

O-217-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2217335  
BY EURODRIVE CAR RENTAL LTD TO REGISTER  
A TRADE MARK IN CLASS 39**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 52703  
BY ENTERPRISE RENT-A-CAR COMPANY**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2217335  
by Eurodrive Car Rental Ltd  
to register a trade mark in Class 39**

**and**

**IN THE MATTER OF Opposition No. 52703  
by Enterprise Rent-a-Car Company**

**BACKGROUND**

1. On 15 December 1999 Eurodrive Car Rental Ltd applied to register the following series of three trade marks:



in Class 39 of the register for a specification of “Arranging vehicle hire; hire of vehicles”.

2. The application was subsequently accepted by the Registrar and advertised in the Trade Marks Journal.

3. On 19 June 2001 Roystons, on behalf of Enterprise Rent-a-Car Company filed a Notice of Opposition. In summary the grounds were –

- (i) Under Section 5(1), 5(2)(a) and 5(2)(b) of the Act because the marks applied for are identical with or similar to the following earlier trade marks owned by the opponent which cover identical and/or similar services and goods and a likelihood of confusion

exists on the part of the public – UK Registration Nos. 1544987, 1545521, 1566075, 1566076, 2035279, 2033136, 2033436, 2129548 and European Community Trade Mark Registration Nos. 000036343, 000036335, 000036541, 000036574, 000509976. Details of these trade marks are at Annex One to this decision.

(ii) Under Section 5(3) of the Act because the marks applied for are identical with or similar to the above mentioned trade marks owned by the opponent and to the extent that the applicant's marks are to be registered for services which are not similar to those for which the opponent's marks are registered and those trade marks have a reputation, use of the applicant's trade marks without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier marks.

(iii) Under Section 5(4)(a) of the Act by virtue of the law of passing off.

(iv) Under Section 5(4)(b) of the Act because the opponent's trade marks are well known trade marks within the meaning of Article 6 bis of the Paris Convention and the provisions of Section 56 of the Act apply.

4. On 26 July 2001 the applicant through its agents, Brookes Batchellor filed a Counterstatement denying the above grounds. Both sides ask for an award of costs in their favour and have filed evidence. The matter came to be heard on 11 May 2004 when the applicant for registration was represented by Mr Mitcheson of Counsel, instructed by Brookes Batchellor and the opponent by Mr Hamer of Counsel instructed by Roystons.

### **Opponent's Evidence**

5. The opponent's evidence consists of three statutory declarations, two by Judith Diana Rawlence dated 1 November 2001 and 1 July 2002 and one by Daryl Harvey Scales, in addition to affidavits by Raymond T Wagner Jnr. dated 31 January 2002 and 2 May 2002.

6. Judith Diana Rawlence is a Trade Mark Attorney at Roystons (the opponent's professional advisors in these proceedings).

7. In her first declaration, Ms Rawlence states that the opponent has made substantial use in the UK of various marks, including a "family" of marks comprising or containing an "e" logo. She adds that use of the "e" logo mark commenced in the UK at least as early as 1994 in relation to the provision of vehicle related goods and services, including vehicle hire services, arranging vehicle hire and sales of vehicles. Ms Rawlence goes on to state that the approximate annual turnover values under the "e" logo mark during the period up to 1999 inclusive, in relation to vehicle hire services, arranging/reservation of vehicle hire and vehicle related activities ie. vehicle towing and breakdown recovery services, and other related services and goods were as follows:

- (a) Vehicle hire/rental services; vehicle towing services; vehicle breakdown recovery services; reservation services for vehicle hire/rental:

		<u>£'s</u>
Calendar year ending 1995	:	113,379
“ year ending 1996	:	3,332,115
“ year ending 1997	:	18,048,499
“ year ending 1998	:	35,006,725
“ year ending 1999	:	92,111,748

(b) Sales of vehicles and parts and fittings therefor:

		<u>£'s</u>
Calendar year ending 1995	:	534,232
“ year ending 1996	:	4,864,599
“ year ending 1997	:	15,358,785
“ year ending 1998	:	29,849,837
“ year ending 1999	:	60,851,473

(c) Vehicle fleet management services; information and advisory services relating to the aforesaid:

		<u>£'s</u>
Calendar year ending 1995	:	Data not currently available
“ year ending 1996	:	11,026
“ year ending 1997	:	5,102
“ year ending 1998	:	4,723
“ year ending 1999	:	Data not currently available

(d) Vehicle insurance and financial services; financial valuations of vehicles; vehicle lease and lease purchase financing:

		<u>£'s</u>
Calendar year ending 1995	:	4,386
“ year ending 1996	:	56,312
“ year ending 1997	:	296,172
“ year ending 1998	:	419,876
“ year ending 1999	:	604,698

8. Ms Rawlence states that the above sales figures all relate to use in the United Kingdom of the aforesaid mark “e” logo.

9. Turning to marketing and publicity, Ms Rawlence states that there has been substantial promotional activity under the above mentioned mark “e” logo, in the United Kingdom, since the date of first use and continuously thereafter up to the date of the opposed application of 15 December 1999, as well as similar substantial promotional activity thereafter. She adds that approximate annual expenditure on promotional activity during the foregoing period

encompassing each of the vehicle related services and goods of vehicle hire services, arranging/reservation of vehicle hire and similar activities, is as follows:

- (a) Vehicle hire/rental services; vehicle towing services; vehicle breakdown recovery services; reservation services for vehicle hire/rental:

		<u>£'s</u>
Calendar year ending 1995	:	37,635
“ year ending 1996	:	256,490
“ year ending 1997	:	729,897
“ year ending 1998	:	659,643
“ year ending 1999	:	684,223

- (b) Sales of vehicles and parts and fittings therefor:

Calendar year ending 1995	:	7,769
“ year ending 1996	:	1,602
“ year ending 1997	:	1,932
“ year ending 1998	:	Data not currently available
“ year ending 1999	:	Data not currently available

10. Next, Ms Rawlence goes to use of the “e” logo mark outside of the UK. She states that it is likely that visitors from the UK to those countries where the mark is in use e.g., the USA, will have encountered such use in those countries and this would serve to yet further increase the reputation of the opponent’s aforementioned mark amongst the public and trade within the UK itself. Ms Rawlence adds that this connection, the approximate worldwide annual turnover values, for 1997 to 1999 inclusive, encompassing provision of the following services and goods of the opponent, namely (a) vehicle hire services, arranging/reservation of vehicle hire and also (b) sales of vehicles (c) vehicle fleet management services and (d) insurance and financial services relating to vehicles, are as follows:

Financial year ending 1997	:	US\$ 3.7 billion
Financial year ending 1998	:	US\$ 4.2 billion
Financial year ending 1999	:	US\$ 4.7 billion

11. Turning back to promotional activity Ms Rawlence states that there has been extensive and numerous different types of promotion of the “e” logo mark. For instance, the mark “e” has appeared on business cards, “flyers”, invoices (and credit notes), on numerous types of stationery items, adverts, ticket jackets e.g., holders for tickets issued to customers hiring vehicles from the opponent, on vehicle stickers supplied to customers for the opponent’s aforementioned vehicle services (and vehicle related goods) and on promotional “give away” items to such customers including items such as rulers; pens, pencil boxes and sweet containers. She adds that the promotional activities include substantial advertising within “Yellow Pages” which she states is demonstrated by the extract from Yellow Pages dated 16 April 1995 at Exhibit JDR2 to her statement. Ms Rawlence goes on to draw attention to Exhibit JDR3 to her statement which

comprises a sample of extracts from the Internet, relating to vehicle related services and goods made available to, and intended for purchase by, the UK public and trade and which contain mention of the opponent's activities in inter alia vehicle hire services, as well as other vehicle related activities such as vehicle fleet services, under the "e" logo mark. She adds that although the abovementioned Internet extracts are after the relevant date they are indicative of those utilised in respect of sales/potential sales in the UK prior to the date of the opposed application.

12. Next, Ms Rawlence draws attention to Exhibit JDR4 to her statement which comprises copies of promotional items and copies of invoices and stationery, which, she concedes, even if of recent date nevertheless correspond to those utilised by the opponent in the United Kingdom prior to the date of the present opposed application in relation to inter alia vehicle hire services and arranging/reservation of vehicle hire.

13. Ms Rawlence states that the aforementioned vehicle hire and arranging of vehicle hire services of the opponent have been supplied and promoted to customers and potential customers throughout various regions of the United Kingdom and as evidence thereof she refers to Exhibit JDR5 to her statement which lists the locations of various of the UK trading premises of the Opponent. She adds that while Exhibit JDR5 bears a date of October 2000, the locations listed thereon are indicative of the various locations of such premises prior to the date of filing of the present opposed application. She adds that the aforesaid list is not an exhaustive indication of the geographic spread of the opponent's customer base and that the opponent's foregoing activities may have been supplied, under the opponent's aforesaid "e" logo mark, to customers from elsewhere within the UK.

14. Ms Rawlence goes on to make a number of submissions in relation to similarity of marks and the grounds of opposition.

15. Raymond T Wagner Jnr is Legal & Legislative Vice President of Enterprise Rent-a-Car Company (the opponent).

16. In his first affidavit Mr Wagner confirms the details of his company's use and promotion of the "e" logo trade mark provided by Ms Rawlence. He also makes a number of submissions in relation to the position on the similarity of marks.

17. The purpose of Mr Wagner's second affidavit is to submit certain additional information and exhibited material. This comprises:

- a) Exhibit I - a copy of the Annual Report and Accounts for the activities in the UK of Enterprise Rent-a-Car UK Limited in relation to the year ending 31 July 1997. This confirms that the primary business of the company is the renting ie. hire, of vehicles in the UK;
- b) Exhibit II - a "stress ball" bearing the company's "e" logo mark which, Mr Wagner states, is representative of promotional items given to customers.

18. Daryl Harvey Scales declaration is dated 24 June 2002. Mr Scales is Finance Director of Enterprise Rent-a-Car UK Limited, a wholly owned subsidiary of the opponent company.

19. Mr Scales draws attention to Exhibit 1 to his declaration which comprises photographs of the front of the premises of his company in Birmingham and Milton Keynes to show use of the “e” logo. He adds that such use predates the relevant date for these proceedings. Mr Scales also states that the word “eurodrive” is descriptive and is in use by third parties. In this regard he refers to Exhibit 2 to his statement to show use of the word (identified on an Internet search) by Renault Eurodrive and a freight haulage operator.

20. In her second declaration Ms Rawlence refers to a Questionnaire conducted on behalf of the opponent. She explains that in May 2002, 45 letters requesting the completion of an enclosed Questionnaire were sent out to individuals selected from a list of names and addresses of persons resident in various regions of the United Kingdom. She adds that 24 Questionnaires related to the mark  of the present opponent and the remainder related to the mark subject of the present opposed application.

21. By way of explanation Ms Rawlence states that the recipients of the Questionnaires were selected on a random basis, namely by selecting the last name and address entered on each of the 1<sup>st</sup>, 3<sup>rd</sup>, 5<sup>th</sup> and odd numbered pages thereafter of a list of names and addresses of persons resident in the Liverpool, West Midlands, Milton Keynes, North East regions of England, plus Scotland. The foregoing was subject to the exception that if a particular listed name and address was “incomplete” the previous name/address on that list was selected. A Questionnaire relating to the opponent’s aforesaid mark was sent to the first of the aforesaid names and addresses (on the regional list in question), a similar Questionnaire but relating to the present opposed mark was sent to the second name and address concerned, then a Questionnaire relating to the opponent’s aforesaid mark was despatched to the next name and address concerned, then a Questionnaire relating to the opposed mark dispatched to the next name and address in question and thereafter in similar fashion, thus issuing the respective Questionnaires alternatively to the subsequent names and addresses concerned. Ms Rawlence states that the intention was that responses should be obtained from the public to approximately equivalent numbers of issued Questionnaires for each mark. A sample of the letter sent in relation to each of the aforesaid Questionnaires, a copy of the Questionnaire as enclosed with that letter and a list of the names and addresses from which the aforementioned random selection was made are attached, at Exhibit JDR1, to Ms Rawlence’s declaration.

22. Ms Rawlence states that in response to the above dispatched Questionnaires 18 replies were recovered, 13 replies related to Questionnaires issued bearing the opponent’s aforesaid mark. Of these, in fact 5 comprised simply items returned “Gone Away”. Of the remainder, 4 respondents associated the mark with the opponent company. Ms Rawlence adds that of the 5 remaining replies, relating to Questionnaires bearing the mark of the applicant, two related to items noted “Gone Away”, two respondents had no knowledge of the mark and the remaining reply associated the mark of the applicant with the *opponent* company.

## **Applicant's Evidence**

23. The applicant's evidence consists of a witness statement by Richard Alan Lowden dated 25 February 2003. Mr Lowden is Chairman and Managing Director of Eurodrive Car Rental Limited (the applicant company). He explains that Eurodrive is a franchise vehicle rental system which was established in 1993. Mr Lowden adds that, to date, Eurodrive have franchise operations located throughout the UK.

24. Mr Lowden states that Eurodrive provides a whole range of facilities and services to its franchise network including the following:

### **“Provision of Centrally Acquired Bookings “Retail-Leisure”**

Eurodrive operates a retail – leisure Central Reservations Department (Wakefield – opened in 1994) which handles vehicle rental enquiries for UK and worldwide destinations. Once the booking has been confirmed all booking confirmation and relevant details are forwarded on to the customer by the Central Reservations Department. All stationery and marketing including booking confirmation vouchers carry the “e eurodrive” Mark.

### **The Provision of Centrally Acquired Bookings Corporate**

Eurodrive also operates a Corporate Central Reservations Department (located in Olney, Buckinghamshire) which manages all corporate bookings from Eurodrive's national corporate account holders. All stationery and marketing relating to the booking of corporate vehicles carries the “e eurodrive” Mark.

### **Marketing**

Eurodrive operates its own in-house marketing department based in Olney, Buckinghamshire which is responsible for the origination, production and processing of all Eurodrive's national, international and local branch marketing needs. A considerable number of international and national marketing campaigns, point of sale and local branch advertising carries the “e eurodrive” Mark.

### **Branch Branding**

Eurodrive is responsible for location branding which includes both internal and external signage and decal back drops which include the “e eurodrive” Mark. In addition the aforementioned Mark has been heavily utilized on commercial vehicle livery.

## **E-Commerce – www.eurodrive.com**

Eurodrive has been a pro-active user and endorser of e-commerce since 1996 being one of the first European car rental companies to launch its own website facility.

**eurodrive.com** has enjoyed a rapid evolution and has the proud accolade of being one of the world's first car rental companies to produce a fully transactional on-line facility.

Eurodrive's web facility has carried the "e eurodrive" Mark since its inception in 1996.

All bookings from Eurodrive's web facility are automatically transferred to the relevant location throughout the UK and worldwide."

25. Turning to promotional activities, Mr Lowden states that the "e eurodrive" mark appears extensively throughout all Eurodrive's operational and general stationery and marketing and promotional material. He goes on to list numerous examples including booking confirmation vouchers, signage, promotional flyers, national advertising with Yellow Pages, Thomson Directories and international advertising within airline in-flight magazines. Mr Lowden confirms that every customer is exposed to the "e eurodrive" mark whenever they communicate or acquire services from his organisation. He draws attention to Exhibit RAL1 to his statement which, he states, comprises two files containing 775 copy documents with a schedule at the front of each file which provides a brief explanation of each enclosure which all provide examples of use of the "e eurodrive" mark from 1993 onwards.

26. Mr Lowden goes on to explain that in order to protect both the trading name and trading style/brand of Eurodrive several limited companies have been registered throughout the United Kingdom which provide date lines to the genuine activity of the organisation, as follows:

Eurodrive Car Rental Limited	2883607	23/12/1993
Eurodrive Van Rental Limited	2973647	05/10/1994
Eurodrive Fleet Services Limited	3202534	22/05/1996
Eurodrive Management Services Ltd	3246666	06/09/1996
Eurodrive Vehicle Rental Limited	3399607	07/07/1997
Eurodrive Selfdrive Limited	3399464	07/07/1997
Eurodrive Car & Van Rental Ltd	3797090	18/07/2000
Eurodrive Limited	4476501	03/07/2002

27. Mr Lowden states that in addition to operating the website www.eurodrive.com Eurodrive owns and operates in excess of 250 domain names all of which point at our main site. He provided numerous examples of domains containing the element "eurodrive" and adds that all of these domains are actively promoted by search engines and directory sites.

28. Mr Lowden is critical of the opponent's evidence and states that very little trading appears to have been done prior to 1996 and that there is no evidence to demonstrate actual confusion. He is unimpressed with the questionnaire exercise and points out that only one individual (very surprisingly in his view) felt that the eurodrive "e" logo was associated with the opponent. Turning to third party use of "evidence", Mr Lowden states that use by Renault is limited to

vehicle leasing, not spot hire (daily rental and haulage activities are not vehicle rental). Mr Lowden adds that he met senior representatives of Enterprise, in particular Ms Lombardo and Mr Patmore, at vehicle launch events and business cards were exchanged. No comments about the respective “e” logos were made.

29. Turning to a comparison of the letter “e” elements within the respective marks. Mr Lowden states that the applicant’s “e” is formed from the generic typeface “Baskerville” whilst the opponents “e” logo is a drawn image meant to mimic a road.

### **Opponent’s Evidence in Reply**

30. The opponent’s evidence in reply consists of an affidavit dated 27 May 2003 by Raymond T Wagner Jnr and three witness statements, one each from Judith Diana Rawlence, Susan Eileen Lombardo and James Patmore dated 1 July 2003, 3 July 2003 and 3 July 2003 respectively.

31. Mr Wagner confirms that he is the same individual who completed two previous affidavits on behalf of the opponent.

32. Mr Wagner states that the annual accounts submitted by the applicant to the Registrar of Companies for the years ending 31 March 1998 and 31 March 1999 are in the form of “abbreviated financial statements” which he understands are submitted on the premise that the company falls within the definition of a “small company” under the Companies Act 1985. Mr Wagner notes that the applicant’s evidence omits any mention of its annual turnover figures and promotional expenditure.

33. Mr Wagner goes on to state that the applicant’s evidence does not show that the “eurodrive” mark referred to therein, relates to the actual mark in suit and the examples in the exhibits contain illustrations of various different marks. Mr Wagner notes that the mere incorporation of a company is not evidence of trading activity and he adds that neither the company names nor the domain names correspond to the mark in suit.

34. Mr Wagner confirms that his company’s use of its “e” mark in the UK in relation to vehicle hire services commenced in 1994.

35. Turning to third party use of the word “eurodrive”, Mr Wagner submits that the opponent’s evidence indicates the descriptive nature of the word for vehicle related activities. He also refers to Exhibit V to his affidavit which, he states, comprises Internet material demonstrating use by Renault in relation to the rental of vehicles.

36. Ms Rawlence’s declaration concerns a second Questionnaire exercise conducted on behalf of the opponent. She explains that during September 2002 and October 2002 a total of 42 letters requesting the completion of an enclosed Questionnaire were sent out to persons selected from a list of names and addresses of persons resident in various regions of the United Kingdom, as outlined further below. All of the aforesaid Questionnaires related to the mark of the opposed UK Trade Mark application No. 2217335.

37. Ms Rawlence states that the recipients of the Questionnaires were selected on a random basis, by selecting the 28<sup>th</sup> name and address entered on each of the 1st, 3<sup>rd</sup>, 5<sup>th</sup> and odd numbered pages thereafter of a list of names and addresses, for each of the Liverpool, West Midlands, Milton Keynes and North East regions of England plus Scotland, of persons resident in each of the aforementioned regions. The foregoing was subject to the exception that if a particular listed name and address was “incomplete” the subsequent name/address on that list was selected. Also, if the number of names and addresses on a page, e.g. the last page, of any of the aforementioned lists was less than 28, no name/address was chosen from that particular page. A copy of each and all of the aforementioned letters which were sent in relation to the aforesaid Questionnaire, plus a copy of the Questionnaire as enclosed with each of those letters, and a copy of the list for each of the aforesaid regions of the names and addresses from which the aforementioned random selection was made, are attached at Exhibit JDR1 to her declaration.

38. Ms Rawlence declares that 5 replies were received to the Questionnaires, with one of these replies simply noted “gone away”. She stated that of the remaining 4 responses, *none* associated the mark of the subject Application No. 2217335 with the applicant company and one of those respondents associated the mark of the opposed Application No. 2217335 with the “*Enterprise*” company. Copies of the five replies are at Exhibit JDR2 to Ms Rawlence’s declaration.

39. Ms Rawlence goes on to note that none of the persons who completed the Questionnaires bearing the mark in suit, associated it with the applicant company and one of the persons associated the mark with the opponent.

40. The declarations of Ms Lombardo and Mr Patmore, both employees of Enterprise Rent-a-Car UK, refer to their meetings with the applicant’s Mr Lowden and go to the exchange of business cards. They both state that they had no conversation about the trade marks of the respective businesses prior to the relevant date for these proceedings.

41. This completes my summary of the evidence filed in this case. I turn now to the decision.

## **DECISION**

42. In his skeleton argument and at the hearing, Mr Hamer stated that the opponent would not be pursuing the Section 5(1), Section 5(2)(a), Section 5(4)(a) and Section 5(4)(b) (Section 56) grounds, for the purposes of this opposition. Accordingly, only the Section 5(2)(b) and Section 5(3) grounds remain.

43. Furthermore, at the hearing both Mr Micheson, on behalf of the applicant, and myself sought clarification on the identity of those respondents to the surveys mentioned in the evidence of Ms Rawlence, in particular as to how they had been selected. The opponent subsequently decided to disregard anything obtained as a result of the questionnaires and therefore my decision pays no regard to the surveys evidence covered within Ms Rawlence’s evidence.

Section 5(2)(b)

44. Firstly, I go to the ground of opposition based upon Section 5(2)(b) of the Act. Section 5(2) reads 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 earlier 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.”

45. An earlier right 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,”

46. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer 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.

47. 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* paragraph 27;

- (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*, paragraph 23;
- (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*, paragraph 23;
- (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-Mayer Inc.*, paragraph 17;
- (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*, paragraph 24;
- (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*, paragraph 26;
- (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*, paragraph 41;
- (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-Mayer Inc.*, paragraph 29.

48. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark(s) at issue and widen the penumbra of protection of such a mark or marks. The opponent has filed evidence in relation to the reputation of the marks covered by its earlier registrations. The evidence confirms, in my view, that the opponent has, since 1994, a very considerable presence in the UK in relation to vehicle hire/rental services. While the bulk of its business has been conducted under the “e logo” Enterprise mark ie. the composite word and logo mark, there is evidence to support the claim that the “e” logo mark has been used both by itself and as a secondary trade mark.

49. Although there are clear deficiencies in the opponent’s evidence e.g. there is no indication of the opponent’s market share or supporting evidence from the trade or third parties, it seems to me that the extent of the opponent’s activities and in particular the scale of their turnover and marketing figures means that, on balance, I am able to infer that, at the relevant date, the

opponent possessed a reputation in its “e” logo Enterprise trade mark and in its “e” logo in relation to vehicle hire/rental services. I will take this into account in my decision.

50. In essence the test under Section 5(2) is whether there are similarities in marks and 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 recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the services, the category of services in question and how they are marketed. In this case it is accepted that the opponent’s mark has a reputation. However, it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

51. Furthermore, in addition to making comparisons which take into account actual use of the respective marks, I must also compare the mark applied for and the opponent’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the services covered within the respective specifications.

52. Firstly, I turn to a comparison of the respective services. The application in suit is in respect of “Arranging vehicle hire; hire of vehicles” in Class 39. The opponent’s earlier marks include registrations in respect of “vehicle rental services” and “reservation and/or booking services relating to vehicles”. At the hearing Mr Mitcheson sensibly conceded that the opposition involved identical services.

53. I now go on to a comparison of the mark in suit with the opponent’s earlier registrations.

54. The opponent submits that it has a family of marks as a letter “e” is common to the opponent’s registrations and this would link its marks together in the mind of the customer and increase the likelihood of confusion through imperfect recollection. In a decision of the Appointed Person – *The Infamous Nut Co Ltd’s Trade Marks* [2003] RPC 7 at paragraphs 35, 36 and 37, Professor Ruth Annand stated that:

“It is impermissible for section 5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponent.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by section 6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant’s mark must be considered

against each of the opponent's earlier trade marks separately (*ENER-CAP Trade Mark* [1999] RPC 362).

In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a "family of marks" in the proprietorship and use of the opponent (*AMORE*, Decision No. 189/1999 of the Opposition Division, OHIM OJ 2/2000, P.235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31."

55. In the present case I found earlier (paragraphs 48 and 49 refer) that the opponent has a reputation in its "e" logo Enterprise mark and its "e" logo mark. I do not believe the opponent to have demonstrated any reputation in its remaining trade mark registrations and I do not consider the "family of marks" argument to put the opponent in any stronger position in this case as a matter of law or practicality.

56. In his skeleton argument and at the hearing Mr Hamer submitted that the opponent's strongest case rested with its registration No. 1544987 – its "e" logo in Class 39. I agree.

57. The opponent's letter "e" logo comprises a stylised letter "e" which the applicant describes as a representation of a road. In my view there is undoubtedly a high degree of stylisation to the letter, which is confirmed by the disclaimer of "a letter e" in the opponents 1938 Act registrations.

58. The opponent submits that through use its "e" logo has acquired distinctiveness to the effect that it had overcome its limited distinctiveness through nature. In this regard, it is widely accepted that trade marks comprising single letters, without stylisation, lack inherent distinctiveness. Furthermore, in the present case the applicant points out that the letter e is indicative of e-business or commerce ie. business undertaken electronically over the Internet – a means of business in which both parties are very much engaged. This reinforces the non-distinctive nature of the letter e in relation to the services at issue.

59. Insofar as the opponent's claim to enhanced distinctiveness in its "e" logo is concerned, there is no evidence from the public or the trade that the letter e would be associated only with the opponent. While the opponent has used its "e" logo, especially in tandem with the word Enterprise, it does not follow that it has, through this use, acquired a monopoly in the letter e per se. In *Bach Flower Remedies Trade Marks* [2000] RPC 513 the Court of Appeal made it clear that use of a trade mark does not of itself prove that the sign is distinctive. In my view, while use of the opponent's "e" logo mark may have enhanced its distinctive character through nature and in effect, widened its penumbra of protection, it does not follow that the opponent can monopolise the letter e or any stylised variation of this letter per se.

60. I turn now to the mark in suit, which is a composite mark comprising the letter e, a "star" device and the words "eurodrive car rental". The applicant submits that the letter "e" element is in an ordinary type face. This is no surprise – it does not seem to me to possess any real degree

of stylisation. On the applicant's mark, the opponent submits that a star device can be a laudatory epithet or indicate a star service. Furthermore, the opponent submits that the word EURODRIVE is non-distinctive and has been used by a third-party (Renault) in non-distinctive manner. However, it seems to me that the evidence indicates that any use by Renault was in a trade mark context and on a prima facie basis, the word EURODRIVE is perfectly capable of functioning as a trade mark in the market place in relation to vehicle hire services.

61. In the comparison of marks the guiding authorities make clear that they must be compared as a whole although, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison, reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade. I must bear this in mind when making the comparisons.

62. On a visual comparison, both marks contain representations of the letter "e", the opponent's mark a stylised representation and the applicant's mark an ordinary representation. However, the opponent's mark also contains the words "eurodrive car rental" and the device of a star. It seems to me that the distinctive word eurodrive is highly visible and possesses a good degree of prominence within the opponent's mark. I see no reason why this word would be overlooked or marginalised in use and in my view the respective marks are visually different overall, especially after taking into account the degree of stylisation apparent in the opponent's "e" logo.

63. Turning to aural use, the opponent's case could be stronger in that the stylisation to its letter "e" may be ignored in aural descriptions of its mark. However, I do not believe it follows that the mark in suit would be described as an "e" mark in aural use in that the word EURODRIVE is an obvious oral reference, particularly given that the public are likely to be aware that a straightforward letter e is non-distinctive in relation to e (or electronically available) car hire via the Internet. Furthermore, I think it appropriate to take into account that the opponent's "e" logo has a primarily visual identity, especially as, in my view, the opponent has not demonstrated that the letter e per se is distinctive of its services.

64. I go now to a conceptual comparison. As mentioned previously, the respective marks contain representations of the letter e. However, given the non-distinctive nature of this letter, the degree of stylisation to the opponent's mark and the presence of the additional word eurodrive within the applicant's mark, I believe the respective marks to be conceptually different in their totality.

65. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must undertake a global appreciation and consider all the surrounding circumstances, including the nature of the services at issue and the average customer for the services.

66. At the hearing Mr Mitcheson made much of the opponent's failure to show any instances of actual confusion in the market place given that both marks were in use in relation to vehicle hire/rental prior to the relevant date. While Mr Hamer was critical as to the extent of the

applicant's use, the evidence clearly demonstrates use and promotion of the applicant's mark and I am able to infer from this evidence that the applicant had a real presence in the market place.

67. The absence of actual confusion is not necessarily conclusive in cases involving conflict with earlier trade marks and I must be careful not to give this point undue weight. Nevertheless in the current proceedings it is evident that the respective marks have been used in the market place for a not insubstantial period on the exact same services. I will take this into account for the purposes of my decision.

68. I now go on to take into account the category of services in question. The customer for vehicle hire/rental is the general public. While I have no evidence before me on this point, my own knowledge and experience tells me that vehicle hire or rental is normally undertaken with relative care and consideration. The potential customer is normally concerned to compare rates, ascertain insurance cover and enquire about other potential charges e.g. fuel and penalties. In my view the customer for the services would be relatively careful and discerning. This reduces the scope for confusion.

## **CONCLUSION**

69. On a global appreciation, taking into account the relevant factors I have come to the conclusion that there is no likelihood of confusion among the average customer for the services. While the respective specifications of services are the same, the visual, aural and conceptual differences in the marks combined with the category of services in question means that the possibility of confusion is remote. The Section 5(2)(b) ground fails.

### **Section 5(3)**

70. Immediately prior to the hearing, in its skeleton arguments the opponent sought to amend its Statement of Case in relation to Section 5(3) of the Act, so that it referred to "similar" as opposed to "not similar" services following the recent European Court of Justice Decisions in *Davidoff & Cie SA and Zino Davidoff v Gofkid Ltd* (C – 292/00) and *Adidas – Salomon AG and Adidas Benelux BV v Fitnessword Trading Ltd* (C – 408/01) and the amendment to the 1994 Act contained in SI 2004 No. 946. This was understandably resisted by the applicant given the "last minute" nature of the request to alter the grounds.

71. Section 5(3) of the Act, as amended, reads as follows:

“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.”

72. The term “earlier mark” is defined in Section 6 of the Act which is set out earlier in this decision.

73. Notwithstanding the late amendment to the Section 5(3) ground it seems to me, as a matter of practical import, the opponent’s case under Section 5(3) is no stronger than its Section 5(2)(b) case.

74. Earlier in this decision I found that the respective marks would not be confused and for the same reasons it is my view that use of the applicant’s mark would not take unfair advantage of or be detrimental to, the distinctive character or repute of the earlier mark. I do not believe the customer for the services would be likely to associate the applicant’s mark with the opponent and there is no evidence to support the opponent’s view on this point. This lack of evidence of any confusion is relevant given that the respective marks have co-existed in the market place prior to the relevant date.

75. The Section 5(3) ground fails.

## **COSTS**

76. The applicant is entitled to a contribution towards its costs. In relation to costs the applicant has requested that I take into particular account:

- i) that the opponent decided not to pursue the Section 5(1), Section 5(2)(a), Section 5(4)(a) and Section 5(4)(b) grounds just prior to the hearing;
- ii) that the opponent decided to disregard its own survey evidence, on which the applicant had spent considerable time and effort in considering and developing a response.

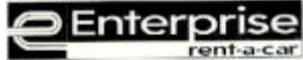
77. In relation to (i) (above), I am not convinced that the applicant has been put to any great inconvenience or additional cost in that the evidence of the opponent was not really particular to any of the above grounds and was also relevant to the pleaded grounds under Section 5(2)(b) and Section 5(3) of the Act. However, in relation to (ii) (above), I think the applicant has a point and the costs award, stated below, reflects a £200 addition in respect of disregarded survey evidence.

78. I order the opponent to pay the applicant the sum of £2,200. This sum is 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 22<sup>nd</sup> day of July 2004**

**JOHN MacGILLIVRAY  
For the Registrar  
the Comptroller-General**

## UK Trade Mark Registrations

Mark	Number	Classes	Goods/Services	Trade Mark Journal/Date	Page
	1544987	39	Vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; all included in Class 39.	6012 16.2.94 Effective Date 14.08.93	899
	1545521	12	Land vehicles; apparatus for locomotion by land; parts and fittings for all the aforesaid; all included in Class 12.	6037 10.08.94 19.08.93	4866
	1566076	39	Vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; reservation and/or booking services relating to vehicles; reservation services for vehicle leasing and/or rental; all included in Class 39.	6068 29.03.95  18.03.94	1994
	1566075	12	Land vehicles; apparatus for locomotion by land; parts and fittings for all the aforesaid goods; all included in Class 12.	6068 29.03.95  18.03.94	1927
   Series of 2 marks. First mark in Series in colour.	2035279	12 & 39	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.	6114 28.02.96  19.09.95	1606
	2033436	12 & 39	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 for the rental and leasing of vehicles; all the foregoing relating to land vehicles; information and/or	6124 8.05.96  13.09.95	4479

			advisory services relating to the aforesaid.		
	2033136	12,35, 37 & 39	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.	6116 13.03.96  9.09.95	2083
	2129548	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.	6184 16.07.97  15.10.96	7813

**ANNEX ONE (CONT'D)**

**Community Trade Mark Registrations**

<b>Mark</b>	<b>Number</b>	<b>Classes</b>	<b>Goods/Services</b>	<b>Trade Mark Journal/ Date</b>	<b>Page</b>
	000036343	12, 36 & 39	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.	32/97 6.12.97  20.11.95	55/ 66
	000036335	12, 36 & 39	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 relation 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.	37/97 29.12.97  1.04.96	43/ 44
 (in colour)	000036541	12, 36 & 39	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;	32/98 4.05.98  16.10.95	58

			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.		
	000036574	12, 36 & 39	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.	31/98 27.04.98  2.10.95	
	000509976	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.	24/98 6.04.98  15.10.96	552/ 3