

O-272-15

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION BY
PURUS MOTOR CARS LTD
UNDER NO 3028284 FOR THE TRADE MARK**



AND

**IN THE MATTER OF OPPOSITION NO. 402384 THERETO
BY AUTOMOBILI LAMBORGHINI S.P.A.**

THE BACKGROUND AND THE PLEADINGS

1) On 28 October 2013 Purus Motor Cars Ltd (“the Applicant”) filed application no. 3028284 to register the following mark for the following goods and services:



Class 12: *Motor land vehicles; apparatus and vehicles for locomotion by land, air or water; motor engines; power plants for land vehicles; parts and fittings for all the aforesaid goods.*

The application was published in the Trade Marks Journal on 28 March 2014.

2) On grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) Automobili Lamborghini S.p.A. (“the Opponent”) opposes the registration of the Applicant’s mark for all the goods for which the Applicant seeks registration.

3) For the purposes of its claim the Opponent relies on the following Community trade mark (“CTM”) and the following goods protected by its registration:

URUS

Class 12: *Automobiles and parts thereof.*

The CTM was filed on 28 February 2008 and completed its registration process on 23 July 2008, which was more than five years before the publication date of the opposed mark. The significance of these dates is that the CTM constitutes an “earlier mark” for the purposes of sections 5(2)(b) of the Act, and the proof of use provisions in section 6A of the Act apply in respect of it.

4) The Applicant filed a notice of defence and counterstatement, denying the grounds of opposition, and putting the Opponent to proof of use in respect of the CTM relied on in the opposition. The period during which genuine use of the marks must be proved (“the relevant period”) is 29 March 2009 to 28 March 2014.

6) Both parties filed evidence and written submissions during the evidence rounds. Neither side requested a hearing. The Opponent filed submissions in lieu of a hearing. The Applicant filed no further submissions. I therefore give this decision after a careful review of all the papers before me.

EVIDENCE SUMMARY

The Opponent's evidence

7) The Opponent filed a witness statement, dated 18 November 2014, of Mr Klaus le Vrang, authorized officer of the Applicant. In summary, Mr le Vrang makes the following statements:

- It takes several years from the initial design of a new car model to the first sale, and longer if there is no direct predecessor.
- A concept vehicle (or show vehicle) often is part of this process, often being shown at motor shows to gauge customer reaction to new designs and to alert possible customers that such car will come to the market in the near future. In this way motor manufacturers begin to establish a market share.
- The Lamborghini's URUS concept car was unveiled at the international Beijing Auto Show on 22 April 2012, which received considerable publicity in Europe in the press, motor magazines and on the Internet. Lamborghini also showed it at the Quail motorsports event in California in August 2012, creating new interest and fresh publicity in Europe as well as the United States.
- Following the official unveiling in April 2012 Lamborghini continues to promote the show car under the URUS trademark with a view to creating and maintaining awareness amongst possible customers that the URUS will become available to buy in the near future, and persuading possible customers to postpone their buying decisions until the Lamborghini URUS is on the market.
- The URUS show car was displayed during the Gala evening to celebrate Lamborghini's 50th Anniversary. On this occasion it was publicly announced that the Lamborghini URUS will be produced in 2017.
- Information about the URUS concept car, including images and videos, was made available on Lamborghini's website in 2012, and it is also promoted, for example, through the posting of videos on YouTube. These promotional efforts are mirrored by editorials and news articles on the URUS car.

Mr le Vrang's statements are supported by a number of documentary exhibits containing downloads of various reports of the relevant events and sample editorials and news articles from third party publications available online.

The Applicant's evidence

8) The Applicant filed a witness statement, dated 16 January 2015, of Mr James Peter Davison, Managing Director of the Applicant. After describing his qualifications and experience in relation to the motor industry he explains the choice of the word PURUS in the contested mark, stating:

“3. Establishing the ‘Purus’ brand is intended to give an identity to the unique selling proposition of our products. My aim as a designer is to gain recognition for myself, designing the world’s greenest car with zero emissions, the word pure best represents such a product.

4. The name ‘Purus’ meaning pure in Latin, pure British car designs made in Britain, composite material made from 100% eco-friendly materials — pure, zero emissions — pure.

5. Some basic market research was conducted into the ‘Purus’ name prior to filing for the trademark where qualified technicians, engineers and designers within the automotive industry were approached for their professional opinion. For the purposes of this matter we sent out questionnaires to professional individuals within the motor trade and knowledgeable consumers to obtain their considered view on the Purus name. Some within the automotive industry completed questionnaires, but many were prevented from providing Witness Statements because of their employment. Copies of completed questionnaires are included in exhibit ‘JPD 1’.”

9) Exhibit JPD1 contains five completed questionnaires. They reproduce the contested mark and ask a) whether the word PURUS conveys any meaning or impression and, if so, what, and b) with what other word or name (if any) the person responding would associate it. The respondents are also asked to describe the steps they would take, the time they would spend, and the considerations they would take into account when purchasing a car.

10) The Opponent filed two further witness statements, both dated 13 January 2015: one of Adam Czuprynski (who completed the first questionnaire in JPD1) and one of Lee Ellingham (who completed the second questionnaire in JPD1). Mr Czyprynski and Mr Ellingham both append copies of the questionnaires completed by them in Exhibit JPD1, having briefly explained (in largely identical terms) their experience of owning different types and makes of motor vehicles.

Relevance of the Applicant’s evidence from professionals in the motor industry and consumers

11) In *esure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 the Court of Appeal considered survey evidence and expert witness evidence. Arden LJ observed:

“62. Firstly, given that the critical issue of confusion of any kind is to be assessed from the viewpoint of the average consumer, it is difficult to see what is gained from the evidence of an expert as to his own opinion where the tribunal is in a position to form its own view.....If more cogent evidence of customer perception is needed, the traditional method of consumer surveys must (subject to my second point) carry more weight and is to be preferred.....”

A motor car is not a specialist product about which the tribunal might require evidence in order to understand how the goods are bought and sold in the relevant market. Therefore this sort of opinion evidence has no evidential weight.

12) On survey evidence generally Whitford J. held in *Imperial Group plc & Another v Philip Morris Limited & Another*, [1984] RPC 293 that:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

13) The Applicant’s questionnaire evidence is deeply flawed for several reasons. The criteria used in selecting those approached is not clear. There is nothing to establish that they are independent and unconnected with the Applicant, or that the “knowledgable consumers” represent a relevant cross-section of the car-buying public. The number of questionnaires completed is not clear; certainly the five submitted are nothing like a statistically significant sample from which general inferences could reliably be extrapolated. If a party intends to draw conclusions from a survey, based upon its statistical validity, it will be necessary to furnish evidence from a suitable expert. It is in order to avoid the submission of evidence containing such flaws that, as explained in Tribunal Practice Notice 2/2012, survey evidence and expert witness evidence can only be adduced into trade mark proceedings before the Intellectual Property Office with the permission of the hearing officer. No such permission was sought in this case. For all the above reasons the questionnaire evidence filed by the Applicant has no weight, and has not assisted me in my assessments of the average consumer, the conceptual content (or lack of conceptual content) in the contested mark, or the likelihood of its confusion with the earlier mark.

PROOF OF USE

14) The Applicant put the Opponent to proof of use of the mark relied on in respect of *automobiles and parts thereof*. Section 6A of the Act provides:

“(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.....

..... (5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

Section 100 of the Act provides:

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

15) In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

16) The Opponent submits: "... the Opponent provided proof of use, to which no comments were made by the Applicant. As a consequence, the Opponent is entitled to rely upon all the goods for which the Earlier Trade Mark is registered". In the submissions filed by the Applicant the issue of proof of use is simply not addressed explicitly; no comment whatever is made on the evidence submitted by the Opponent, though the Applicant concedes that "*Whilst the goods covered by the*

Applicant's trade mark may be considered similar to those covered by the Opponent's trade mark, this is the only point of similarity in this particular dispute." There is no further discussion of proof of use or the comparison of goods. The rest of the Applicant's submissions are addressed to the issues of the perception of the average consumer of motor vehicles and automotive parts, comparison of the marks and likelihood of confusion. Nevertheless, I do not think the Applicant's submissions should be seen as amounting to a tacit concession that the Opponent's evidence suffices to prove genuine use of the goods relied on in this opposition. In the absence of an explicit concession, I shall therefore examine whether the evidence is sufficient.

17) The Opponent announced at a high profile event that the URUS car will be produced in 2017. It is very unusual for genuine use to be found in respect of goods which do not yet exist. The law in this area was recently examined by the Appointed Person in *THE BABA HOUSE*, O-049-15. He concluded from his review of the relevant legislative provisions and authorities that – in some contexts – there may be genuine use of a trade mark even where the goods do not yet exist. I accept that it takes several years from the design of a new car to the first sale, and that this period will be longer where there is no direct predecessor. In this case, a concept car has been produced and exhibited under the URUS name at the Beijing Auto Show in 2012 and Quail motorsports event in California, with attendant publicity, including in Europe. I accept that this represents the start of a process by which motor manufacturers begin to establish a market share. I accept Mr le Vring's evidence that Lamborghini continues to promote the show car under the URUS trade mark with a view to creating and maintaining awareness amongst possible customers that the URUS will become available to buy in the (relatively) near future, and persuading them to postpone their buying decision until the Lamborghini URUS is on the market. On the particular facts of this case, and having regard in particular to the nature of the goods and the characteristics of the market concerned, I find that there has been real commercial exploitation of the mark on the market for the relevant goods, i.e. exploitation that is aimed at maintaining or creating a share in that market. The marketing of a particular model of car will inevitably involve the marketing of the appropriate parts. Accordingly, I find that the Opponent has proved genuine use of the CTM in the European Community for the goods relied on: *automobiles and parts thereof*.

SECTION 5(2)(b)

18) Sections 5(2)(b) of the Act reads as follows:

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

(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".

I have taken into account the guidance provided by the Court of Justice of the European Union ("CJEU") in a number of judgments. The following principles are

gleaned from the decisions 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 great 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 the earlier mark to mind, is not sufficient;

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

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

Comparison of the goods

19) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, (“*Meric*”) the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20) Whilst conceding in its submissions that “*the goods covered by the Applicant’s trade mark may be considered similar to those covered by the Opponent’s trade mark*”, the Applicant did not discuss further the degree of similarity between the

competing goods. It is therefore appropriate for me to provide a more precise assessment.

Motor land vehicles; apparatus and vehicles for locomotion by land; motor engines; power plants for land vehicles; parts and fittings for all the aforesaid goods.

21) The Opponent's *automobiles*, fall within the ambit both of the Applicant's *motor land vehicles* and the Applicant's *apparatus and vehicles for locomotion by land*; they are identical under the guidance in *Meric*. The Applicant's *motor engines and parts and fittings for all the aforesaid goods* are covered by the Opponent's *and parts thereof*; they are identical. The Opponent's *and parts thereof* include power plants for automobiles, which are also covered by the Applicant's *power plants for land vehicles*, and are thus identical.

Apparatus and vehicles for locomotion by air or water; parts and fittings for all the aforesaid goods

22) Aircraft and waterborne vessels may share with automobiles the very general purpose of locomotion, and users may overlap, but their nature and use is different, any competition between them will be very limited, and they do not share channels of trade. The same is true of parts for the respective goods. There is only a low degree of similarity between the Applicant's *apparatus and vehicles for locomotion by air or water* and the Opponent's *automobiles*, and the same applies as between the Opponent's *and parts thereof* and the Applicant's *parts and fittings for all the aforesaid goods* insofar as it relates to these goods.

The average consumer and the purchasing process

23) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24) The average consumer for automobiles will principally consist of the general motoring public, though commercial concerns will also need to purchase cars, vans and other vehicles as “company cars”, and for car-hire and delivery fleets, etc. In view of the nature of these goods, in particular their price and their highly

technological character, the average consumer displays a high level of attention at the time of purchasing such goods¹. This also applies generally in the case of other land vehicles as well as aircraft, boats, etc. Similarly, the selection of parts and fittings for these goods, will overall involve a fair degree of consideration, calling for a reasonably high level of attention to ensure that the goods have the required technical compatibility and functionality, quite apart from the factor of the aesthetic appeal and matching of visible parts. Safety and performance considerations will be paramount, resulting in a higher than normal level of care and attention. Factors such as warranty and insurance considerations will also play a role. Purchase of a vehicle will not be a quick process, but will normally involve deliberation over a period, perusal of catalogues and of information made available by the manufacturer, including online, comparison of product information, and of the terms available from various dealers and sources. Test drives will routinely be arranged. All this reduces the scope for imperfect recollection. Whilst parts and fittings can be purchased and fitted at home, the most likely method will be that the goods are purchased and fitted in a garage or other vehicle-based retail establishment. When purchased in this way, the end consumer will not necessarily see the goods before they are fitted; they may be selected by the business fitting them using a professional degree of attention; their purchase may also involve some discussion with the end consumer, who will often wish to specify what goods are to be used. Here again, apart from questions of technical and aesthetic compatibility, factors such as warranty and insurance requirements may play a role, and safety and performance considerations will be paramount, resulting in a higher than normal level of care and attention. Though the purchasing process for vehicles and vehicle parts will be a predominantly visual one, aural considerations may also play a role, and will not be overlooked in my assessment.

The distinctiveness of the earlier marks

25) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

¹ Case 361/04 P, *Ruiz-Picasso and Others v OHIM*, at paragraph 39.

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

I have found the evidence of promotion of the URUS show car in motor industry circles and among enthusiasts in the target market sufficient to establish genuine use. That evidence, however, falls far short of establishing that the distinctiveness of the mark has been enhanced to any material degree among the relevant public for the relevant goods in the UK. This leaves the question of inherent distinctiveness to be considered. The earlier mark has no meaning likely to be known by the average consumer and is not descriptive or allusive of the goods protected by it. It has a high degree of distinctiveness in relation to the goods covered by it.

Comparison of the marks

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

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would be wrong, therefore, to dissect the trade marks artificially, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

27) The marks to be compared are shown below:

The opposed mark	The earlier mark
	<p>URUS</p>

28) The opposed mark consists of the word PURUS written in a highly stylised form against an orange background with a fancy border. Highlighting effects are used, giving an impression like that of an enamelled badge on which the letters of the word and the border are metallic. The figurative elements make some contribution to the overall impression and distinctiveness of the mark, but it is the word PURUS which will have a greater relative weight in the overall impression created by the mark. The earlier mark consists solely of the word URUS, and its distinctive character resides in the whole word.

29) In its submissions the Opponent draws my attention to a decision of the General Court² in which the opposed mark consisted of four letters and the earlier five-letter marks contained the same four letters in the same sequence, differing only through the addition of a further initial letter. In that case the court observed that under these circumstances it could not be denied that in the overall impression there was a significant degree of visual similarity. It is true that the court found that although the marks at issue were relatively short, the difference between the respective marks, despite occurring in the first letter of the earlier marks, could not offset the overall impression of visual similarity arising from the identity of the other letters. The court also pointed out, however, (at paragraph 48) that the Board of Appeal had taken into account in its decision the fact that the difference between the competing marks occurred at their beginning and that the marks were of different lengths, and that this was why it had concluded that there was only an average degree of visual similarity between them. The court then proceeded to uphold the decision of the Board of Appeal, finding no error. I have borne this case in mind but must, of course, reach my decision in the present proceedings on the particular facts of the present case and on the particular marks that are before me. Moreover, the comparison considered by the General Court in Case T-382/09 involved two word marks. I do not consider that the figurative elements of the mark opposed in the present proceedings – particularly the manner in which the word PURUS is graphically represented – can be discounted.

30) The opposed mark contains the earlier mark in its entirety, differing from the earlier mark only by the addition of a further initial letter. When it comes to the visual

²T-382/09, *Ergo Versicherungsgruppe AG v OHIM*

comparison of marks, there is a rule of thumb that it is, in general, the first component of word marks that is more likely to catch the consumer's attention³. This is no more than a rule of thumb. Each case must be considered on its merits⁴. My assessment must take account of the overall impression created by the marks. In this case, I consider that the rule of thumb is a useful guide. The initial P in the contested mark makes a considerable difference. I consider that the eye of the average consumer will perceive the word PURUS as a whole, rather than dissecting the mark and seeing URUS as a sequence within it. This tendency is reinforced by the manner in which the word is graphically presented in the contested mark. The initial P, the central R and final S are all brought to the fore, the two U letters appearing to be in the background, partially eclipsed by the other letters. I bear in mind that since the earlier mark is a word mark, notional and fair use of it would include use in a variety of fonts and that, being unlimited as to colour, it is registered for all colours⁵. It is a step too far, however, to consider that a normal and fair use will include use in the same manner of presentation as the contested mark.

31) For a conceptual meaning to be relevant in a mark, it must be one capable of immediate grasp. This has been emphasised in a number of judgments of both the GC and the CJEU (see, for example, *Ruiz Picasso v OHIM* [2006] ETMR 29). Neither of the competing marks has a meaning likely to be known by the average consumer, who will see them either as invented words, or as words the meaning of which is unknown to him. There is neither conceptual similarity nor conceptual difference.

32) Since neither of the words in the competing marks are words which will be known to the average consumer, there is no obviously correct pronunciation of them. Some consumers may pronounce the initial U in URUS like the U in "pure", others like the U in "purpose". The same will apply with regard to PURUS. Either way, it is likely that the only difference in pronunciation will result from the initial consonant in the contested mark. Here too, however, despite the coincidence of sound in the rest of the words, I consider that the initial plosive P in the contested mark makes a substantial difference, distinguishing it quite strongly from the earlier mark, and establishing it as a word quite separate and distinct from the earlier mark. The Opponent submits that the initial P is "*an extremely short consonant which can often be overheard*". However, I see no reason why it should be lost aurally in normal marketing conditions in the present case.

33) There is a reasonable degree of visual similarity between the marks and, since the visual stylisation does not affect the pronunciation, a somewhat, but not markedly, higher degree of aural similarity. The semantic content of the marks is neutral in the overall comparison.

³ See the case law cited by the GC in paragraph 36 of *Hipp & Co KG v OHIM* Case T-41/09

⁴ Cf. *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-438/07 at paragraph 23.

⁵ See the observations of Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) at paragraph 119.

Likelihood of confusion

34) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

35) I have found the earlier mark to have a high degree of distinctiveness. I have found a reasonable degree of visual similarity and a somewhat higher degree of aural similarity between the competing marks. Conceptual content is neutral. I have also found that the initial P in the contested mark distinguishes it both visually and aurally quite strongly from the earlier mark and that the graphic presentation of the contested mark also reinforces its distinction from the earlier mark. Bearing in mind my findings on the average consumer and the purchasing process, I consider that, even in the case of identical goods, the differences between the marks are sufficient to rule out any likelihood either that the consumer will directly confuse the marks or that s/he will believe that they are used by the same or by economically linked undertakings. The opponent is obviously in no better position with regard to the goods which are not identical. **Accordingly, the opposition fails in its entirety.**

COSTS

36) Purus Motor Cars Ltd has been successful and is entitled to a contribution towards its costs. I have taken into account the quality of the the evidence submitted by Purus Motor Cars Ltd. I hereby order Automobili Lamborghini S.p.A. to pay Purus Motor Cars Ltd the sum of £1,200. This sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	£300
<i>Preparing evidence and considering the other side's evidence</i>	£500
<i>Written submissions</i>	£400

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of June 2015

Martin Boyle
For the Registrar,
The Comptroller-General