

O-0808-23

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3700824
BY RS DOMINATOR LTD
TO REGISTER**



**AS A TRADE MARK
IN CLASS 12
AND OPPOSITION THERETO (UNDER NO. 430256)
BY
FORD MOTOR COMPANY LIMITED**

Background and pleadings

1. RS Dominator Ltd (“the applicant”) applied to register the trade mark set out on the title page on 24 September 2021. It was published for opposition purposes on 15 October 2021 in class 12. The goods will be set out later on this decision.

2. Ford Motor Company Limited (“the opponent”) opposed the trade mark application on 17 January 2022 under sections 5(1), 5(2)(a), 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Mark Act 1994 (“the Act”). Under sections 5(1), 5(2)(a), 5(2)(b) and 5(3), the opponent relies on the following UK trade mark.

UK TM No.1292115	Goods relied on:
RS Filing date: 19 November 1986 Registration date: 1 September 1989	Motor land vehicles and parts and fittings therefor; all included in class 12

3. Under section 5(4)(a), the opponent claims use of the sign **RS** since 1970 throughout the UK for the same goods set out above.

4. Under section 3(6), the opponent has claimed the applicant has acted in bad faith and had a dishonest intention in filing the application.

5. The opponent’s above trade mark has a filing date that is earlier than the filing date of the application and, therefore, it is an earlier mark, in accordance with Section 6 of the Act. As the registration procedure was completed more than 5 years prior to the filing date of the contested application, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

6. The applicant filed a counterstatement in which it denied the grounds of the opposition and put the opponent to proof of its claims.

7. In these proceedings the applicant has represented itself and the opponent has been represented by HGF Limited. Only the opponent filed evidence and written submissions in lieu of a hearing.

8. I make this decision based on a reading of all the material before me.

9. Although the UK has left the EU, 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Preliminary issues

10. I note in the applicant's counterstatement, it claims that there are already a number of marks containing the letters RS existing on the UK Trade Mark Register. Before going on, it is necessary to explain why, as a matter of settled case law, this point about the state of the register has no bearing on the outcome of these opposition proceedings. In *Zero Industry Srl v OHIM*,¹ the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM –*

¹ Case T-400/06

Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

11. Essentially this means that regardless of the number of trade marks existing on the UK register which include the letters RS, it will make no difference to the outcome of this decision.

Opponent's evidence

12. The opponent filed two witness statements in support of its case, both in the name of Sharon Sorkin, the opponent's Chief Trade Mark Counsel. Ms Sorkin appends 18 exhibits to her first witness statement dated 5 December 2022. Her second witness statement (entitled “supplementary witness statement”) dated 16 December 2022 sought to clarify details contained within Exhibit SCS18.

13. I do not intend to summarise every exhibit here save for the most pertinent points but I have read the evidence in full and will bear it in mind in this decision.

14. Ms Sorkin states that the opponent was ranked as the world's fourth largest manufacturer of motor vehicles in 2019 and that 9.28% of cars registered in the UK in 2020 were manufactured by the opponent². Figures provided from the Department of Transport, which controls the registration of vehicles in the UK, indicate that between 8500-9500 of the opponent's RS branded vehicles were registered per quarter between 2016 and 2021. Ms Sorkin states that “this demonstrates the volume of vehicles bearing Ford's RS mark available in the marketplace”. However there is a significant difference between registrations and the new vehicle unit sales set out by Ms Sorkin below.


15. The opponent supplies its goods under the RS trade mark in the UK and worldwide through a network of distributors, dealers and importers.

16. Ms Sorkin exhibits website pages³ from the following sites:

² Exhibit SCS01

³ Exhibit SCS02



- www.rsownersclub.co.uk dated 5 December 2022 using the mark , and showing a number of images of Ford cars using the RS designation such as Capri RS2800 and Escort RS2000 4WD to give two examples.
- <https://mk3focusrs.club> dated 5 December 2022 which is described as a “dedicated community for the third generation Ford Focus RS”.
- www.caranddriver.com dated 5 December 2022 which contains an article dated 27 February 2015 entitled “The story of RS: A visual history of every Ford RS model”. The article lists significant milestones in the production of RS models from 1968 to 2010.

17. Ms Sorkin supplies the following unit sales and sales revenue figures for the UK for motor vehicles in the RS range,

Year	UK units sold
2016	2861
2017	3211
2018	1312
Total	7384

Year	UK revenue
2016	£90m
2017	£100m
2018	£40m
Total	£230m

18. Ms Sorkin provides a brochure dated August 2016⁴ for the Ford Focus RS model. The brochures were distributed via the opponent’s network of dealerships in the UK. The stylised RS mark appears on the car to the left of the registration plate and in the car’s interior on the steering wheel and on the seats, viz:

⁴ Exhibit SCS04



19. Ms Sorkin does not state the exact advertising expenditure figures spent by the opponent in promotion of the RS branded goods save for her general assertion that it is “millions of dollars”. Ms Sorkin exhibits web pages⁵ from YouTube dated 5 December 2022 showing three examples of UK broadcast television commercials for RS branded cars and twelve extracts of test drives or reviews of the Ford Focus RS branded cars. YouTube appears to date its content backwards from the date of the print, so in this case 5 December 2022. The three commercials are entitled “Ford Focus RS (Commercial)”, “Ford Focus RS 2017 Commercial” and “Ford Focus AD Commercial Europe”. The first commercial appears to be dated 4 years prior to the

⁵ Exhibit SCS07

print so I assume it dates from 2018. The second commercial appears to date from 2017 which ties in with its title. The third commercial appears to date from 2019.

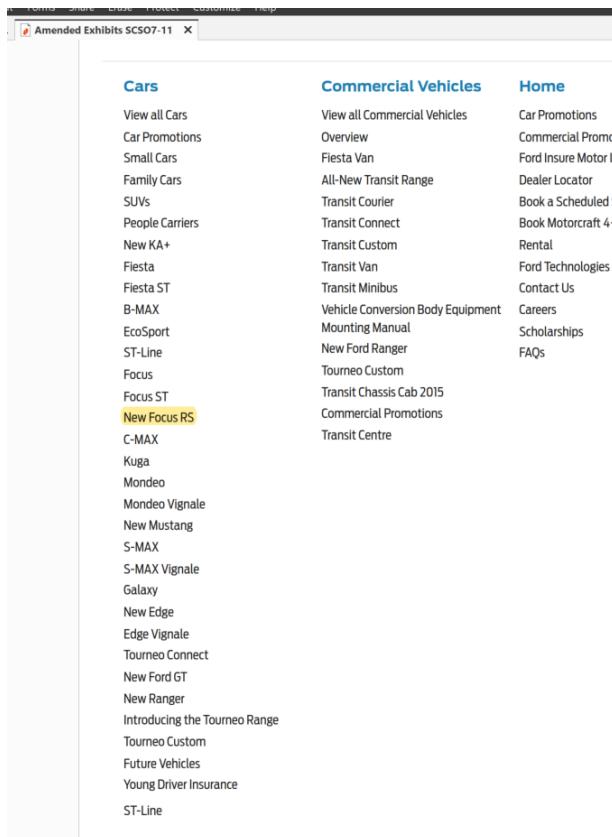
With regard to the twelve extracts of test drives or reviews, these are listed below with posting dates and country from which they were posted (where apparent).

- Ford Focus RS vs Focus ST ST ACCELERATION & TOP SPEED Autobahn POV – posted in 2016 by AutoTopNL, which I assume to be from the Netherlands
- Top Gear Ford Focus RS test – posted in 2010 which I assume is from the UK
- Ford Focus RS MK2 [PRUEBAS-POWERART] S02-E20 posted in 2018 by PowerArt Guille Garcia Alfonsin
- ManageMotor.es – Ford Focus RS vs Focus ST posted in 2016 by ManageMotor.es, which I assume is from Spain
- Uw Garage: Ford Focus RS (2009) – posted in 2018 by Autovisie
- Ford Mustang vs Ford Ficus RS| Top Gear: Drag races posted in 2016 by Top Gear which I assume is from the UK
- Ford Focus RS im Test – Mikko Hirvonen gibt Gas posted in 2010 by Motorvision Deutschland which I assume is from Germany
- All-new Ford Focus RS on the road posted in 2015 by Ford News Europe
- James' Bagged Focus RS | (4K) posted in 2021 by LouisMorrisMedia
- Ford Focus RS Option Pack posted 2017 by Ford News Europe
- Ford Focus 2.3T Ecoboost RS AWD Euro 6(s/s) 5dr posted in 2022 by Autostrada Cars
- 2016 Ford Focus RS hatchback Livermore Brentwood San Leandro Concord Tracy posted in 2022 by Livermore Ford Lincoln

20. Ms Sorkin exhibits archive website prints⁶ from the opponent's UK website, namely www.ford.co.uk, using the Wayback Machine service. She also states that between 2016 and 2020 approximately 24 million visits were made to this website. The pages show a list of sub headings such as "Book a service". "Ford account", "Find a dealer" and "Contact us". In the print from 2016, under a list titled "Cars",

⁶ Exhibit SCS09

the New Focus RS is listed as illustrated below. The same model is listed in prints dated 2017. There are no other references to RS on the website pages exhibited.



21. Ms Sorkin further states that the opponent regularly promotes its vehicles at trade shows and other festival events in the UK and gave the following list of attendance,

- MOBILITY ROADSHOW – 2011, Peterborough
- GREENFLEET - 2012
- NATIONAL ASSOCIATION OF POLICE FLEET MANAGERS' CONFERENCE – 2012, Peterborough
- GOODWOOD, FESTIVAL OF SPEED – 2013, Sussex
- CCIA - 2014
- CENEX – 2014, Loughborough
- FORD FAIR – 2014, Towcester, Northamptonshire
- GLASGOW COMMONWEALTH GAMES - 2014
- CCIA - 2015
- FLEET WORLD SILVERSTONE – 2015, Towcester, Northamptonshire
- FORD FLEET DRIVE – 2015
- MOTABILITY THE BIG EVENT – 2019, Birmingham
- GOODWOOD, FESTIVAL OF SPEED – 2018, Sussex
- COMMERCIAL VEHICLE SHOW – 2019, Birmingham
- GOODWOOD REVIVAL – 2019, Sussex

22. Ms Sorkin also exhibits abstracts of where the Ford Focus RS branded vehicles have been reported on in the automotive and mainstream press between 2016 and 2022⁷ and a list of TV appearances of the Ford Focus RS between 2002 and 2022.⁸

23. That concludes my summary of the evidence.

Proof of use provisions

24. The relevant statutory provisions for proof of use are 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 section 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

⁷ Exhibit SCS12

⁸ Exhibit SCS13

(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)-(5A) [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.”

25. Section 100 of the Act states that:

“100. 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.”

26. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....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 P *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*

Bunderversvereinigung 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 P *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].

(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].”

Relevant period

27. My first task is to establish whether, or to what extent, the opponent has shown genuine use of the earlier UK mark within the ‘relevant period’. In this case the relevant period is 25 September 2016 to 24 September 2021.

Variant use

28. The opponent’s evidence indicates that the mark **RS** is used as a sub brand of Ford plus the particular car model, so for example Ford Focus RS. There are many examples of the “Ford plus model plus RS” formation within the evidence, most prominently in Exhibit SCS02 from the Car and Driver article, namely “The Story of RS”. In *Colloseum Holdings AG v Levi Strauss & Co.*⁹, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

⁹ Case C-12/12


32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1). (emphasis added)

29.. I find that the use of RS in the composite mark is acceptable because the letters continue to indicate the origin of the goods

30. The earlier mark, as registered, is **RS**. There are instances within the evidence where the mark used is in this form, namely  which is the version affixed to the goods themselves in various colours. The issue of use in a differing form was considered in *Lactalis McLelland Limited v Arla Foods AMBA*¹⁰, where Phillip

¹⁰ BL O/265/22

Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:


“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”.

31. In my view the use of  is acceptable as use in a differing form, as the stylisation is a minor change which does not alter the distinctive character of the letters **RS** themselves. Most average consumers will focus on what the text elements are, namely the letters **RS**. Overall then I find use of the differing form of the earlier mark is acceptable.

Sufficiency of use

32. Ms Sorkin submitted turnover figures for 2016, 2017 and 2018 for sales of **RS** branded vehicles in the UK and unit sales of several thousand vehicles between the same period. Much of the evidence goes to the prominence of the opponent in the motor manufacturing sector, but the evidence does support that the **RS** brand has a following by collectors and enthusiasts for the older and newer RS models. She also exhibited details of the second hand car market¹¹ for **RS** branded vehicles stating that they are an indication of the “public’s knowledge of our vehicles”. However the sale of second hand vehicles by third parties bearing a trade mark affixed when the vehicles were new does not constitute use of the trade mark for the goods by the proprietor or with his consent. It can only be considered genuine use if the opponent was selling second hand vehicles itself or with its consent¹², however the evidence presented in Exhibit SCS05 demonstrates third party websites and not the opponent’s own resales. Overall though I find that there is sufficient evidence to support the opponent’s position that there has been genuine use of the earlier mark during the relevant period.

¹¹ Exhibit SCS5

¹² See Joined Cases C-720/18 & C-721/18, EU:C:2020:854, *Ferrari SpA v DU*

Framing a fair specification

33. The next stage is to decide whether the opponent's use entitles it to rely on all of the goods for which it made a statement of use. In framing a fair specification, I rely on guidance given in the following judgments. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*¹³, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“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.”

34. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*¹⁴, Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“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].

¹³ BL O/345/10

¹⁴ [2016] EWHC 3103 (Ch)

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 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."

35. The evidence demonstrates that the opponent has used its mark on motor cars as well as parts and fittings. There was no indication from the evidence that RS is used on any vehicles other than cars. As such I find that a fair specification which reflects use made of the mark demonstrated by the evidence provided would be *Motor cars; parts and fittings therefor*.

Sections 5(1) & 5(2)(a)

36. Section 5(1) of the Act reads as follows:

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


37. Section 5(2)(a) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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”.

Identity of the marks

38. The marks to be compared are:

Opponent's mark	Applicant's mark
RS	

39. I am guided on the matter of identity from *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*,¹⁵ in which the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

And also in *Migros-Genossenschafts-Bund v EUIPO*,¹⁶ where the GC held that the mark shown below was not identical to the word mark CREMESPRESSO.

¹⁵ Case C-291/00

¹⁶ Case T-189/16



40. In that case the court stated that:

“According to the case law, word marks are marks consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element (see, to that effect, judgment of 7 October 2010, *Accenture Global Services v OHIM - Silver Creek Properties (acsensa)* (T-244/09) not published, EU:T:2010:430 , at [28] and the case-law cited). Therefore, the applicant’s claim that the protection of the earlier mark held by it would also apply with respect to the variations of stylisation CReMESSO and **CReM** ESSO must be rejected.”

41. Therefore, a word mark registered in standard characters may be considered to cover the use of the same word(s) presented in any normal font. This is irrespective of the use of upper and lower case letters, or any customary combination of the two. However, normal and fair use of word-only marks, in this case CREMESSO, should not be taken to include stylisation that goes beyond normal and fair use of the word mark, such as in the CReMESPRESSO example shown above.

42. Clearly the applicant’s mark is stylised and contains a white line which runs through the middle of two conjoined black letters. The applicant in its TM8 stated this was meant to resemble a racetrack. As the *Sadas* guidance above states, the differences must be ‘so insignificant that they may go unnoticed’. I do not find the differences between the marks in this case are insignificant. The differences are visually noticeable to the average consumer. The *Cremespresso* case states that stylisation beyond normal and fair use, that is use in upper, lower or title case or normal fonts, cannot be considered identical. Taking these factors into account I do not find that the marks are identical.

43. Having found that the respective marks are not identical, I do not need to consider these grounds further, since section 5(1) and 5(2)(a) of the Act require the marks to be identical. These grounds are dismissed.

Section 5(2)(b)

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

“5(2) 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”.

45. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

46. The following principles are gleaned from the decisions of the EU courts 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 B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may 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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

Comparison of the marks under 5(2)(b)

47. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*¹⁷, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which 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.”

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

49. I remind myself that the marks to be compared are set out in paragraph 38 above

50. The opponent's mark consists of two letters, R and S, with no other aspect to them and the overall impression is derived from these letters.

¹⁷ Case C-591/12P

51. The applicant's mark consists of the letters R and S conjoined in a stylised font with a single white line running through the middle of the letters. The letters and the stylisation both contribute to the overall impression of the mark.

52. In a visual comparison the respective marks clearly share the letters R and S. In the applicant's mark the letters are conjoined and have additional stylisation as a point of difference. Overall I find there is a medium degree of visual similarity.

53. The stylisation does not factor in to the aural comparison, so I consider the text elements only. Neither mark is capable of being pronounced as a word so consumers will instead sound out the letters. I find that the marks will be pronounced identically.

54. With regard to a conceptual comparison, the evidence provided in exhibit SCS02 indicated that RS stood for Rally Sport. It is likely that some consumers will know this abbreviation, but other consumers will not and will regard the mark as merely being two letters of the alphabet. In its counterstatement the applicant states that RS are the initials of its owner. However, this is not a conceptual factor I can take into account as this information is not known to consumers at large. Overall, to the extent that a concept can attach to two letters of the alphabet, I find the marks to be conceptually identical.

Comparison of the goods

55. In *Canon*¹⁸, the CJEU stated at paragraph 23 that:

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

¹⁸ Case C-39/97

56. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case¹⁹, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

57. I also find that the following case law is useful in these proceedings where in *Gérard Meric v Office for Harmonisation in the Internal Market ("OHIM")*²⁰, the GC stated that:

“29. 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”.

¹⁹ [1996] R.P.C. 281

²⁰ Case T- 133/05

58. In *Kurt Hesse v OHIM*,²¹ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

59. In *Sanco SA v OHIM*²², the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

²¹ Case C-50/15 P

²² Case T-249/11

60. The goods to be compared are

Opponent's relied on goods in class 12	Applicant's goods in class 12
<p><i>Motor cars; parts and fittings therefor.</i></p>	<p><i>Cars; Lifting cars [lift cars]; Driverless cars [autonomous cars]; Platform cars; Hand cars; Hybrid cars; Motor cars; Passenger cars; Dining cars; Autonomous cars; Casting cars; Sleeping cars; Cycle cars; Camping cars; Driverless cars; Dump cars; Car tidies; Armoured cars; Touring cars; Electric cars; Railway cars; Ladle cars; Side cars; Refrigerator cars; Container cars; Racing cars; Car transporters; Sports cars; Car seats; Cable cars; Robotic cars; Mine cars; Golf cars [vehicles]; Mine-car pushers; Motor car doors; Car sun blinds; Cable car cabins; Electric railway cars; Railway freight cars; Children's car seats; Fuel cell cars; Hydrogen fueled cars; Passenger motor cars; Racing motor cars; Motor car seats; Rear car windows; Motor car windows; Dining cars [carriages]; Railway passenger cars; Car seat tidies; Motor racing cars; Convertible car seats; Car seat canopies; Series hybrid cars; Car seat covers; Car boot lids; Car seat harnesses; Car theft alarms; Mine-car pullers; Self-driving cars; Chains for motor cars; Motor car convertible tops; Bodies for railway cars; Car-top luggage carriers; Undercarriages for railway</i></p>

	<p><i>cars; Car body modification parts for sale in kit form; Sports cars sold in kit form; Vehicle bodies; Automobile bodies; Motor vehicles in kit form; Vans; Vans [vehicles]; Motor vans; Delivery vans; Camper vans; Structural parts for vans; Motor car derived vans; Vehicle body hardware; Carriage body parts; Bodies for aircraft; Bodies for trailers; Insulated vehicle bodies; Bodies for vehicles; Vehicles sold in kit form; Motor vehicle bodies; Tipping bodies for vehicles; Bodies for land vehicles; Armoured bodies for vehicles; Body panels for vehicles; Insulated vehicle body panels; Bodies for motor vehicles; Protective strips for vehicle bodies; Interlocking panels for vehicle bodies; Aerodynamic attachments for vehicle bodies; Panels for vehicle bodies [shaped]; Trim panels for vehicle bodies; Vehicle safety harnesses for pram bodies; Axle boot kits for use with land vehicles; Components for the outer bodies of vehicles; Vehicle safety restraints for use with pram bodies; Reinforcement strips for use in panels for vehicles bodies; Animal transport containers in the nature of vehicle bodies; Motorized dirt bikes for motocross; Dirt bikes; Quad bikes; Mountain bikes; Folding bikes; Bike bags; Mini-bikes; Road bikes; Electric</i></p>
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	<p><i>motors for motor cars; Motor scooters; Motor homes; Buses (Motor -); Motor vehicles; Motor lorries; Motor caravans; Motor buses; Motorized scooters; Motor cycles; Motor coaches; Bicycle motors; Motorized bicycles; Vinyl roofs for vehicles; Alloy wheels for vehicles; Wheels; Wheel trims; Wheel chairs; Wheeled vehicles; Wheeled carrycots; Wheel brakes; Steering wheels; Bicycle wheels; Wheel suspensions; Wheel hubs; Wheel rims; Wheel covers; Wheel barrows; Wheel sprockets; Wheel spacers; Automobile wheels; Vehicle wheels; Wheels (Vehicle -); Wheel hubs (Vehicle -); Vehicle wheel hubs; Wheel hubs (Vehicles -); Steering wheel locks; Automobile steering wheels; Castors [vehicle wheels]; Wheels for bicycles; Vehicle wheel tyres; Wheels for vehicles; Mine cart wheels; Two-wheeled trolleys; Bicycle wheel spokes; Spokes (Vehicle wheel -); Wheels for motorcycles; Wheel tyres (Vehicle -); Spare wheel covers; Aircraft landing wheels; Vehicle wheel spokes; Vehicle wheel rims; Rear wheel sprockets; Wheel tires (Vehicle -); Coverings for car seats; Seats for railway cars; Seat cushions for the seats of cars; Head-rests for car seats; Children's safety seats for cars; Car safety seats for children; Seat safety harnesses for</i></p>
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	<p><i>motor cars; Safety seats for use in cars; Children's seats for use in cars; Car seat covers [shaped or fitted]; Head rests for seats for motor cars; Cushions adapted for use with car seats; Safety seats for children for motor cars; Seat back organizers specially adapted for use in cars; Seats (Vehicle -); Airplane seats; Vehicle seats; Vehicle seating; Bicycle seats; Loose seat covers [shaped] for vehicle seats; Passenger seat belts; Vehicle safety seats; Automobile seat cushions; Children's bicycle seats; Seats for automobiles; Seats of aircraft; Seat cushions for the seats of aircraft; Seat cushions for the seats of vehicles; Seat cushions for the seats of land vehicles; Bicycle seat posts; Power rumble seats; Seating for vehicles; Seats for vehicles; Vehicle seat subsystems; Vehicle seat covers; Vehicle seat belts; Pumps (Air -) [vehicle accessories]; Air pressure pumps [vehicle accessories]; Air pumps [vehicle accessories]; Spare tyre covers; Spare tire covers; Spare wheels for vehicles; Automobile spare wheel holders; Spare tire carriers for vehicles; Alarm systems for cars; Convertible roofs being parts of cars; Tipping apparatus [parts of railway freight cars]; vans ; Cars; Lifting cars [lift cars]; Driverless cars [autonomous cars];</i></p>
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	<p><i>Platform cars; Hand cars; Hybrid cars; Motor cars; Passenger cars; Dining cars; Autonomous cars; Casting cars; Sleeping cars; Cycle cars; Camping cars; Driverless cars; Dump cars; Car tidies; Armoured cars; Touring cars; Electric cars; Railway cars; Ladle cars; Side cars; Refrigerator cars; Container cars; Racing cars; Car transporters; Sports cars; Car seats; Cable cars; Robotic cars; Mine cars; Golf cars [vehicles]; Mine-car pushers; Motor car doors; Car sun blinds; Cable car cabins; Electric railway cars; Railway freight cars; Children's car seats; Fuel cell cars; Hydrogen fueled cars; Passenger motor cars; Racing motor cars; Motor car seats; Rear car windows; Motor car windows; Dining cars [carriages]; Railway passenger cars; Car seat tidies; Motor racing cars; Convertible car seats; Car seat canopies; Series hybrid cars; Car seat covers; Car boot lids; Car seat harnesses; Car theft alarms; Mine-car pullers; Self-driving cars; Alarm systems for cars; Chains for motor cars; Motor car convertible tops; Bodies for railway cars; Car-top luggage carriers; Undercarriages for railway cars.</i></p>
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61. For the purpose of a comparison, it is appropriate to group related goods together, where they are sufficiently comparable to do so²³.

62. In its written submission, the opponent claims that the respective goods overlap as both contain vehicles and parts and fittings. However I note that goods the opponent can rely on are *motor cars; parts and fittings therefor*. As such I find the applicant's terms set out below, to be identical under the *Meric* principle to the opponent's goods.

Cars; Driverless cars [autonomous cars]; Platform cars; Hybrid cars; Motor cars; Passenger cars; Autonomous cars; Cycle cars; Camping cars; Driverless cars; Car tidies; Armoured cars; Touring cars; Electric cars; Racing cars; Sports cars; Car seats; Robotic cars; Motor car doors; Car sun blinds; Children's car seats; Fuel cell cars; Hydrogen fueled cars; Passenger motor cars; Racing motor cars; Motor car seats; Rear car windows; Motor car windows; Car seat tidies; Motor racing cars; Convertible car seats; Car seat canopies; Series hybrid cars; Car seat covers; Car boot lids; Car seat harnesses; Car theft alarms; Self-driving cars; Chains for motor cars; Motor car convertible tops; Car-top luggage carriers; Car body modification parts for sale in kit form; Sports cars sold in kit form; Vehicle bodies; Automobile bodies; Motor vehicles in kit form; Vehicle body hardware; Insulated vehicle bodies; Bodies for vehicles; Vehicles sold in kit form; Motor vehicle bodies; Tipping bodies for vehicles; Bodies for land vehicles; Armoured bodies for vehicles; Body panels for vehicles; Insulated vehicle body panels; Bodies for motor vehicles; Protective strips for vehicle bodies; Interlocking panels for vehicle bodies; Aerodynamic attachments for vehicle bodies; Panels for vehicle bodies [shaped]; Trim panels for vehicle bodies; Vehicle safety harnesses for pram bodies; Axle boot kits for use with land vehicles; Components for the outer bodies of vehicles; Vehicle safety restraints for use with pram bodies; Reinforcement strips for use in panels for vehicles bodies; Animal transport containers in the nature of vehicle bodies; Electric motors for motor cars; Motor vehicles; Vinyl roofs for vehicles; Alloy wheels for vehicles; Wheels; Wheel trims; Wheeled vehicles; Wheel brakes; Steering wheels; Wheel suspensions; Wheel hubs; Wheel rims; Wheel covers; Wheel sprockets; Wheel spacers; Automobile wheels; Vehicle wheels; Wheels (Vehicle -); Wheel hubs (Vehicle -);

²³ *Separode Trade Mark* decision, BL O-399-10 (AP)

Vehicle wheel hubs; Wheel hubs (Vehicles -); Steering wheel locks; Automobile steering wheels; Castors [vehicle wheels]; Vehicle wheel tyres; Wheels for vehicles; Spokes (Vehicle wheel -); Wheel tyres (Vehicle -); Spare wheel covers; Vehicle wheel spokes; Vehicle wheel rims; Rear wheel sprockets; Wheel tires (Vehicle -); Coverings for car seats; Seat cushions for the seats of cars; Head-rests for car seats; Children's safety seats for cars; Car safety seats for children; Seat safety harnesses for motor cars; Safety seats for use in cars; Children's seats for use in cars; Car seat covers [shaped or fitted]; Head rests for seats for motor cars; Cushions adapted for use with car seats; Safety seats for children for motor cars; Seat back organizers specially adapted for use in cars; Seats (Vehicle -); Vehicle seats; Vehicle seating; Loose seat covers [shaped] for vehicle seats; Passenger seat belts; Vehicle safety seats; Automobile seat cushions; Seats for automobiles; Seat cushions for the seats of vehicles; Seat cushions for the seats of land vehicles; Power rumble seats; Seating for vehicles; Seats for vehicles; Vehicle seat subsystems; Vehicle seat covers; Vehicle seat belts; Pumps (Air -) [vehicle accessories]; Air pressure pumps [vehicle accessories]; Air pumps [vehicle accessories]; Spare tyre covers; Spare tire covers; Spare wheels for vehicles; Automobile spare wheel holders; Spare tire carriers for vehicles; Alarm systems for cars; Convertible roofs being parts of cars; vans ; Cars; Driverless cars [autonomous cars]; Platform cars; Hybrid cars; Motor cars; Passenger cars; Autonomous cars; Cycle cars; Camping cars; Driverless cars; Car tidies; Armoured cars; Touring cars; Electric cars; Racing cars; Sports cars; Car seats; Robotic cars; Motor car doors; Car sun blinds; Children's car seats; Fuel cell cars; Hydrogen fueled cars; Passenger motor cars; Racing motor cars; Motor car seats; Rear car windows; Motor car windows; Car seat tidies; Motor racing cars; Convertible car seats; Car seat canopies; Series hybrid cars; Car seat covers; Car boot lids; Car seat harnesses; Car theft alarms; Self-driving cars; Alarm systems for cars; Chains for motor cars; Motor car convertible tops; Car-top luggage carriers; Motor car derived vans

63. With regard to the remaining goods in the applicant's specification, I find they can be grouped together in the following categories:

Vans; Vans [vehicles]; Motor vans; Delivery vans; Camper vans; Structural parts for vans; Refrigerator cars; Container cars; Car transporters; Golf cars [vehicles]; Motor

homes; Buses (Motor -); Motor lorries; Motor caravans; Motor buses; Motor coaches; Refrigerator cars; Container cars; Car transporters; Golf cars [vehicles]; Motor scooters; Motorized scooters; Motor cycles; Bicycle motors; Motorized bicycles; Motorized dirt bikes for motocross; Dirt bikes; Quad bikes; Side cars; Wheels for motorcycles;

64. These goods are vehicles and associated parts and fittings. I find the goods to share their nature and purpose with the opponent's goods and there will be a crossover over in users and trading channels as they are all motor vehicles. There may also be some competition and complementarity. Taking these factors into account I find these goods to be highly similar to the opponent's goods.

Wheel chairs; Wheeled carrycots; Wheel barrows;

65. I regard the above goods to be hand operated manual goods which are not vehicular. As such I find they do not share a nature and purpose with the opponent's goods. There is no crossover of trading channels as wheel barrows, carry cots and wheelchairs will be sold by an individual specialist retailers. There is no competition or complementarity with the opponent's goods. There may be a crossover of users being the general public but it is at too general a level for a finding of similarity. Overall I find these goods to be dissimilar.

Dining cars; Sleeping cars; Railway cars; Electric railway cars; Railway freight cars; Dining cars [carriages]; Railway passenger cars; Bodies for railway cars; Undercarriages for railway cars; Seats for railway cars; Tipping apparatus [parts of railway freight cars]; Carriage body parts; Dining cars; Sleeping cars; Railway cars; Electric railway cars; Railway freight cars; Dining cars [carriages]; Railway passenger cars; Bodies for railway cars; Undercarriages for railway cars

66. The above goods are railway and train rolling stock and related parts and fittings. These goods do not share a nature and purpose with the opponent's goods. Neither will there be an overlap of users or trade channels for the respective goods as automotive and train industries are in separate sectors. The respective goods are not in competition nor are they complementary. Overall I find these goods to be dissimilar to the opponent's goods.

Mountain bikes; Folding bikes; Bike bags; Mini-bikes; Road bikes; Bicycle wheels; Wheels for bicycles; Bicycle wheel spokes; Bicycle seats; Children's bicycle seats; Bicycle seat posts;

67. I regard the above goods as pedalled bicycles, rather than the motorised equivalent, and their associated parts and fittings. As such I find they do not share a nature and purpose with the opponent's goods, other than as a means of general locomotion which is too low a level to find similarity. There is no likely crossover of trading channels as bicycles are not usually traded in the same places as cars. There may be a crossover of users being the general public but again it is at too general a level for a finding of similarity. Overall I find these goods to be dissimilar.

Lifting cars [lift cars]; Hand cars; Casting cars; Dump cars; Ladle cars; Cable cars; Mine cars; Mine-car pushers; Cable car cabins; Mine-car pullers; Mine cart wheels; Two-wheeled trolleys; Lifting cars [lift cars]; Hand cars; Casting cars; Dump cars; Ladle cars; Cable cars; Mine cars; Mine-car pushers; Cable car cabins; Mine-car pullers; Bodies for trailers

68. I find the above goods are used as part of a transport infrastructure in industrial plant, e.g. mining, construction or for other industrial applications. These goods do not share a nature and purpose with the opponent's general motoring goods. Neither will there be an overlap of users or trade channels for these goods as they are specialist apparatus. The respective goods are not in competition nor are they complementary. Overall I find these goods to be dissimilar.

Bodies for aircraft; Aircraft landing wheels; Airplane seats; Seats of aircraft; Seat cushions for the seats of aircraft;

69. I regard the above as aviation goods and related parts and fittings. These goods do not share a nature and purpose with the opponent's goods. Neither will there be an overlap of users or trade channels for these goods as aviation is a specialist industry. The respective goods are not in competition nor are they complementary. Overall I find these goods to be dissimilar.

70. Where I have found the goods to be dissimilar, it follows that there is no likelihood of confusion to be considered for these goods. I am guided on this matter

in the case of *eSure Insurance v Direct Line Insurance*,²⁴ where Lady Justice Arden stated that:

“49..... 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.”

Average Consumer

71. I next consider who the average consumer is for the contested goods and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect²⁵. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question²⁶.

72. The average consumers for the contested goods are the general public and businesses for the specialist vehicular equipment. The purchasing of vehicles is likely to be less frequent than for parts and fittings and there will be considerable price variations for the goods. The purchasing process will be predominately visual as consumers will either visit a physical showroom, garage or browse online images. An aural element cannot be ruled out as consumers may seek advice from sales staff or order parts in person or by telephone. Given that there are a number of factors to consider during purchase such as suitability for purpose, engine size, technical capabilities and aesthetics, I find that a consumer will be paying at least a medium degree of attention.

²⁴ [2008] ETMR 77 CA

²⁵ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch)

²⁶ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

Distinctiveness of the earlier marks

73. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive an earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*²⁷ 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 Attenberger* [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).”

74. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent distinctive character, such as invented words.

²⁷ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

75. I begin by considering the inherent position. A mark consisting of two letters must be assessed in relation to the goods at issue as with all other types of marks. The letters **RS** may be meaningful to some consumers for cars if they understand **RS** to stand for Rally Sport. This results in a low level of inherent distinctiveness. If consumers do not know the connection between **RS** and Rally Sport then the level of inherent distinctiveness is somewhat higher but not significantly so, as there is nothing particularly striking or inventive about a combination of two letters of the alphabet. On that basis, I find that there is between a low and medium level of inherent distinctiveness.

76. As evidence was provided in these proceedings, I consider whether use of the earlier mark has enhanced its distinctiveness. The relevant market for this consideration is the UK. Taking into account the *Chiemsee* factors given above, I note the evidence shows the mark in use with other trade marks and in a different stylised form during the relevant period. The Ford Focus RS model indicated in the evidence was promoted in the opponent's dealerships throughout the UK. Unit sales and turnover figures for new RS models were provided for three years of the relevant period and I note the opponent has provided figures as to the number of RS models have been registered, although numbers registered will include second hand sales as well as the new sales evidenced by the opponent for what appears to be only the Ford Focus RS. Whilst the opponent's own market share for vehicles at large is undoubtedly huge as it is a major motor manufacturer, no figures were demonstrated showing the market share for the RS models. There is evidence demonstrating that there are collectors and enthusiasts specifically for RS models such as the RS Owners Club. However the evidence does not give any indication of how widespread the membership is. But it is unlikely, in my view, that they form a significant part of the general public. Overall I find the evidence insufficient to demonstrate that the opponent has enhanced the distinctiveness of the mark through use.

Likelihood of confusion

77. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they

have kept in mind²⁸. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

78. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

79. In *L.A. Sugar Limited*²⁹, Mr Iain Purvis Q.C., 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 recognized 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”.

80. However it is also settled case law that it is not sufficient to find a likelihood of confusion if a mark merely calls to mind another mark.³⁰ This is considered mere association not indirect confusion.

²⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

²⁹ *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

³⁰ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

81. So far in this decision I have found that,

- Most of the goods are considered identical and highly similar but there is a dissimilarity for some of the applied for goods
- The average consumers for the contested goods are the general public and businesses paying a medium degree of attention in a predominantly visual purchasing process
- There is a medium degree of visual similarity between the respective marks
- There is aural and conceptual identity between the respective marks
- The earlier mark is inherently distinctive to between a low and medium degree

82. Based on the marks and goods before me and taking into account the assessments made above, I find that there is a likelihood of direct confusion for those goods I have identified as identical and highly similar. There are some visual differences relating to stylisation but both marks contain the letters **RS** and are aurally and conceptually identical. The stylisation in the applicant's mark resembles the variant use in the opponent's evidence in terms of the font and the conjoined letters and indicates that this type of development of the mark would not be surprising to the consumer. Even if the stylisation is noted, it could still lead to one mark being mistaken for the other as the consumer rarely has the chance to make direct comparisons between marks but instead relies on an imperfect recollection they have formed in their mind.

83. The opposition largely succeeds under section 5(2)(b) but for those goods which have survived the 5(2) grounds, I will go on to consider the other pleaded grounds.

Section 5(3)

84. The opponent opposes the contested trade mark under Section 5(3) of the Act on the basis of its earlier mark and goods for which it claims have a reputation. In particular the opponent argues,

“...In light of the of the opponent's reputation in its marks, it is inevitable that the public will assume there to be an economic connection between the parties. The applicant will capitalise on the opponent's reputation in RS and

use of the opposed mark will take unfair advantage of the opponent's reputation and investment in the RS mark; such use will be detrimental to the opponent's reputation in RS and its business as a whole."

85. Section 5(3) of the Act states:

"5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

86. Section 5(3A) of the Act states:

"Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

87. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

88. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its mark is similar to the applicant's mark. Secondly, that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

80. From my previous assessment of the opponent's evidence I find it has demonstrated a reputation for *motorcars; parts and fittings therefor*.

Link

77. Having found that the opponent has established the requisite reputation, I will go on to make the assessment of whether the public will make the required mental 'link' between the marks, taking account of all relevant factors. The factors identified in *Intel* (underlined below) are:

The degree of similarity between the conflicting marks

78. For the reasons given previously I find there is a medium degree of visual similarity, and aural and conceptual identity.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

79. The applicant is seeking to register its mark for goods in class 12 which include the goods of the opponent. Although the relevant consumer concerned with train rolling stock or aviation are likely to be specialist business, they are still transportation goods and it is conceivable that they would still recognise the RS or its variant mark and the public who travel on trains and planes may also see the RS mark on a seat or some other interior fitting and make an association with the opponent's mark.

The strength of the earlier mark's reputation

80. I found that the opponent's evidence has demonstrated a reasonable reputation for *motor cars; parts and fittings* in the UK based on the use shown.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

81. I found that the earlier mark is inherently distinctive to between a low to medium degree.

Whether there is a likelihood of confusion

82. Previously in this decision, I found there was a likelihood of direct confusion.

83. Taking the above factors into account, I find that the required link will be made

Damage

83. I must next assess whether any of the pleaded types of damage will arise. In its notice of opposition, the opponent stated,

“there will be detriment to the distinctive character and reputation of the opponent because it will reduce the ability of that mark to signify origin”

84. In *Environmental Manufacturing LLP v OHIM*³¹, the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words ‘[i]t follows that’, immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the

³¹ Case C-383/12P

distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of ‘change in the economic behaviour of the average consumer’ lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers’ perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that ‘the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark’s ability to identify the goods for which it is registered as coming from the proprietor of that mark’.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”

85. As set out above, I found sufficient evidence that the opponent enjoys a reputation for its goods. Given that reputation, the shared letters RS and the identity and similarity of the goods, it is clear that there is the potential for the applicant cause detriment to the distinctive character of the earlier mark.

86. As damage is made out on the basis of detriment, it is not necessary for me to go on and consider the other heads of damage.

87. The opposition is therefore successful under section 5(3).

Section 5(4)(a)

88. The opponent opposes the application under Section 5(4)(a) of the Act on the basis of its alleged earlier rights in the use of the sign **RS** since 1970 for the goods set out earlier in this decision. It claims to have acquired goodwill under this sign. Use of the applicant’s mark in the course of trade would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

89. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(a) [...]

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

90. In *Discount Outlet v Feel Good UK*³², Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

91. In terms of the relevant date for assessment of this ground, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,³³ Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:³⁴

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the

³² [2017] EWHC 1400 IPEC

³³ BL O-410-11

³⁴ BL O-212-06

applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

92. Therefore the relevant date in this case is the filing date for the contested mark namely 24 September 2021.

Goodwill

93. The first hurdle for the opponent is to show that it had the requisite goodwill at the relevant date. and that the sign relied upon, **RS**, is associated with, or distinctive of, that business.

94. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

95. Given my previous analysis of the opponent’s evidence I find that it has established sufficient goodwill for *motor cars; parts and fittings therefor*.

Misrepresentation

96. Having cleared the first hurdle of goodwill I now go on to consider the second hurdle of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another*³⁵, Morritt L.J. stated that:

³⁵ [1996] RPC 473

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is “is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

97. On the subject of how many of the relevant public must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*³⁶, where Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the

³⁶ [2013] EWCA Civ 590

Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

98. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to find a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

99. So far I have found that the opponent has proved goodwill for the sign RS in respect of *motor cars; parts and fittings therefor*. The respective marks are visually similar, but aurally and conceptually identical. The contested application contains some goods which are identical and highly similar as well as dissimilar goods. In terms of the goods I found to be dissimilar under the section 5(2)(b) assessment, I am alert to the fact that passing off can occur where there is no common field of activity. In *Harrods Limited v Harrodian School Limited*³⁷, Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch.

³⁷ [1996] RPC 697 (CA)

282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

100. The opponent’s goods and what remains of the applicant’s goods, i.e. goods in the train, aviation and industrial transport field are all still within the broader arena of vehicles and associated parts and fittings, as such I find that there is likely to be an association in the minds of the public between the respective goods.

Damage

101. Having found that the goodwill and misrepresentation limbs of the test have been satisfied, it follows that damage to the opponent’s goodwill will arise, the most obvious example being the diversion of trade from the opponent to the applicant

102. In conclusion I find the case has been made out under section 5(4)(a)

Section 3(6)

103. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

104. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].
5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].
6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].
7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].
8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].
9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].
10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].
11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacılık* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]”.

105. According to *Alexander Trade Mark*³⁸, the key questions for determination in a claim of bad faith are:

- (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
- (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
- (c) Was it established that the contested application was filed in pursuit of that objective?

106. It is necessary to ascertain what the applicant knew at the relevant date³⁹. The relevant date in this case is the filing date for the contested mark namely 24 September 2021.

107. I pause here to remind myself that as per the case law cited above, bad faith is a serious allegation and it is for the party alleging it to prove it. I will start therefore by examining whether the opponent has provided such evidence.

108. In its notice of opposition under section 3(6), the opponent states that,

“The Applicant's behaviour and intention when filing the application at issue was dishonest and falls short of the standard of acceptable commercial behaviour. In brief:

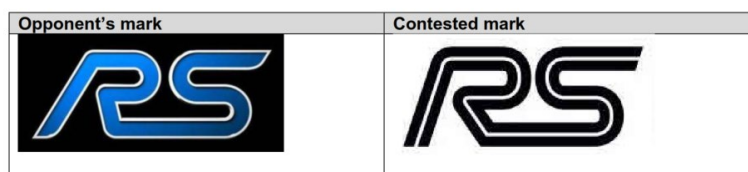
³⁸ BL O/036/18

³⁹ *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch).

- The applied-for mark is identical/confusingly similar to the Opponent’s mark. The Applicant’s mark reproduces in its entirety the Opponent’s well-known RS stylised mark;
- The Applicant knew or must have known about the use of the Opponent’s mark;
- The Applicant had a dishonest intention in relation to filing the Application with a view to capitalising on the Opponent’s goodwill and reputation in its RS stylised mark.”

109. The opponent further goes on to state,

“We illustrate below the contested mark and an image of the most recent RS mark used by the Opponent. As you can see, there are distinct similarities.



The Applicant’s mark reproduces almost identically the Opponent’s well-known RS stylised mark. The adoption of this styling for the Opponent’s name appears too great to be coincidental.”

110. The applicant did not file any evidence but stated, under a statement of truth in its counterstatement, that

“my design is a figurative deign [sic] of a RACE TRACK not just look like RS is joined up with 2 boundary lines”.

111. The applicant also states that RS are the initials of Rajib Sagggar, its sole shareholder.

112. I note the opponent's submission on the similarities between the application and the opponent's stylised version of its mark but that appears to be the high point. I do not find that it has furnished me with any evidence of the applicant's dishonest intent. The assertion that the applicant "must have known" about the opponent's mark appears not to have any particular basis and as such is not sufficient reason in and of itself although I accept that the mark RS has a reputation. The material filed at the time of the notice of opposition tells me only that the opponent uses its RS mark on vehicles which was confirmed by the formal evidence filed in support of the earlier registration relied on and which I assessed in this decision previously. The opponent mentions the applicant is capitalising on goodwill and reputation but has not shown me any evidence that it has done so. I would also point out these are grounds on which its section 5(4)(a) and 5(3) are founded and I have already dealt with those grounds previously in this decision. It does not follow that a partial or full successful prosecution of a case under sections 5(2)(b), 5(3) and 5(4)(a) (which are distinct objections) will automatically result in success under section 3(6). The assertion that the applicant intends to capitalise on the opponent's goodwill and reputation appears to be speculative rather than based on evidence that this was the applicant's intention at the time of filing. Therefore I do not find that the section 3(6) case has been made out.

Conclusion

113. The opposition succeeds under section 5(2)(b), 5(3) and 5(4)(a). Subject to any appeal against this decision, the application shall be refused.

Costs

114. The opponent has been successful, so it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs as follows:

£200	Official fee for Notice of Opposition
£200	Preparation of statement & consideration of counterstatement
£500	Preparation of evidence
£300	Preparation of written submissions

£1200 Total

115. I order RS Dominator Ltd to pay Ford Motor Company Limited the sum of £1200. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of August 2023

**June Ralph
For the Registrar
The Comptroller-General**