

O/0919/26

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
NO. WO0000001824376 IN THE NAME OF BOTE, LLC
FOR THE FOLLWING MARK:**

ZEPPELIN

IN CLASS 12

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600003625 BY
ZEPPELIN TRADING COMPANY LIMITED**

BACKGROUND AND PLEADINGS

1. Bote, LLC (“the applicant”) is the holder of the International Registration shown on the cover page of this decision (“the IR”). The IR was registered on 31 October 2024 and, with effect from the same date, the applicant designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 28 February 2025. Protection is sought for the following goods:

Class 12: Kayak-like boats.

2. On 7 March 2025, the IR was opposed under the fast track procedure by Zeppelin Trading Company Limited (“the opponent”). The opposition is brought under section 5(2)(a) of the Trade Marks Act 1994 (“the Act”) and is reliant upon the following trade mark:

Zeppelin

UK registration no. 3542467

Filing date 9 October 2020; registration date 16 April 2021

Relying on all services, namely:

Class 35: Retail services connected with the sale of vehicle parts.
 (“the opponent’s mark”)

3. The opponent’s position is that the marks at issue are identical and that the goods and services at issue are similar, thereby resulting in a likelihood of confusion.
4. The applicant filed a counterstatement wherein it made no comment as to the claim that the marks are identical but denied that the goods and services at issue were similar.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.
7. The opponent is unrepresented and the applicant is represented by Carpmaels and Ransford LLP. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary and I note that only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

DECISION

Section 5(2)(a): legislation and case law

9. Section 5(2)(a) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

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

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

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

11. The opponent’s mark qualifies as an earlier trade mark under the above provisions. As the opponent’s mark had not completed its registration process more than five years before the date on which the IR was designated for protection in the UK, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on the services for which its mark is registered.

12. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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;

[...]

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

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

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

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

Identity of the marks

13. It is a prerequisite of section 5(2)(a) of the Act that the marks at issue are identical.

In the present case, the applicant has made no comment as to the claim of identity by the opponent. I consider that its silence on this point equates to an acceptance of the claim that the marks are identical. In any event, the marks at issue are 'ZEPPELIN' and 'Zeppelin'. While present in difference cases, I remind myself that when it comes to word only marks, fair and notional use covers use in any standard typeface and in any case.¹ As such, the fact that the marks use different cases is not a point of difference between the marks. Therefore, regardless of whether the applicant's silence is to be taken as a concession or not, the marks are plainly identical.

¹ See *LA Superquímica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17 and *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

Comparison of goods and services

14. The competing goods and services are as follows:

The opponent's services	The applicant's goods
<u>Class 35</u> Retail services connected with the sale of vehicle parts.	<u>Class 12</u> Kayak-like boats

15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, 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.

17. The opponent's position is that it has been selling parts for motor vehicles under the 'Zeppelin' name for nearly 30 years. It is alleged that this operation has included the sale of parts for marine vessels, including boats. While it may be the case that the opponent retails in parts for boats, this does not speak to the similarity of its own services and the applicant's kayaks. As such, I do not consider that the opponent's comments are particularly helpful. That being said, the present assessment is a notional one so I must still consider whether there exists any overlaps in the relevant factors in order to determine whether the goods and services are similar or not.

18. As for the applicant, its position is as follows:

"While in principle retail services connected with a certain good might be considered similar to that exact same good, e.g. retail of clothing and clothing (because many clothing retailers also sell own label products alongside other brands), that principle does not apply here. First, the opponent's retail services relate to the retail of vehicle parts not vehicles. Consumers would not expect the retailer of a spare part for a car engine, for example, to also manufacture the car itself. The retailer of spare parts is a step further removed. Second, the applicant's goods are highly specialised; consumers would expect kayak-like boats to be made by a specialised manufacturer. Even if the opponent's (unsubstantiated and inadmissible) claim about selling parts for marine vessels were true, retail services relating to parts for nautical vessels with engines, and consumers of such services, are entirely different to kayak-like boats, used as

sporting goods for recreational purposes. Consumers would not associate the applicant's goods with a retailer of general spare parts for vehicles."

19. In respect of the applicant's point regarding similarity between goods and retail service, I remind myself of the case of *Oakley, Inc v OHIM*, Case T-116/06 wherein the General Court found that goods and services for the retail of those goods can be similar. It is also worth pointing out that goods and retail services can still be similar even if the goods covered by the services are not the exact same as the actual goods at issue.² That being said, there still needs to be a sufficient overlap between them.

20. The applicant's term is "kayak-like boats" which, to me, covers narrow boats that sit low to the water and are commonly suited for one person, but can be big enough for two people. They are propelled through the water by the user with a paddle. It is my understanding that such boats are commonly used for recreational purposes such as water sports. For the avoidance of doubt, I am of the view that 'kayak-like boats' not only covers kayaks but other similar, self-propelled boats such as canoes, for example.

21. The opponent's term is for the retail of vehicle parts. The type of vehicle covered is not limited in any way meaning that the term can cover any type of part for any type of vehicle, such as windscreen wiper blades for cars, propellers for planes or engine parts for speedboats. While noted, the comparison I am required to make here is with kayak-like boats and the question before me is whether a such goods are considered vehicles. In determining this point, I have considered two separate online dictionaries for the term 'vehicle', I note that it is defined as a '*machine such as a car, bus, or truck which has an engine and is used to carry people from place to place*'³ or a '*machine, usually with wheels and an engine, used for transporting people or goods, especially on land*'.⁴ I appreciate that these definitions do not expressly exclude a vehicle without wheels, meaning that a boat can be considered a vehicle. However, both definitions make reference to a machine, which kayaks

² *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14

³ <https://www.collinsdictionary.com/dictionary/english/vehicle>

⁴ <https://dictionary.cambridge.org/dictionary/english/vehicle>

or other kayak-like boats are clearly not. In short, I do not consider that the average consumer would consider that a kayak (or a similar type boat) was a type of vehicle. As a result, while I accept that the opponent's service covers the retail of parts for boating vehicles, I do not consider that the opponent's service will cover the retail of parts for kayaks or similar type self-propelled boats.

22. In considering the terms at issue, they are clearly different in nature, method of use and purpose. In respect of trade channels, I consider that a kayak or other similar type boat, and their parts, would be sold via recreational or outdoor retailers as opposed to vehicle dealerships or garages (being the type of retailer offering the opponent's services). On this point, I have nothing from the opponent to suggest that kayaks (or similar types of boats) are produced or sold through undertakings that also retail in vehicle parts, generally. Without such, I do not consider it appropriate or reasonable to make such a finding. In respect of user, the user base for the opponent's services is so broad that, inevitably, a user of a kayak (or other kayak-like boats) will also require a part for any type of vehicle, such as their car. While I appreciate that this technically gives rise to an overlap in user, I consider any overlap to be fleeting. Given that the retail of parts for vehicles does not cover parts for kayak-like boats, the goods and services do not share a complementary or competitive relationship. Taking all of this into account, I do not consider that the aforementioned overlap in user is sufficient by itself to give rise to a material finding of similarity. These goods are, therefore, dissimilar.

23. In light of the above, I remind myself that where goods and services are dissimilar under section 5(2) grounds, there can be no likelihood of confusion.⁵ Therefore, regardless of the identity between the marks, the opposition fails at this stage.

CONCLUSION

24. The opposition fails in its entirety and, subject to any successful appeal of my decision, the IR may proceed to protection in the UK.

⁵ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

COSTS

25. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale for fast track proceedings published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £500 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Considering the notice of opposition and preparing a counter statement:	£250
Preparing written submissions in lieu:	£250
Total	£500

26. I therefore order Zeppelin Trading Company Limited to pay Bote, LLC the sum of £500. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 7th day of October 2026

A COOPER

For the Registrar