O/0986/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003935478

IN THE NAME OF RETYRE LIMITED

TO REGISTER THE TRADE MARK:

RE-TYRE

RE-TYRE

SERIES OF TWO

IN CLASSES 7, 17, 19 AND 40

AND

AND THE OPPOSITION THERETO

UNDER NO. 444901

BY RETYRE AS

BACKGROUND AND PLEADINGS

1. On 19 July 2023, Retyre Limited ("the applicant") applied to register the series of trade marks shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 27 October 2023 in respect of the following goods and services:

> Class 7: Machines for use in rubber recycling plants; machines used in tyre recycling plants.
> Class 17: Crumb rubber.
> Class 19: Rubber crum for surfacing areas.
> Class 40: Recycling of tyres; recycling of rubber.

2. On 27 December 2023, Retyre AS ("the opponent") opposed the application under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all goods and services in the application. The opponent relies upon the following mark:

> WO0000001599725
> Date of protection of the international registration in UK: 25 May 2023
> International registration date: 12 May 2021
> Designation date: 4 November 2022
> Office of origin : Norway
> Relying on all the goods and services listed in the table in paragraph 13.

3. Neither party filed evidence in these proceedings. In addition, neither party requested a hearing. Both parties filed submissions in lieu of a hearing. The applicant is represented by Maguire Boss; the opponent is represented by Beck Greener LLP. I do not intend to summarise the submissions filed by the parties here, but I will refer to them, where necessary, in the decision. This decision is taken after careful consideration of the papers.

4. 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 (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. This is why this decision continues to make reference to the trade mark case law of the EU courts.

DECISION

Section 5(1)

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

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

Section 5(2)

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

> "5(2) A trade mark shall not be registered if because –
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the trade mark is protected, or
>
> (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."

7. Due to its earlier filing date, the relied upon mark constitutes an earlier mark within the meaning of section 6 of the Act. As the opponent's registration had not completed its registration process more than five years before the filing date of the application, it is not

subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all the goods and services they have identified under the earlier right without having to demonstrate use.

My approach

8. I will begin the substance of my decision by first considering whether the opponent's first mark and the applicant's mark are identical. I do so because it is a prerequisite of both sections 5(1) and 5(2)(a) that the marks be identical. If they are deemed to be identical then both grounds will proceed, and I will move to consider the comparison of the services. However, if they are not deemed identical then the grounds will fall away, and I will then proceed to consider the section 5(2)(b) ground only.

CLAIM UNDER SECTIONS 5(1) AND 5(2)(A)

COMPARISON OF THE MARKS

EARLIER RIGHT	APPLICATION
	 (series of two)

9. In S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA, Case C-291/00, the Court of Justice of the European Union ("CJEU") held that:

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

10. The effect of the above case law is that, technically, marks do not have to be presented in exactly the same way in order for them to be deemed identical. For example, use of the same word in an alternative stylisation (even if it is not covered by notional and fair

use) may still be sufficient to give rise to a finding of identity. Had any of the marks been a word only mark, there is a possibility that it would have been capable of being presented in an alternative typeface. However, this will not extend to cover the stylistic differences in these particular marks.

11. The earlier mark and the contested series of marks are not word only marks, rather, they both consist of the text 'RETYRE'/'RE-TYRE' with additional stylisation elements and hyphen. In the present case, I am of the view that when taking the marks as wholes, the culmination of the various points of difference are such that the consumer will notice them. Therefore, I do not consider that the marks are identical, meaning that the opponent's section 5(1) and 5(2)(a) grounds fail at the first hurdle. I will now proceed to consider the section 5(2)(b) ground, beginning with a comparison of the services.

CLAIM UNDER SECTION 5(2)(B)

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

COMPARISON OF THE GOODS AND SERVICES

13. The goods and services to be compared are as follows:

Opponent's goods and services	**Applicant's goods and services**

Class 12: Tyres; inner tubes for pneumatic tyres; casings for pneumatic tires [tyres]; treads for retreading tyres; spikes for tyres; solid tyres for vehicle wheels; pneumatic tyres; bicycle tyres; tubeless tyres for bicycles; automobile tyres; tyres for land vehicles; tyres for wheelchairs; tyres for motorcycles; tyres for strollers; valves for vehicle tyres; adhesive rubber patches for repairing inner tubes; patch set for tyres; non-skid devices for vehicle tyres; non-slip covers for tyres; pumps for bicycle tyres; air pumps [vehicle accessories]. Class 35: Retail and wholesale services, in stores and online, related to tyres, inner tubes for pneumatic tyres, casings for pneumatic tires [tyres], treads for retreading tyres, spikes for tyres, solid tyres for vehicle wheels, pneumatic tyres, bicycle tyres, tubeless tyres for bicycles, automobile tyres, tyres for land vehicles, tyres for wheelchairs, tyres for motorcycles, tyres for strollers, valves for vehicle tyres, adhesive rubber patches for repairing inner tubes, patch set for tyres, non-skid devices for vehicle tyres, non-slip covers for tyres, pumps for bicycle tyres, air pumps [vehicle accessories]. Class 40:Custom manufacture for others of tyres, inner tubes for pneumatic tyres, casings for pneumatic tires [tyres], treads for retreading tyres, spikes for tyres, solid tyres for vehicle wheels, pneumatic tyres, bicycle tyres, tubeless tyres for bicycles, automobile tyres, tyres for land vehicles, tyres for	Class 7: Machines for use in rubber recycling plants; machines used in tyre recycling plants. Class 17: Crumb rubber. Class 19: Rubber crum for surfacing areas. Class 40: Recycling of tyres; recycling of rubber.

wheelchairs, tyres for motorcycles, tyres for strollers, valves for vehicle tyres, adhesive rubber patches for repairing inner tubes, patch set for tyres, non-skid devices for vehicle tyres, non-slip covers for tyres, pumps for bicycle tyres, air pumps [vehicle accessories]. Class 42: Design and development of tyres, inner tubes for pneumatic tyres, casings for pneumatic tires [tyres], treads for retreading tyres, spikes for tyres, solid tyres for vehicle wheels, pneumatic tyres, bicycle tyres, tubeless tyres for bicycles, automobile tyres, tyres for land vehicles, tyres for wheelchairs, tyres for motorcycles, tyres for strollers, valves for vehicle tyres, adhesive rubber patches for repairing inner tubes, patch set for tyres, non-skid devices for vehicle tyres, non-slip covers for tyres, pumps for bicycle tyres, air pumps [vehicle accessories].	

14. 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."

15. 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.

16. 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 General Court ("GC") stated that "complementary" means:

> "82. ...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility

17. While the opponent has made some specific comparisons between certain goods and services, it has also made more generalised comparisons. In such circumstances, I remind myself of the case of *Abus August Bremicket Sohne KG v Muhammad Ali* (O/0911/24) wherein Mr Iain Purvis K.C., sitting as the Appointed Person, found that:

> "28. […] it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identicality). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. [This] approach […] would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have

had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent."

18. Therefore, where the opponent has provided comparisons between specific goods and services, I will compare those goods and services. However, where specific comparators have not been identified, , I will proceed by only comparing goods and services that I consider offer the best prospect of a finding of similarity, rather than comparing each of the earlier terms with each of the applied-for terms.

Class 7

Machines for use in rubber recycling plants; machines used in tyre recycling plants.

19. The opponent submits that the applicant's term *"machines for use in rubber recycling plants"* includes machines that are used for tyre recycling – I agree. The opponent submits that the applicant's class 7 goods are similar to its class 12 goods, particularly *"tyres";* more specifically the opponent submits that the goods are complementary to one another in that tyres are necessary for tyre recycling and that a finding of complementarity is sufficient for a finding of similarity.

20. Firstly, I agree with the opponent that, as outlined above in the case of *Kurt Husse*, complementarity alone can be sufficient for a finding similarity. However, I do not consider that the goods at issue are complementary. Whilst I acknowledge that tyres would be important and/or indispensable to the applicant's goods, in order to find that those goods are complementary, and therefore can be regarded as similar, the goods must be important and/or indispensable in such a way that consumers may think that the responsibility for those goods lies with the same undertaking – if they would not, then there cannot be a finding of similarity on the basis of complementarity alone.

21. It is therefore my view that they are not complementary in the same way that wine glasses are not complementary to wine.[1] This is because consumers will not reasonably believe that they derive from the same undertaking. Rather, I am of the view that the average consumer will consider that tyre recycling machines (and rubber recycling machines) are produced by a company that specialises in the creation of recycling machines; and that tyres are produced by a specialist tyre manufacturer. In addition, I consider that the users, methods

[1] *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13

of use, purposes and nature of the goods will differ. Also, the goods are not in competition. Therefore, I find these goods to be dissimilar.

Class 17

Crumb rubber

22. The opponent outlines that crumb rubber is a *"granulated rubber produced in the process of recycling automotive tyres."* The opponent submits that, as crumb rubber is made from tyres, and can also be used to produce tyres, there is a complementary relationship between the goods. Whilst I recognise the relationship between the goods, I do not consider the goods to be complementary. This is because I do not consider that consumers will reasonably believe that the goods derive from the same undertaking. Rather, I am of the view that the average consumer will likely consider that crumb rubber will be produced by a company that recycles materials, and that tyres are produced by a specialist tyre manufacturer. As such, I do not consider that the goods are complementary.

23. Further, I do not consider that there is an overlap in trade channels, as it is my view that crumb rubber will most likely be sold by building and construction suppliers for use in construction; or by suppliers of raw materials to manufacturers of goods made of rubber – whereas tyres will be sold by mechanics and tyre retailers. In addition, I do not consider that there is an overlap in the nature, purpose, method of use, or users of the goods. Taking the above into account, I consider the goods to be dissimilar.

Class 19

Rubber crumb for surfacing areas.

24. Similarly to the comparison above, the opponent submits that the applicant's goods are also produced by recycling tyres, and, therefore, these goods are similar to tyres in class 12 of its specification. I do not consider that there is an overlap in users, method of use, purpose and nature of the goods at issue. Further, I do not consider that there will be an overlap in trade channels. It is my view that rubber crumb for surfacing will be sold by a construction/building retailers, whereas tyres will be sold by specialist tyre stores or mechanics. I do not consider that the goods are in competition. I recognise that tyres are used to create crumb rubber, and that crumb rubber may potentially be reused to create tyres, however, it is my view that the goods are not complementary, this is because it is unlikely that

consumers will believe that they originate from the same undertaking. Therefore, I find the goods to be dissimilar.

Class 40

Recycling of tyres

25. The opponent submits that the services in class 40 of the application are identical and *"if not identical then they are virtually so"* to class 40 in its specification. In particular, the opponent submits that *"the class 40 services of the registration include "custom manufacture for others of tyres, and of treads for tyres" and such services can therefore be achieved by, for instance, "recycling of tyres and recycling of rubber [tyres].""* The opponent then goes on to state *"that the above is not intended to be a complete account of the points of identity and similarity between the goods and services and should not be taken as such but identify in each case significant points of similarity."* It is not entirely clear to me what the opponent is trying to submit here, however, I interpret this to mean that they do not see the above submission as identifying all the points of similarity/identity between the goods and services.

26. I have already outlined my approach to the comparison, taking into account *Abus August Bremicket Sohne KG v Muhammad Ali.* Accordingly, I will carry out my comparison using the particular services provided by the opponent, being *"custom manufacture for others of tyres, and of treads for tyres."*

27. I am of the view that the method of use, nature, purpose and users of the services will differ. In addition, I consider that the trade channels will differ, as tyre recycling services will be provided by a specialist recycling service and custom tyre manufacturing will likely be provided by a car/ tyre customisation company. The services are not in competition; and I do not consider that there is any complementarity between them either – this is because it is unlikely that consumers will believe that they originate from the same undertaking. Therefore, I find these goods to be dissimilar. For completeness, although it is not my responsibility to identify alternative comparators,[2] I do not consider any other term in the opponent's specification would have put the opponent in a better position.

28. Whilst I recognise that the applicant's service "*recycling of rubber"* is wider than "*recycling of tyres",* it nonetheless encompasses the recycling of tyres. I consider that the comparison I have made above equally applies to the recycling of rubber, and find the services to be dissimilar.

[2] *Abus August Bremicket Sohne KG v Muhammad Ali*

29. A level of similarity is required between the competing goods and services for there to be a likelihood of confusion under section 5(2)(b) of the Act.[3] My findings are that no such similarity exists, therefore, there can be no likelihood of confusion, the ground of opposition under section 5(2)(b) therefore also fails.

CONCLUSION

30. The opposition fails under sections 5(1), 5(2)(a) and 5(2)(b) of the Act. Trade mark application number 3935478, subject to any appeal, will proceed to registration for all the applied-for goods and services, namely:

> Class 7: Machines for use in rubber recycling plants; machines used in tyre recycling plants.
> Class 17: Crumb rubber.
> Class 19: Rubber crum for surfacing areas.
> Class 40: Recycling of tyres; recycling of rubber.

COSTS

31. The applicant has been successful in these proceedings and is entitled to an award of costs. The applicant's costs will be awarded based on the scale published in Tribunal Practice Notice 1/2023, as the proceedings commenced after 1 February 2023. The sum is calculated as follows:

Preparing a statement and considering the other side's statement	£250
Preparing submissions-in-lieu and considering the other side's submissions	£350
TOTAL	**£600**

32. I therefore order Retyre AS to pay Retyre Limited the sum of £600. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 22nd day of October 2025

A Klass
For the Registrar

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