

O-279-13

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION NO 2615821**  
**BY**  
**HAYMARKET MEDIA GROUP LIMITED**  
**TO REGISTER THE TRADE MARK**

**AUTOCAR**

**IN CLASS 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**  
**UNDER NO 103519**  
**BY**  
**AUTACO GMBH**

## BACKGROUND

1) On 28 March 2012, Haymarket Media Group Limited ('Haymarket') applied to register the trade mark 'AUTOCAR' for the following services in class 35:

*Advertising services; consultancy and information services relating to the rental and sale of advertising space; television and radio advertising; business administration and information services; on-line business information services; database management; compilation and dissemination of business directories and customer listings; compilation of advertisements for use as web pages; database management of cherished vehicle registration numbers; organisation, arranging, implementation, conducting and presentation of exhibitions, business shows, demonstrations, trade shows, business and commercial trade shows; compilation of advertisements; uploading vehicle stock information; database car search services; compilation, storage, analysis, retrieval and provision of information; all relating to the trading of motor vehicles.*

2) The application was published on 27 April 2012 in the Trade Marks Journal and notice of opposition was subsequently filed by AUTACO GmbH ('Autaco'). Autaco claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opposition is directed against all of the services in the application.

3) One earlier International Registration ('IR') is relied upon, details of which are as follows:

Mark details	Services relied upon
<p><b>IR designating the EU: 1043591</b></p>  <p><b>International Registration Date: 30 April 2010</b></p> <p><b>Date of designation of the EU: 30 April 2010</b></p> <p><b>Date protection granted in the EU: 31 May 2011</b></p> <p><b>The mark claims the colours light blue, dark blue and grey.</b></p>	<p><b>Class 35:</b> <i>Payroll services; preparation of cost-price analysis; business management consultancy; organisational business consultancy; advice on the organisation and the management of businesses; advice on company management; consultancy services for the management; accounting; auditing; valuation in business matters; planning (support) for the management; preparation of business reports; preparation of tax returns; data systematization of data bases; advice on the organisation and the management of companies; preparation of economic forecasts.</i></p> <p><b>Class 36:</b> <i>Financial analysis; financial advice; liquidation of businesses (financial services); asset management.</i></p>

4) Autaco claims that the respective marks are confusingly similar and that all of the services of the application are identical or similar to the services covered by its earlier mark and, as a consequence, there is a likelihood of confusion.

5) The IR designated the European Union for protection on 30 April 2010; protection was subsequently conferred on 31 May 2011. The consequences of these dates are i) the IR constitutes an earlier mark in accordance with section 6 of the Act and ii) it is not subject to the proof of use conditions contained in section 6A of the Act.

6) Haymarket filed a counterstatement denying that the respective marks and services are similar or that there exists a likelihood of confusion and put Autaco to proof thereof. It also asserted that its 'rights' in the Autocar name date back to 1895 in the UK.

7) Both parties filed written submissions. Only Haymarket filed evidence. Neither party requested to be heard. I therefore make this decision after conducting a thorough review of the papers and giving full consideration to all submissions. I will refer to certain of the parties' submissions as, and when, I consider it appropriate.

### **Applicant's Evidence**

8) The applicant's evidence consists of a witness statement, dated 07 February 2013, in the name of Aaron Newell, a solicitor with the law firm Lewis Silkin LLP (Haymarket's representative in these proceedings). Mr Newell states, inter alia, that Haymarket has consistently published a magazine under the name AUTOCAR in the United Kingdom on a weekly basis since 1895, offering advertising services associated with that magazine. Exhibits 1-6 contain, inter alia, copies of cover pages of the relevant magazine dating back to 1926 and printouts from a website offering the magazine for sale. Mr Newell asserts that the evidence shows that the mark AUTOCAR has been in use in the UK since 1895 in respect of magazines and 'associated' advertising services.

### **DECISION**

#### **Section 5(2)(b)**

9) This section of the Act states:

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

*(a) .....*

*(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.*

10) The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co*

*GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) 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*,

(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; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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.*

### **Comparison of services**

11) In making an assessment of the similarity of the services, all relevant factors relating to them in the respective specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro- Goldwyn-Mayer* the court stated at paragraph 23 of its judgment:

*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.*

12) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- (a) *The respective uses of the respective goods or services;*
- (b) *The respective users of the respective goods or services;*
- (c) *The physical nature of the goods or acts of service;*
- (d) *The respective trade channels through which the goods or services reach the market;*
- (e) *In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;*
- (f) *The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.*

13) The General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05 held:

*29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark*

14) I also take into account the guidance in *Avnet Incorporated v Isoact Limited* - [1998] F.S.R. 16, where the High Court stated:

*...specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.*

15) Turning to the instant case, the services to be compared are:

<b>Autaco's services</b>	<b>Haymarket's services</b>
<p><b>Class 35:</b> Payroll services; preparation of cost-price analysis; business management consultancy; organisational business consultancy; advice on the organisation and the management of businesses; advice on company management; consultancy services for the management; accounting; auditing; valuation in business matters; planning (support) for the management; preparation of business reports; preparation of tax returns; data systematization of data bases; advice on the organisation and the management of companies; preparation of economic forecasts.</p> <p><b>Class 36:</b> Financial analysis; financial advice; liquidation of businesses (financial services); asset management.</p>	<p><b>Class 35:</b> Advertising services; consultancy and information services relating to the rental and sale of advertising space; television and radio advertising; business administration and information services; on-line business information services; database management; compilation and dissemination of business directories and customer listings; compilation of advertisements for use as web pages; database management of cherished vehicle registration numbers; organisation, arranging, implementation, conducting and presentation of exhibitions, business shows, demonstrations, trade shows, business and commercial trade shows; compilation of advertisements; uploading vehicle stock information; database car search services; compilation, storage, analysis, retrieval and provision of information; all relating to the trading of motor vehicles.</p>

16) Autaco has provided no evidence and very little in the way of submission on the issue of similarity of the respective services. However, it does state, inter alia, the following:

*It has to be stated, that the services of the younger trademark are highly similar and in part identical to the services of the older mark. Providing "business administration and information services", which is a service claimed by the younger mark does not mean anything else than providing "business management consultancy" or "organizational business consultancy", which is a service of the older trademark. The same applies for the other services claimed by the younger trademark.*

17) At this point, I remind myself of the comments in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* where the court stated:

*22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.*

18) The court required evidence of similarity to be adduced. Such an approach was advocated by Mr Hobbs QC sitting as the Appointed Person in *Raleigh International trade mark* [2001] R.P.C. 11 where he stated:

*If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their “similarity” (whether or not the objection is directed to the use of an identical mark): Canon paragraph 22. Paragraph 23 of the Judgment in Canon indicates that it is appropriate to consider the pattern of trade with reference to factors such as those (uses, users and physical nature of the relevant goods and services; channels of distribution, position in retail outlets, competitive leanings and market segmentation) identified by Jacob J. in *British Sugar Plc v James Robertson v Sons Ltd.* [1996] RPC 281 at 296, 297.*

19) Accordingly, in approaching the question of similarity of the respective services, I bear in mind the above comments such that where I am able to establish that there is similarity, this is because I consider it to be self-evident.

20) I will make the comparison by addressing each of the terms within the specification of the application in turn, and, where appropriate and for the sake of expediency, grouping certain terms together (*Separate Trade Mark* BL O-399-10). I will also bear in mind the effect, if any, of the limitation ‘all relating to the trading of motor vehicles’ in Haymarket’s specification. However, if I am silent on this point, this is because I consider that Autaco’s services could equally relate to the trading of motor vehicles.

***business administration and information services; on-line business information services.***

21) I agree with Autaco that the above services would be encapsulated by the terms ‘organisational business consultancy’, ‘business management consultancy’ (and also ‘advice on the organisation and the management of businesses’) in its specification. The respective services are identical.

***database management; database management of cherished vehicle registration numbers; uploading vehicle stock information; database car search services.***

22) To my mind, it is self-evident that the above services are highly similar, if not identical, with Autaco's 'data systematization of data bases'. The latter would essentially involve the arrangement of data in a database into a structured system and it seems logical to me that Haymarket's services would also involve such a service or highly similar service.

***compilation, analysis, retrieval and provision of information.***

23) In my view it is self evident that the above terms are highly similar, if not identical, to a number of Autaco's services which are likely to involve, to a certain extent, the compilation, analysis, retrieval and/or provision of information, such as 'preparation of business reports', 'auditing', 'preparation of cost price analysis', 'business management consultancy', 'data systematization of data bases' and 'preparation of economic forecasts'.

***Advertising services; consultancy and information services relating to the rental and sale of advertising space; television and radio advertising; compilation of advertisements for use as web pages; compilation of advertisements; compilation and dissemination of business directories and customer listings; organisation, arranging, implementation, conducting and presentation of exhibitions, business shows, demonstrations, trade shows, business and commercial trade shows; storage of information.***

24) Autaco has given nothing more than a bald assertion that its 'business management consultancy' and 'organizational business consultancy' are highly similar (if not identical) to all of Haymarket's services. It is not clear to me that business management consultancy (or any of Autaco's other services) should be deemed self evidently identical or similar to any of the above listed services. In the absence of any evidence or detailed submission from Autaco as to why I should find to the contrary, and bearing in mind the principle in *Avnet*, I must conclude that there is no similarity. As a consequence, the opposition must fail at this point in relation to those of Haymarket's services listed directly above, as there cannot be a likelihood of confusion where there is no similarity between the respective services (*Waterford Wedgewood plc v OHIM-C-398/07*).

**Average consumer and the purchasing process**

25) It is necessary to consider these matters from the perspective of the average consumer of the services at issue (*Sabel BV v.Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of services.

26) All of the respective services are those which will be primarily aimed at and purchased by businesses. The purchasing act, for all of the services, is likely to take place after some degree of contemplation. I would conclude that the degree of attention afforded during the purchasing act will vary from reasonably high to high, depending on the exact service in question; I do not consider that it will ever be low as none of the respective services can be described as an impulse purchase. The service provider is likely to be chosen after a perusal of the internet, tenders or trade

directories and therefore the purchase is likely to be mainly visual. However, that is not to say that aural considerations are disregarded.

### Comparison of marks

27) For ease of reference, the respective marks are:

Autaco's mark	Haymarket's mark
	

28) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. 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*). Accordingly, there cannot be an artificial dissection of the marks, although, it is necessary to take into account any distinctive and dominant components.

29) Haymarket's mark is presented as one word. However, I think it likely that the average consumer will perceive it as a conjoining of the two immediately recognisable English words 'AUTO' and 'CAR'. Those two words appear to hang together and neither is more dominant than the other. The distinctiveness of the mark lies in its totality.

30) Autaco's mark contains two independently distinctive elements; the (slightly stylised) word 'autaco' being one element and the blue oval device (in the centre of which, is a series of concentric white circles) being the other.

31) Haymarket states, inter alia, that:

*...the bright whirlpool device... makes a striking impression against the grey text autaco, which fades into the background by comparison.*

32) I agree that the device element makes a striking impression. However, I do not agree that 'autaco' fades into the background by comparison; the latter takes up a substantial proportion of the mark. To my mind, viewing the mark as a whole, the two elements share roughly equal dominance.

### **Visual Comparison**

33) A clear point of visual difference is the presence of the device element at the beginning of Autaco's mark which is alien to Haymarket's mark. The respective word elements differ in length, with 'autaco' consisting of six letters and 'AUTOCAR' of seven letters, however they share the same initial three letters 'AUT' and the fifth letter 'C'. The fourth and sixth letters of the words differ, being 'a' and 'o' in Autaco's mark and 'o' and 'a' in Haymarket's mark, respectively. Haymarket's mark also has

an additional seventh letter 'R' which is absent from Autaco's mark. 'AUTOCAR' is presented in a standard font. The term 'autaco' is slightly stylised, but it is nonetheless a fairly unremarkable font. Taking into account all of the aforementioned similarities and differences, and viewing the marks as wholes, I find there to be a fairly low degree of visual similarity.

### **Aural Comparison**

34) Haymarket's mark consists of three syllables and is likely to be pronounced as OUGHT-OH-CAR. Autaco's mark also consists of three syllables and is likely to be vocalised as OUGHT-AH-COH. The device element is unlikely to be pronounced.

35) It is clear that the first syllable of the respective marks is identical. The second syllable differs, although it is a short vowel sound in both. The third syllable also differs, although I bear in mind that, in both marks, it begins with the sound of the letter 'c' (which will be hard as in 'cat'). Taking all of these factors into account, I find there to be a reasonable degree of aural similarity.

### **Conceptual Comparison**

36) As I have already stated, Haymarket's mark is likely to be perceived as the two words, 'Auto' and 'car' conjoined, particularly since all of the applicant's services relate to the trading of motor vehicles. The term 'car' is clearly an everyday English language word with an immediately recognisable concept- that of a motor vehicle. With regard to the term 'Auto', Collins English Dictionary defines this as an abbreviation for 'automatic, automobile and automotive'.<sup>1</sup> To my mind, it is likely that the average consumer will be aware of at least one, if not all, of these various possible meanings. As regards which particular meaning is likely to be perceived by the average consumer, nothing turns on this; in every possible instance, given that 'AUTO' hangs together with 'CAR', the overriding concept conveyed by the mark as a whole will be that of a car of some sort.

37) Turning to Autaco's mark, Haymarket contends, inter alia, that:

*...the incorporation of the suffix "CO" [in Autaco's mark], creates a conceptual impression of a type of "corporation" or "company". In other words, it is clear that this is a "-Co" ("corporation", "company") mark, which is conceptually distinct from any "Car" mark.*

...

*The marks are therefore strikingly distinct on a conceptual level. The lasting impressions created are, respectively, of a "car" and a type of corporation.*

38) I do not agree with Haymarket's assessment of the conceptual impression conveyed by the term 'autaco'. In my view, 'autaco' does not lend itself to such deconstruction; it is likely to be immediately perceived as a single invented word. As regards the device element this is also rather abstract in its nature and is unlikely to

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<sup>1</sup> '[auto.](#)' 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 29 May 2013, <from <http://www.credoreference.com/entry/hcengdict/auto/1>>

establish a conceptual hook in the mind of the average consumer. Viewing Autaco's mark as a whole, it does not possess any immediately identifiable concept.

39) Haymarket's mark therefore possesses a concept which is not shared by Autaco's mark; there is no conceptual similarity.

### **Distinctive character of the earlier mark**

40) I must consider the distinctive character of the earlier mark. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00 [2002] ETMR 91*). As no evidence of use has been filed by Autaco, I have only the inherent level of distinctiveness to consider.

41) As I have already stated, Autaco's mark will be perceived as an invented word together with an abstract device element. As such, the mark neither, describes or alludes to any characteristic of the services in any way and I conclude that it is possessed of a high level of inherent distinctiveness.

### **Likelihood of confusion**

42) In light of the ground of opposition and issues raised in these proceedings, the evidence filed on behalf of Haymarket, purporting to show use of its mark since 1895 in relation to advertising services and magazines, is of no assistance to me and has no bearing on the determination of the likelihood of confusion in the instant case.

43) The factors which must be borne in mind when approaching the assessment of the likelihood of confusion are the interdependency principle, the distinctive character of the earlier mark, the average consumer and nature of the purchasing act and the factor of imperfect recollection.

44) I have found that certain of Haymarket's services share no similarity with those of Autaco. For the reasons given at paragraph 24, there can be no likelihood of confusion in respect of those services. However, I have also found that some of the respective services are identical, with others being highly similar (if not identical). The average consumer of those services will primarily be businesses who will pay a reasonably high to high degree of attention during the, mainly visual, purchasing act. I also bear in mind my conclusion that the earlier mark is possessed of a high degree of inherent distinctive character.

45) As regards the marks themselves, I have found that the marks share a fairly low degree of visual similarity and a reasonable degree of aural similarity. In relation to the conceptual aspect, where I found no similarity, I note the comments of the Court of First Instance (now the GC) in *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)(2003) ECR Case T-292/01*:

*Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and*

*aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately....*

*The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.*

46) To my mind, as Haymarket's mark will conjure an immediately graspable concept (a car of some sort) which is not shared by Autaco's mark, this conceptual distinction serves to counteract, to a large extent, the reasonable degree of aural similarity and the (already) fairly low degree of visual similarity. This counteraction together with the reasonably high to high degree of attention that will likely be paid during the purchasing act (militating against imperfect recollection) leads me to conclude, notwithstanding the identity of certain of the services, that there is neither a likelihood of direct nor indirect confusion.

**The opposition fails.**

## **COSTS**

47) Haymarket has been successful and is entitled to an award of costs. However, in approaching the award I take into account that the evidence filed by Haymarket was of no assistance to me. I award costs on the following basis:

Considering the notice of opposition and preparing a counterstatement:	£300
Written submissions:	£300
<b>Total:</b>	<b>£600</b>

48) I order Autaco GmbH to pay Haymarket Media Group Limited the sum of **£600**. 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 10th day of July 2013**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**