

O/0908/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3747186

IN THE NAME OF YIFAN ZHANG

AND

OPPOSITION THERETO UNDER NO. 432895

BY TRANSPORTES J. CARRION S.A.

Background and pleadings

1. This decision concerns an opposition by Transportes J. Carrion S.A. (“the opponent”) to the registration of trade mark application number 3747186, which is shown below (“the contested mark”):



2. The application for registration was filed on 25 January 2022 (“the relevant date”) by Yifan Zhang (“the applicant”). The goods and services for which trade mark registration is sought are:

Class 9: Downloadable mobile applications for transportation; Downloadable tablet applications for transportation.

Class 35: Online advertising and marketing services in the field of transportation via wireless networks for display on mobile devices; Provision of an on-line marketplace for buyers and sellers of goods and services; Providing a website used to place on-line commercial orders in the field of transportation; Moving and relocation services, namely, planning and implementing moves of homes for others; On-line advertising and marketing services; Advertising relating to transport and delivery.

Class 39: Import and export cargo handling services; Online transportation reservation services; Transport services, namely, local, interstate and international moving services; Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of goods for others by air, rail, ship or truck; Global transportation of freight for others by all available means; Freight and

transport brokerage; Transport of persons and goods; Providing information in the field of transportation via a website; Rental of vehicles for transportation; Transportation logistics services, namely, arranging the transportation of goods for others; Arranging for pickup, delivery, storage and transportation of documents, packages, freight and parcels via ground and air carriers; Transportation services.

Class 42: Designing and developing websites in the field of transportation; Designing websites for advertising purposes; Customized software development in the field of traffic and transportation; Building and maintaining websites; Computer software development in the field of mobile applications; Traffic planning services; Design and development of software in the field of mobile applications.

3. The opposition is based upon ss. 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods and services in the specification. The opponent relies upon the same six trade marks for both grounds. These are the opponent’s earlier marks:

- (i) UK 910066876 (“the ’876 mark”). Filed 22 June 2011; registered 11 April 2014:

CARRION

- (ii) UK 910066587 (“the ’587 mark”). Filed 22 June 2011; registered 25 November 2011:

grupoCARRION

- (iii) UK 910067122 (“the ’122 mark”). Filed 22 June 2011; registered 25 November 2011:

grupoJCARRION

- (iv) UK 904453891 (“the ’891 mark”). Filed 23 May 2005; registered 11 April 2006:

J. CARRION

(v) UK 904453908 (“the ’908 mark”). Filed 23 May 2005; registered 11 April 2006:

GRUPO CARRION

(vi) UK 904453941 (“the ’941 mark”). Filed 23 May 2005; registered 11 April 2006:

GRUPO J. CARRION

4. The opponent relies upon the following services in classes 35, 37, 39 and 42 of its marks’ specifications:

Class 35: Business management; Business administration; Office functions; Business management assistance and consultancy in the exploitation or management of a commercial company, or commercial functions of an industrial company; Import-export agencies and commercial agencies; Commercial retailing or retailing via global computer networks of goods of all kinds, in particular of vehicles, industrial vehicles and spare parts and accessories therefor.

Class 37:

The ’876, ’587 and ’122 marks: Repair and maintenance (preservation) of vehicles of all kind; Vehicle service stations; Vehicle washing and cleaning services; Building construction; Installation services; Rental of machines or tools for building.

The ’891, ’908 and ’941 marks: Repair and maintenance (preservation) of vehicles of all kind; vehicle service stations (petrol stations); vehicle washing and cleaning services; construction services; installation services; rental of machines or tools for building.

Class 39: Transport; Distribution; Package and storage of goods; Rental of stores (warehouses) and storage containers; Rental of vehicles; Distribution and

transport of vehicles, industrial vehicles and spare parts and accessories therefor;
Car parking; Rental of parking places.

Class 42: Engineering services; Surveys; Research, development and evaluation of technical projects; Design and development of computer software.¹

5. The opponent contends that the respective trade marks are visually highly similar and aurally identical. It also submits that the marks are conceptually identical. As the goods and services are, it says, also highly similar or identical, this will lead to a likelihood of confusion, including the likelihood of association. Accordingly, the application should be refused under s. 5(2)(b).

6. The opponent also claims that the earlier marks have a reputation as a result of the use which has been made of them, particularly in relation to freight transportation and logistics where the marks have a reputation for high quality in the transport of frozen produce from Spain to other countries in the EU and the UK. The opponent says that the similarity between the marks is such that the relevant public will believe the marks are used by the same or economically connected undertakings. The opponent also says that the use of the contested marks will take unfair advantage of the earlier marks' reputation and cause detriment to their reputation and distinctive character. Consequently, the application should be refused under s. 5(3).

7. The applicant filed a counterstatement denying all of the grounds and putting the opponent to proof.

8. Both parties filed evidence and submissions during the evidence rounds. Neither party requested a hearing; the applicant filed written submissions in lieu. This decision is taken following a careful reading of all of the papers.

¹ There are some minor differences in terminology (e.g. the '891, '908 and '941 marks read "parking place rental" instead of "rental of parking places" in class 39) but these do not materially affect the coverage.

9. The opponent is represented by Elys IP Limited. The applicant is represented by Sanderana Limited.

Witnesses

10. The bulk of the opponent's evidence is given by Miguel Carrión Cáceres, the General Director of the opponent. His evidence goes to the use which the opponent has made of its marks.

11. There is also a witness statement (with exhibits) from Yvonne Onomor, a solicitor and Chartered Trade Mark Attorney at the opponent's representatives. Ms Onomor gives evidence about an Australian company and trade mark.

12. The applicant's evidence is a witness statement from Eugene Pienaar, the Managing Director of RevoMark, the applicant's previous representatives. Mr Pienaar's statement simply introduces one exhibit, a print from www.statista.com. The print appears to show the same information as the Statista report filed by Mr Carrión Cáceres in his exhibit MCC-6.

13. None of the witnesses was cross-examined.

14. I have read all of the evidence. I will refer to it, as appropriate, in the course of this decision.

Proof of use

15. In view of their registration dates, all of the earlier marks are subject to the use provisions at s. 6A of the Act. The opponent indicated in its notice of opposition that it has used the marks in respect of all the services relied upon and the applicant has put it to proof.

16. The use provisions at s. 6A read 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

(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.”

17. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

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

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

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

18. The burden of proving use is on the opponent: s. 100 of the Act.

19. 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 Bundesvereinigung 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].”

20. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), 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].

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."

21. The relevant period is 26 January 2017 to 25 January 2022.

The opponent's evidence of use

22. The evidence is that the opponent was founded in Spain in 1980 as a transporter of refrigerated fruit and vegetables.² It has operated in the UK for 20 years and the UK is said to be one of the opponent's most important European commercial markets.³

23. A brochure from 2018 shows that the opponent provided transport services for frozen and dry foodstuffs, drinks, pharmaceuticals, cosmetics and perfumes, parcels and technological goods as well as fresh produce.⁴ This appears to have included road, rail and sea transport; lorries and rail freight wagons are shown bearing the opponent's

² Carrión Cáceres, §4.

³ Carrión Cáceres, §6.

⁴ MCC-2.

branding. There are a number of quality certificates dated within the relevant period, which include certificates for transport of food and other products.⁵

24. The evidence is that annual turnover for transportation services to and from the UK was €51,017 in 2019, €45,361 in 2020 and €36,860 in 2021.⁶ Invoices dated within the relevant period addressed to WM Morrison Supermarkets Plc (at a UK address) and Reckitt Benckiser Healthcare (UK) Ltd, show transport of goods between the UK and the continent (mainly Gibraltar and Spain, respectively).⁷ There are also invoices to S&A Produce Limited at an address in Hereford for transport from Spain to the UK.

25. The invoices show the '122 mark, as registered, at the bottom, whilst the sign reproduced below is in the header:



26. Mr Carrión Cáceres's unchallenged evidence is that the opponent's UK customers also include Tesco.⁸ He also says that the invoices show logistical and IT services but it is not clear to me that that is the case.

27. A Statista report indicates that the opponent was ranked number 7 among Spanish road freight transport companies in 2019, with a turnover of €258.54 million.⁹

28. The opponent is said to have participated at food industry trade fairs, including Fruit Attraction in Madrid in 2021 and 2022; the documentary evidence only relates to the latter (in October 2022).¹⁰

29. During the relevant period, the opponent operated warehouses for logistics services. This included the storage and management of goods as well as services such as loading and unloading, checking and verifying and despatch of goods.¹¹ Promotion for a 2022

⁵ MCC-1.

⁶ Carrión Cáceres, §30.

⁷ MCC-6.

⁸ Carrión Cáceres, §19.

⁹ MCC-6. See also exhibit 1 to Mr Pienaar's statement.

¹⁰ Carrión Cáceres, §32; MCC-7.

¹¹ MCC-2.

event says that the opponent will assume “100% of the logistics management, optimizing the processes of the cold chain and allowing the customer to devote its efforts to the core of its fruit and vegetable business”.¹²

30. The opponent had a service area in Almería in the relevant period, which appears to have been in operation since 1996.¹³ It bears a stylised “j.carrion” sign.

31. The opponent’s website address is www.jcarrion.es and is visible in the 2018 brochure.¹⁴ The same brochure shows word-only use of “JCarrion”. However, most of the branding is “JCARRION” in a stylised blue typeface, as shown below; there is also some use of the same sign in white on blue (or another dark background on lorry cabs):

JCARRION

32. The 2018 brochure also shows the following sign on buildings which appear to be a logistics hub of some description and an office block:¹⁵



33. The opponent has operated Facebook and LinkedIn pages, showing the same stylised “JCARRION” mark as above, as well as “Jcarrion” or “JCARRION” in plain text, since 2020.¹⁶

Assessment

34. Mr Carrión Cáceres’s evidence that the opponent has operated a transportation business for many years, first in Spain and then in the UK, is unchallenged and I accept it. Although the UK turnover is not especially large, it is not trivial and the business has had repeat custom from several UK companies, including at least one major supermarket. I am satisfied that the level of use shown in relation to transport services is sufficient to

¹² MCC-7.

¹³ MCC-2, MCC-3.

¹⁴ MCC-2.

¹⁵ MCC-2

¹⁶ Carrión Cáceres, §§21-22; MCC-4.

amount to genuine use. “Distribution” appears to be a synonym for the transportation services the opponent provides.

35. There are, however, no sales or turnover figures for any services other than transportation. While I accept that cross-border and long-distance transport may involve, for example, goods being stored securely in warehouses between different legs of a journey, I do not consider that this would amount to the opponent attempting to obtain a niche in the market for services such as storage and rental of storage, and there is nothing to suggest the scale of the business in relation to any services in class 39 other than transportation.

36. In relation to the service station which appears to have been operated by the opponent in Almería between 1996 and 2018, this is not token use. However, I am not satisfied that it is sufficient to qualify as genuine use either. Whilst the nature of a motorway service station, which is what the facility appears to be, means that the users of the services will not necessarily be local, I do not think that the length of use alone establishes a real attempt to carve out a section of the market when the services are provided in a single locality and there is no evidence of revenue at all.

37. There is no evidence at all that the opponent has provided any other services in class 37, or any services in classes 35 or 42.

38. Turning to the forms of the marks, s. 6A(4) permits the use of a mark in a form differing in elements which do not alter the distinctive character of the registered mark. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Mr Phillip 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.”

39. Although s. 46(2) relates to revocation non-use proceedings, the same applies to the assessment of genuine use under s. 6A(4).

40. There is word-only use of “JCARRION” and the signs shown below:

JCARRION

**TRANSPORTES
JCARRION**

41. Whilst I acknowledge the applicant’s submission that the full stop is missing from the forms used and that there is no space between the letter “J” and the rest of the mark, I am satisfied that the use of the word form “JCARRION” is use of an acceptable variant of the ’891 mark (i.e. “J. CARRION”). The average consumer is likely to recognise “CARRION”, an English dictionary word, as a word in its own right. The omission of the full stop and space is unlikely to alter the consumer’s perception of the mark as an initial and surname. The stylised form of the words “JCARRION” is also acceptable: the distinctiveness of the registered mark is in the words and the stylisation is too slight to alter its distinctive character. I also consider that the use of “TRANSPORTES JCARRION” in the form shown above is qualifying use. It is settled law that 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, provided that the registered trade mark is perceived as indicative of the origin of the goods or services: *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, EU:C:2013:253. I find that to be the case here: “JCARRION” is the most prominent part of the sign and the word “TRANSPORTES”, even to an English-speaking consumer, will be perceived as probably meaning “transport”, i.e. a descriptive word in the context of the services provided.

42. There is some use of the ’122 mark as registered. There is also use in the following form:



43. The distinctiveness of the registered mark is principally attributable to the words “grupoJCarrion”, whilst the stylisation plays a minor role. In my view, the separation of “grupo” from the string “JCARRION” and its placement above the latter in a smaller typeface and different colour is a minor change not sufficient to alter the distinctive character of the mark. This form is an acceptable variant. I acknowledge that the use of the '122 mark as registered is not prominent on the invoices. However, bearing in mind that the use is consistent on invoices from May 2018 to December 2021, beyond the end of the relevant period, and that there is also use of the variant form on buildings owned by the opponent I am prepared to accept that genuine use has been shown for the '122 mark. I also accept that there has been use of the '941 mark as, for the reasons given above, I do not think that the omission of the full stop or the stylisation, including the placement of “grupo”, alter the distinctiveness of the registered words.

44. That leaves the '876, '587 and '908 marks, being stylised versions of “CARRION” and “grupoCARRION”, and the word-only “GRUPO CARRION”, respectively. There is no evidence that any of these marks have been used in their registered form. In my view, the addition of the letter “J” alters the distinctive character of each of these marks. “CARRION” is not, to my knowledge, a common surname in the UK. It is therefore unlikely that the registered marks would be perceived as meaning a surname, because the word “carrion” has a specific meaning of an animal’s dead and decaying flesh. In contrast, the addition of the letter “J” to the forms used conveys the impression of an individual’s name, i.e. the initial J, followed by the name CARRION. In my view, this is a change which alters the distinctive character of the marks because it alters their meaning.

45. It bears mentioning that the applicant’s position on the conceptual meaning of the marks has not been entirely consistent during the course of proceedings. Its primary position appears to be that none of the marks has a meaning. It has also submitted that “carrion” means “the decaying flesh of animals” but that this is “lesser known”, and it has acknowledged that the word “CARRION” in the registered marks may be perceived as a

surname.¹⁷ I do not agree that no concept at all will be attributed to any of the registered marks. At the very least, “J. CARRION” (or “JCARRION” in the ’122 mark) will be understood as an initial and surname. There does not appear to be any evidential basis for the assertion that the dictionary meaning of “carrion” is “lesser known”: it is not marked as a specialist meaning or as obsolete or archaic in the *Collins* dictionary online.¹⁸ In my view, the similarity of the word “GRUPO” to the English “group” will lead the average consumer to assume that “GRUPO” means “group” even if they have no specific knowledge to that effect. Taking all of this into account, the applicant’s submission appears to me to be incorrect. However, even on the alternative bases that the registered marks either have no meaning or no meaning beyond indicating a group, or that they are a reference to a family name, the addition of the initial “J” conveys the meaning of a particular individual (or group attributable to a particular individual). That is a material alteration. There has been no genuine use of the ’876, ’587 or ’908 marks.

46. In consequence of my findings, above, the opponent has shown genuine use for, and may rely upon, the ’122, ’891 and ’941 marks in relation to “transport; distribution” in class 39 only.

Section 5(2)(b)

47. Section 5(2)(b) of the Act reads 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.”

¹⁷ Submissions filed 24 January 2023, §29.

¹⁸ <https://www.collinsdictionary.com/dictionary/english/carrion> [accessed 5 September 2023].

48. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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 will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

49. The earlier marks cover “transport”, which is identical to, at least, “transportation services” in the contested mark’s specification. As there are identical services in issue, I will proceed on the basis that the respective goods and services are identical. If the opposition is unsuccessful where there is identity between the goods and services, it will also fail where the goods and services are only similar.

The average consumer and the nature of the purchasing act

50. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. For the purposes 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 and services in question: *Lloyd Schuhfabrik*.

51. The opponent submits that the average consumer of the goods and services at issue is a business consumer operating in the transport industry who will pay a medium to high

degree of attention.¹⁹ The applicant's position appears to be that the average consumer will pay a higher than average degree of attention and that the average consumer will at least include businesses.

52. I agree that businesses and professional users are likely to be the main consumer of many of the respective services, such as advertising services, import and export cargo handling services, distribution services and traffic planning services. I also agree that the level of attention for the professional or business consumer is likely to be above average across the specifications, as they may have complex or specific requirements, such as refrigerated vehicles, or the transactions may involve significant sums. However, some of the goods and services at issue may also be offered to the general public, whose level of attention will vary across the specifications. A member of the public selecting a downloadable mobile application is unlikely to take more than a medium degree of care because whilst some features of the application will be considered, e.g. the modes of transport covered, the goods are commonly used and are inexpensive but for services such as moving services, more attention will be paid to, for example, reliability, insurance and the range of services offered. The level of attention is therefore likely to be at least medium but may be above average, depending on the goods and services.

53. Both groups of users are likely to be exposed to the trade marks primarily via visual means such as websites and written advertising material. There may be an aural element to the selection, for example from word-of-mouth recommendations or discussions with sales representatives, which I will bear in mind.

¹⁹ Submissions filed 17 October 2022, §54.

Distinctive character of the earlier trade marks

54. In *Lloyd Schuhfabrik*, the Court of Justice of the European Union (“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).”

55. The '891 mark is the word-only mark “J. CARRION”. The average consumer may recognise “carrion” as having a meaning of dead animal flesh but the mark as a whole suggests an initial and surname. It has no obvious connection with the services for which use has been shown. The mark is inherently distinctive to a medium degree.

56. Although the '941 mark includes the word “GRUPO” and the '122 mark is the same words in a stylised form, in my view these marks are also inherently distinctive to a medium degree. As I have already indicated, the word “GRUPO” is likely to be understood

as a foreign word for “group”, which is of limited distinctive character, nor is the stylisation of the '122 mark particularly striking.

57. My view is that the evidence does not show sufficient use in the UK to demonstrate that the distinctiveness of the earlier marks has been enhanced through use. I acknowledge that the opponent is said to have operated in the UK for over twenty years but UK turnover is only given for 2019 to 2021 and the figures are modest. The invoices themselves, even after other listed charges are deducted, total rather more than this (approximately £59,000 for 2019 and 2020, £70,000 in 2021, plus around €54,000 after customs charges in 2018). However, even these figures are not particularly substantial. There is limited evidence of promotion, nothing showing third-party recognition of the marks, such as press reports, and no evidence of the UK market share. The evidence does not establish that the opponent’s marks have acquired distinctiveness.


Comparison of trade marks

58. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

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

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

60. The trade marks to be compared are:

Earlier marks	Contested mark
<p data-bbox="407 432 591 464">J. CARRION</p> <p data-bbox="347 527 654 558">GRUPO J. CARRION</p> <p data-bbox="274 625 727 674"><i>grupoJCARRION</i></p>	

Overall impression of the contested mark

61. The contested mark has a number of elements which contribute to its overall impression. The words “CARRYON” are visible with a device. Although the use of capitals and lower case is a little unusual, it will be plain to the average consumer that the letters represent the words “carry on”. The device itself is striking. The opponent says that it represents the side profile of a lorry; I am rather doubtful that this would be the perception for all average consumers but I accept that some may see the device as a representation of a moving vehicle. In any event, the device is a significant part of the mark into which the words are incorporated. The words and the device are the dominant elements of the mark, both playing a role in the overall impression though the words are slightly more dominant. The colour is bold but not an unusual combination and the stylisation of the letters is not particularly remarkable. These elements play a weaker role.

Comparison with the '891 mark

62. Taking the “J. CARRION” mark first, the mark will be understood as meaning a person’s initial and surname. The overall impression is of that unit, in which neither element is dominant. I recognise that “CARRION” occupies a larger space than the letter “J” but the initial enjoys a position at the start of the mark and is neither negligible nor

immaterial; on the contrary, it plays an important role in the mark, even if the word “CARRION” is more distinctive.

63. In terms of the visual similarity with the contested mark, it is true that both share the letters “CARR” and “ON”. There are, though, significant differences. The identical letters “CARR” are not in the same position in the marks, whilst the earlier mark includes the letter “J”. Additionally, the contested mark has “Y” not “I” as the third to last letter, the words themselves are stylised and they are presented in a significant device element which has no counterpart in the earlier mark. The marks are visually similar to a lower than average degree.

64. The opponent submits that the marks are aurally identical. I disagree. Given that the earlier mark forms a unit of a person’s name, the initial will not be disregarded. My view is that both parts of the earlier mark will be articulated, resulting in a mark of four syllables. “J” will be given its conventional pronunciation. The word “CARRION” will, in my view, be given its usual English pronunciation. Importantly, the final syllable will not be an “ON” sound, with an “o” as in “pot”. Rather, the letters “ION” form a combination vowel sound as in “tier”. I recognise that “CARRION” may, to a Spanish speaker, be pronounced with the final syllable as “ON”. However, the notoriously monolingual UK average consumer is unlikely to adopt such a pronunciation, particularly as the word corresponds to an ordinary English dictionary word. Even those with a knowledge of Spanish are unlikely to pronounce the word in this way in the absence of an accent to indicate that it is meant to be understood as a foreign word. The whole mark will be articulated as “JAY-CA-RI-UHN”. The words are the only part of the contested mark which will be verbalised, “CA-RI-ON”. The marks share two identical syllables but their position in the respective marks is not the same; the final syllable is similar but not identical. They are aurally similar to a medium degree.

65. The earlier mark is most likely to be perceived as a personal name. The later mark will be understood as meaning “continue” or “bring aboard”. They are conceptually dissimilar. The same conclusion would apply if the word “carrion” in the earlier mark were perceived as meaning dead and decaying flesh.

Comparison with the '941 mark

66. The “J. CARRION” element of the mark “GRUPO J. CARRION” will be understood as a person’s name. Although “GRUPO” is a Spanish word, for the reasons given above, the average consumer is likely to understand it as meaning “group”. The overall impression of the mark is of the words as a phrase, meaning the “J. CARRION group”, though the balance of distinctiveness is in the words “J. CARRION”.

67. The marks share the letters “CARR” and “ON”. However, again the contested mark includes a “Y” rather than an “I”. The presence of the word “GRUPO” and the initial “J” in the earlier mark are significant differences and their position at the start of the earlier mark also means that the similarity caused by the shared letters has less visual impact. The device element of the contested mark is also an important difference. These marks have a fairly low degree of visual similarity.

68. My assessment of the pronunciation of the contested mark and of the “J. CARRION” element of the earlier mark is the same as above. There is an additional difference in this comparison because the word “GRUPO” will also be articulated. Of six syllables in the earlier mark, only two from the middle of the mark are shared by the contested mark; the last syllables of the competing marks are not wholly dissimilar. The marks have a low degree of aural similarity.

69. The earlier mark means a group belonging to or operating under the name “J. CARRION”. It is a meaning which is different from that of the contested mark.

Comparison with the '122 mark

70. The overall impression of the stylised “grupoJCARRION” mark is dominated by the words which, despite the absence of spaces and a full stop after the initial, will be read as a complete phrase with no single element dominating, for the same reasons as given for the '941 mark. As there, the more distinctive element is “JCARRION”. The stylisation plays a lesser role.

71. Visually, this mark differs from the contested mark in the inclusion of the string “grupoJ” and in its stylisation, which is contrasted with the different words, device and stylisation of the words in the contested mark. The opponent says that in this mark the letter “J” is indistinguishable and unlikely to be easily noticed by the average consumer. I disagree, though I accept that the conjoining of the words has the effect of drawing less attention to the additional letter. Bearing all of the above in mind, this mark has a low degree of visual similarity with the contested mark.

72. The same reasons and conclusions apply to the aural and conceptual similarity for this mark as for the '941 mark: there is a low degree of aural similarity and the marks are conceptually different.

Likelihood of confusion

73. The opponent submits that the similarity between the “CARRION” and “CARRY ON” elements of the marks, coupled with the distinctiveness of the earlier marks, will lead to direct and/or indirect confusion. Direct confusion is where the consumer simply mistakes one mark for the other. Indirect confusion was explained by Mr Iain Purvis Q.C., as the Appointed Person, in *LA Sugar Limited v Back Beat Inc.*, BL O/375/10 as follows:

“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.”

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

74. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold L.J. pointed out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

75. The opponent submits that Mr Purvis's categories (a) and (c) apply, because the similarities between "CARRION" and "CARRY ON" will lead the average consumer to believe that the contested mark belongs to the opponent or is a brand extension of the earlier marks.

76. The impact of conceptual differences on the likelihood of confusion has been considered a number of times. On the one hand, in *The Picasso Estate v OHIM*, Case C-361/04 P, EU:C:2006:25, the CJEU found that conceptual differences, where at least one mark has a clear meaning, may counteract any visual and aural similarities. On the other hand, in *Nokia Oyj v OHIM*, Case T-460/07, EU:T:2010:18, the General Court held that although there was a "real conceptual difference" between the signs, it did not neutralise the visual and aural similarities.

77. The closest of the earlier marks to the contested mark is the '891 mark. My view is that there are very clear conceptual differences between the respective marks which are sufficient to rule out both direct and indirect confusion even where identical goods or services are concerned. I acknowledge that I have found a medium degree of aural similarity between the '891 mark and the contested mark but the selection method is primarily visual and the conceptual differences will, notwithstanding the aural similarity between the marks, be apparent even in spoken exchanges. I do not think it likely that a substantial number of consumers would be confused, even those paying only a medium degree of attention. The level of both visual and aural similarity is lower for the remaining earlier marks and the conceptual differences remain: confusion is even less likely for the '941 and '122 marks. There is no likelihood of confusion, whether direct or indirect, in respect of any of the earlier marks.

78. The opposition under s. 5(2)(b) is dismissed.

Section 5(3)

79. Section 5(3) states:

“(3) A trade mark which-

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 the repute of the earlier trade mark”.

80. Section 5(3A) states:

“(3A) 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.”

81. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07,

EU:C:2008:655 *Intel*, [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Salomon*, [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L'Oréal v Bellure* [2009] ETMR 55; Case C-323/09, EU:C:2011:604, *Marks and Spencer v Interflora*; and Case C-383/12P, EU:C:2013:741, *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'Oréal 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'Oréal 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'Oréal 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'Oréal v Bellure*).

Reputation

82. In *General Motors*, the CJEU gave the following guidance for the assessment of a trade mark's reputation:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

83. As the earlier trade mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union.”

84. I have already set out much of the evidence filed by the opponent to show its use of the marks. I have accepted Mr Carrion Cáceres’s evidence that the opponent has operated in the UK for over twenty years and longer in Spain. In spite of the length of use and Mr Carrion Cáceres’s evidence that the UK is one of the opponent’s most important European commercial markets, there is no evidence which shows any particular recognition among the relevant UK public of the opponent’s activities. My view is that, even taking the higher invoice figures rather than the stated turnover, the evidence I have already considered is insufficient to establish a reputation.

85. However, the status of the earlier mark as a comparable mark means that use in the EU prior to 31 December 2020 must be taken into account in establishing whether there was a reputation at the relevant date, i.e. 25 January 2022. In this regard, there is a print in evidence from www.statista.com titled “Road freight transport: companies ranked by turnover Spain 2019”.²⁰ A graph shows the opponent had a turnover of €258.54 million and ranked seventh. The exhibit is rather confusing, because it contains a statement that Xpo Transport Solutions Spain SL had the largest turnover in 2019 (€435.5 million) but there is an entry for Marcotran Transportes Internacionales SL which quite clearly outstrips that (€1,725 million). The supplementary notes also say that the data used are from 2016 but this appears to be where “sometimes the ranking includes mixed results from two different years (2016 and 2017)”. Given that the first page of the print is focused on 2019, it seems likely that the explanatory notes are not relevant to the 2019 figures.

86. Although the applicant has challenged the evidence of the opponent’s position in the Spanish market, it has not adduced evidence which shows that the opponent’s 2019 position or its turnover were not as the opponent claims. The opponent’s ranking of seventh in the Spanish market points towards it being known to a significant part of the

²⁰ MCC-6.

Spanish public in 2019. However, the relevant date for the assessment of a reputation is 25 January 2022. A reputation does not disappear overnight but although the 2019 figures are impressive, they represent a single year and there are two clear years between these figures and the relevant date in 2022. 2020 figures for the opponent's European operations would have been taken into account, had they been filed but there are no such figures. The remaining evidence is too thin to demonstrate a reputation absent significant sales figures. I do not consider that any of the earlier marks enjoyed a reputation at the relevant date.

87. In case I am wrong, I will consider the next step of the test, namely whether the relevant public would make the link, on the basis that the opponent had a qualifying but small reputation for transport and distribution services in respect of its '891 mark at the relevant date. The instances of the '122 and '941 marks in the evidence are too infrequent to support any reputation for those marks, absent more precise evidence.

Link

88. Whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors are identified in *Intel* (see paragraph 81(d), above). I have already decided most of these factors and adopt those findings here. For convenience, they are incorporated as relevant below.

The degree of similarity between the conflicting marks

89. There is a lower than average degree of visual similarity, a medium degree of aural similarity and the marks are conceptually different.

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

90. I am proceeding on the assumption that all of the goods and services are identical. The average consumer is a business person or member of the public, paying a medium

to above average level of attention, depending on the particular goods and services, to what is a primarily but not exclusively visual purchase.

The strength of the earlier mark's reputation

91. I am proceeding on the basis that the earlier mark had a small reputation at the relevant date.

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

92. The '891 mark is inherently distinctive to a medium degree and has not acquired any distinctiveness through use in the UK.

Whether there is a likelihood of confusion

93. There is no likelihood of confusion.

94. In addition to the factors considered above, the location of the opponent's reputation is relevant in determining whether the UK relevant public will make the required link. In *Iron & Smith kft v Unilever NV*, Case C-125/14, the CJEU held that:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

95. It is apparent from the court's judgment that "a commercially significant part of the [relevant] public" is intended to cover a lesser but still significant degree of recognition of the EUTM in the Member State where the same or a similar trade mark has been applied for by a third party. It follows that where there is no awareness of the EU trade mark in the UK, or only a negligible level of awareness of it, the relevant UK public will not make the necessary 'link' between the EU mark and the later national mark. Consequently, the use of the national mark will not take unfair advantage of, or be detrimental to, the (EU) reputation and/or the distinctive character of the EU trade mark.

96. The level of turnover evidenced is modest and there is little else in the way of marketing, promotion or press recognition to support a finding that there was a significant, if lesser, degree of recognition of the trade mark in the UK.

97. Taking all of the above factors into account, in particular the lower than average visual similarity between the marks, their conceptual difference and the absence of a commercially significant reputation in the UK, I find that the relevant public would not make the required link. The opposition based upon s. 5(3) is dismissed accordingly.

Overall conclusion

98. The opposition is dismissed. The application will proceed to registration.

Costs

99. The applicant has been successful and is entitled to an award of costs. The applicable scale is found in Tribunal Practice Notice 2/2016. I award costs to the applicant as follows:

Considering the notice of opposition and filing the counterstatement:	£400
Preparing evidence and considering the other party's evidence:	£800
Written submission in lieu:	£500
Total:	£1,700

100. I order Transportes J. Carrion S.A. to pay Yifan Zhang the sum of **£1,700**. 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 25th day of September 2023

Heather Harrison

For the Registrar

The Comptroller-General