O/0963/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO.

UK00003765477

BY RHINOMOTIVE L.L.C.

TO REGISTER:

AS A TRADE MARK IN CLASSES

1, 2, 3, 4, 6, 7, 8, 9, 12, 17, 21 AND 37

IN THE MATTER OF OPPOSITIONTHERETO

UNDER NO. OP000436140

BY INDASA-INDUSTRIA DE ABRASIVOS, S.A.

Background and pleadings

1. On 14 March 2022, RHINOMOTIVE L.L.C. ("the applicant") applied to register the trade mark shown below – No. UK00003765477 – and the application was published for opposition purposes on 10 June 2022.

2. The applicant's full specification is set out at Annex A.

3. INDASA-INDUSTRIA DE ABRASIVOS, S.A. ("the opponent") opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against the following of the applicant's goods and services:

Class 3	Abrasive cloth; Abrasive paper; Color-removing preparations; Furbishing preparations; Grinding preparations; Polishing paper; Polishing preparations; Rust removing preparations; Shining preparations [polish]; Cleaning preparations.
Class 7	Adhesive bands for pulleys; Air brushes for applying colour; Atomisers [machines]; Cleaning (Machines and apparatus for —), electric; Cranes [lifting and hoisting apparatus]; Electroplating machines; Housings [parts of machines]; Machine tools; Wrapping machines; Engines, other than for land vehicles.
Class 8	Hand tools and implements (hand-operated); Abrading instruments [hand instruments]; Awls; Belts (Tool-) [holders]; Blades [hand tools]; Crow bars; Cutting tools [hand tools]; Decanting liquids (Implements for-) [hand tools]; Drawing knives;

Edge tools [hand tools]; Emery files; Emery grinding wheels; Extractors (Nail-); Guns [hand tools]; Hammers [hand tools]; Hand pumps; Hand tools, hand-operated; Jacks (Lifting-), hand-operated; Ladles [hand tools]; Nail drawers [hand tools]; Palette knives; Planes; Pliers; Polishing irons [glazing tools]; Saws [hand tools]; Scissors; Scrapers [hand tools]; Screwdrivers; Tongs; Sharpening instruments; Side arms, other than firearms; Spanners [hand tools].

Class 37 Anti-rust treatment for vehicles; Motor vehicle maintenance and repair; Vehicle polishing; Varnishing; Service stations (Vehicle —) [refuelling and maintenance]; Machinery installation, maintenance and repair; Car wash; Painting, interior and exterior; Air conditioning apparatus installation and repair; Information (Repair—).

4. The opposition is based on two earlier marks, with the opponent relying on all the goods for which the respective marks are registered, as detailed below.

UK00914504526[1] ("the opponent's word mark"), filed 25 August 2015, registered 18 April 2016.

RHYNO

Class 3 Sheets, discs and rolls of sandpaper.

Class 7 Sanding and polishing machines with suction systems; Machine tools, motors and engines (except for land vehicles); Coupling

[1] The mark is a "comparable" mark whereby a party who would have relied on a registered EUTM is, instead, able to rely on the comparable UK mark deriving from such rights. UK comparable marks were created automatically on IP Completion Day, with the naming convention for comparable marks derived from EUTMs being that the number is the last 8 digits of the EUTM prefixed with UK009. See Tribunal Practice Note 2 of 2020 for further information.

and transmission components (except for land vehicles); Agricultural implements other than hand-operated; Incubators for eggs; Automatic vending machines.

Class 8 Hand tools and implements (hand operated).

UK00917023052 (“the opponent’s figurative mark”), filed 25 July 2017, registered 26 January 2018.

Class 3 Grinding preparations; Flexible abrasives; Sandpaper in the form of sheets, discs, rolls, strips and belts; Sandpaper; Emery paper; Abrasive strips; Industrial abrasives; Abrasive rolls; Shining preparations [polish].

Class 7 Sanding machines with or without suction systems; Electric sharpeners; Sanding machines; Machine tools; Vacuum cleaners.

Class 17 Gaffer tape; Duct tapes; Masking tape; Adhesive tapes for industrial purposes; Adhesive tapes, for technical purposes; Adhesive anti-slip tape for flooring applications.

5. In its Form TM7 and accompanying statement of grounds, the opponent argues that the applicant’s mark is similar to its marks, and that the contested goods and services are identical or similar.

6. The applicant filed a Form TM8 and counterstatement denying the claims made and putting the opponent to proof of use in respect of its word mark.

7. The opponent filed written submissions in lieu of a hearing, whereas the applicant did not.

8. The opponent filed evidence of use in respect of its word mark.

9. The opponent is represented by Withers & Rogers LLP and the applicant is represented by AA Thornton IP LLP.

10. This decision is taken after careful consideration of the papers.

Evidence

11. The opponent filed a witness statement from Maria Manuel Soares Monge Pinho dos Santos, a member of the board of the opponent, signed and dated 17 February 2023.

12. Along with the witness statement, there are eight exhibits, Exhibit MPS1 to Exhibit MPS8.

DECISION

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

14. Section 5(2)(b) of the Act reads as follows:

"5(2) A trade mark shall not be registered if because –

(a)…

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

15. Given their filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks for the purposes of section 6 of the Act.

Proof of use

16. The opponent's word mark had been registered for more than five years at the filing date of the application and therefore the proof of use provisions apply.

17. The proof of use provisions are set out in section 6A of the Act, the relevant parts of which state:

"(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), (b) 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) 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.

…"

18. Section 100 of the Act is also relevant, which reads:

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

19. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent's word mark is the five-year period ending with applicant's filing date i.e. 15 March 2017 to 14 March 2022.

20. It should be noted that as the opponent's word mark is a comparable mark Tribunal Practice Notice 2 of 2020 applies in that: "Where all or part of the relevant five-year period for genuine use under sections 6A, 46(1)(a) or (b), or 47 falls before IP Completion Day, evidence of use of the corresponding EUTM in the EU in that part of the relevant period before IP Completion Day will be taken into account in determining whether there has been genuine use of the comparable trade mark. For that part of the relevant period, for the purposes of the genuine use assessment, the UK will be taken to include the EU."

21. Consequently, I can take account of evidence of use in the EU up to and including IP Completion Day (31 December 2020).

22. 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 Bundervsvereinigung 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 Merken 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]."

Evidence of use

23. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[2]

24. Founded in Portugal in 1979, the opponent, to quote from Mr Pinho dos Santos' witness statement "specialises in the production of innovative sanding systems which deliver market specific solutions to a wide range of manufacturing and service industries." It expanded its operations to Spain in 1988 and France and the United Kingdom in 1989 and now exports to over 100 countries. Exhibit MPS1, which consists of pages from the company website, expands upon this history.

25. At paragraph 10 of his witness statement, Mr Pinho Dos Santos lists the United Kingdom revenue from "RHYNO branded products" for the years 2014 to 2022. I reproduce below the figures which could fall within the relevant period:

Year	**GBP Revenue**
2017	In excess of 3.9 million
2018	In excess of 4 million
2019	In excess of 4 million
2020	In excess of 3.5 million

[2] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

2021	In excess of 4 million
2022	In excess of 4 million

26. Mr Pinho Dos Santos says, “For reasons of commercial sensitivity, the figures have been approximated. The actual figures are higher than those shown”. It is not possible to say from the figures how much revenue from 2017 and 2022 falls within the relevant period.

27. The revenue, which is not inconsiderable, is an important piece of evidence in my assessment of whether the opponent has shown genuine use of its mark.

28. Mr Pinho Dos Santos acknowledges that as well as products which are named with the word “RHYNO” alone, the opponent also sells “various sub-brands comprising RHYNO in conjunction with additional verbal elements, with the additional verbal elements usually relating to the nature/purpose of the goods. However, the core trade mark RHYNO is used consistently.”

29. This sub-branding approach is apparent in Exhibit MPS2 which features pages from the opponent’s website as well as third party websites. The opponent’s website is set to “global” and English language. The third-party websites are all UK based. Products on view include “Rhynogrip Red Line” abrasive paper, “Rhynostick” backing pads for automated sanding, the “Rhynogrip Dust Extraction Handblock”, and the “Rhyno Mixing Board”. An example product from one of the UK based third party websites is shown below.

(https://bndabrasives.co.uk/indasa rhynogrip-redline-aluminium-oxide-self-grip-discs-150mm-15-hole-p2000-pack-of-50-c38673-1)

★★★★★

Indasa Rhynogrip Redline Aluminium Oxide Self-Grip Discs 150mm Plain / No Hole P2000 - Pack Of 50 (Https://Bndabrasives.Co.Uk/Indasa-Rhynogrip-Redline-Aluminium-Oxide-Self-Grip-Discs-150mm-15-Hole-P2000-Pack-Of-50-C38673-1)

£24.14

30. Mr Pinho Dos Santos concedes that the website pages date from February 2023 but confirms that "the RHYNO trade mark has been used in the same or substantially the same manner in relation to these products during the period March 2017 to March 2022."

31. The opponent's practice of sub-branding is further illustrated by Exhibit MPS3 which consists of a table that breaks down UK net sales by product, in pounds sterling, from 2014 to 2022. Examples of sales within the relevant period are that in 2018 there were net sales of £335,800 for "RHYNOGRIP RED LINE" (abrasive paper) and in 2021 there were net sales of £183,600 for "RHYNOSOFT" (foam backed abrasive sheets). In relation to the precision of the figures offered in evidence, Mr Pinho Dos Santos again states that "the figures have been approximated for reasons of commercial sensitivity, and the actual figures are higher than those shown in Exhibit MPS3."

32. Exhibit MPS4 consists of a sample of invoices sent to addresses across England. Of those that fall within the relevant period, they range in value from £733.44 to £109,226.29, albeit not all of the itemised products are prefixed "Rhyno…".

33. Having cross-checked the website pages against the net sales information and the invoices, I am satisfied that the marks is shown to be in use for a variety of abrasive papers, numerous discs for use with automated sanders, hand-held sanding blocks with or without dust extraction capability, and filler mixing boards.

34. The opponent has supplied evidence of some marketing activity in the relevant period in the form of the production of catalogues and process guides, and attendance at trade shows (Exhibits MPS5 to MPS7). It has also supplied two adverts, one for "RHYNOGRIP ULTRAVENT" and one for "RHYNOLITE ROLLS". However, the first one dates from September 2016, outside the relevant period.

35. The opponent has not supplied any data as to market share.

Use of the mark at issue

36. A typical invoice offered in evidence will list products sold, as per the example below.

Part No.	Description	Quantity	Unit of Measure
C42682	Rhynogrip Plusline Discs 75mm 3H P180	39	Box of 50
C42684	Rhynogrip Plusline Discs 75mm 3 Hole P240	4	Box of 50
C42697	Rhynogrip Filmline Discs 75mm 3H P800	10	Box of 50
C43427	Rhynogrip Plusline Strips 70X198 11 hole P80	120	Box of 50
C43429	Rhynogrip Plusline Strips 70X198 11 hole P120	30	Box of 50
C43431	Rhynogrip Plusline Strips 70X198 11 hole P180	100	Box of 50
C43433	Rhynogrip Plusline Strips 70X198 11 hole P320	100	Box of 50
C43434	Rhynogrip Plusline Strips 70X198 11 hole P400	6	Box of 50
C45667	Rhynogrip Plusline Strips 70 X 127mm 11 hole P80	6	Box of 50
C45671	Rhynogrip Plusline Strips 70 X 127mm 11 hole P180	7	Box of 50
C45697	Rhynogrip Plusline Strips 70 X 420mm 23 hole P180	7	Box of 50
C45910	Indasa Web Handpads Ultra Fine (Grey)	80	Box of 20
C52729	Rhyno X/Z Belts 10x330mm P60	130	Pack of 10
C52734	Rhyno X/Z Belts 20x520mm P60	60	Pack of 10
C53314	Rhynogrip HT line Strips70 X 198mm 11h P180	2	Box of 50
C55371	Rhynogrip HT Line Discs 150mm Ultravent P2000	7	Box of 50
C56209	Rhynogrip HT Line Discs 150mm Ultravent P320	100	Box of 50
C56215	Rhynogrip HT Line Discs 150mmUltravent P1000	60	Box of 50

37. As can be seen from this example, the opponent's word mark is occasionally shown as registered as the first word of a product description. However, it more commonly appears with a suffix such as "GRIP".

38. In respect of the mark being used as a standalone word as the first word of the product description, I consider this to be use of the mark as registered.

39. Where the mark appears with a suffix, these suffixes are descriptive or lowly distinctive in nature and I do not consider them to alter the distinctive character of the mark. This constitutes acceptable variant use. In this regard, I am mindful of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22. Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under section 46(2) of the Act and said at paragraph 16: "Fourthly, the addition of descriptive or suggestive words … is unlikely to change the distinctive character of the mark."

Sufficient use

40. Notwithstanding the figures having been "approximated", the UK revenue is considerable and consistent across the relevant period and is broken down into UK net sales by product. There is also a sample of invoices which show numerous "RHYNO…" products being purchased across England during the relevant period.

41. While the website evidence dates from February 2023, the opponent's claim that its word mark appeared on substantially the same product range during the relevant period is substantiated by the "RHYNO…" products listed in the UK net sales breakdown and on the invoices.

42. While no figures are supplied as to market share, there is some evidence of marketing activity.

43. Looking at the evidence in the round, and having considered all the relevant factors, there has been real commercial exploitation of the opponent's word

mark on the market in accordance with its commercial *raison d'être* in relation to a variety of abrasive papers, numerous discs for use with automated sanders, hand-held sanding blocks with or without dust extraction capability, and filler mixing boards. An outlet has been created and I therefore consider there to be proof of genuine use of the mark for these goods in the relevant period. What I must do now is consider what constitutes a fair specification in the context of the opponent's registered terms and the evidence of genuine use supplied.

Fair specification

44. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, 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."

45. 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:

> "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 Pl*c [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."

46. Mr Pinho Dos Santos claims in his witness statement that the opponent's word mark has been used during the relevant period for "a variety of abrasive, sanding and grinding preparations, backing pads and interface pads for use

with abrasives, hand sanding blocks, sanding blocks with dust extraction, and filler mixing boards".

47. As previously stated, my own analysis of the evidence yields a variety of abrasive papers, numerous discs for use with automated sanders, hand-held sanding blocks, with or without dust extraction capability, and filler mixing boards. On this basis, the opponent can retain its Class 3 goods. However, I consider the opponent's Class 8 term to be too broad and I will modify it so that it is consistent with the opponent only having shown use of hand-held sanding blocks.

48. I have not seen any evidence of use of the mark in relation to the opponent's Class 7 terms.

49. I consider a fair specification for the opponent's word mark to be:

Class 3 Sheets, discs and rolls of sandpaper.

Class 8 Hand-held sanding tools and implements (hand operated).

Comparison of the trade marks

50. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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."

51. 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.

52. The respective marks are shown below.

<table>
<tr><th>Opponent's trade marks</th><th>Applicant's trade mark</th></tr>
<tr><td>RHYNO</td><td rowspan="2"> 
</td></tr>
<tr><td>  </td></tr>
</table>

53. The opponent contends that in respect of its word mark by comparison with the applicant's mark, they are highly similar on the basis that "visually, orally, and conceptually, each mark shares the common element "RHINO", or "RHYNO" as the opponent's word mark is spelt."

54. The opponent further asserts that the word "RHYNO" is the dominant and distinctive part of its mark and that the word "RHINO" in "RHINOMOTIVE" and

the rhino image are the dominant and distinctive parts of the applicant's mark, the word "MOTIVE" being less noticeable and less distinctive. The opponent therefore argues, "By virtue of the common dominant and distinctive elements of RHINO and RHYNO, the marks are highly similar."

55. The opponent asserts that in respect of its figurative mark by comparison with the applicant's mark, the marks are highly similar "by virtue of the similar images of the rhinoceroses. The opponent points out that the animal's horn appears on the right of both images. It contends that "the concept that is brought to mind in respect of both marks is that of a rhino and therefore the marks are conceptually identical."

56. I will now conduct my analysis of the marks.

57. The opponent's word mark is "RHYNO", the only thing that contributes to the overall impression made by the mark. The opponent's figurative mark consists of a photograph of a static rhinoceros with its prominent head slightly inclined in the direction of the camera. The photograph is inside a white box with curved corners. The photograph is the dominant element of the mark, with the shape it inhabits playing a very minor role in forming the overall impression.

58. The applicant's mark is a figurative mark, consisting of a side-on graphic of a charging rhino in black, below which are the conjoined words "RHINOMOTIVE". The word "RHINO" is in bold, and the word "MOTIVE" is in plain text, and the conjoined words are very slightly italicised. The graphic and the conjoined words (neither of the two words being any more dominant than the other) play a roughly equal role in forming the overall impression.

59. Visually, the opponent's word mark consists of the word "RHYNO", spelt with a "Y". The applicant's mark has the conjoined words "RHINOMOTIVE", with the word "RHINO" spelt correctly. The applicant's mark has a graphic of a

rhinoceros, whereas the opponent's word mark is simply a plain word mark. I find the respective marks to be of medium visual similarity.

60. The opponent's figurative mark has a photograph of a rhinoceros, whereas the applicant's mark has a graphic of a rhinoceros. The animals are positioned differently, and one is static, whereas the other one is charging. The applicant's mark also has the conjoined words "RHINOMOTIVE", whereas there are no words in the opponent's figurative mark. Overall, I find the respective marks to be of medium visual similarity.

61. Aurally, the opponent's word mark is pronounced "RY-NO" and the applicant's mark is pronounced "RY-NO-MO-TIV". The marks are of medium aural similarity.

62. It is not possible to articulate the opponent's figurative mark which consists of a photograph inside a box. By contrast, the applicant's mark is pronounced "RY-NO-MO-TIV". The marks are aurally dissimilar.

63. The opponent's word mark consists of the word "RHYNO" which the average consumer would see as misspelt short form of the animal rhinoceros and hence that is the concept that they would derive from the mark. The opponent's figurative mark consists of a photograph of a rhinoceros inside a box which conveys the concept of the animal rhinoceros. The applicant's mark contains a graphic of a rhinoceros, together with the conjoined words "RHINOMOTIVE". The average consumer would see the first word as the short form of "rhinoceros" and hence the concept of the animal rhinoceros would come to mind. The graphic is of a charging rhinoceros, reinforcing the concept of a rhinoceros, but its forward momentum, along with the second word being "MOTIVE", would also give rise to the concept of motion/moving. The respective marks are of medium similarity conceptually.

Distinctive character of the earlier marks

64. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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)."

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

66. The opponent contends that both the earlier marks "enjoy a high level of inherent distinctiveness in respect of the goods covered by the opponent's

registrations. RHYNO or rhinos, the animal, has no connection to the goods and services."

67. I disagree with the opponent about the level of inherent distinctiveness of the earlier marks. The word mark "RHYNO" and the photograph of the rhinoceros in the figurative mark give rise to the concept of a rhinoceros. Neither the word nor the image would be seen as inventions and neither mark is suggestive of the goods and services at issue. I consider the marks to be of medium inherent distinctiveness.

68. The opponent has not pleaded that the distinctive character of its word mark or its figurative mark have been enhanced through use, but given the evidence filed I first consider whether the opponent's word mark has an enhanced degree of distinctive character beyond its inherent distinctive character.

69. The mark is in use in the UK (there being itemised invoices for various addresses across England). The overall revenue and the net sales figures, which are broken down by product, are significant and the opponent attests to the mark having been in use in the UK since at least 1989. As such, although the marketing activity that has been evidenced is modest and I have been given no information as to market share, overall the evidence strikes me as indicative of a level of activity that would lead to the capacity of the mark, measured from the perspective of the average consumer, to more greatly identify the goods for which they have been registered as coming from a particular undertaking, beyond its inherent capability to do so. Whilst I am satisfied that there is evidence of enhanced distinctiveness, there is only a modest degree, which raises the distinctiveness of the mark overall to a slightly higher than medium degree". While I am satisfied that there is evidence of enhanced distinctiveness, there is only a modest degree, which raises the distinctiveness of the mark overall to a slightly higher than medium degree.

70. In respect of the opponent's figurative mark, although it appears on some of the website pages and in the invoice headers, there is no data supplied as to any revenue or net sales data under the mark and I therefore do not consider that the level of distinctiveness for this mark can be raised beyond its inherent level.

Comparison of the goods and services

71. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

> "23. 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."

72. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

73. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

74. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"…the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

75. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-133/05, the General Court ("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."

76. In *Kurt Hesse v OHIM*, Case C-50/15 P, 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 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 the responsibility for those goods lies with the same undertaking."

77. In *Sanco SA v OHIM*, Case T-249/11, 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 Amalia 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."

While on the other hand:

78. "… 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."

79. For reasons that will be more fully explained later in this decision, I do not consider the opponent's figurative mark by comparison with the applicant's mark to give rise to a likelihood of confusion. This is the case even where the respective goods are identical, such as "Sandpaper" under the opponent's figurative mark being *Meric* identical to "Abrasive paper" under the applicant's mark. As such, I will not carry out a full goods and services comparison for these marks.

80. I will only analyse the goods specified for the opponent's word mark and the goods and services specified for the applicant's mark as set out below.

Opponent's goods - word mark	Applicant's goods and services
Class 3 Sheets, discs and rolls of sandpaper.	Class 3 Abrasive cloth; Abrasive paper; Color-removing preparations; Furbishing preparations; Grinding preparations; Polishing paper; Polishing preparations; Rust removing preparations; Shining preparations [polish]; Cleaning preparations.
	Class 7 Adhesive bands for pulleys; Air brushes for applying colour; Atomisers [machines]; Cleaning (Machines and apparatus for —), electric; Cranes [lifting and hoisting apparatus]; Electroplating machines; Housings [parts of machines]; Machine tools; Wrapping machines; Engines, other than for land vehicles.
Class 8 Hand-held sanding tools and implements (hand operated).	Class 8 Hand tools and implements (hand-operated); Abrading instruments [hand instruments]; Awls; Belts (Tool-) [holders]; Blades [hand tools]; Crow bars; Cutting tools [hand tools]; Decanting liquids (Implements for-) [hand tools]; Drawing knives; Edge tools [hand tools]; Emery files; Emery grinding wheels; Extractors (Nail-); Guns [hand tools]; Hammers [hand tools]; Hand pumps; Hand tools, hand-

	operated; Jacks (Lifting-), hand-operated; Ladles [hand tools]; Nail drawers [hand tools]; Palette knives; Planes; Pliers; Polishing irons [glazing tools]; Saws [hand tools]; Scissors; Scrapers [hand tools]; Screwdrivers; Tongs; Sharpening instruments; Side arms, other than firearms; Spanners [hand tools].
	Class 37 Anti-rust treatment for vehicles; Motor vehicle maintenance and repair; Vehicle polishing; Varnishing; Service stations (Vehicle —) [refuelling and maintenance]; Machinery installation, maintenance and repair; Car wash; Painting, interior and exterior; Air conditioning apparatus installation and repair; Information (Repair—).

Class 3

81. "Abrasive paper" is *Meric* identical to the opponent's "Sheets, discs and rolls of sandpaper" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.

82. I compare "Abrasive cloth" to the opponent's "… sandpaper". Both are abrasive in nature and share the same purpose in that they seek to remove layers from a particular item and/or make it smooth. The respective goods will

be sold through the same trade channels. They are not complementary but will be in competition in choosing between abrasive cloth and abrasive paper. I find the respective goods to be highly similar.

83. I compare “Grinding preparations” with the opponent’s “… sandpaper”. The former will be used with grinding equipment to remove layers from an item and/or make it smooth and so its broad purpose is shared with sandpaper. Both will be found in DIY stores. They are not complementary, but they will be in competition as between those who face a choice between grinding or sanding as the best way of removing layers and/or making an item smooth. I find these goods to be of medium similarity.

84. I compare “Rust removing preparations” with the opponent’s “… sandpaper”. They differ in nature as between preparations and paper, but both are used to remove surface layers. Both will be found in DIY stores. They are not complementary, but they would be in competition in respect of rust removal. I find the respective goods to be of medium similarity.

85. I compare “Color-removing preparations” with the opponent’s “… sandpaper”. I take colour-removing preparations to be liquids containing chemicals that break down paint or dye while leaving an item intact. As such, they differ in nature and method of use, but share the broad purpose of altering the appearance of an item. The respective goods will be sold through the same trade channels. However, they are not complementary, nor are they in competition. I find the goods to be of low similarity.

86. I compare “Furbishing preparations”, “Polishing paper”, “Polishing preparations” and “Shining preparations [polish]” with the opponent’s “… sandpaper”. While all the goods improve the appearance of items, the applicant’s goods have the purpose of cleaning, protecting and shining, whereas the opponent’s goods have the purpose of removing layers from a particular item and/or making it smooth. All the goods could be found in a DIY store, but the opponent’s goods could also be found in the cleaning aisle of a

supermarket. The goods are not complementary, nor are they in competition. I find them to be of low similarity.

87. I compare "Cleaning preparations" with the opponent's "… sandpaper". While both goods improve the appearance of items, the applicant's goods have the purpose of cleaning whereas the opponent's goods have the purpose of removing layers from a particular item and/or making it smooth. The applicant's goods will generally be found in supermarkets and the opponent's goods will generally be found in DIY stores, and so the convergence of trade channels is limited. The goods are not complementary, nor are they in competition. I find them to be of low similarity.

Class 7

88. I compare "Machine tools" with the applicant's "hand-held sanding tools and implements (hand operated)". The former goods are mechanical and of large scale, whereas the latter are hand operated. The former goods have a wide range of purposes (which include sanding), whereas the latter are for the specific purpose of sanding. The users will also differ – businesses versus individual members of the public and tradespeople. The trade channels will also diverge in respect of the retailers of machinery that could be used in an industrial setting and generic DIY outlets. The competing goods are not complementary, nor are they in meaningful competition, even when it comes to sanding, because of the differing user groups. I find the respective goods to be of low similarity.

89. With the exception of "Machine tools", the applicant's machinery, cranes, and engines have nothing meaningful in common with the opponent's sandpaper and hand-held sanding tools. They differ in nature, purpose, and method of use. They are also not complementary, nor are they in competition. As such, the applicant's "Adhesive bands for pulleys", "Air brushes for applying colour", "Atomisers [machines]", "Cleaning (Machines and apparatus for —), electric", "Cranes [lifting and hoisting apparatus]", "Electroplating machines", "Housings

[parts of machines]", "Wrapping machines" and "Engines, other than for land vehicles" are dissimilar to the opponent's goods.

Class 8

90. "Hand tools and implements (hand-operated)" and "Hand tools, hand-operated" are *Meric* identical to the opponent's Hand-held sanding tools … (hand operated)" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.

91. "Abrading instruments [hand instruments]" are *Meric* identical to the opponent's "Hand-held sanding … implements (hand operated) in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.

92. I compare "Emery files" and "Emery grinding wheels" with the opponent's "hand-held sanding tools and implements (hand operated)". All are abrasive tools that seek to remove layers from a particular item and/or make it smooth. The respective goods will be sold through the same trade channels. They are not complementary but will be in competition as between filing, grinding, and sanding. I find the respective goods to be highly similar.

93. I compare "Awls", "Blades [hand tools]", "Crow bars", "Cutting tools [hand tools]", "Decanting liquids (Implements for-) [hand tools]", "Drawing knives", "Edge tools [hand tools]", "Extractors (Nail-)", "Guns [hand tools]", "Hammers [hand tools]", "Ladles [hand tools]", "Nail drawers [hand tools]", "Palette knives", "Planes", "Pliers", "Polishing irons [glazing tools]", "Saws [hand tools]", "Scissors", "Scrapers [hand tools]", "Screwdrivers", "Tongs", "Sharpening instruments" and "Spanners [hand tools]" with the opponent's "hand-held sanding tools and implements (hand operated)". All of the applicant's goods are hand tools, albeit with different purposes to the opponent's hand-held sanding tools. They would all be shelved in the same

part of a DIY store or builders' merchants. They are not complementary, nor are they in competition. I find these goods to be of medium similarity.

94. The applicant's "Belts (Tool-) [holders]" are not hand tools *per se*, but they would be shelved with these goods in a DIY store or builders' merchants. The goods would also be complementary in that there is a close connection between them, in the sense that hand tools are indispensable for the use of tools belts in such a way that customers may think the responsibility for those goods lies with the same undertaking. The respective goods are of medium similarity.

95. I compare the applicant's "Hand pumps" and "Jacks (Lifting-), hand-operated" with the opponent's "hand-held sanding tools and implements (hand operated)". While they are hand operated, they differ in nature and purpose and would be found in a separate part of a DIY store or in a motoring retailer. They are not complementary, nor are they in competition. I find them to be of low similarity.

96. "Side arms, other than firearms", being weapons, are dissimilar to the opponent's goods.

Class 37

97. I compare "Painting, interior and exterior" services with the opponent's sandpaper and hand-held sanding tools. The respective services and goods differ in nature, purpose and method of use. The services are intended to save the average consumer the work of painting whereas the opponent's goods would be used a member of the public or tradesperson in preparation for doing a painting job themselves. The trade channels differ in that painting services do not act as outlets for sanding supplies. The services and the goods are not complementary: customers would not think that the responsibility for painting services and sanding supplies would lie with the same undertaking. The services and the goods are not in competition. They are dissimilar.

98. “Anti-rust treatment for vehicles” may also use the opponent’s goods as part of the delivery of the service, but the respective service and goods differ in nature, purpose, and method of use. The service is intended to save the average consumer the work of treating rust themselves whereas the opponent’s goods may be used by a member of the public to do the job themselves. The trade channels differ in that an anti-rust treatment service would not act as an outlet for sanding supplies. The service and the goods are not complementary: customers would not think that the responsibility for an anti-rust treatment service and sanding supplies would lie with the same undertaking. The service and the goods are not in competition. They are dissimilar.

99. I can see no meaningful point of similarity with the rest of the applicant’s services – “Motor vehicle maintenance and repair”, “Vehicle polishing”, “Varnishing”, “Service stations (Vehicle —) [refuelling and maintenance]”, “Machinery installation, maintenance and repair”, “Car wash”, “Air conditioning apparatus installation and repair” and “Information (Repair—)” – and the opponent’s goods. They are dissimilar.

The average consumer and the nature of the purchasing act

100. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *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), Birss J (as he then was) described the average consumer in these terms:

> “60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

101. The goods at issue would typically be purchased by members of the public intent on doing some DIY or by tradespeople. The purchase of such goods would not require a great deal of attention and the costs involved would be generally modest. However, they would be more than an impulse buy and I consider that the level of attention paid during the purchasing process would be medium.

102. Buying the contested goods would be primarily a visual process in that the goods in question could normally be selected from the shelves without the need for verbal enquiries. I do not, however, entirely rule out verbal considerations.

Case law

103. 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:

(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 greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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.

Likelihood of confusion

104. 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. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is 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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

105. By comparison with the goods in the fair specification that I have established for the opponent's word mark, the applicant's goods and services are identical, highly similar, of medium similarity, or of low similarity (except where I have found them to be dissimilar).

106. The respective marks are of medium visual and conceptual similarity. Aurally, the opponent's word mark and the applicant's mark are of medium similarity, while the opponent's figurative mark and the applicant's mark are dissimilar.

107. I have found the earlier marks to be of medium inherent distinctiveness, but in respect of the opponent's word mark found a modest degree of enhanced distinctiveness which raises the distinctiveness of the mark overall to a slightly higher than medium degree.

108. The level of attention paid by the average consumer of the competing goods at issue, a member of the public or tradesperson, would be medium. The purchasing process would be primarily a visual, but verbal considerations are not entirely ruled out.

109. With regard to the opponent's word mark, it is the plain word "RHYNO", whereas the applicant's mark contains the conjoined words "RHINOMOTIVE", together with a graphic of a charging rhinoceros. The average consumer would notice these differences and so there is no likelihood of direct confusion. However, in relation to "RHYNO" and "RHINO…", the opponent's word mark benefits from an enhanced level of distinctiveness, albeit a modest one, and that, combined with the fact that both that word and the first of the conjoined words in the applicant's mark give rise to the identical concept of a rhino, a rhinoceros (as does the rhinoceros graphic in the applicant's mark), make it likely that the average consumer could misremember the spellings of "RHYNO"/"RHINO…". There would then be two rhino-based marks, with the applicant's mark, having "…MOTIVE" as the second of its two conjoined words, forming a plausible sub-brand, perhaps being hand tools for something that moves, like cars, or indicating hand tools that have a moving part themselves. I therefore conclude that there is likelihood of indirect confusion between these marks in respect of the goods that I have found to be identical, highly similar, or of medium similarity, but not those goods that are similar to only a low degree; it

is in my view a step too far to extend the finding to the goods with only a low degree of similarity when the various factors are considered, even bearing in mind the interdependency principle.

110. With regard to the opponent's figurative mark, it has a photograph of a rhinoceros, whereas the applicant's mark has a graphic of a rhinoceros. The animals are also positioned differently: one is static, whereas the other one is charging, one has its head inclined towards the camera, the other one is exactly side on. The applicant's mark also has the conjoined words "RHINOMOTIVE", whereas there are no words in the opponent's figurative mark. The average consumer could not fail to notice these differences, and there is therefore no likelihood of direct confusion. There is also no possibility of indirect confusion because the manner in which the images of the rhinos are rendered is completely different. Anyone seeking brand extension or variation between such marks would ensure that there was some kind of commonality between the images of the rhinos that they were using. The presence of the rhino images would therefore be put down to coincidence rather than to there being an economic connection. These findings apply even where the goods are identical.

CONCLUSION

111. Subject to appeal, the opposition succeeds in respect of the opponent's word mark for the following of the applicant's contested goods:

Class 3 Abrasive cloth; Abrasive paper; Grinding preparations; Rust removing preparations.

Class 8 Hand tools and implements (hand-operated); Abrading instruments [hand instruments]; Awls; Belts (Tool-) [holders]; Blades [hand tools]; Crow bars; Cutting tools [hand tools]; Decanting liquids (Implements for-) [hand tools]; Drawing knives; Edge tools [hand tools]; Emery files; Emery grinding wheels;

Extractors (Nail-); Guns [hand tools]; Hammers [hand tools]; Hand tools, hand-operated; Ladles [hand tools]; Nail drawers [hand tools]; Palette knives; Planes; Pliers; Polishing irons [glazing tools]; Saws [hand tools]; Scissors; Scrapers [hand tools]; Screwdrivers; Tongs; Sharpening instruments; Spanners [hand tools].

112. The opposition fails in respect of the opponent's word mark for the following of the applicant's contested goods and services:

Class 3 Color-removing preparations; Furbishing preparations; Polishing paper; Polishing preparations; Shining preparations [polish]; Cleaning preparations.

Class 7 Adhesive bands for pulleys; Air brushes for applying colour; Atomisers [machines]; Cleaning (Machines and apparatus for —), electric; Cranes [lifting and hoisting apparatus]; Electroplating machines; Housings [parts of machines]; Machine tools; Wrapping machines; Engines, other than for land vehicles.

Class 8 Hand pumps; Jacks (Lifting-), hand-operated; Side arms, other than firearms.

Class 37 Anti-rust treatment for vehicles; Motor vehicle maintenance and repair; Vehicle polishing; Varnishing; Service stations (Vehicle —) [refuelling and maintenance]; Machinery installation, maintenance and repair; Car wash; Painting, interior and exterior; Air conditioning apparatus installation and repair; Information (Repair—).

113. The opposition in respect of the opponent's figurative mark fails in its entirety.

114. Therefore, all the goods and services annexed to this decision, with the exception of the goods listed at paragraph 110, proceed to registration.

COSTS

115. Considering the contested goods and services, the level of success achieved is roughly equal between the parties. As such, each party will bear its own costs.

Dated this 10th day of October 2023

JOHN WILLIAMS
For the Registrar

Annex A

The applicant's full specification:

Class 1 Additives chemical to motor fuel; Adhesives for industrial purposes; Automobile body fillers; Extinguishing compositions (Fire-); Frosting chemicals (Glass-); Glue for industrial purposes; Industrial chemicals; Coolants for vehicle engines; Chemical additives for oils; Detergent additives to petrol [gasoline].

Class 2 Agglutinants for paints; Anti-corrosive preparations; Coatings [paints]; Varnishes; Undercoating for vehicle chassis; Ceramic paints; Dyestuffs; Oils (Anti-rust-); Primers; Thickeners for paints.

Class 3 Abrasive cloth; Abrasive paper; Color-removing preparations; Furbishing preparations; Grinding preparations; Polishing paper; Polishing preparations; Rust removing preparations; Shining preparations [polish]; Cleaning preparations.

Class 4 Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; Additives, non-chemical, to motor-fuel; Belts (Grease for-); Combustible oil; Gas oil; Gas (Producer-); Gas (Solidified-) [fuel]; Paints (Oils for-).

Class 6 Common metals and their alloys; transportable buildings of metal; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; Aluminum; Arbours [structures of metal]; Badges of

metal for vehicles; Bindings of metal; Chromium; Ferrules of metal; Handling pallets of metal; Keys; Knobs of metal; Ladders of metal; Packaging containers of metal; Paint spraying booths, of metal; Pallets of metal (Handling-); Pallets of metal (Loading-); Pegs of metal; Pilings of metal; Rods of metal for brazing and welding.

Class 7 Adhesive bands for pulleys; Air brushes for applying colour; Atomisers [machines]; Cleaning (Machines and apparatus for —), electric; Cranes [lifting and hoisting apparatus]; Electroplating machines; Housings [parts of machines]; Machine tools; Wrapping machines; Engines, other than for land vehicles.

Class 8 Hand tools and implements (hand-operated); Abrading instruments [hand instruments]; Awls; Belts (Tool-) [holders]; Blades [hand tools]; Crow bars; Cutting tools [hand tools]; Decanting liquids (Implements for-) [hand tools]; Drawing knives; Edge tools [hand tools]; Emery files; Emery grinding wheels; Extractors (Nail-); Guns [hand tools]; Hammers [hand tools]; Hand pumps; Hand tools, hand-operated; Jacks (Lifting-), hand-operated; Ladles [hand tools]; Nail drawers [hand tools]; Palette knives; Planes; Pliers; Polishing irons [glazing tools]; Saws [hand tools]; Scissors; Scrapers [hand tools]; Screwdrivers; Tongs; Sharpening instruments; Side arms, other than firearms; Spanners [hand tools].

Class 9 Nautical apparatus and instruments; Clothing for protection against accidents, irradiation and fire; Gloves for protection against accidents; Shoes for protection against accidents, irradiation and fire; Helmets (Protective—); Fire extinguishing apparatus; Computers; Galvanic batteries; Cables, electric; Waling glasses.

Class 12 Vehicles; apparatus for locomotion by land, air or water; Anti-theft alarms for vehicles; Automobile tires [tyres]; Automobiles (Sun-blinds adapted for-); Cleaning trolleys; Covers for vehicles steering wheels; Covers (Seat-) for vehicles; Direction signals for vehicles; Handling carts; Hoods for vehicles; Horns for vehicles; Lifting cars [lift cars]; Pumps (Air-) [vehicle accessories]; Rearview mirrors; Repair outfits for inner tubes; Reversing alarms for vehicles; Seats (Vehicle-); Vehicle bumpers; Windscreen wipers.

Class 17 Anti-dazzle films for windows [tinted films]; Adhesive tapes other than stationery and not for medical or household purposes; Caulking materials; Insulating materials; Insulating refractory materials; Radiation of heat (Compositions to prevent The—); Plastic film other than for wrapping; Artificial resins [semi-finished products]; Insulating paints; Packing [cushioning, stuffing] materials of rubber or plastic.

Class 21 Aerosol dispensers, not for medical purposes; Beaters, non-electric; Bins (Dust—); Boot jacks; Bottle openers; bottles; Brooms; Brushes; Brushes (electric-), except parts of machines; Scrubbing brushes; Buckets; Buckskin for cleaning; Chamois leather for cleaning; Cleaning instruments [hand- operated]; Cleaning (Rags [cloth] for—); Cleaning tow; Closures for pot lids; Cups; Dusting cloths [rags]; Funnels; Glass flasks [containers]; Gloves (Polishing—); Glue-pots; Jugs; Mops wringers; Mops; Pads for cleaning; Spouts; Sprinkling devices.

Class 37 Anti-rust treatment for vehicles; Motor vehicle maintenance and repair; Vehicle polishing; Varnishing; Service stations (Vehicle —) [refuelling and maintenance]; Machinery installation, maintenance and repair; Car wash; Painting, interior and

exterior; Air conditioning apparatus installation and repair; Information (Repair—).