

O-283-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2292727
BY CASTROL LIMITED
TO REGISTER THE TRADE MARK
SECTION
IN CLASS 4**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 90758
BY CHEVRONTEXACO CORPORATION**

BACKGROUND

1) On 14 February 2002, Castrol Limited of Wakefield House, Pipers Way, Swindon, Wiltshire, SN3 1RE applied under the Trade Marks Act 1994 for registration of the trade mark “TECTION” in respect of “Lubricants; lubricating oil for motor vehicles” in Class 4.

2) On 27 June 2002 ChevronTexaco Corporation of 575 Market Street, San Francisco, California 94105, USA filed notice of opposition to the application. The ground of opposition is in summary:

a) The opponent is the proprietor of the following earlier trade marks:

Mark	Number	Effective Date	Class	Specification
TECHRON	1244675	24.06.85	1	Chemical additives for fuels.
TECHRON	CTM 79103	01.04.96	1	Gasoline additives and motor fuel additives.

b) The mark in suit is similar to the opponent’s marks as are the goods. In particular the opponent notes that both marks are made up of seven letters, the first three letters and the last two in the respective marks being identical. The goods of both parties are ones which facilitate the effective running of motor vehicle engines and potentially are sold through the same outlets. The mark in suit offends against Section 5(2)(b) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the grounds of opposition.

4) Neither side filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard although the opponent provided written submissions which I will refer to as relevant in my decision. In the written submissions the opponent appeared to be attempting to submit evidence. If the opponent had wished these matters, such as the actual use of the marks and comments from websites to be taken into account, then these should have been submitted in the proper format and not under the guise of submissions. I have therefore not taken into account certain aspects of the submissions made by the opponent.

DECISION

5) I now consider the ground of opposition under Section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because -

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

6) An “earlier trade mark” is defined in Section 6, the relevant part of which states:

“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,”

7) The opponent’s two trade marks have effective dates of 24 June 1985 and 1 April 1996 and both are plainly “earlier trade marks”.

8) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-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. It is clear from these cases that:

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

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

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

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

- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*;

- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG*;

- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG*;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

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

10) The opponent's marks are inherently distinctive when used on the goods for which they are registered. The opponent has not filed any evidence of use and so it cannot benefit from enhanced distinctiveness.

11) I now turn to the comparison of the specifications of the two parties and take into account the factors referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

12) The opponent, in its statement of grounds claimed that the goods sought to be registered were similar to the goods it has registered in Class 1. For ease of reference the relevant parts of the two parties specifications are reproduced below:

Opponent's specifications		Applicant's specification
1244675	Class 1: Chemical additives for fuels.	Class 4: Lubricants; lubricating oil for motor vehicles.
CTM 79103	Class 1: Gasoline additives and motor fuel additives.	

13) In the absence of evidence I shall have to make the best I can of the comparison. The specification for trade mark 1244675 would seem to include all fuels rather than just those used in motors, and so could include central heating systems amongst others. Both of the opponent's specifications relate to additives for fuels, which could be either to improve the combustion of the fuel either by raising its calorific value or

by cleaning the fuel system thereby aiding the flow of fuel. In contrast the applicant's specification covers lubricants which are used to reduce friction between moving parts.

14) The opponent in their written submissions stated that the goods of both parties are petroleum derivatives which can be sold in similar portable containers. They also claim that both are sold in fluid form. Whilst I may accept that the two parties goods could be in fluid form and sold in portable containers, the specifications do not restrict either party in such a manner that they could not produce powders sold in bulk.

15) To my mind the uses of the goods of the two parties are different. The users of the goods of the two parties would overlap in that a number of consumers who purchase lubricants, particularly for cars, would also purchase fuel additives. The opponent contended that both sides' goods are designed to maintain high performance engines and to control or prevent engine deposits. Whilst I accept that both sides' products could indeed be used in such a manner, again they are not restricted in their specifications in this way, and it is the total specifications which must be compared.

16) It is also possible that they would be sold in garages and stores which cater for the motorist. However, they could also be sold in bulk or through other outlets. The goods of the two parties are not in competition but cannot be said to be complementary as whilst motors require lubrication they do not necessarily require fuel additives. I therefore do not consider the goods to be similar.

17) I now turn to consider the marks of the two parties. For ease of reference the applicant's mark is "TECTION" whilst the opponent's marks are both "TECHRON". As the opponent's marks are identical I need only carry out a single comparison.

18) Clearly, the marks share the same first three letters and the last two letters and are both seven letter words. They have a degree of visual similarity. Although it is possible to pronounce both marks in different ways I think the most likely pronunciation will be "TECH – SHONE" and "TECH- RON". The marks have identical first syllables but distinctly different second syllables. I accept that both marks end with the letters "ON". No evidence was provided regarding any possible meanings of the marks. However, there would seem to me to be a degree of allusiveness in both marks. Lubrication provides a motor with protection whilst both parties goods could be described as technical products. This point was accepted by the opponent in their written submissions, although they viewed it as providing a point of similarity. In addition the second part of the opponent's mark could be seen as a reference to the system of measuring the octane of fuels which is often given by way of a number and the term RON which I believe is shorthand for the Research Octane Test which is widely used in Europe. Other systems used elsewhere include the Motor Octane Test (MON) and the Pump Octane Number (PON). Thus, in the UK petrol pumps often display the octane rating of fuel such as super unleaded as 95 RON. The marks have both similarities and differences.

19) Mr Hobbs Q.C. sitting as the Appointed Person in *Raleigh International* (BL O/253/00) stated:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences.”

20) Neither side has identified the average consumer of their products. Although both sides’ goods could be purchased in bulk by professionals, I believe that the opponent’s strongest case is served by considering the position from the standpoint of the average driver. Neither sides’ goods are the proverbial bag of sweets and I believe that motorists would take care in selecting a product before putting it in their vehicle. To do otherwise would risk considerable expense.

21) On the basis of the slight visual and aural similarity, I would not discount the possibility that some consumers may, on seeing the applicant’s trade mark in use call to mind the opponent’s earlier trade marks. Is this sufficient for a finding of confusion under section 5(2)? The ECJ in *Sabel v Puma* rejected this approach. The requirements of section 5(2) require a likelihood of confusion or an association in that the public wrongly believe that the respective services come from the same or economically linked undertakings. Mere association in the sense that the later mark brings the earlier trade mark to mind is not sufficient for the purpose of section 5(2)(b).

22) The opponent contended that the public would be aware that its products were produced by them and the opponent would be recognised as an “oil company”. Therefore, the products would be viewed as petrochemicals provided by an “oil company” and hence the association would occur. Unfortunately in the absence of any formally submitted evidence to support this contention I am not willing to accept such sweeping statements.

23) Taking a global view of the issue it is my opinion that the differences between the goods of the two parties more than outweigh the slight similarities of the marks. I believe that there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

24) As the applicant has been successful it is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19th day of October 2005

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