

O-296-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2359787  
BY WHEELS 'R' US LIMITED  
TO REGISTER A SERIES OF TWO TRADE MARKS  
IN CLASSES 12, 37 & 42**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 92822  
BY GEOFFREY, INC.**

## BACKGROUND

1) On 31 March 2004, Wheels 'R' Us Limited of 9 Kings Drive, Hassocks, BN6 8DX applied under the Trade Marks Act 1994 for registration of the following series of two trade marks:

**WHEELS 'R' US**

**WHEELS 'R' US**

The applicant claims the colours blue and red as an element of the first mark.

2) The mark was sought to be registered in respect of the following:

In Class 12: Wheels and tyres for automobiles; wheel hubs, screws and caps all for automobiles; parts and fittings for automobile wheels; bumpers and metallic trims for automobiles; parts and fittings for automobiles vehicles; but not including any of the aforesaid goods for use in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid.

In Class 37: Refurbishment and fitment of wheels, including alloy wheels; refurbishment and fitment of parts and accessories for wheels; vehicle repair and maintenance; information and advisory services relating to the aforesaid; but not including any of the aforesaid services provided in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid.

In Class 42: Licensing of intellectual property; franchising; provision of agreements for the aforesaid; franchising compliance; vehicle roadworthiness testing; information and advisory services relating to the aforesaid.

3) On 24 September 2004 Geoffrey, Inc. of One Geoffrey Way, Wayne, New Jersey 07470, United States of America filed notice of opposition to the application. The grounds of opposition are in summary:

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

Mark	Number	Effective Date	Class	Specification
<b>BIKES "R" US</b>	1473950	22.08.91	12	Bicycles, tricycles and parts and fittings for all the aforesaid goods; all included in Class 12.
BIKES "R" US	CTM 2778611	17.07.02	35	Retail store services.
<b>"R" US</b>	CTM 1786946	25.07.00	3	Bath preparations; skin preparations; baby care products (non-medicated); toothpaste; toiletries; soaps; shampoos; haircare products; cosmetics; paper wipes and tissues impregnated with cosmetic and toilet preparations; make-up, cotton wool and cotton wool buds, balls, pads and wipes for non-medical purposes.

			5	Sanitary wear, undergarments and panties; sanitary tampons, shields and lining for panties, towels, napkins and pads; sanitary belts and holders for towels, pads and napkins; sanitary articles of clothing; disposable briefs; breast nursing pads; babies and infants foods and beverages; baby care products (medicated); sterilising preparations; disinfectants and bactericides; non-prescription pharmaceutical preparations; first aid kits; vitamins; wipes for first aid use; bandages; plasters; dietary supplements; dental plaque disclosing preparations.
			8	Cutlery; cutlery sets; baby feeding utensils and cutlery; pushers for babies; scissors; nail manicure instruments and kits; shovels; hand tools; tool sets; cycle tools; tool bags (filled).
			9	Audio and video apparatus and instruments; computer hardware, software and peripherals; computer games software; educational computer software; printers; video displays; modems; telephones and accessories therefor; calculators; electronic language translation devices; microphones; speakers; audio equipment and systems; tape, CD and mini-disc recorders and players; digital TV decoders; TVs; cameras and camera accessories; video cameras and accessories therefor; clock radios; radios; optical and video discs; CDs; CD ROMs; mini-discs; videos; video and audio recordings; video game systems and accessories therefore; films; walkie-talkies; batteries; multimedia hardware and software and accessories therefor; safety apparatus and equipment; sunglasses; cycle helmets and glasses; helmets for use in sports; safety gates; kitchen and appliance safety equipment and devices; smoke detectors and alarms; child safety electrical socket protectors; fire extinguishers; baby alarms; baby sound, breathing and movement monitors; nursery monitors; bed safety rails and guards; intercom apparatus and devices; magnets; floatation aids; swimming goggles, masks, fins, floats and flippers; snorkels; life saving jackets; windsocks; sport protective wear; mouth protectors for sports; speedometers; thermometers; microscopes; telescopes; magnets; instructional apparatus and instruments; chemistry sets, electronics kits; scientific investigation kits; scientific models.
			10	Baby feeding bottles; teats; pacifiers; teething rings; soothers; breast feeding protectors, shells and accessories; breast pumps; brushes for baby feeding bottles, thermometers for medical use.
			11	Light; table lamps; uplighters; night-light; novelty lights; fairy lights; baby feeding bottle heater and coolers; sterilisers for babies bottles,

				cycle lights, lamps and reflectors; night lights; bulbs; fans; electric dehumidifiers
			12	Baby carriages and strollers; covers and hoods for the aforesaid goods; baby and child car seats and car seat restraints; stroller canopies and stroller footwarming muffs; baskets and bags for baby carriages and strollers; cycles; scooters; parts of and fittings for cycles and scooters; cycle bells, horns, sirens, chains, mirrors, pumps, training wheels, saddles, tyres, tubes, tyre repair kits, tyre patches and stands; cycle carriers for use on vehicles; child carriers for bicycles; inflatable boats; oars.
			14	Clocks; watches; watch straps; jewellery; egg cups, goblets, cups, boxes, figurines, ornaments and napkin rings and holders of precious metal; jewellery boxes; key rings and chains; key fobs.
			15	Keyboards; musical instruments for children; harmonicas; drums; drum kits; drumsticks; musical boxes; recorders; castanets; triangles; cymbals; guitars.
			16	Printed matter; trading cards; books; dictionaries; comics; magazines; publications; wall charts; cards; greetings cards; gift-wrap; tissue paper; paper; notebooks; pencil cases; erasers; files; ring binders; paper ribbons; gift boxes; bags, table cloths; coasters, mats and napkins of paper; paper and cardboard decorations; confetti; spraycan novelty string and foam; babies' diapers (disposable); diaper pants (disposable); bibs of paper; decalcomanias; stickers; paper tissues; calendars; teaching and instructional material; flash cards; craft sets; origami paper and sets; artists materials; paper; paints; felt tips pens; crayons; pens; pencils; office requisites; school supplies; stationery; posters; drawing materials and instruments; stencils and printing stamp pads and blocks; stamps; stamp collectors albums, modelling clay and other modelling materials; wood-craft sets and kits; photo albums; glue; adhesives; sticky tape; cement for model making; beadcraft sets; pictures; sewing, embroidery and knitting patterns; globes; typewriters; playing cards.
			18	Stroller parasols; baby carriers, baby harnesses and slings; bags; school cases and bags; knapsacks; wallets; purses; beauty cases; make-up bags; belts; parasols; umbrellas; wheeled shopping bags; sports bags; cycle baskets and bags; tool bags; key cases and holders; key fobs and rings; musical recorder cases.
			20	Furniture; bedroom furniture; garden furniture; children's and babies' furniture; bassinets; baby dressers; highchairs; highchair pads and head support pads; hook on high chairs; baby and child booster seats; baby walkers; cots, travel cots; cot mattresses; baby changing mats; baby

			swing-carriers; bumpers for cots, play pens; pillows; picnic tables and chairs; bean bags; pictures frames, mirrors; storage boxes; toy boxes; picnic baskets; sleeping bags; mobiles; festive decorations (not of paper); cake decorations; toy boxes and chests; work benches; key chains (non-metallic); key ring tags and fobs.
		21	Baby baths; baby top-and-tail bowls; potties, diaper buckets; buckets; waste bins; potty training seats and carrier cases; toilet-seat adapter seats for children; brushes; combs; hair, tooth and nail brushes; brush and comb sets; sponges; tableware; cups; mugs; plates; bowls; tableware sets for infants and children; feeding cups; picnic boxes and sets; vanity cases (fitted); piggy banks; paper plates and cups; lunch boxes; baby food grinders and graters; portable coolers; cool bags and boxes; baby bottle coolers; tea sets; cooking and baking trays, containers and sets; bottle brushes; kitchen containers and utensils; kitchen appliances (non-electric) for food preparation; kitchen towels of papers; kitchen weighing scales; bins; baskets; water sprinklers; hose pipe attachments for spraying water; water carriers; water bottles; candle holders; drinking straws.
		22	Stroller bags; tents.
		24	Household linens; bed and cot linen and bedding; baby bedding; quilts, sheets; pillow cases, blankets; towels; cloths; face cloths; table mats and napkins; fabric; curtains; blinds; mattress covers; slumber bags; quilts; slumber tents; nightdress/pyjama cases; hot water bottle covers.
		25	Clothing, headgear and footwear for children, babies and infants; T-shirts; caps; female undergarments; disposable underwear; disposable briefs; babies diapers and bibs of textile; babies pants; waterproof pants; fancy dress costumes; sports clothing, headgear and footwear; sweatbands and sweatpads for wear.
		26	Sewing kits, boxes, needles and thimbles; beads; hair ornaments; hair slides, clips and bands; ribbons and bow; false hair, wigs, beards and moustaches; badges; bowbiters.
		27	Mats and rugs; wallpaper and wallpaper borders and friezes; wall hangings.
		28	Toys, games and playthings; gymnastics and sporting articles and equipment; bicycle toys; party novelties; streamers; children's and infants ride-on-toys; cycles; battery and pedal powered vehicles; rocking horses; electrical and electronic toys, games and playthings; chemistry sets, electronics kits and science and biology investigation kits, all for educational play purposes; radio, battery and remote controlled models and vehicles and accessories therefor; remote controllers for model vehicles;

			<p>model vehicles; model vehicles; model vehicles construction kits and parts thereof; construction toys; preschool toys; bubbles; marbles; fancy dress outfits being children's playthings; masks; outdoor recreation and adventure apparatus and accessories therefor; toy models and toy model kits; bath toys; rattles; train sets; mobiles; crackers (party novelties); puppets; puzzles; adult toys and puzzles; Christmas tree decorations; swimming, play and paddling pools; accessories for swimming pools; water toys; inflatable mats and loungers; pool toys; inflatable toys in the form of boats; toboggans; sleds; snow discs; sand boxes and pits; hose pipe attachments for water-play; kites and kite strings; plush toys; soft toys; dolls and doll accessories; dolls houses; play house, mats, easels, picnic tables, desks, chairs, tables, table and chair sets, desk and chair set, easel desks, foam furniture, rocking chairs, shops and tents; balloons; ride on bouncers; jump ropes; balls; beach balls; sports balls; baseball equipment; softballs; baseball training devices; marks and catchers; baseball gloves, bats and balls; baseball uniform sets; volleyball sets; sports nets; goals; darts; dart boards; frisbees, yo-yos, bowling balls; hula hoops; pogo sticks; golf equipment; golf clubs and bags; basketball hoops; hockey sticks; sports rackets; roller skates; shoe skates; toy skates; inline roller skates; ice skates; skate and skateboard accessories; skateboards; tetherball; athletic bags; boxing gloves; punch bags; badminton rackets, shuttle cocks, nets and sets; ping-pong balls, nets, tables and bats; tennis rackets and balls; squash rackets and balls; bocce balls and equipment; racquetball equipment; equipment for fishing; lacrosse sticks and balls; croquet sets, sticks and balls; cricket bats, balls and bags; snooker tables, cues, cue chalk, score boards and balls; paddleball rackets and balls; exercise and body building equipment.</p>
			<p>29</p> <p>Snack foods made from fruits and vegetables; nuts; milk and yogurt based beverages.</p>
			<p>30</p> <p>Ice cream; ices; frozen yogurt; chocolate-based beverages; confectionery; Easter eggs; chocolate novelties; snack foods made from cereals; edible Christmas decorations; edible cake decorations; chewing and bubble gum.</p>
			<p>32</p> <p>Non-alcoholic drinks; fruit drinks; fruit juices; mineral water.</p>
			<p>35</p> <p>Retail information and advisory services relating to the suitability, purchase and use of children's articles, items for children and infants, items for instruction, education and entertainment of children and infants, clothing for children and infants and nursery apparatus and equipment; promotion and advertising of the goods of others; on-line promotion and</p>

				advertising of the goods of others; promotion of infant and child safety.
			36	Consumer credit services.
			38	Information and advice with respect to telecommunication services and equipment.
			39	Transportation of goods by land.
			41	Information in respect of books, teaching aids and equipment for infants and children, recreation and sports equipment, cycles, games, toys and playthings.
			42	Computer hardware, software and peripherals information and support services; information with respect to infant care and health; information with respect to health and safety matters with respect to products for children and to product safety standards.
<b>TOYS'R'US</b>	CTM 1786862	25.07.00	3	Bath preparations; skin preparations; baby care products (non-medicated); toothpaste; toiletries; soaps; shampoos; haircare products; cosmetics; paper wipes and tissues impregnated with cosmetic and toilet preparations; make-up, cotton wool and cotton wool buds, balls, pads and wipes for non-medical purposes.
			5	Sanitary wear, undergarments and panties; sanitary tampons, shields and lining for panties, towels, napkins and pads; sanitary belts and holders for towels, pads and napkins; sanitary articles of clothing; disposable briefs; breast nursing pads; babies and infants foods and beverages; baby care products (medicated); sterilising preparations; disinfectants and bactericides; non-prescription pharmaceutical preparations; first aid kits; vitamins; wipes for first aid use; bandages; plasters; dietary supplements; dental plaque disclosing preparations.
			8	Cutlery; cutlery sets; baby feeding utensils and cutlery; pushers for babies; scissors; nail manicure instruments and kits; shovels; hand tools; tool sets; cycle tools; tool bags (filled).
			9	Audio and video apparatus and instruments; computer hardware, software and peripherals; computer games software; educational computer software; printers; video displays; modems; telephones and accessories therefor; calculators; electronic language translation devices; microphones; speakers; audio equipment and systems; tape, CD and mini-disc recorders and players; digital TV decoders; TVs; cameras and camera accessories; video cameras and accessories therefor; clock radios; radios; optical and video discs; CDs; CD ROMs; mini-discs; videos; video and audio recordings; video game systems and accessories therefor; films; walkie-talkies; batteries; multimedia hardware and software and accessories therefor; safety apparatus and equipment; sunglasses; cycle helmets and glasses; helmets for use in sports;

			<p>safety gates; kitchen and appliance safety equipment and devices; smoke detectors and alarms; child safety electrical socket protectors; fire extinguishers; baby alarms; baby sound, breathing and movement monitors; nursery monitors; bed safety rails and guards; intercom apparatus and devices; magnets; floatation aids; swimming goggles, masks, fins, floats and flippers; snorkels; life saving jackets; windsocks; sport protective wear; mouth protectors for sports; speedometers; thermometers; microscopes; telescopes; magnets; instructional apparatus and instruments; chemistry sets, electronics kits; scientific investigation kits; scientific models.</p>
		10	<p>Baby feeding bottles; teats; pacifiers; teething rings; soothers; breast feeding protectors, shells and accessories; breast pumps; brushes for baby feeding bottles, thermometers for medical use.</p>
		11	<p>Light; table lamps; uplighters; night-light; novelty lights; fairy lights; baby feeding bottle heater and coolers; sterilisers for babies bottles, cycle lights, lamps and reflectors; night lights; bulbs; fans; electric dehumidifiers</p>
		12	<p>Baby carriages and strollers; covers and hoods for the aforesaid goods; baby and child car seats and car seat restraints; stroller canopies and stroller footwarming muffs; baskets and bags for baby carriages and strollers; cycles; scooters; parts of and fittings for cycles and scooters; cycle bells, horns, sirens, chains, mirrors, pumps, training wheels, saddles, tyres, tubes, tyre repair kits, tyre patches and stands; cycle carriers for use on vehicles; child carriers for bicycles; inflatable boats; oars; cycles; battery and pedal powered vehicles.</p>
		14	<p>Clocks; watches; watch straps; jewellery; egg cups, goblets, cups, boxes, figurines, ornaments and napkin rings and holders of precious metal; jewellery boxes; key rings and chains; key fobs.</p>
		15	<p>Keyboards; musical instruments for children; harmonicas; drums; drum kits; drumsticks; musical boxes; recorders; castanets; triangles; cymbals; guitars; musical recorder cases.</p>
		16	<p>Printed matter; trading cards; books; dictionaries; comics; magazines; publications; wall charts; cards; greetings cards; gift-wrap; tissue paper; paper; notebooks; pencil cases; erasers; files; ring binders; paper ribbons; gift boxes; bags, table cloths; coasters, mats and napkins of paper; paper and cardboard decorations; confetti; babies' diapers (disposable); diaper pants (disposable); bibs of paper; decalcomanias; stickers; paper tissues; calendars; teaching and instructional material; flash cards; craft sets; origami paper and sets; artists materials; paper; paints; felt tips pens;</p>

				crayons; pens; pencils; office requisites; school supplies; stationery; posters; drawing materials and instruments; stencils and printing stamp pads and blocks; stamps; stamp collectors albums, modelling clay and other modelling materials; wood-craft sets and kits; photo albums; glue; adhesives; sticky tape; cement for model making; beadcraft sets; pictures; sewing, embroidery and knitting patterns; globes; typewriters; playing cards.
			18	Stroller parasols; baby carriers, baby harnesses and slings; bags; school cases and bags; knapsacks; wallets; purses; beauty cases; make-up bags; belts; parasols; umbrellas; wheeled shopping bags; sports bags; cycle baskets and bags; tool bags; key cases and holders; key fobs and rings.
			20	Furniture; bedroom furniture; garden furniture; children's and babies' furniture; bassinets; baby dressers; highchairs; highchair pads and head support pads; hook on high chairs; baby and child booster seats; baby walkers; cots, travel cots; cot mattresses; baby changing mats; baby swing-carriers; bumpers for cots, play pens; pillows; picnic tables and chairs; bean bags; pictures frames, mirrors; storage boxes; toy boxes; picnic baskets; sleeping bags; mobiles; festive decorations (not of paper); cake decorations; toy boxes and chests; work benches; key chains (non-metallic); key ring tags and fobs; slumber bags.
			21	Baby baths; baby top-and-tail bowls; potties, diaper buckets; buckets; waste bins; potty training seats and carrier cases; toilet-seat adapter seats for children; brushes; combs; hair, tooth and nail brushes; brush and comb sets; sponges; tableware; cups; mugs; plates; bowls; tableware sets for infants and children; feeding cups; picnic boxes and sets; vanity cases (fitted); piggy banks; paper plates and cups; lunch boxes; baby food grinders and graters; portable coolers; cool bags and boxes; baby bottle coolers; tea sets; cooking and baking trays, containers and sets; bottle brushes; kitchen containers and utensils; kitchen appliances (non-electric) for food preparation; kitchen towels of papers; kitchen weighing scales; bins; baskets; water sprinklers; hose pipe attachments for spraying water; water carriers; water bottles; candle holders; drinking straws.
			22	Stroller bags; tents.
			24	Household linens; bed and cot linen and bedding; baby bedding; quilts, sheets; pillow cases, blankets; towels; cloths; face cloths; table mats and napkins; fabric; curtains; blinds; mattress covers; quilts; nightdress/pyjama cases; hot water bottle covers.
			25	Clothing, headgear and footwear for children, babies and infants; T-shirts; caps; female

			<p>undergarments; disposable underwear; disposable briefs; babies diapers and bibs of textile; babies pants; waterproof pants; fancy dress costumes; sports clothing, headgear and footwear; sweatbands and sweatpads for wear.</p>
		26	<p>Sewing kits, boxes, needles and thimbles; beads; hair ornaments; hair slides, clips and bands; ribbons and bows; false hair, wigs, beards and moustaches; badges; bowbiters.</p>
		27	<p>Mats and rugs; wallpaper and wallpaper borders and friezes; wall hangings.</p>
		28	<p>Toys, games and playthings; gymnastics and sporting articles and equipment; bicycle toys; party novelties; streamers; children's and infants ride-on-toys; rocking horses; electrical and electronic toys, games and playthings; chemistry sets, electronics kits and science and biology investigation kits, all for educational play purposes; radio, battery and remote controlled models and vehicles and accessories therefor; remote controllers for model vehicles; model vehicles; model vehicle construction kits and parts thereof; construction toys; preschool toys; bubbles; marbles; fancy dress outfits being children's playthings; masks; outdoor recreation and adventure apparatus and equipment, namely, wendy houses, play houses, climbing frames, slides, swings, paddling pools, swimming pools and trampolines; baby swings; handheld electronic and computer games; action figures and accessories therefor; toy models and toy model kits; bath toys; rattles; train sets; mobiles; crackers (party novelties); puppets; puzzles; adult toys and puzzles; Christmas tree decorations; swimming, play and paddling pools; accessories for swimming pools; water toys; inflatable mats and loungers; pool toys; inflatable toys in the form of boats; toboggans; sleds; snow discs; sand boxes and pits; hose pipe attachments for water-play; kites and kite strings; plush toys; soft toys; dolls and doll accessories; dolls houses; play houses, mats, easels, picnic tables, desks, chairs, tables, table and chair sets, desk and chair sets, easel desks, foam furniture, rocking chairs, shops and tents; balloons; ride on bouncers; jump ropes; balls; beach balls; sports balls; baseball equipment; softballs; baseball training devices; masks and catchers; baseball gloves, bats and balls; baseball bats, baseball batting gloves, catcher gloves, masks and baseballs; volleyball apparatus and equipment, other than clothing; sports nets; goals; darts; dart boards; frisbees, yo-yos, bowling balls; hula hoops; pogo sticks; golfing apparatus and equipment, other than clothing; golf clubs and bags; basketball hoops; hockey sticks; sports rackets; roller skates; shoe skates; toy skates; inline roller skates; ice skates; skate and skateboard</p>

				accessories; skateboards; tetherball; athletic bags adapted to the products they are intended to contain; boxing gloves; punch bags; badminton rackets, shuttle cocks, nets and sets; ping-pong balls, nets, tables and bats; tennis rackets and balls; squash rackets and balls; bocce balls and equipment; racquetball equipment; equipment for fishing; lacrosse sticks and balls; croquet sets, sticks and balls; cricket bats, balls and bags; snooker tables, cues, cue chalk, score boards and balls; paddleball rackets and balls; exercise and body building equipment; playthings and novelties for parties, namely spray can novelty string and foam; slumber tents, all being for play purposes.
			29	Snack foods made from fruits and vegetables; nuts; milk and yogurt based beverages.
			30	Ice cream; ices; frozen yogurt; chocolate-based beverages; confectionery; Easter eggs; chocolate novelties; snack foods made from cereals; edible Christmas decorations; edible cake decorations; chewing and bubble gum.
			32	Non-alcoholic drinks; fruit drinks; fruit juices; mineral water.
			35	Retail information and advisory services relating to the suitability, purchase and use of children's articles, items for children and infants, items for instruction, education and entertainment of children and infants; clothing for children and infants and nursery apparatus and equipment; promotion and advertising of the goods of others; on-line promotion and advertising of the goods of others; promotion of infant and child safety.
			36	Consumer credit services.
			38	Information and advice with respect to telecommunication services and equipment.
			39	Transportation of goods by land.
			41	Information in respect of books, teaching aids and equipment for infants and children, recreation and sports equipment, cycles, games, toys and playthings.
			42	Computer hardware, software and peripherals information and support services; information with respect to infant care and health; information with respect to health and safety matters with respect to products for children and to product safety standards.
<b>TOYS'R'US</b>	CTM 400929	15.10.96	35	Retail services relating to the suitability, purchase and use of children's articles, items for children and infants, including clothing, toys, games and playthings, sporting equipment, electronic goods, furniture, health and beauty aid products, nursery apparatus and equipment, items for instruction, education and entertainment of children and infants; advisory services relating to the suitability, purchase and use of children's articles, items for children and infants, including clothing, toys, games and

				playthings, nursery apparatus and equipment, items for instruction, education and entertainment of children and infants.
<b>GAMES "R" US</b>	1490278	10.02.92	28	Games; toys and gymnastic and sporting articles; all for playing games; all included in Class 28.
<b>MUMS "R" US</b>	2213106	02.11.99	5	Sanitary wear, undergarments and panties; sanitary tampons, shields and linings for panties, towels, napkins and pads; sanitary belts and holders for towels, pads and napkins; sanitary articles of clothing; disposable briefs; breast nursing pads.
			25	Female undergarments; disposable underwear; disposable briefs.
			35	Retail advice and information regarding maternity and sanitary items and articles.
<b>SWEETS "R" US</b>	2197319	14.05.99	29	Potato chips and snack foods made from potato.
			32	Non-alcoholic drinks, fruit drinks and fruit juices.
<b>TOYS "R" US EASYBUY</b>	2102912	18.06.96	36	Financial credit services for the purchase of goods; customer credit services.
<b>BABIES'R'US</b>	CTM 439158	31.12.96	25	Clothing, footwear and headwear.
			28	Toys, games and sporting equipment.
			35	Advisory services for the business of selling children's items, clothing and toys.
<b>BABIES'R'US</b>	CTM 698928	25.11.97	3	Soaps, shampoos, bath products, creams, lotions and oils for baby care, hair lotions, toothpaste, perfumery, cosmetics and dentifrices.
			5	Baby foods.
			12	Baby carriages and strollers.
<b>KIDS "R" US</b>	2172720	21.07.98	3	Soaps; shampoos; bubble bath; skin lotions; hair lotions; cosmetics; toiletries.
			8	Cutlery, forks and spoons.
			11	Lamps; lighting apparatus; lamp shades.
			14	Clocks and watches.
			16	Paper; writing, drawing and painting implements; crayons; felt tip pens; paints; easels; paper and paint brushes used in conjunction with easels; books; cards; posters; teaching and instructional material; gift wrap; adhesives; table mats, cloths and napkins of paper.
			20	Children's furniture; chairs; rocking chairs; benches; bean bag chairs; tables; dressing tables; shelf units; chests of drawers; beds; bed frames and headboards; toy boxes with benches; toy boxes; mattresses; pillows.
			21	Cups, mugs, bowls, plates; waste paper baskets; combs; sponges; brushes.
			24	Sheets, blankets, bedspreads, comforters, duvet covers, pillow cases, curtains, towels, wash cloths and dust ruffles; table mats, cloths and napkins, fabric lengths.
			27	Wallpaper; wallpaper borders; rugs; mats.
42	Design of signs displaying information relating			

				to the suitability, purchase and use of children's articles, and articles of clothing, footwear and headwear for children and infants.
SNACKS "R" US	2233170	19.05.00	35	The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store.

b) The opponent is a wholly owned subsidiary of Toys "R" US, Inc. and the registered proprietor of the mark "R" US in addition to a family of marks incorporating the "R" US suffix. The opponent states that the "R" US element is the strong and distinctive badge of origin which consumers immediately associate with the opponent and it is used on a wide range of goods and services. The opponent states that they have considerable presence on the Internet with the UK website receiving between 1.25 and 2.5 million visits per month.

c) The opponent has used the mark TOYS "R" US in the UK since 1985 and has used other "R" US marks. As a result of this use the opponent has acquired a substantial goodwill and reputation in the "R"US marks in the UK, such that it is a well-known mark under Section 56 of the Trade Marks Act 1994. The application offends against Sections 5(2)(b), 5(3), 5(4)(a) and 56 of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent's claims and putting the opponent to strict proof of use.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 11 July 2006 when the opponent was represented by Mr Edenborough of Counsel instructed by Messrs David Keltie Associates. The applicant was not represented but provided written submissions, which I shall refer to as and when required.

### **OPPONENT'S EVIDENCE**

6) The opponent filed a witness statement, dated 11 April 2005, by Thomas DeLuca the Vice President for Product Development Safety Assurance of the opponent company which is a wholly owned subsidiary of Toys "R" Us Inc. Much of the evidence relates to use of trade marks after the date of the application. He states that the opponent set up a UK subsidiary in 1984, TOYS "R" US Ltd and commenced trading the same year. He states that prior to August 2004 BABIES "R" US retail sections were on the premises of the TOYS "R" US (hereinafter TRU) stores. He also confirms that the BIKES "R" US, SNACKS "R" US AND "KIDS "R" US sections are similarly within the TRU stores. He provides a list of stores which shows that there are TRU stores throughout the UK. He provides the following turnover figures under the TRU name in the UK:

Year	£ million
2000	340
2001	375
2002	430
2003	460

7) Mr DeLuca also provides advertising and promotional figures for all the “R”US marks which in the period 2000-2003 average over £8 million per annum. At exhibit TD5 he provides a sample of catalogues from 2004. However, although he provides a list of the catalogues and the dates that they were issued the actual exhibits filed do not tally with the list. As none are specifically dated I am only able to accept those that are marked with Spring or Easter as being prior to the relevant date, assuming that these are indeed from 2004 as claimed. All three have a mark similar to CTM1786862 albeit with a large star device surrounding the “R” element. The brochures show toys, bikes, games, electronic goods, videos and DVDs and outdoor activity equipment offered for sale. At exhibit TD6 are copies of TRU promotional material for the years 1994-97 which show similar items offered for sale under the TRU plus device mark with the letter “R” reversed.

8) At exhibit TD7 he provides copies of Christmas television advertising for the years 2003 and 2004. The tape for 2004 is after the relevant date. The other shows use of the TRU plus device mark. Mr DeLuca states that the TRU mark also appears on delivery trucks. At exhibit TD8 he provides a carrier bag which shows use of the TRU and BABIES “R” US (hereinafter BRU) marks, a set of three babies bibs which have a label sown on one which shows three marks TRU, BRU and KIDS “R” US (hereinafter KRU). Also included in this exhibit is a toy truck with the TRU mark on the model itself as well as the packaging and photos of packaging and also signs inside the store which show use of TRU, KRU, and SNACK “R” US (hereinafter SRU). However, as none of these items are dated they cannot be taken into account.

9) Mr DeLuca states that the opponent has opened two stores under the BRU mark, although this was after the relevant date. He states that sales are also made from a catalogue and website which both use the BRU mark. He states that BRU was first used in the UK in 1998 both on items within TRU stores and also via a catalogue. At exhibit TD9 he provides an example of the Spring/Summer catalogue which is not dated although coupons at the back of the catalogue have an expiry date of 31 July 2004. Also included are copies of pages from the website dated 14 April 2005. At exhibit TD10 he also provides copies of a magazine which is sent to members of the Mother & Baby Club operated by BRU. These are undated. He states that, during the period 1999-2004, the turnover under the BRU mark in the UK exceeded £85 Million. However, as for most of this period the sales were made within the TRU stores it is not clear how the distinction between the sales was made. He states that during this period £8 million was spent promoting the BRU mark.

10) Mr DeLuca states that the BIKES “R” US (hereinafter BKRU) mark has also been used in TRU stores since 1985. At exhibit TD11 he provides photographs of the BKRU signage used in 1999 and also other photographs of the BKRU mark which are after the relevant date. At exhibit TD12 he provides a copy of the Christmas 2001 TRU catalogue which features within it the BKRU mark. He states that the turnover under the BKRU mark for the years 1999-2004 was in excess of £1.4 million. However, he does not state that this was solely within the UK. Even if I accept that all the sales occurred in the UK, the items were sold in the TRU shops or via the TRU catalogue. In all instances the letter “R” in the BKRU mark is reversed.

11) At exhibit TD13 Mr DeLuca provides various newspaper and magazine articles which refer to TRU. However, they all date from 1980-1985 and so at the relevant

date were at least eighteen years old, I do not believe that these can assist in my decision. At exhibit TD14 he provides further examples of articles mainly from UK newspapers such as *The Times*, *The Independent*, *The Guardian*, *The Sun* and *The Mirror* amongst others. For the most part these articles mention TRU in passing. On 1 April 1998 The Guardian reports the opening of sixty BRU departments within TRU stores. Mr DeLuca claims that these articles show that his company has a very high profile in the UK. He also suggests that the press is aware that the use of “R” US with other matter will be understood to indicate the “R” US Group’s business. He points out that one article is headed “Access to “R” US”.

12) Mr DeLuca states that the opponent began trading primarily in toys and games and then moved into baby goods, bikes, furniture, snacks and drinks, haulage services, travel club services, credit card services, DVD rental and property leasing under various marks which contain “R” US. At exhibit TD15 he provides copies of pages from the company website which he states shows use in relation to a number of services. These are all dated 14 April 2005. At exhibit TD16 he provides copies of invoices relating to leasing of property, where the opponent appears to have developed a retail complex and then leased out the stores around its own outlet to create a shopping precinct. The invoices are dated after the relevant date. At exhibit TD17 he provides copies of backhauling services. These appear to be agreements for the opponent to use its empty lorries to carry goods on the return journey. The goods are taken to the opponent’s depot where they would have to be collected. The opponent does not therefore appear to be offering a full haulage service. Alternatively, it might simply be collecting the goods that it sells in its outlets from the various importers/ wholesalers/ manufacturers. In all of the evidence filed none of the actual goods carries the TRU logo, they have other brand names such as “Lego”, “Hot Wheels” etc. It is only the brochures, the stores and areas within the stores which are headed up with the TRU logo.

13) Mr DeLuca makes a number of submissions regarding the distinctiveness of the opponent’s marks and commenting on the reasons for the applicant to seek to register a mark which includes “R”US. He also comments on the similarity of the goods of the two parties in the instant case and the likely reaction of the average consumer. He points out that Halfords sells bikes and parts for bicycles as well as wheels and other accessories for cars. He also provides evidence that the applicant company changed its name from WHEELS R US LIMITED to WHEELS “R” US LIMITED on 21 May 2004.

## **APPLICANT’S EVIDENCE**

14) The applicant filed two witness statements. The first, dated 9 September 2005, is by Caitriona Mary Desmond the applicant’s Trade Mark Attorney. She provides evidence from the Internet that there are a number of companies in the UK with the prefix “R US”. She provides details of the companies including their names and dates of incorporation. Most of the evidence is dated after the relevant date. Although Ms Desmond has shown incorporation dates for some of the companies even where these predate the relevant date it does not show that the company name has been used in the marketplace or the extent of the use. Even where the Internet evidence refers to companies which have been in existence for some time prior to the relevant date it does not provide evidence of the extent, nature or duration of use. This is effectively

“state of the Register” evidence which does not inform as to what is happening in the marketplace. It is well established that such evidence lacks relevance ( See *Treat* [1996] RPC 281). She also provides details of previous cases between the opponent and two companies which had the prefix “R US” in their name. I do not find any of the information provided of assistance in making my decision.

15) The applicant’s second witness statement, dated 13 September 2005, is by Jonathan Kemp the Managing Director of the applicant company. Mr Kemp makes a number of comments regarding the opponent’s evidence which do not assist my decision. Mr Kemp states that his company has used the mark in suit since the latter part of 2002 and that sales have exceeded £100,000 per annum in the years 2003 and 2004. This, he states, represents a significant proportion of the local high end alloy repair market.

### **OPPONENT’S EVIDENCE IN REPLY**

16) The opponent filed another two witness statements by Mr DeLuca dated 13 December 2005 and 27 January 2006. He makes a number of comments regarding the applicant’s evidence which do not assist my decision. He also states that:

“use of “R” US combined with any other matter by the “R” US Group, would be seen as use of “R” US, especially as the additional matter in the “R” US Group trade marks is merely descriptive wording, i.e. TOYS or BIKES. The distinctive and dominant trade mark element of the “R”US Group trade marks is quite clearly “R” US.”

17) Mr DeLuca points out that the applicant has given no explanation as to why they chose the name they did. He points out that the opponent adopted the “R” US mark in 1978. He states that although they have only identified Halfords as a retailer selling bikes and parts for bikes alongside car accessories including wheels the UK consumer is aware of the activities of Halfords due to the number of stores it has throughout the UK.

18) Mr DeLuca confirms that his company sells bikes for all ages from toddlers to adults and also accessories for them including, inter alia, helmets, lights and pumps. He states that there are sixty six BKRU departments in TRU stores in the UK.

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

### **DECISION**

20) At the hearing a preliminary point was raised regarding the issue of the limitation to the applicant’s specification. Mr Edenborough set out his contention with the appropriate case law (for which I am grateful) in his skeleton which I reproduce below:

“9. Pursuant to the case of *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (POSTKANTOOR), Case C-363/99, it is submitted that the limitation “*but not including any of the aforesaid services provided in relation to*

*bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid*” is unacceptable in any event.

10. POSTKANTOOR was concerned with negative limitations. The eighth question that was referred to the ECJ asked:

*“Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign "Postkantoor" for the services of direct-mail campaigns and the issue of postage stamps "provided they are not connected with a post office")?”*

11. In its judgment, the ECJ responded to this question as follows:

*“105. By the eighth question, to be examined in sixth place, the national court asks essentially whether the Directive or the Paris Convention prevents a trademark registration authority from registering a mark for certain goods or services subject to the condition that they do not possess a particular characteristic.*

*106. The national court explains in that regard that the question seeks to ascertain whether 'Postkantoor' could be registered, for example, for services such as direct-mail campaigns or the issue of postage stamps 'provided they are not connected with a post office'.*

*107. KPN submits that the question is not regulated by the Directive and thus does not fall within the Court's jurisdiction. In the alternative, it maintains that such limitations are permissible and that exclusions may be accepted or even required when the application is filed.*

*108. The BTMO contends that under the Directive, although procedural issues are a matter for the Member States, the conditions for obtaining and continuing to hold a trademark are, in general, identical in all of them. Those conditions include the obligation to draw up the registration in accordance with internationally accepted standards, in particular the classification provided for in the Nice Agreement.*

*109. Under the Nice Agreement there is no provision for registration of the absence of a particular characteristic which cannot be objectively defined as a sub-category of a list of goods or services.*

*110. The Commission argues, first, that the Court has no jurisdiction to adjudicate on the compatibility of a provision of national law with the Paris Convention. Second, relying on Regulation No 40/94, it submits that Article 3(1)(c) of the Directive does not prevent marks which are descriptive of certain goods or services from being refused in relation to some of the goods or services listed in the application for registration, a practice which is also*

*followed by the Office for Harmonisation in the Internal Market Trademarks and Designs (OHIM).*

*111. The Nice Agreement divides goods and services into classes in order to facilitate the registration of trademarks. Each class brings together various goods or services.*

*112. Although an undertaking may apply for registration of a mark in respect of all the goods or services falling within such a class, nothing in the Directive prohibits it from seeking registration solely in respect of only some of those goods or services.*

*113. Likewise, when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.*

*114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.*

*115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties - particularly competitors - would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.*

*116. Since the Directive precludes such a practice, there is no need to examine the request for an interpretation of the Paris Convention.*

*117. In those circumstances, the answer to the eighth question must be that the Directive prevents a trademark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic.”*

12. Therefore, it is clear that the presently worded negative limitation is unacceptable and so the specification for the class 12 goods and the class 37 services must be deleted in their entirety in order to conform to this ECJ jurisprudence.”

21) I also take into account the comments of Richard Arnold Q.C. acting as the Appointed Person in *MERLIN B/L O-043-05* where he said:

“25. In *Croom’s Trade Mark Application* [2005] RPC 2 the applicant applied to

register the mark McQUEEN CLOTHING CO in respect of “bags” in Class 18 and “trousers for casual wear, T-shirts, sweatshirts, jackets and tops” in Class 25. The application was opposed by the fashion designer Alexander McQueen. The hearing officer upheld the opposition, and the applicant appealed. On the appeal the applicant offered to restrict his specification of goods by adding the words “none being items of haute couture” or “not being items of haute couture”. Geoffrey Hobbs QC sitting as the Appointed Person held at [28]- [30] that such a restriction was not permissible in the light of *POSTKANTOOR* since the proposed restriction related to the characteristics (viz. the style and quality) of the goods and not the nature, function or purpose of the goods.

26. In *Oska’s Ltd’s Trade Mark Application* (BL O/317/04) the applicant applied to register the mark LORNA MORGAN in respect of “clothing, footwear, headgear”. The application was opposed by Morgan SA, the proprietor of a chain of high street shops selling clothing under the mark MORGAN. The eponymous Lorna Morgan was a “glamour model” and the applicant argued that the target audience for its goods would not be confused. In the course of allowing an appeal by the opponent I rejected this argument. I added at [56] the parenthetical observation that I did not consider that it would be permissible to limit the specification by reference to the applicant’s intended target market in light of *POSTKANTOOR* and *Croom*.

27. In my judgment both of the disclaimers offered by the applicant in the present case are free from objection on this ground since they are not disclaimers framed by reference to the absence of particular characteristics of the services but restrictions on the scope of the services embraced by the specification.

28. This is clearest in the case of the first disclaimer, the effect of which is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable.

29. The position with regard to the second disclaimer is more debatable, but in my judgment the disclaimer does not relate to a characteristic of the services. I consider that there is a distinction between goods and services here. An article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser. By contrast, services can be defined in part by the recipient of the service. The opponent’s registration is an example of this, since both the Class 35 and the Class 36 specification are limited to services provided to the pharmaceutical biotechnological and bioscientific sectors. In my view *POSTKANTOOR* does not make it impermissible to define services in this way. That being so, I consider that it makes no difference if the definition is expressed negatively rather than positively.”

22) It is clear from the above that whether the limitation is expressed positively or negatively it has to provide legal certainty as to what goods or services are covered by the specification. In the instant case the discussion relates to two of the three classes

included in the specification. For ease of reference the specifications for these classes is reproduced below:

Class 12: Wheels and tyres for automobiles; wheel hubs, screws and caps all for automobiles; parts and fittings for automobile wheels; bumpers and metallic trims for automobiles; parts and fittings for automobiles vehicles; but not including any of the aforesaid goods for use in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid.

Class 37: Refurbishment and fitment of wheels, including alloy wheels; refurbishment and fitment of parts and accessories for wheels; vehicle repair and maintenance; information and advisory services relating to the aforesaid; but not including any of the aforesaid services provided in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid.

23) Mr Edenborough contended that the term “automobile” means “something that is allowed to move because it possesses wheels. It does not define the number of wheels that the automobile must have”. He continued “But this would include all automobiles: lorries, multi-axle lorries, but it will also include two-wheel vehicles: scooters.” I do not agree that this is the definition of automobile. An automobile is another word for a car, which would usually be defined as being a motorised vehicle designed to transport passengers which usually has four wheels. Cars and car accessories are not usually sold alongside lorries, scooters or motorbikes. The markets for each are quite distinct and different. Mr Edenborough contended that old or vintage cars had much narrower wheels and tyres than modern cars and so were more akin to motorbikes. Whilst I accept that older cars did indeed have much narrower wheels they were substantially different in their manner of fitting and also in the weight bearing characteristics. I do not believe that the owner of a vintage car would seek replacement wheels or tyres from a motorbike dealer in the same way that a motorbike owner would not go to a car dealer or supplier for wheels or tyres. The same arguments would apply to all accessories. To my mind the limitation made to the specifications provides the legal certainty that is required.

24) I now move onto the first ground of opposition which is under Section 5(2)(b) of the Act which reads:

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

(a)....

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

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

25) An “earlier trade mark” is defined in section 6, the relevant 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.”

26) The opponent agreed that its best case under this section was served by CTM 1786946 and UK trade mark 1473950. These have effective dates of 25 July 2000 and 22 August 1991 respectively and are clearly earlier trade marks.

27) 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 Benelux 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 Benelux 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.*

28) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods 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 judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

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

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

30) I also have to consider whether the marks that the opponent is relying upon have a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of them. The opponent's marks are as follows:

**"R"US** and **BIKES "R" US**

31) Clearly, the first mark is inherently distinctive for all goods and services. The second mark is also inherently distinctive even when used on bicycles.

32) I now turn to consider whether the opponent’s marks have become distinctive by use. The opponent contends that the “R” US part of the TOYS “R” US trade mark is the dominant and distinctive part as the mark is used primarily on toys. They therefore claim that the sales figures in their evidence should be considered as relating to the “R” US mark as it appears in the TRU trade mark. I do not agree with this contention. To my mind, the opponent has a considerable reputation as a retailer of toys under the mark TOYS “R” US with the letter “R” being reversed. There is no evidence of use of “R” US being used on its own, nor has any evidence been presented to the effect that consumers view the “R” US part of the mark as indicating the opponent. I also note that under Section 5(3) the opponent is relying upon its mark TOYS “R” US. As Mr Edenborough put it at the hearing, “Toys “R” Us is, of course, necessary with respect to 5(3) because of the way the argument is developed and the reputation point”. In my view the opponent cannot enjoy an enhanced level of protection under its “R”US mark through use.

33) ) 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* [1999] ETMR 1. 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.”

34) The applicant’s specification and the relevant part of the opponent’s specifications are reproduced below for ease of reference:

Applicant’s specification	Opponent’s specification
Class 12: Wheels and tyres for automobiles; wheel hubs, screws and caps all for automobiles; parts and fittings for automobile wheels; bumpers and metallic trims for automobiles; parts and fittings for automobiles vehicles; but not including any of the aforesaid goods for use in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid.	CTM1786946: Class 12 Cycles; scooters; parts of and fittings for cycles and scooters; tyres, tubes, tyre repair kits, tyre patches.  CTM1786946:Class 28: Cycles; battery and pedal powered vehicles  UK 1473950: Class 12: Bicycles, tricycles and parts and fittings for all the aforesaid goods; all included in Class 12.
Class 37: Refurbishment and fitment of wheels, including alloy wheels; refurbishment and fitment of parts and accessories for wheels; vehicle repair and	CTM1786946: Class 41: Information in respect of books, teaching aids and equipment for infants and children, recreation and sports equipment,

maintenance; information and advisory services relating to the aforesaid; but not including any of the aforesaid services provided in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid.	cycles, games, toys and playthings.
Class 42: Licensing of intellectual property; franchising; provision of agreements for the aforesaid; franchising compliance; vehicle roadworthiness testing; information and advisory services relating to the aforesaid.	CTM1786946: Class 42: Computer hardware, software and peripherals information and support services; information with respect to infant care and health; information with respect to health and safety matters with respect to products for children and to product safety standards.

35) I shall first consider the Class 12 goods of each party. Clearly, the opponent's specification for "tyres" would encompass the applicant's "tyres for automobiles". However, I do not accept the contention put forward at the hearing that the term "wheels" would equate to a metal hub fitted with a tyre. From my own experience I am aware that the term "wheel" is used to designate the metal hub only. I was also invited to take judicial note that milk floats are battery powered vehicles. However, the opponent has battery powered vehicles registered only in Class 28 under their mark 1786946. This Class relates to toys and games and I do not believe that milk floats could be considered a toy. In my view the opponent's specification in Class 28 relates to toy cars which are battery powered. These are simply the modern equivalent of pedal cars, albeit for the new lazy generation.

36) It was also contended that "parts and fittings for cycles and scooters" would cross-relate to "parts and fittings for automobiles vehicles". Again, I do not accept this contention. Because of the design of parts for such articles and the various safety restraints and legislation I do not believe that there is any commonality of parts. Nor are such parts normally sold at the same outlets. The only instance that the opponent mentioned was Halfords. I note that even in these stores the parts for bikes and cars are in quite separate parts of the store which are clearly indicated.

37) It was also argued that older cars used wheels and tyres which were considerably narrower than those found on modern vehicles. These were said to be derived from cycles and to have a degree of commonality. Whilst I accept that older cars were fitted with narrower wheels and tyres than the modern equivalent, these were still considerably different to bicycle wheels and tyres due to the vastly increased loads that they are required to take.

38) If one considers the factors outlined in paragraph 33 above then the users would have to be regarded as similar as the users of the applicant's products would be car drivers many of whom would also shop in the opponent's stores for cycles and scooters and of course drivers also shop for tyres. The uses of the products ostensibly are similar in that they are all related to modes of transport but there are very fundamental differences between cycles and scooters and wheels and parts for cars. I accept that wheels require tyres to be used effectively and so in this instance the uses are similar. Tyres are not similar in use to other parts for cars. The physical nature of

wheels and tyres are different, especially if one considers that a wheel consists solely of what the opponent referred to as the metal hub. Similarly, car parts (bumpers and metallic trims) and tyres are physically different. Equally cycles and scooters are physically different from car wheels and car parts. As to trade channels clearly Halfords sell all the products of both parties in Class 12 and so whilst they may be the only such incidence this cannot be ignored. Tyres are clearly sold alongside wheels as witnessed by the applicant. Lastly, although the products are clearly not in competition with each other tyres would have to be regarded as complimentary to wheels although not to car parts such as bumpers.

39) Overall, “cycles; scooters; parts of and fittings for cycles and scooters” are not similar goods to any of the goods contained in the applicant’s specification. However, “tyres” in the opponent’s specification are similar in terms of users, uses and trade channels to “wheels for automobiles; wheel hubs, screws and caps all for automobiles; parts and fittings for automobile wheels”. Clearly, tyres are identical in both specifications. With regard to “tyres” and “bumpers and metallic trims for automobiles; parts and fittings for automobiles vehicles” then they are not similar.

40) When considering the Class 28 goods the opponent made much of the fact that “battery powered vehicles” was in the specification. However, as I have commented previously Class 28 deals, broadly, with toys. Therefore, any battery powered vehicles which fall within this Class would be toy cars that are battery powered. These cannot be construed as automobiles and are substantially different in every way to automobiles.

41) I now move on to consider the position under Class 37. With regard to the applicant’s specification under this Class the opponent relied not only upon its Class 41 specification but also upon its Class 12 specification for “tyre repair kits, tyre patches”. It was contended that: “If you are going to do anything in respect to a wheel, you are going to have to mend a puncture for example. It is the same argument as bar services are similar to wine marks.” This contention is based upon the idea that a wheel consists of a hub plus a tyre and is the composite whole. As I have commented earlier, this is not a view that I share. There is a great deal written in the press regarding the ease with which wheels, particularly alloy wheels, which are fitted with low profile tyres can be dented or even cracked when parking. There is, as a consequence, a thriving industry in the repair and refurbishment of these wheels, by which I mean repairs to the metal part or hub only. It is a fact that the actual tyre is frequently not damaged as it does not protrude beyond the wheel and thus does not protect the wheel at the expense of damage to itself. The opponent is erroneous, therefore, in the view that repairs to a wheel will also necessitate repairs to a tyre. I also note that the manufacture of tyre repair kits and the provision of a service of repairing and refurbishing metal wheels are completely different activities.

42) The opponent also claims that its Class 41 specification for “Information in respect of cycles” is said to be similar to the applicant’s Class 37 services. I assume that the opponent is particularly targeting the part of the applicant’s specification which reads: “information and advisory services relating to the aforesaid; but not including any of the aforesaid services provided in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid”. Whilst I accept that information regarding cycles may include information regarding the repair and

refurbishment of wheels, the applicant’s specification excludes cycles. As I found earlier in this decision that the limitation created legal certainty and was acceptable it obviously provides clear blue water between the services of the two parties here.

43) Moving on to consider the Class 42 services of the parties. The opponent argued that there was similarity between their provision of “information, with regard to health and safety matters, with respect to products and safety standards” and “vehicle roadworthiness testing” in the applicant’s specification. However, I note that the opponent’s specification on health and safety is “in respect to products for children”. Even without this caveat, I would still not regard the services of the two parties as similar. The testing of vehicle roadworthiness is a highly skilled and detailed process. One needs to be licensed and approved by the Government in order to undertake such an activity. These days it also requires the testing operator to have a computer link to the government body responsible for the issuing of certificates of roadworthiness. The services of the two parties in this class are very different.

44) I now turn to consider the marks of the two parties. For ease of use they are reproduced below:

Applicant’s mark	Opponent’s marks
<p><b>WHEELS 'R' US</b></p> <p><b>WHEELS 'R' US</b></p>	<p><b>"Я" US</b></p>
	<p><b>BIKES "Я" US</b></p>

45) I will first compare the mark in suit with the opponent’s “R” US mark as shown above with the reversed letter “R”. It is accepted that marks must be compared as wholes on the basis of their visual, aural and conceptual similarities. It is also accepted that distinctive and dominant characteristics must be identified. However, it is important that any points of dissimilarity must also be considered (*Crooms* [2005] RPC 2).

46) The applicant contended that the letter and word combination R US is weak in terms of distinctive character and will not in themselves indicate origin. They state that the market will rely upon the totality of the respective marks which they contend are distinguishable.

47) The opponent contends that the addition of descriptive words, such as WHEELS, BIKES or TOYS to the R US element does not diminish the distinctiveness of the R US element nor does it render the marks dissimilar. At the hearing I was referred to Case-120/04 *Medion AG v Thompson Multimedia Sales Germany & Austria GmbH* [2006] EMTR 13. Mr Edenborough submitted that when considering the mark in suit “there can be no doubt that the “R” US bit maintains its distinctive character and so therefore we say that it is sufficient to give rise to a conflict between the two marks”. He does not suggest that the “Wheels” element of the mark in suit be ignored when comparing the marks, but its essentially descriptive nature must weaken its distinctiveness.

48) The opponent's mark has a number of distinctive features i.e. the substitution of the letter "R" for the word "are", the fact that the letter "R" is reversed and the incorrect grammar which is merely emphasised when words such as "BIKES" or "TOYS" are placed in front of the R US mark. I accept that grammatical correctness is now, unfortunately, all too rare in the market but even by the current low standards the opponent's mark is unusual.

49) Visually and aurally the mark in suit differs from the opponent's mark in that it has the word WHEELS at the beginning, and the letter "R" is not reversed. It is also in a plain font rather than the slightly stylised version of the opponent's mark. Conceptually, the mark in suit informs the average consumer that the applicant deals in wheels whereas the opponent's mark provides no real conceptual message. The addition of the word WHEELS occurs at the beginning of the mark, which it is accepted is the most important part of the mark. However, the word is not the dominant part of the mark in suit nor does it take away the independent existence of "R" US element. Taking into account all of the above, when the marks are compared as wholes the similarities in the marks outweigh any differences.

50) When considering the issue globally, allowing for imperfect recollection, there is, in my opinion, a likelihood of confusion or a likelihood of association on the part of the public in relation to the following goods in Class 12:

"Wheels and tyres for automobiles; wheel hubs, screws and caps all for automobiles; parts and fittings for automobile wheels."

51) With regard to "bumpers and metallic trims for automobiles; parts and fittings for automobiles vehicles; but not including any of the aforesaid goods for use in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid" in Class 12 and the whole of the applicant's Class 37 and 42 specification there is no likelihood of confusion or a likelihood of association on the part of the public.

52) I will not go on to consider the opponent's mark BIKES "R" US under section 5(2)(b). The opponent contended that the word "wheels" is a slang term often used for motor bikes and so there is greater conceptual similarity than under the "R" US simpliciter mark. I do not accept that the word wheels is a slang term for bikes. It is used in relation to a wide range of transport, primarily cars. Therefore, in my opinion, the opponent's case under its BIKES "R" US mark is no stronger than under its "R" US mark and would not provide a more favourable outcome for the opponent.

53) I will now consider the aspects of the applicant's specification which did not offend against Section 5(2)(b) under the Section 5(4)(a) ground of opposition which reads:

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

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

(b).....

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

54) In deciding whether the mark in question “WHEELS “R” US” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

‘To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.’”

55) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty*

*Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429. In their evidence the applicant claims to have first used their mark in the “latter part of 2002”.

56) Earlier in this decision I found that the opponent did not have a reputation in the “R” US mark but did have a reputation as a retailer of toys under the TOYS “R” US mark. I have already compared the applicant’s and opponent’s trade marks and found there to be similarities. It is well established that in the law of passing off there is no limitation in respect of the parties’ fields of activity. Nevertheless the proximity of an applicant’s field of activity to that of the opponent’s is highly relevant as to whether the acts complained of amount to a misrepresentation.

57) In essence the question I have to address is whether the relevant public seeing the applicant’s mark used on what can broadly be described as “parts and fittings for automobiles”, “Refurbishment of wheels and vehicle repairs” and “vehicle roadworthiness testing” would be likely to believe that the goods and services were being offered by the opponent. The point can be supported by reference to the following passage from Millett L.J.’s judgment in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by Wynn-Parry J. in *McCulloch v May* [1948] 65 RPC 58 when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd v John Griffiths Cycle Corporation Ltd* (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* (1902) 2 Ch. 282 (The Times Newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing-off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing-off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

Also:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

And:

“Passing off is a wrongful invasion of a right of property vested in the plaintiff, but the property which is protected in an action for passing off is not the plaintiff’s proprietary right in the name or get-up which the defendant has

misappropriated but the goodwill and reputation of the business which is likely to be harmed by the defendant's misrepresentations."

58) I have no evidence before me on whether the public would associate the applicant's goods and services with the retailing of toys. Furthermore, the opponent has provided no evidence as to whether toy retailers commonly produce parts for automobiles or refurbish wheels or MOT testing or vice versa. On the basis of my own knowledge and experience I would venture to say that retailing toys and the motor trade are discrete trades. At any rate it is for an opponent who wishes to claim that they have characteristics of, or would be recognised as the provider of an applicant's goods or services to support such a claim with evidence.

59) In the absence of evidence to the contrary I do not consider that the opponent's goodwill will extend to the goods and services in the motor trade provided by the applicant and in my view the applicant's use of their mark on these goods will not amount to misrepresentation.

60) With regard to the opponent's Section 56 ground of opposition I cannot see how its case can be stronger under this ground than under either the Section 5(2)(b) or Section 5(4)(a) grounds. Therefore, I will not consider this ground of opposition.

61) Lastly, I turn to the ground of opposition under Section 5(3) of the Act which in its original form reads:

"5-(3) A trade mark which -

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

(b) is to be registered for goods or services which are not similar to those for which the earlier mark is protected,

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."

62) By virtue of regulation 7 of the Trade Mark (Proof of Use, etc) Regulations 2004, Section 5(3)(b) has now been repealed. The equivalent provision in Section 10 of the Act dealing with infringement has also been amended. As the explanatory note indicates:

"These amendments implement the decision of the European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* of 9th January 2003 (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* of 23rd October 2003 (C-408/01). Those decisions determined that Article 5(2) of the Directive, which on the face of it, grants a right to the proprietor of a trade mark to prevent third parties from using an identical or similar trade mark in relation to goods or services which are *not similar* where the earlier trade mark has a reputation and

use of that sign takes unfair advantage or is detrimental to the distinctive character of that earlier trade mark, also applies to goods or services which are similar or identical to those for which the earlier trade mark is registered."

63) Notwithstanding the broader interpretation of Section 5(3) (Article 5(2)) that has now been confirmed by the ECJ, the opponent's claim here is based on the fact that the respective goods and services are dissimilar.

64) I shall limit my considerations to those aspects of the applicant's specification which did not offend against Section 5(2)(b), which for ease of reference are:

Class 12: "bumpers and metallic trims for automobiles; parts and fittings for automobiles vehicles; but not including any of the aforesaid goods for use in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid";

In Class 37: Refurbishment and fitment of wheels, including alloy wheels; refurbishment and fitment of parts and accessories for wheels; vehicle repair and maintenance; information and advisory services relating to the aforesaid; but not including any of the aforesaid services provided in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid.

In Class 42: Licensing of intellectual property; franchising; provision of agreements for the aforesaid; franchising compliance; vehicle roadworthiness testing; information and advisory services relating to the aforesaid.

65) The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (Visa)* 2000 RPC 484 *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00, *Mastercard International Inc and Hitachi Credit (UK)Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] ETMR 31.

66) In relation to reputation under Section 5(3), *General Motors Corporation v Yplon SA* [2000] RPC 572 paragraphs 26 & 27 indicate the standard that must be reached:-

"26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."

67) This test sets out a high threshold, and the onus is upon the opponent to prove that its trade mark enjoys a reputation or public recognition. At the hearing Mr Edenborough contended:

“Toys "R" Us is, of course, necessary with respect to 5(3) because of the way the argument is developed and the reputation point.”

68) I have found earlier in this decision that the opponent has a reputation for retailing toys under its TOYS “R” US mark. I am willing to accept that the opponent’s TOYS “R” US mark is known by a significant part of the public concerned. The opponent also sought to rely upon its BIKES “R” US mark. However, the evidence does not support the contention that this mark has any reputation in the marketplace. The opponent is relying upon the inclusion of the “R” US element in the mark effectively making the claim that any use of “R” US in a trade mark would automatically form a link in the general public’s mind to the opponent, irrespective of the goods or services offered. I reject this contention. To my mind the opponent has not shown that it has reputation in any mark other than its TOYS “R” US mark.

69) The opponent contended that use of the mark in suit would give rise to an association between the sign and the opponent’s mark in the minds of the relevant public which in the instant case must be considered to be the general public; that the applicant’s use of the mark would take unfair advantage; and lastly that such use would tarnish or diminish the opponent’s mark.

70) The applicant has provided evidence of other companies with the “R” US element in their name. The inference being that use of the “R” US element by a range of companies will lessen the likelihood of the public associating such use with the opponent. However, the evidence provided was, as stated earlier in this decision, merely “state of the register” evidence as it did not show the nature, extent and duration of trading. It is not possible to say what, if any, effect the existence of these companies has had on the general public. Whilst the general public may be aware that others are using or seeking to use “R”US in their names or trading styles it is probable that initially the general public will be reminded of TOYS “R” US simply because of the volume of sales that the opponent has achieved and the considerable advertising it has undertaken. The opponent has therefore succeeded in overcoming the first hurdle as I accept that there will be association.

71) I now move on to consider the issue of unfair advantage. The opponent contended that they have vast sales under the “R”US mark, as this is the dominant part of the mark TOYS “R” US; that they sell wheels and battery and pedal powered cars (albeit children’s cars); that there is a close association in practice between the bicycle business of “R” US and the automotive business of the applicant as illustrated by Halfords; that the applicant has changed its company name from WHEELS R US to WHEELS ‘R’ US which the opponent claims is piggy backing on their operation and that the applicant has offered no “due cause” for its adoption of the mark in suit.

72) Firstly, I do not regard the alteration of the company name, which happened after the relevant date to have any bearing on the opposition. The ground under this section considers the trade mark which is sought to be registered. The opponent has not pleaded bad faith despite some of the comments made in its evidence. Equally, the issue of “due cause” is a defensive issue that the applicant can seek to rely upon if it wishes. It does not have to show reasons why it adopted the mark in suit if it chooses

not to, although I accept that silence on this issue is a factor that I have to take into account in determining the matter.

73) Mr Edenborough contended that there is a close association between the automotive and bicycle businesses and gave as an illustration the retailer Halfords. Whilst I accept that Halfords does indeed sell parts and accessories for cars and also bicycles I do not accept that this establishes a close association between the two businesses. Most retailers of automotive parts do not sell bicycles and the opponent has in any case not shown that it has a reputation as a bicycle retailer but as a retailer of toys which can include bicycles. It is accepted that despite Section 5(3) now covering identical, similar or dissimilar goods/services that the proximity of the goods or services is a factor which has to be taken into account.

74) I note the following comment from Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) in *Electrocoin Automatics Limited and Coinworld Limited and Others* [2005] EMTR 31:

“ 102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

75) It seems to me that the opponents have singularly failed to show that the use of the mark in suit on the goods and services which are dissimilar to its own would cause detriment. I believe that this is a case where use of the mark in suit on the goods and services set out in paragraph 64 may remind some consumers of the opponents’ mark but I do not believe that it would affect the consumers economic behaviour or damage the opponents’ mark by tarnishing or blurring. It seems to my mind to stretch credibility to suggest that consumers will purchase automotive parts, have their wheels repaired or automobile MOT’d simply because they have been reminded of a mark which has a reputation for retailing toys. The opposition under Section 5(3) of the Act fails.

76) The overall effect of my decisions under the various grounds of opposition is that the application will proceed to registration with the following reduced specification:

Class 12: “Bumpers and metallic trims for automobiles; parts and fittings for automobiles vehicles; but not including any of the aforesaid goods for use in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid”;

In Class 37: Refurbishment and fitment of wheels, including alloy wheels; refurbishment and fitment of parts and accessories for wheels; vehicle repair and maintenance; information and advisory services relating to the aforesaid; but not including any of the aforesaid services provided in relation to bicycles, tricycles, motor cycles, scooters or parts and fittings for the aforesaid.

In Class 42: Licensing of intellectual property; franchising; provision of agreements for the aforesaid; franchising compliance; vehicle roadworthiness testing; information and advisory services relating to the aforesaid.

## **COSTS**

77) As the applicant has retained most of the goods and services contained in its application and the opponent having been only marginally successful the applicant is entitled to a contribution towards their costs. Taking all of the circumstances in account I order the opponent to pay the applicant the sum of £1,200. 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 2006**

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