

O-078-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATIONS
Nos. 2481271, 2481272 & 2481273
BY GBA (HOLDINGS) LIMITED
TO REGISTER THE TRADE MARKS
GBA**

GBA Group
of Companies

&



IN CLASSES 9, 37, 39 AND 42

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER NOs. 98216, 98495 & 98502 BY
GBA AUTOMOTIVE COMPONENTS (WEST YORKSHIRE) LIMITED**

BACKGROUND

1) On 1 March 2008, GBA Holdings Ltd (hereinafter the applicant), applied to register the following trademarks:

2481271	GBA
2481272	GBA Group of Companies
2481273	 GBA Group of Companies

2) The specification applied for on each of the three marks was identical, and was as follows:

Class 9: Computer software programs for shipping and forwarding business processing, computer software programs for automotive logistics processing, computer software programs for estimate resource requirements in relation to automotive logistics and vehicle technical services.

Class 37: Technical repairs and enhancement and body/panel repairs and enhancement of automotive vehicles new and used.

Class 39: Shipping agency services; shipping of goods, shipping agency services for arranging transportation of goods.

Class 42: Computer software development for shipping and automotive logistics purposes.

3) The applications were examined and accepted, and subsequently published for opposition purposes on 8 August 2008 (2481271) in Trade Marks Journal No.6747 and 24 October 2008 (2481272 & 2481273) in Trade Marks Journal No.6758

4) G B Automotive Components (West Yorkshire) Limited (hereafter the opponent), filed three notices of opposition, dated 10 November 2008 (2481271) and 23 December 2008 (2481272 & 2481273) subsequently consolidated. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Trade Mark	Number	Application Date and Registration Date	Specification
	2177173	12.09.98 / 26.03.99	Class 12: Automotive components, including shock absorbers, brake callipers, drive shafts, cv joints and steering parts, all for use with cars and vans with a weight up to 35 cwt; excluding coaches, buses and minibuses, windscreens and parts and fittings for those goods.

b) The opponent states that the marks applied for are similar to the opponent's earlier registration and that the services applied for in Class 37 are similar to those for which its' mark is registered. The opponent states that the application offends against Section 5(2)(b) of the Trade Marks Act 1994.

5) On 20 January 2009 and 4 March 2009, the applicant filed counterstatements which denied the opponent's claims. The applicant puts the opponent to strict proof of use.

6) Only the opponent filed evidence, both parties seek an award of costs in their favour. The matter came to be heard on 26 January 2010. At the hearing, the opponent was represented by Mr Waddington of Messrs Appleyard Lees, the applicant was represented by Mr Malynicz of Counsel instructed by Messrs Rollits.

OPPONENT'S EVIDENCE

7) This consists of a witness statement, dated 14 July 2009, by Gerald Bates the Managing Director of the opponent company, a position he has held since July 1988. In the statement of grounds the opponent states that the mark has been used on all its goods. In his witness statement Mr Bates states that the following shows that the mark has been used in the relevant period on the goods shown in the brochures. Mr Bates explains that brochures are only reprinted "every couple of years or so". He provides the following evidence of use:

Exhibit GBA 1; Copies of the front and rear covers of catalogues advertising products available under the mark in suit. The first page of each catalogue is included and shows GBA branded parts for Alfa Romeo cars. The catalogues are dated 2003 - 2008 and although only one page has been provided Mr Bates states that they cover most makes of cars and so run to a considerable number of pages. The catalogues advertise shock absorbers (2008), brake callipers (2008), transmissions (2003) & power steering racks (2004), Mr Bates confirms that all the catalogues were issued prior to August 2008.

Exhibit GBA2: This also consists of copies of the front and rear covers and also the first page of catalogues for shock absorbers (2000 & 2002), transmissions (2000), brake callipers (2003), Power steering racks (2008), Coil and leaf springs (2005 & 2009). All the catalogues show use of the mark in suit.

Exhibit GBA3: This consists of an advertisement from the Pocklington Post dated 24 April 2003 which shows use of the mark in suit. The exhibit includes letters to three UK based clients. These have the mark used as a letter head, which Mr Bates confirms was used in this manner throughout the relevant period. A leaflet issued prior to 2004 showing use of the mark in suit referring to an array of component parts is also provided. Lastly, a poster showing use of the mark in suit in relation to suspension, steering, transmission and brake products which Mr Bates confirms was issued prior to 2004.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The only ground of opposition is under section 5(2)(b) which reads:

“5.-(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.”

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

11) The opponent is relying upon its trade mark listed in paragraph 4 which is clearly an earlier trade mark. It was registered on 26 March 1999 and is therefore subject to The Trade Marks (Proof of Use, etc) Regulations 2004, paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

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

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

12) In the instant case the publication dates of the applications were 8 August 2008 and 24 October 2008. Therefore, the relevant combined period for the proof of use is 9 August 2003- 24 October 2008. I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

13) Mr Malynicz also referred me to the following cases:

- *Vitakraft-Werke Wührmann & Sohn GmbH & Co. K v. OHIM*, Case T-356/02, Judgment dated 6 October 2004 in which the Court made it clear that “genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned” (paragraph 28, citing previous case law) and that the provision of catalogues does not itself show actual distribution, the extent of that distribution or the number of sales (paragraph 34). Such evidence might make it “probable or credible” that use had taken place but it was not enough;
- *La Baronía de Turis, Cooperativa Valenciana v. OHIM*, Case 323/03, Judgment dated 10 July 2006 where the Court stated account had to be taken of the commercial volume of the alleged use and the smaller that appeared to be, the more necessary it was to dispel possible doubts as to the genuineness (paragraph 44). In addition merely putting in some

evidence that appeared to show use during the period did not address the question as to the extent of use or volume of use (paragraph 45) or the frequency of use (paragraph 46);

- *Sonia Rykiel création et diffusion de modèles v. OHIM*, Case T-131/06, Judgment dated 30 April 2008 in which the Court stated that in assessing all the circumstances to establish whether the use was genuine, account had to be taken of the scale of use, the commercial volume, the duration and the frequency (paragraph 40). Where the volumes are not high, that may be offset by frequent use and vice-versa (paragraph 41).

14) The suggestion that the Registry should apply the same standard of proof as required by OHIM and, on appeal, the General Court is wrong in principle. The Directive leaves matters such as the applicable rules of procedure, including the rules of evidence, to member states. This is clear from the recital to the Directive covering revocation for non-use. I have to determine the issue on the standard of proof applicable in the UK, which is the balance of probability. The opponent has only the evidential burden of providing the documents and facts upon which the decision can be made (per *Extreme*). The opponent has provided a few catalogues for some of the components for which the mark is registered. A number of these are prior to the period, but combined with those within the period they show use before and during the relevant period. The opponent gave no details as to whom these catalogues were sent, the extent of the distribution, or any details of sales volumes or turnover figures. However, I take into account the catalogues combined with the single advertisement in a local paper prior to the relevant date and the letters to customers, which also contained the mark in suit. There has been no challenge to the assertion of Mr Bates that the mark has been used during this period in relation to the parts shown in the catalogues and on letterheads, posters and leaflets. Mr Malynicz stated that the applicant did not challenge the evidence as it was not accusing Mr Bates of lying but simply felt that the opponent had not put forward enough evidence to overcome its section 100 obligation. I agree with much of his criticism of the evidence provided, however I am willing to accept that the evidence provided just scrapes over the bar of what is acceptable to meet the proof of use requirement. I am willing to accept that the opponent has used its mark on shock absorbers, brake callipers, transmissions and power steering racks but not upon CV Joints. I note that the specification reads "Automotive components, including...". As all of the aforementioned items are automotive components it is my opinion that the specification should stand unchanged. In reaching this conclusion I have taken into account the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10 (2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10 (1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success

under s.10 (2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10 (2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

15) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant.

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

16) The opponent's earlier mark is therefore protected for all of the goods for which it is registered, and the full specification will be used in the comparison test. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) 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; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

17) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the applicant's marks and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods outlined at paragraph 14 above.

18) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have

been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

19) The opponent has singularly failed to show that it has a reputation in the goods for which its mark has been used. The fact that it has only just cleared the hurdle to show proof of use does not mean that it has established anything other than the most basic reputation. The opponent has not provided turnover figures, market share or any independent trade evidence. It is certainly not sufficient for them to enjoy enhanced protection because of reputation. However, I do accept that the opponent’s mark is inherently distinctive for the goods for which it has been used.

20) I must now determine the average consumer for the goods and services of the parties. It seems clear that the goods and services offered by the two parties are aimed at both the general public and also the business community. For instance, parts for cars and car repair services will be purchased by both the general public and businesses. Both groups must therefore be regarded as the average consumer.

21) I shall first consider the goods and services of the two parties. The opponent is only opposing the applicant’s services in Class 37. For ease of reference, I set out the goods of the opponent and the services of the applicant that are opposed.

Applicant’s specification	Opponent’s specification
Class 37: Technical repairs and enhancement and body/panel repairs and enhancement of automotive vehicles new and used.	Class 12: Automotive components, including shock absorbers, brake callipers, drive shafts, cv joints and steering parts, all for use with cars and vans with a weight up to 35 cwt; excluding coaches, buses and minibuses, windscreens and parts and fittings for those goods.

22) In carrying out the comparison I will take into account *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281. This identified the following as elements to be considered, uses, users, nature, trade channels, where the items are to be found and whether they are in competition.

23) I also take into account the views of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

24) Further, I also bear in mind the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

25) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 the CFI stated:

“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).”

26) Clearly, the goods and services are not identical. The applicant drew my attention to paragraph 22 of *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* which reads:

“It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered.”

27) The current case is not on all fours with *Canon* where there was considerable differences between the goods and services of the two parties concerned. It has not been the Registry or indeed the Court’s position to require evidence on such issues but rather to accept submissions unless the position is otherwise untenable. In the instant case the opponent manufactures parts for automobiles and the applicant’s services involves repairs to automobiles. It seems clear to me that the type of automotive components produced by the opponent would be essential for the automotive repairs carried out by the applicant and that evidence on this point is unnecessary and superfluous. I accept that the applicant will also use other items such as body panels, paint etc but the types of items produced by the opponent would form a considerable proportion of the components used in the applicant’s business. It is common knowledge that whilst vehicle manufacturers such as Ford, Toyota and BMW manufacture parts and body panels such items are also produced by third parties and are sold as such. At independent garages one is usually asked if you want manufacturers’ parts or “pattern” parts. The services of the applicant must therefore be considered as complementary to the goods of the opponent.

28) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Trade Marks	Opponent's Trade Marks
<p data-bbox="183 324 255 353">GBA</p> <p data-bbox="215 376 454 443">GBA Group of Companies</p>  <p data-bbox="188 638 550 674"><i>GBA Group of Companies</i></p>	

29) The opponent's mark and two of the applicant's marks contain more than one word or element and are, therefore, composite marks. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components. The applicant contended that the letters "GBA" could not be considered the distinctive element of the opponent's mark as it also contained the word "Premier" and a device element. It also contended that visually the word "Premier" is dominant. Further, it is stated that the letters "GB" are commonplace in the names of companies based in Great Britain. However, I do not agree with these contentions. I believe that the majority of consumers will view the word "Premier" as a laudatory term despite its prominence due to its size. Nor do I believe that they will pay much attention to the device element which looks like a pennant or flag. As to the letters "GB" being commonplace in the UK, even if I were to accept this, the opponent has the letters "GBA". Such letters are usually at the end of a company name, so even if the opponent's mark were to be seen as "Premier GBA" the average consumer would not simply ignore the letter "A" or try to make sense of it. To suggest otherwise implies that they would effectively view the mark as "Premier Great Britain A". I reject that submission. In my view, the relevant consumers would not dissect GBA into "GB" and "A", but would view it as a whole and as a distinctive collection of three random letters. To my mind, the distinctive and dominant aspect of the opponent's mark must be considered to be the letters "GBA".

30) Although the applicant has three marks applied for they differ only slightly. The device of a flag and flagpole do not, in my opinion, add much to the distinctiveness of the applicant's mark even though they cannot be completely ignored. Two of the marks also contain the words "Group of Companies". To my mind this adds little to the distinctiveness of the marks. In my opinion the distinctive and dominant aspects of all three of the applicant's marks are the letters "GBA". Visually and aurally the marks share as their distinctive elements the identical aspect of the letters "GBA". There are differences but these are minor device elements or words which have little distinctiveness. The similarities far outweigh any differences. To my mind none of the marks of either party has any conceptual meaning which would affect the average consumers' view of the marks as wholes.

31) I take all of the above into account when considering the marks globally. To my mind, the similarities in the marks are such that when used on goods or services which are complementary

I believe that there is a likelihood of consumers being confused into believing that the services provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2) (b) therefore succeeds in relation to the services in Class 37, as they currently stand.

32) During the hearing the applicant offered a revised specification if I were to be inclined to find against them. Clearly, this is the case and so the issue of a revised specification must be considered. During the hearing Mr Malynicz offered the following revision:

“Class 37: Technical repairs and enhancement and body/panel repairs and enhancement of automotive vehicles new and used, all provided as part of the service of arranging transportation of motor vehicles.”

33) This is far more than a “blue pencil” revision, and so the opponent should have an opportunity to comment. The opponent has seven days from the date of the covering letter for this decision in which to comment. My preliminary view on this is that the above specification is a more accurate reflection of the actual activity carried out and it is sufficiently specific enough that it creates clear blue water between the specifications of the two parties such that it negates the likelihood of confusion.

34) I will also deal with costs in my supplementary decision. Both parties commented on the issue at the hearing, however should either side wish to comment further they should do so within seven days of the issue date of this decision.

Dated this 3 day of March 2010

**George W Salthouse
For the Registrar,
the Comptroller-General**