vehicles; motors for land vehicles; gear boxes for land vehicles; automobile bodies; automobile chassis; wheels for automobiles; automobile wheel tires; upholstery for vehicles; air bags [safety devices for automobiles]; bumpers for automobiles; freewheels for land vehicles; clutches for land vehicles; brakes for land vehicles; hoods for land vehicle engines; windscreens for automobile; rearview mirrors; shock absorbers for automobiles; doors for vehicles; safety belts for vehicle seats; steering wheels for vehicles; windows for vehicles; Car pedals on both sides; Car sun shield; spare wheel covers; none of the foregoing items for use with bicycles; all the</i></p>	

Contested goods/services	Earlier goods/services
<p><i>goods being exclusively used for vehicles for the transport of passengers.</i></p>	
<p><u>Class 35</u> <i>Import-export agency services; sales promotion for others; procurement services for others [purchasing goods and services for other businesses]; marketing management; advertising; presentation of goods, for retail purposes; provision of an online marketplace for buyers and sellers of goods and services; business management consultancy; business organization consultancy; all the services being exclusively used for vehicles for the transport of passengers.</i></p>	
<p><u>Class 37</u> <i>Vehicle service stations [refuelling and maintenance]; motor vehicle maintenance and repair; vehicle maintenance; anti-rust treatment for vehicles; land vehicle breakdown repair services; vehicle greasing; vehicle cleaning; vehicle washing; vehicle polishing; varnishing services for vehicle; machinery installation, maintenance and repair; rustproofing; Retreating of tires for vehicles; vehicle wheel rubber tire repair; tire balancing for vehicles; all the services being exclusively used for vehicles for the transport of passengers</i></p>	<p><u>Class 37 (word mark)</u> <i>Maintenance and repair for automobiles and motorcycles; Finishing and preparation of automobiles and motorcycles; Assembly and fitting of parts and fittings for automobiles and motorcycles; Vehicle and car wash; Cleaning of automobiles and motorcycles; vehicle repair; all the aforesaid services being exclusively offered in relation to logistical for automobiles industry.</i></p>
	<p><u>Class 39 (logo mark)</u> <i>Transportation, by road or rail, and storage; Transporting by road or rail of... goods from one place to another; Freightage [road or rail]; Transport of goods by rail, by road ...; Storage of goods; Rental of ... warehouses and garages; Inspection of vehicles or goods before transport; Provision of information relating to the transport and storage of goods; all the aforesaid services being exclusively</i></p>

Contested goods/services	Earlier goods/services
	<p><i>offered in relation to logistical services for the motor industry.</i></p> <p><u>Class 39 (word mark)</u></p> <p><i>Logistics for the automobiles industry (vehicles, motorcycles, spare parts and fittings therefore and goods) including in particular railway [or] road ... transport; Vehicle storage of spare parts and fittings for automobiles, transit services by rail or road, warehousing services; Garaging of automobiles and motorcycles; Inspection of vehicles, spare parts and components of automobiles prior to the transport thereof; Freightng ... by road or rail of automobiles and motorcycles, spare parts and fittings therefore and goods; Information services in connection with storage and transportation of vehicles, spare parts, components of automobiles and goods; all the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.</i></p>

Class 9

47. The opponent submits that the applicant’s computer programs and software are similar to its vehicle logistics services as software applications are often used to enable customers to book services or keep track of the location of the goods that are being delivered or stored. It submits that it follows from this that the uses are highly similar and the users are identical.²⁴

48. At this point, I remind myself that the contested goods and services are all subject to a limitation, restricting the protection to those goods and services that are “*exclusively used for vehicles for the transport of passengers*”. The Class 9 and 12

²⁴ Written submissions, paragraph 29.

goods are further limited to goods not for use with bicycles. I accept that the vehicles that are the subject of the earlier services will also be for the transport of passengers, so there will be at least an overlap in user. I do not accept that the uses are similar: the earlier services are used to store and transport vehicles and parts, while the contested services are used to access, share and process data. However, I believe that to the extent that the software and applications relate to the supply of vehicle logistics service they are complementary. The average consumer would expect a logistics service provider to be responsible for related software. There will therefore be some degree of overlap in trade channels. The nature of the goods and services and their method of use will be different. The goods and services are not in competition. I find that where *Computer programs, recorded; computer operating programs, recorded; monitors [computer programs]; computer programs, downloadable; downloadable image files; computer software applications, downloadable; computer screen saver software, recorded or downloadable; Smartphone software applications, downloadable; Face recognition equipment* are for use with logistics services they are similar to a medium degree.

49. The opponent submits that the contested goods in this class also include safety goods that would be used or worn by the providers of logistics drivers. These are *Reflective articles for wear, for the prevention of accidents; digital signs; rescue laser signaling flares*. I accept that this may be the case. However, the users of the earlier services are not logistics drivers, but businesses in the automotive industry. They are therefore different. The opponent gives no further reasons why it submits that the goods and services are similar. In my view, the purposes of the goods and services and their nature differ, and they will be distributed through different trade channels. I do not find them to be in competition or complementary. They are dissimilar.

50. The opponent also submits that “*Any class 9 products that could be found in motor vehicles will likely be sourced and fitted for customers as part of the pre delivery inspection services, for example the electric vehicle batteries.*”²⁵ In my view, this group also includes *Accumulators, electric for vehicles; batteries, electric, for vehicles; accumulator jars; battery jars*. As the specification is subject to the limitation already

²⁵ *Ibid*, paragraph 30.

discussed, the following goods would also fall within this group: *Intercommunication apparatus; mobile telephones; satellite finder meters; phonograph records*. I shall compare these goods to the opponent's *Finishing and preparation of automobiles and motorcycles; Assembly and fitting of parts and fittings for automobiles and motorcycles*. While the end user of the goods and services is different, the user of the earlier services may also purchase the contested goods to be fitted into the vehicles which will then be sold on to the end user. There is likely to be an overlap in trade channels and some complementarity as the average consumer may expect the parts and the fitting and finishing to be provided by the same undertaking. The consumer may also choose to buy the part and fit it themselves, or pay for a fitting service. The purpose, method of use and nature of the goods and services are different. Taking these factors into account, I find that the goods and services are similar to a medium degree.

Class 12

51. The contested Class 12 goods are all cars or parts and fittings for land vehicles (except bicycles). I shall compare the goods to the opponent's *Maintenance and repair for automobiles and motorcycles*. The opponent submits that its repair services under Class 37 are provided to owners of the contested Class 12 goods, and that they are frequently provided by the same, or commercially linked, undertakings. They therefore share end users and trade channels. The opponent also submits that the goods and services are complementary, as repair and maintenance services are vital to the proper functioning of the Class 12 goods in such a way that the average consumer would believe that the goods and the services are the responsibility of the same, or commercially linked, undertakings.²⁶

52. The average consumer will, in my view, understand the term "*automobile*" to refer to a car. The contested specifications cover *vehicles for the transport of passengers*, which is a broader term and would include coaches and buses. To the extent that the contested goods are for use with cars or motorcycles, I accept that the end users are the same and that there will be a noticeable degree of overlap in the trade channels. I

²⁶ *Ibid*, paragraphs 31-32.

also agree that the goods and services are complementary. The nature and purpose of the goods and services differ, as do the methods of use. I find that the goods and services are similar to a medium degree.

53. To the extent that the contested goods are for use with the buses or coaches, I consider that the users and trade channels would be different. These goods are *Engines for land vehicles; motors for land vehicles; gear boxes for land vehicles; upholstery for vehicles; freewheels for land vehicles; clutches for land vehicles; brakes for land vehicles; hoods for land vehicle engines; rearview mirrors; doors for vehicles; safety belts for vehicle seats; steering wheels for vehicles; windows for vehicles; spare wheel covers*. I do not find complementarity as the goods and services are not essential for the use of the other and neither would the average consumer expect the same undertaking to be offering parts and fittings for coaches and buses and repair and maintenance services for cars and motorcycles. I shall return to this point later in my decision if necessary.

Class 35

54. The opponent makes the following submissions on the services in this class:

“... the broad terms such as ‘import-export agency services’ and ‘procurement services for others [purchasing goods and services for other businesses]’ would cover the import/export, or storage or procurement of vehicles and so would be considered highly similar to the logistics and storage services of the Opponent. The Opponent’s business is international and is used to import and export both vehicles and parts of vehicles around Europe meaning the respective services coincide in their end users and distribution channels. Similarly, part of the preparation service of the Opponent would include the procurement of certain parts or fittings for the vehicles concerned.”²⁷

²⁷ *Ibid*, paragraph 34.

55. In construing terms, I am required to consider their “*ordinary and natural, or core, meaning[s]*”, particularly where those terms denote services: see *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraph 12; *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), paragraph 56.

56. I understand that *Import-export agency services* are provided by a business that acts as an intermediary between organisations or individuals shipping goods to and from different countries. They would take responsibility for checking that all the necessary regulatory requirements had been met, as well as arranging the transportation. The purpose of the services is highly similar to that of the opponent’s transportation and logistics services in Class 39. They are both used to ensure that the goods reach their intended destination. There is overlap in users and some similarity in nature and method of use. They may also be delivered through the same trade channels. I find that *Import-export agency services* are similar to a medium degree to *Logistics for the automobile industry (vehicles, motorcycles, spare parts and fittings therefore and goods) including in particular railway [or] road ... transport*, in so far as the contested services relate to cars and motorcycles. Where they relate to other passenger transport vehicles, the degree of similarity is slightly lower.

57. I accept that the contested *Procurement services for others [purchasing goods and services for other businesses]* would include the purchasing of passenger vehicles. There will be some shared users as an undertaking may use the earlier logistics services to manage the transportation and storage of goods that have been purchased through the contested procurement services. The purpose of the services is different, as is the method of use and nature. I have no evidence to suggest that trade channels will be shared. I do not consider that the services are in competition or are complementary. The overlap in user is not sufficient for me to find any similarity between the services.

58. The earlier *Sales promotion for others; marketing management; advertising* are all forms of marketing and promotional services. The opponent has made no specific submissions on the similarity of these services to any of its earlier services. I cannot see any similarity between these services and any of the opponent’s Class 37 repair and maintenance services or its Class 39 logistics and transportation services.

59. The next services I shall consider are *Presentation of goods, for retail purposes* and *Provision of an online marketplace for buyers and sellers of goods and services*. The purpose of these services is to enable the consumer to make a choice between different goods or services and, in the latter case, complete the purchase transaction. The purpose, users and nature of the service are different from those of the opponent's services, as is the method of use. The trade channels are also different and there is no competition or complementarity. I find that they are dissimilar.

60. The final services in this class are *Business management consultancy* and *Business organization consultancy*. The effect of the limitation *all the services being exclusively used for vehicles for the transport of passengers* is not entirely clear, but I understand it to refer to consultancy services offered to businesses in the passenger vehicle industry. The contested services are intended to help companies manage their business and might include the development of strategies or organisational design. They will be delivered by business consultants. While they may be targeted towards the same users as the opponent's logistics services, I find similarity in none of the other relevant factors. The shared users are, in my view, not sufficient for me to find that the services are similar.

Class 37

61. The opponent submits that the contested Class 37 services include the earlier services and will therefore be seen as identical. The General Court ("GC") stated in *Gérard Meric v OHIM*, Case T-133/05, that:

"In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."²⁸

²⁸ Paragraph 29.

62. I find that the contested *Motor vehicle maintenance and repair; Vehicle maintenance* include the opponent's *Maintenance and repair for automobiles and motorcycles*. Even taking account of the limitations in the respective specifications, these services are identical per *Meric*.

63. I also find that the contested *Vehicle cleaning* includes the opponent's *Cleaning of automobiles and motorcycles*. These services are identical per *Meric*.

64. The contested *Vehicle washing* includes the opponent's *Vehicle and car wash* and is identical.

65. I shall compare the contested *Vehicle service stations [refuelling and maintenance]* to the opponent's *Maintenance and repair for automobiles and motorcycles*. The purpose of the applicant's services is to enable the vehicle user to refill the fuel tank with, for example, petrol and diesel, or recharge the battery in their electric vehicle. It would also offer some maintenance services, which could include refilling of tyres or vehicle washing. The users of the opponent's services are customers of the logistics services. They may also use the applicant's services. The nature of the services is similar, as is the purpose. There is some overlap in the services provided, with both providing some maintenance services. I find that they are highly similar.

66. The contested *Anti-rust treatment; Vehicle greasing; Rustproofing; Tire balancing for vehicles* are particular types of maintenance services. Without the limitations, I would find that these are included in the earlier *Maintenance and repair for automobiles and motorcycles* and so identical. However, the effect of the limitation is that the opponent's services are exclusively offered in relation to logistical services for the motor industry, while the applicant's are offered more widely for exclusive use for vehicles for the transport of passengers. To the extent that the contested services are offered in relation to logistical services they are identical to the opponent's services. The remaining services are highly similar.

67. The same rationale applies in comparisons between the contested *Land vehicle breakdown repair services; Retreading of tires for vehicles; Vehicle wheel rubber tyre repair* and the opponent's *Vehicle repair*, between the contested *Vehicle polishing*;

Varnishing services for vehicle and the opponent's Finishing and preparation of automobiles and motorcycles; and between the contested Machinery installation, maintenance and repair and the opponent's Assembly and fitting of parts and fittings for automobiles and motorcycles and Maintenance and repair for automobiles and motorcycles.

Final remarks on the comparison of goods and services

68. I found the following goods and services to be dissimilar to the opponent's services:

Class 9

Reflective articles for wear, for the prevention of accidents; digital signs; rescue laser signaling flares; all the goods being exclusively used for vehicles for the transport of passengers.

Class 35

Sales promotion for others; procurement services for others [purchasing goods and services for other businesses]; marketing management; advertising; presentation of goods, for retail purposes; provision of an online marketplace for buyers and sellers of goods and services; business management consultancy; business organization consultancy; all the services being exclusively used for vehicles for the transport of passengers.

69. In *eSure Insurance Limited v Direct Line Insurance Plc*, [2008] EWCA Civ 842 CA, Lady Justice Arden stated that:

"... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion

has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”²⁹

70. The opposition therefore fails in respect of the goods and services listed in paragraph 68 above. It proceeds for the remaining goods and services.

Average consumer and the purchasing process

71. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”³⁰

72. The average consumer of the earlier services is a business in the motor industry. This could be a manufacturer or a trader. The services may be purchased as a contract or on an *ad hoc* basis. I have no evidence that allows me to make a firm finding on the likely costs of the services, as this information is redacted from the invoices. The 2021 presentation in Exhibit SMW1 states that the Vehicle Division generated turnover of €1,300m, transported 7.3 million vehicles and prepared 1.7 million vehicles, but there is no further breakdown of the figures.³¹ The quality of the services will have an impact on the reputation of the customer and so it is likely that they will be paying a higher than average degree of attention when choosing a provider. The choice is likely to be made after viewing promotional material, including websites, social media and printed matter. It is also possible that there will be word-of-mouth recommendations or

²⁹ Paragraph 49.

³⁰ Paragraph 60.

³¹ Page 4.

presentations from sales staff. The visual and aural aspects of the mark will be important.

73. The average consumer of the contested goods and services is either a member of the general public who owns a motor vehicle or a business. This could be a garage or other repair service, a motor dealer or a fleet operator. I shall consider the goods first. These will vary in price. For example, computer software applications may be low cost, or even free to the user, while cars are costly purchases that are made relatively infrequently. The purchase of all the goods will be made largely on a visual basis, either through websites or in some instances in a retail environment. However, I do not dismiss the potential role of word-of-mouth recommendations or discussions with sales staff. The level of attention to the Class 12 goods will largely be high as the goods are either expensive or are important fittings for a car or other vehicle. In the case of the Class 9 goods, I consider that the degree of attention will be slightly lower, but still above average.

74. The level of attention paid when purchasing the Class 35 and most of the Class 37 services is likely to be higher than average, as the quality of the repairs or maintenance will have an impact on the performance of the vehicle, and, in the case of the *Import-export agency services*, the consumer will want to be sure that the provider of the services has the necessary experience to handle the transportation of the goods and any legal requirements. In the case of the services relating to vehicle cleaning and washing, an average degree of attention will be paid. The services will be selected largely on a visual basis, but the consumer may also receive oral recommendations.

Comparison of marks

75. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”³²

76. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

77. The respective marks are shown in the table below. I shall conduct my comparison of the marks on the basis of the earlier word mark for two reasons. First, the services I found to be similar to the contested services are all covered by this mark and, secondly, a word mark will be more similar to the contested marks than the logo mark.

Earlier mark	Contested marks
<p>CAT</p>	<p>No. 3720982</p> <p>FUNKY CAT</p> <p>No. 3720978</p> <p>FUNKY CAT <i>GT</i></p>

78. The earlier mark consists of a three-letter word with no other elements that could make a contribution to its overall impression. In *LA Superquimica v European Union Intellectual Property Office*, Case T-24/17, the GC held that such plain word marks protected the word or words contained in the mark in whatever form, colour or typeface.³³ The average consumer will, in my view, identify this as the word for a feline animal, even if they also understand it to be an abbreviation.

³² Paragraph 34.
³³ Paragraph 39.

79. The contested mark consists of two words, the second of which is the same three letters as the earlier mark. The mark is presented in upper case in a blocky typeface. I agree with the opponent that the words are clearly recognisable.

80. The opponent submits that the word “FUNKY” is descriptive or non-distinctive of most of the goods and services and cites the definition from the Cambridge Online Dictionary: “*fashionable in an unusual and noticeable way*”.³⁴ For this reason, it argues that “CAT” is the dominant and distinctive element of the earlier mark. I am not persuaded by these submissions. This is because I consider that the two words hang together as a unit, with “funky” describing a characteristic of the cat. The overall impression lies in this unit, with the blocky typeface making only a very small contribution.

81. I have already noted that the second word of the contested mark is the same as the earlier mark. The first word is longer and I do not accept that the overall impression of the mark is dominated by the word “CAT”. I find that the marks are visually similar to a medium degree.

82. The earlier and contested marks will be pronounced as “CAT” and “FUN-KEE CAT” respectively. It will be seen that the contested mark has three syllables, the last of which is identical to the earlier mark. I find that the marks are aurally similar to a medium degree.

83. I turn now to the conceptual comparison. In my view, the word “CAT” is used to denote a domestic animal or the family of animals that includes the domestic cat and wild animals such as lions and tigers. There are other meanings, but I consider that this is the most likely one to be evoked in the mind of the average consumer. The contested mark will bring to mind a particular type of cat, one who is fashionable in an unusual and noticeable way. Consequently, there is a degree of conceptual similarity between the marks and in my view that degree is high.

³⁴ Written submissions, paragraph 20.

84. This contested mark is identical to the other contested mark with the addition of the letters “GT” in a slightly stylised typeface. The opponent submits that “*The acronym ‘GT’ is also descriptive and non-distinctive in relation to vehicles and vehicle related products and services as it will be recognised as being short for Grand Tourer or Grand Touring.*”³⁵ I have been provided with no evidence of this and it does not appear to me to be a fact that is so notorious that I can take it on judicial notice. I accept that it is possible that some consumers will understand the abbreviation in this way, but I consider that there will also be a group of consumers for whom the abbreviation has no meaning. For both these groups, though, the phrase “FUNKY CAT” will make the greater contribution to the overall impression of the mark. It is at the beginning of the mark, to which the average consumer tends to pay more attention: see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraphs 81-83. The letters “GT” will be seen either as being descriptive or as having no meaning. The difference in the typeface emphasises the independent distinctive role of “FUNKY CAT”.

85. I now turn to the visual comparison. Even if the “GT” element is seen as descriptive that does not mean I can ignore it. The earlier mark is in the middle of three words and so I find the marks to be visually similar to a low degree.

86. The contested mark will be pronounced as “FUN-KEE-CAT-GEE-TEE”, with five syllables in contrast to the earlier mark’s one. I find the marks to be aurally similar to a low degree.

87. For those consumers who do not understand the meaning of “GT”, I come to the same finding as I did in my comparison of the other contested mark: see paragraph 83. Those consumers who recognise “GT” as an abbreviation for “grand tourer” or “grand touring” will be caused to think of a kind of vehicle. This has no counterpart in the earlier mark, and so I find that the marks are conceptually similar to between a low and medium degree.

³⁵ *Ibid*, paragraph 20.

Distinctive character of the earlier mark

88. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Alternberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

89. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

90. The word “CAT” is a common word in the English language but it does not describe any characteristics of any of the services for which it is registered and neither does it allude to them. Consequently, the inherent distinctiveness of the mark is at a medium level. The opponent submits that this distinctiveness has been enhanced through the use made of the mark.

91. When considering whether the inherent distinctiveness of the mark has been enhanced, it is the UK consumer that I must consider. Mr Warren has provided some evidence on sales in the UK: see paragraphs 19-22 above. This includes turnover figures for 2018-2021 and a selection of invoices, the earliest of which dates from 2017. The evidence does not tell me how longstanding the use has been in the UK before the relevant period. The 2021 presentation indicates widespread coverage of the road and rail network in England, South Wales, and the central belt of Scotland, but it also indicates that this coverage is achieved through the use of fleets from CVT and STVA, which are owned by Groupe CAT UK.³⁶ At least some of the CVT fleet also bear the earlier marks, but there is no evidence that the STVA vehicles do.³⁷ Storage compounds were located mainly in England, largely in the north and Midlands, with a single compound at Belshill in Scotland.³⁸

92. There is no evidence of advertising, but the opponent is not operating in a business where one would expect to see much media advertising. Ms Huet states that the website is an important means of communicating with existing and potential clients and in the Financial Statements for the year ended 31 December 2021, the Directors of CAT-UK Services Limited said:

“Since CAT-UK’s business model relies on relatively short-term contracts of typically 1-5 years, there is always a focus on retaining existing business and winning new contracts through competitive tendering and some speculative offers.”³⁹

93. However, I am unable to understand from the evidence what share of the UK market the opponent enjoys. Taking the evidence as a whole, I find that, while it was sufficient to demonstrate genuine use, it falls short of what would be required to show that the distinctiveness of the word mark had been enhanced through that use.

³⁶ Exhibit SMW1, page 13.

³⁷ See images on pages 10 and 11 of Exhibit SMW1.

³⁸ Exhibit SMW1, page 14.

³⁹ Exhibit SMW5, page 4.

Conclusions on likelihood of confusion

94. There is no arithmetical formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

95. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Iain Purvis QC, sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.’

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark

at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

96. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."⁴⁰

97. He also said:

"As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."⁴¹

⁴⁰ Paragraph 12.

⁴¹ Paragraph 13.

98. Earlier in my decision, I found that:

- the contested goods were similar to a medium degree to earlier services, except where I found them to be dissimilar;
- *Import-export agency services* were similar to a medium degree to the opponent's services, while the remaining contested Class 35 services were dissimilar;
- the contested Class 37 services were identical or highly similar to the opponent's services;
- the average consumer would select the goods and services on a largely visual basis, although aural considerations may also be relevant, and would be paying a higher than average degree of attention;
- Application No. 37290982 was visually and aurally similar to the earlier word mark to a medium degree and conceptually highly similar;
- Application No. 3720978 was visually and aurally similar to the earlier work mark to a low degree and conceptually similar to between a low and medium degree;

99. In my view, the differences between the marks are such that the average consumer is unlikely to mistake one for the other even where the services are identical, as the consumer will be paying a higher than average degree of attention. There is no likelihood of direct confusion.

100. The opponent submits that the average consumer will be directly confused as they will assume that the contested marks represent a brand variation of the earlier mark, specifically "*the latest or less traditional variant of the Opponent's standard goods or services*".⁴² In support of this submission, it draws my attention to the use by the opponent of a number of other sub-brands: NIGHT CAT, GLASS CAT, BIKE CAT, TOP CAT, SUPPLY CAT. It is not clear how much these sub-brands were used in the market at the time of the applications for the contested marks.

⁴² Statement of grounds, paragraph 7.

101. The earlier mark is repeated in the contested marks. I recall that I found the earlier mark to be inherently distinctive to a medium degree and that the evidence did not show that the distinctiveness had been enhanced through use. I also bear in mind that for the majority of these goods and services the average consumer will be paying a higher than average degree of attention.

102. I do not consider that “CAT” is so strikingly distinctive that no one else could be using it in a trade mark at all. Neither do I believe this to be a case in which the later mark simply adds a non-distinctive element that would be expected in a sub-brand. Furthermore, “funky” is not a logical sub-brand for any of these goods or services and the opponent has not elaborated on what might constitute traditional or less traditional variants of the earlier services. I can see no other basis upon which indirect confusion may arise in relation to the contested marks, even where the services are identical.

103. Consequently, taking all the above factors into account, I am not satisfied that there is a likelihood of indirect confusion. At the most, the earlier marks would be brought to the mind of the average consumer, but that is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81.

OUTCOME

104. The oppositions have failed and Application Nos. 3720978 and 3720982 will proceed to registration.

COSTS

105. The applicant has been successful and under the circumstances is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice No. 2/2016. I have taken account of the facts that the claims made in both oppositions were the same and the applicant filed no evidence or written submissions. I therefore make an award of costs to the applicant as follows:

Preparing statements and considering the other side’s statements: £350

TOTAL: £350

106. I therefore order Compagnie d’Affrètement et de Transport C.A.T. to pay Great Wall Motor Company Limited the sum of £350. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this day of 7th August 2023

**Clare Boucher,
For the Registrar,
Comptroller-General**