

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2317114
BY EMERALD GLOBAL LIMITED
TO REGISTER THE TRADE MARK**



IN CLASSES 9, 16, 36, 39 & 43

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 91668
BY ENTERPRISE RENT-A-CAR**

BACKGROUND

1) On 29 November 2002, Joe Wong applied under the Trade Marks Act 1994 for registration of the following trade mark:



The applicant claims the colour green as an element of the mark.

2) In respect of the following goods and services:

In Class 9: CD Roms, videos.

In Class 16: Holiday brochures.

In Class 36: Travel insurance.

In Class 39: Travel agency services for arranging holidays.

In Class 43: Travel agency services for arranging accommodation.

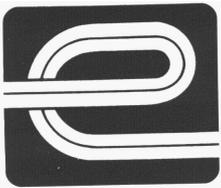
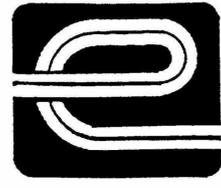
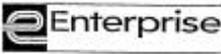
3) On 12 June 2003 the mark was assigned to Emerald Global Limited.

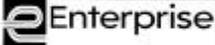
4) On 7 May 2003 Enterprise Rent-A-Car of 600 Corporate Park Drive, St. Louis, Missouri, 63105, United States of America filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of the Community Trade Marks and UK Trade Marks detailed below.

b) The opponent contends that the goods and services included in the applicant's specification are similar to those for which its marks are registered. In the alternative, the goods are not similar but use of the mark would take unfair advantage of or be detrimental to the distinctive character or the repute of the opponent's marks. The opponent contends that its marks have acquired goodwill and reputation in the UK. Therefore, the application offends against Sections 5(2)(b), 5(3), 5(4)(a) and 56 of the Trade Marks Act 1994.

c) Because of the use made by the opponent in the UK of the colour green as a trade mark and in respect of its trade dress since at least as early as 1994, the opponent has acquired reputation in the colour green in respect of its business which is protectable in the UK by virtue of the law of passing off. The mark in suit therefore offends against Section 5(4)(a) and Section 56 of the Trade Marks Act 1994.

Trade Mark	Number	Effective Date	Class	Specification
 Colour claimed: Green	CTM 36335	01.04.96	12	Land vehicles; vehicles, automobiles and apparatus for locomotion on land; parts and fittings for all the aforesaid goods.
			36	Insurance, financial and financing services; financial valuations; all the aforesaid relating to vehicles; vehicle financing services; vehicle lease and lease-purchase financing.
			39	Vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle rental and leasing, and reservation services for vehicle rental and/or leasing.
	CTM 36343	20.11.95	12	Land vehicles; vehicles, automobiles and apparatus for locomotion on land; parts and fittings for all the aforesaid goods.
			36	Insurance; financial and financing services; financial valuations; all the aforesaid relating to vehicles; vehicle financing services; vehicle lease and lease-purchase financing.
			39	Vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle rental and leasing, and reservation services for vehicle rental and/or leasing.
 Colour claimed: Green	CTM 36541	16.10.95	12	Land vehicles; vehicles, automobiles and apparatus for locomotion on land; parts and fittings for all the aforesaid goods.
			36	Insurance; financial and financing services; financial valuations; all the aforesaid relating to vehicles; vehicle financing services; vehicle lease and lease-purchase financing.
			39	Vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle rental and leasing, and reservation services for vehicle rental and/or leasing.
	CTM 36574	02.10.95	12	Land vehicles; vehicles, automobiles and apparatus for locomotion on land; parts and fittings for all the aforesaid goods.
			36	Insurance, financial and financing services; financial valuations; all the aforesaid relating to vehicles; vehicle financing services; vehicle lease and lease-purchase financing.
			39	Vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle rental and leasing, and reservation services for vehicle rental and/or leasing.
	CTM 509976	15.10.96	39	Vehicle rental services; vehicle rental and arranging for vehicle rental services; provision of information and/or advice and/or consultancy services in respect of the foregoing.

 Registration of this mark shall give no right to the exclusive use of a letter "E".	UK 1545521	19.08.93	12	Land vehicles; apparatus for locomotion by land; parts and fittings for all the aforesaid; all included in Class 12.
	UK 2033136	09.09.95	12	Vehicles; apparatus for locomotion by land; parts and fittings for all the aforesaid.
			35	Advertising, business and/or management services relating to vehicles; fleet management services; information and/or advisory services relating to the aforesaid.
			37	Vehicle maintenance services; vehicle repair services; rental, loan and/or hire of equipment relating to the aforesaid; information and/or advisory services relating to the aforesaid.
			39	Vehicle rental services, vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle leasing and rental services and reservation services for the rental and leasing of vehicles; information and/or advisory services relating to the aforesaid.
	UK 2033436	13.09.95	12	Land vehicles; apparatus for locomotion by land; parts and fittings for all the aforesaid.
			39	Vehicle rental services, vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle leasing and rental services and reservation services for the rental and leasing of vehicles; all the foregoing relating to land vehicles; information and/or advisory services relating to the aforesaid.
  The first mark in the series is limited to the colours green, black and white as shown on the form of representation.	UK 2035279	19.09.95	12	Land vehicles; apparatus for locomotion by land; parts and fittings for all the aforesaid.
			39	Vehicle rental services, vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle leasing and rental services and reservation services for the rental and leasing of vehicles; information and/or advisory services relating to the aforesaid.
 Registration of this mark shall give no right to the exclusive use of a letter "E".	UK 1544987	14.08.93	39	Vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; all included in Class 39.

	UK 2129548	15.10.96	39	Vehicle rental services; vehicle rental and arranging for vehicle rental services; provision of information and/or advice and/or consultancy services in respect of the foregoing.
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5) The applicant subsequently filed a counterstatement denying the opponent's claims.

6) Both sides filed evidence and ask for an award of costs. The matter came to be heard on 23 March 2005 when the applicant was represented by Ms Fong of Messrs Rouse & Co. The opponent was represented by Mr Grimshaw of Messrs Mewburn Ellis.

OPPONENT'S EVIDENCE

7) The opponent filed six witness statements. Four of these, dated 14 November 2003, 13 February 2004, 14 April 2004 and 28 April 2004, are by Roger Grimshaw the opponent's Trade Mark Attorney. He states that the opponent has made substantial use of the "e" logo mark in the UK on a continuous basis since 1994 in relation to the "provision of vehicle related services and goods, including vehicle hire services which included the arranging/provision of insurance".

8) He provides combined turnover figures for the UK in relation to, inter alia, the hiring and sale of vehicles, the provision of insurance and financial services relating to vehicles and vehicle fleet management services all under the "e" logo mark which are as follows:

Year	Turnover £ million	Promotion £ million
F/Y ending 96	9.8	0.5
F/Y ending 97	31.2	1.4
F/Y ending 98	60.3	1.2
F/Y ending 99	122.6	1.3

9) Mr Grimshaw states that the promotional activity has included business cards, flyers, invoices, stationery, vehicle stickers, pens, rulers and sweet containers. They have also advertised in Yellow Pages using trade mark UK 2033436. At exhibit RSG3 he provides copies of print outs from the opponent's website dated March 2000 which show use of the "e" logo in relation to car sales, fleet services, and car rental. He states that the internet site was available from January 1998. At exhibit RSG5 he provides copies of invoices, stationery and promotional items such as a key ring and stickers that all feature the "e" logo. At exhibit RSG6 he provides maps which show the number of locations of offices throughout England in 1997 and the UK in 2000 both of which show a substantial number of trading premises.

10) Mr Grimshaw states that the opponent has made substantial use of trade mark 2317114 ("e" logo) which I note was not included in the pleadings. He states that the opponent's "use of the colour green in their trade marks has enabled them to develop a substantial reputation in this colour". He states that the colour has been used on stationery and promotional items. At exhibit RSG7 he provides various items of literature which feature a variety of the opponent's trade marks some of which feature the colour green and most of the brochures and leaflets have a green trim around the

edge. A number of the items have hand written dates all of which are prior to the relevant date. None of those with printed dates are prior to the relevant date.

11) Mr Grimshaw states that the opponent purchases a large number of cars each year and that each car has an “e” logo sticker applied to it. The estimated number of cars purchased is as follows:

Financial year	Estimated number of cars purchased
Aug-July 1997	4,800
Aug-July 1998	8,000
Aug-July 1999	16,700
Aug-July 2000	22,375
Aug-July 2001	26,100

12) Mr Grimshaw also provides photographs, at exhibit RSG9, of some of the opponent’s outlets in the UK which show prominent use of the “e” logo on the outside of the building. He also provides details showing that car rental is available through travel agents both abroad and in the UK.

13) The fifth witness statement, dated 24 march 2004, is by Lee Kaplan the Senior Vice President and Chief Administrative Officer of the opponent company. He states that his company has made substantial use of a family of marks in the UK, all containing an “e” logo, prior to the date of the application. He states that the use began in 1994 in relation to the provision of vehicle related services and goods, including vehicle hire services which includes the arranging/provision of insurance for their customers. He states that the approximate annual turnover in the UK as at 1999 was £60million. Other vehicle related services such as towing, breakdown and recovery services have pushed up the annual turnover to in excess of £90million for each of the years 2000-2003. He also states that sales of vehicles and parts and fittings under the “e” logo in the UK average in excess of £60million for each of the years 2000-2003. He also states that in excess of £600,000 has been spent for each of the years 2000-2003 on promoting these vehicle-based services.

14) Mr Kaplan states that the opponent uses its “e” logo mark elsewhere in the world and so UK tourists may have encountered the mark whilst visiting other countries. Worldwide turnover is said to be over £2billion for each of the years 2000-2003, with worldwide advertising averaging over £32million per annum since 1998. The promotion of the “e” logo has been via Yellow Pages, the Internet and stickers on cars as well as courtesy pens, pencils etc. Mr Kaplan states that all the promotions relate to the vehicle related services provided by the opponent. He provides evidence of the outlets for these activities which show that the opponent has a presence throughout the UK.

15) The sixth witness statement, dated 28 April 2004, is by Daryl Scales an Assistant Vice President of Enterprise Rent-A-Car (UK) Ltd a wholly owned subsidiary of the opponent. He confirms that the opponent has advertised using it’s “e” logo in Yellow Pages and also in national newspapers such as the Daily Mail, Daily Mirror, Daily Express and The Times. He provides details of Yellow Pages Advertisements at exhibit DS1 for 2000-2001. At exhibit DS2 he provides a copy of the newspaper advertisement and details of publication for the period January-May 2002.

16) At exhibit DS3 he provides an example of his company's literature which shows use of an amalgam of trade marks CTM 509976, UK 2055279 and UK 2129548, all of which have the "e" logo. At exhibit DS4 he provides examples of the "e" logo stickers placed in rental vehicles.

17) Mr Scales states that his company provides replacement vehicles to customers of insurance companies whilst the customers' cars are being repaired. He provides examples of advertisements aimed at the insurance companies. He also states that his company, has since 1996, offered car hire services through the website of the online travel agent Travelocity.

APPLICANT'S EVIDENCE

18) The applicant filed a witness statement, dated 20 August 2004, by Gabriel Ng Wong the Managing Director of the applicant company. He states his company is a travel consultancy business which offers air travel, hotel booking, passport and visa procurement services, car hire, rail tickets, conference and group travel and consultative and advisory services. Regarding car hire he states that his company merely serves as a conduit and the actual provision of the car is carried out by companies such as Hertz, Avis and Budget. He states that it is made clear to clients exactly who is providing the car rental services. At exhibit GNW1 he provides copies of invoices provided to travellers which show the name of the relevant car rental company, and also pages from brochures which clearly identify the car rental company in each location. These items are dated after the relevant date.

19) Mr Wong provides details of the history of his company, its turnover, marketing and promotion and reasons for choosing the colour green and other aspects of the mark in suit. He also provides his views on the similarities of the goods/services and the marks of both parties. However, I do not find these comments to be of assistance.

OPPONENT'S EVIDENCE IN REPLY

20) The opponent filed another witness statement, dated 23 November 2004, by Mr Grimshaw. Mr Grimshaw points out that in some of the evidence of brochures provided by the applicant it is not stated clearly who is providing the car rental. He also comments on the evidence provided by the applicant which I do not find of assistance in reaching my decision.

21) That concludes my review of the evidence. I now turn to the decision.

DECISION

22) At the hearing, as a preliminary point, the opponent requested leave to amend their pleading under Section 5(3) to include goods and services which are similar or identical to those for which the earlier trade marks are registered. The applicant did not object to this amendment and so I allowed the pleading to be amended.

23) The opponent also withdrew its opposition with regard to the goods in Classes 9 and 16.

24) I shall deal firstly with the ground of opposition under Section 5(2)(b) which reads:

“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,

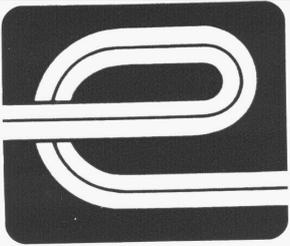
there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

25) An “earlier trade mark” is defined in Section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

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

27) The opponent is relying on five Community Trade Mark Registrations and six UK Trade Mark Registrations which are detailed in paragraph 4 above. All these marks are plainly “earlier trade marks”. At the hearing the opponent identified CTM 36335 as its strongest mark and agreed that if it could not succeed with regards to this mark (on any of the grounds of opposition) then it would not succeed with any of its other marks. For ease of reference I reproduce mark CTM 36335 below and henceforth any references to the opponent’s mark should be viewed as relating to this mark:

Trade Mark	Effective Date	Class	Specification
 <p>Colour claimed: Green</p>	01.04.96	12	Land vehicles; vehicles, automobiles and apparatus for locomotion on land; parts and fittings for all the aforesaid goods.
		36	Insurance, financial and financing services; financial valuations; all the aforesaid relating to vehicles; vehicle financing services; vehicle lease and lease-purchase financing.
		39	Vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle rental and leasing, and reservation services for vehicle rental and/or leasing.

28) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd*

Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V. [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* ;
- (b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG*;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG*;
- (h) further, 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; *Marca Mode CV v Adidas AG*;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.*.

29) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's mark on the basis of their inherent characteristics assuming

normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

30) The opponent's mark consists of a stylised letter "e". Whilst a single letter mark is usually considered to have a low degree of inherent distinctiveness, where there is a considerable degree of stylisation this view can change. In the instant case the opponent's mark has a considerable degree of stylisation, indeed the applicant even contended that it was not a letter mark but a representation of a Scalextric track. I do not accept this contention and believe that most consumers will view the mark as a highly stylised letter "e". The letter "e" does not appear to be descriptive for the goods and services registered under this mark and so I believe that the opponent's mark is inherently distinctive.

31) I must also consider the use of the mark and consider whether the mark has acquired distinctiveness as a result of this use. The opponent has shown considerable use of its mark albeit often as part of its other marks and in particular alongside the word "enterprise". The use has been on vehicle hire and sales as well as services connected with vehicle hire and sales such as insurance, finance and parts and fittings. Combined figures for the UK in relation to all these activities have been provided which show between 1996 and 1999 inclusive the opponent's turnover averaged £55 million, rising from a very low beginning and ending at £122 million. These figures include the purchase and sale of some 16,000 cars in 1999, which had risen to over 26,000 cars in 2001. I take judicial note that the market for new cars in the UK at this time was approximately 2 million units per annum. The market in vehicle finance and insurance would also be in the £billions. However, the opponent provided no evidence of market share or the extent of the market for each aspect of its business. In the absence of such evidence I cannot infer that the opponent has a great reputation under any of its marks or in any particular aspect of its business.

32) The opponent also claimed that it has reputation in the colour green. Whilst this colour is a part of the trade mark it is not clear whether the average consumer would view the colour green solus as the trade mark of the opponent. No evidence to support this supposition has been provided and in its absence the opponent cannot be regarded as having a reputation in the colour green.

33) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

"The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the

market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

34) I now turn to the comparison of the specifications of the two parties and I look to the factors set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

- a) the uses of the respective goods or services;
- b) the users of the respective goods or services;
- c) the physical nature of the goods or services;
- d) the 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 on the same or different shelves; and
- f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

35) These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“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 end users and their method of use and whether they are in competition with each other or are complementary.”

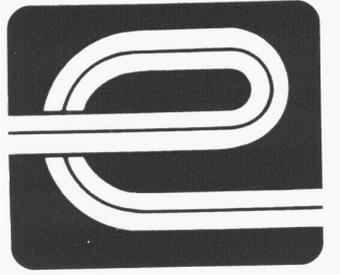
36) For ease of reference the specifications of the two parties are reproduced below:

Applicant's specification	Opponent's specification
In Class 36: Travel insurance.	In Class 12: Land vehicles; vehicles, automobiles and apparatus for locomotion on land; parts and fittings for all the aforesaid goods.
In Class 39: Travel agency services for	In Class 36: Insurance, financial and financing services; financial valuations; all the aforesaid relating to vehicles;

arranging holidays.	vehicle financing services; vehicle lease and lease-purchase financing.
In Class 43: Travel agency services for arranging accommodation.	In Class 39: Vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle rental and leasing, and reservation services for vehicle rental and/or leasing.

37) Clearly, the opponent’s specification of “Insurance” in Class 36 encompasses the applicant’s Class 36 specification of “travel insurance” and must be considered identical. The opponent contended that the applicant’s services in Classes 39 and 43 both involve the booking of hire cars and as such are in competition with the opponent’s services and also complementary. I accept that it has been shown that travel agencies offer car hire as part of their services offered to consumers and there is therefore a degree of similarity between the services of the opponent in Class 39 and the applicant’s services in Classes 39 and 43.

38) I now turn to consider the marks of the two parties. These are reproduced below for ease of reference:

Applicant’s mark	Opponent’s mark
 <p>The applicant claims the colour green as an element of the mark.</p>	 <p>Colour claimed: Green</p>

39) Earlier in this decision I accepted that the average consumer would view the opponent’s mark as a highly stylised letter “e”. The mark is unusual in that the beginning and end of the letter are outside the black background or frame. The degree of stylisation even led the applicant to suggest that the mark would be seen as a Scalextric track. I do not accept this contention as the mark would have required two lines running through it and also for the “ends” of the “track” to join. I believe that most consumers would endeavour to make sense of the mark and would therefore come to view the mark as a strange letter “e”. The applicant’s mark also has a very stylised letter “e” although this is far more readily identifiable as a letter as it tapers at either end in the same way that a written letter would and conforms more closely to the perceived normal method of depicting the letter “e”. It has a very unusual feature in that it has a star device at one end, whilst it also has the words “everybody everywhere” underneath, with the initial letter “e” of each word being in the same style as the larger letter “e” except that they do not have the star device at their ends. Both parties claim the colour green as part of their marks.

40) The opponent contended that the dominant part of the applicant's mark is the letter "e", they also contended that the letter "e" in both marks has limbs which extend beyond the norm. They also point out that both marks have a colour claim for similar shades of green. Whilst I accept the last point I do not believe that the average consumer, those qualified to drive a motor vehicle, would ignore the major differences between the marks. The stylisations of each party's letter "e" is significantly different. The applicant's mark also has a star device and the words "everybody everywhere". The opponent contended that these additional words were superfluous and were "to be regarded as descriptive dressing". I do not accept that I can simply ignore the existence of these words, nor do I believe them to be superfluous. They clearly allude to the fact that the services and goods on offer are for the whole of the population, but I do not believe that they are descriptive of the services.

41) The average consumer views trade marks as a whole and does not analyse their details. The trade marks of the two parties have a degree of visual and aural similarity but these are far outweighed by the visual and aural differences. Conceptually, the opponent's mark has little meaning whereas the applicant's mark gives a feel of inclusiveness. To my mind, the marks must be regarded as not being similar.

42) Carrying out a global assessment and taking into account imperfect recollection and all of the factors outlined earlier in this decision, I consider that when used on the services in Classes 36, 39 and 43 there is no likelihood of confusion between the marks of the two parties. The opposition under Section 5(2)(b) fails.

43) I next turn to the grounds of opposition under Sections 5(3) :

"5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

44) In *General Motors Corporation v. Yplon SA (Chevy)* Case C-375/97 the European Court of Justice established the parameters for claiming a reputation in relation to Section 5(3):

"Article 5(2) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory."

45) On the basis of *Chevy* I consider that the opponent needs to demonstrate that at the relevant date a significant number of persons in a substantial part of the UK knew of the trade mark of the opponent. Absent public opinion survey evidence I must take into account “the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it” (*Chevy*). The opponent’s core business relates to the hire and sale of motor vehicles and associated services such as insurance and finance. The relevant public are those who are qualified to drive motor vehicles and the opponent has to show his market share in relation to vehicle hire and sales. The opponent has filed combined turnover figures but has not put this into context of overall market share. I note that the last year for which turnover figures are provided show sales of £122 million. Given that this figure relates to the hire and sales of motor vehicles and the provision of finance and insurance for vehicles I do not consider these figures to be substantial in terms of the overall market.

46) The opponent has failed to show that it has the reputation in its trade mark CTM 36335 required under Section 5(3). The opposition under 5(3) does not get off the ground.

47) I next turn to the ground of opposition under Section 5(4)(a) which reads:

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

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

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

48) To succeed under this ground the opponent must show that it enjoyed goodwill at the relevant date. The relevant date for passing off purposes relates to the commencement of the behaviour complained of. This will normally be the date of the filing of the application.

49) I have found earlier in this decision that the opponent has no reputation in its trade mark CTM 36335. It has shown that it has made sales of motor vehicles providing figures of the number of vehicles sold. It has also shown combined turnover figures which relate to the core business of vehicle hire and sales and associated services such as insurance and finance and therefore may be said to have goodwill. However, earlier in this decision I found that use of the opponent’s mark on such services, actual or on a fair and notional basis would not result in confusion with the application in suit. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail.

50) Also under this Section the opponent sought to rely upon its claimed use and reputation of the colour green. Earlier in this decision I found that the opponent has

failed to show that it has any reputation or goodwill in the colour green. The opposition under Section 5(4)(a) of the Act therefore fails.

51) Lastly, I turn to the ground of opposition based upon Section 56 of the Act which reads:

“56.-(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who -

- (a) is a national of a Convention country, or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.”

52) The need to be “well known” in the United kingdom is a pre-requisite under this ground and in view of my earlier finding that the opponent has no reputation in its trade mark CTM 36335 in the UK, this claim does not get off the ground. The ground of opposition under Section 56 of the Act must fail.

53) The opponent also sought to rely upon its claimed reputation in the colour green under this section. Earlier in this decision I found that the opponent has failed to show that it has any reputation or goodwill in the colour green. The opposition under Section 56 of the Act therefore fails.

54) The opponent has failed on all the grounds of opposition. I order the opponent to pay the applicant the sum of £2500. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of May 2005

**George W Salthouse
For the Registrar,
The Comptroller-General**