

O-450-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3289684 BY
SHENZHENSHI KANGHAOXIN SUPPLY CHAIN MANAGEMENT LTD**

TO REGISTER THE TRADE MARK:

Manfiter

FOR GOODS IN CLASS 12

AND

**IN THE MATTER OF OPPOSITION TO ITS REGISTRATION
UNDER NO. 412799
BY
MANN+HUMMEL GmbH**

Background and pleadings

1) On 13 February 2018 Shenzhenshi Kanghaoxin Supply Chain Management Ltd (“the Applicant”) applied to register the following trade mark for the following goods:

Manfiter

Class 12: *Anti-skid chains; hoods for vehicles; hub caps; rear view mirrors; bumpers for automobiles; shock absorbers for automobiles; sun-blinds adapted for automobiles; brake pads for automobiles; spare tyre covers; cigar lighters for automobiles; anti-theft devices for vehicles; repair outfits for inner tubes; spikes for tyres; tyres for vehicle wheels; adhesive rubber patches for repairing inner tubes; air pumps [vehicle accessories]; non-skid devices for vehicle tyres [tyres]; luggage carriers for vehicles; valves for vehicle tyres [tyres]; safety belts for vehicle seats; hydraulic circuits for vehicles; windscreen wipers; windshield wipers; windshields; undercarriages for vehicles; upholstery for vehicles; anti-theft devices for vehicles; anti-dazzle devices for vehicles; anti-glare devices for vehicles; anti-theft alarms for vehicles; horns for vehicles; brake linings for vehicles; vehicle covers [shaped]; turn signals for vehicles; covers for vehicle steering wheels*

The application was published for opposition purposes on 16 March 2018.

2) The application is opposed by MANN+HUMMEL GmbH (“the Opponent”). The opposition, which is directed against all the goods applied for, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon the following EU and UK trade mark registrations for the following marks and their respective goods and services:

EU 4473187

(filed on 06 June 2005 and completed its registration procedure on 28 June 2007)

MANN FILTER

Class 4: *Liquids for vehicles and motors, in particular oils, lubricants, additives, coolant, brake fluid.*

Class 7: *Filters and filter systems for motors or engines for the filtration of liquids and gases, in particular oil filters, oil spin-on filters as well as oil filter modules, air filters, fuel filters, in-line fuel filters, in-tank fuel filters, diesel filter modules; centrifuges; filter media of the aforesaid filters.*

Class 11: *Filters and filter inserts, filter elements for oil filters and air filters; cabin air filters, activated carbon filters, tank ventilation filters, urea filters, diesel particulate filters, filters for power steering, filters for braking systems, suspension hydraulic filters, cooling water filters, washer system filters; centrifuges; air-oil separator elements; oil mist separators; air dryer box and/or air dryer box for drying gases by means of liquid absorbents; filters for erosion machines; filter media of the aforesaid filters.*

Class 12: *Filters and filter systems for vehicles, and filter elements for the filtration of liquids and gases, in particular oil filters, oil spin-on filters as well as oil filter modules, air filters, fuel filters, in-line fuel filters, in-tank fuel filters, diesel filter modules; cabin air filters, activated carbon filters; tank ventilation filters, urea filters, diesel particulate filters, filters for power steering, filters for braking systems, suspension hydraulic filters; cooling water filters, washer system filters; centrifuges; air-oil separator elements; oil mist separators; air dryer box and/or air dryer box for drying gases by means of liquid absorbents; filters for erosion machines; filter media of the aforesaid filters.*

Class 37: *Repair, maintenance services for motors, engines and vehicles.*

EU 4602835

(filed on 24 August 2005 and completed its registration procedure on 21 June 2007)

**MANN
FILTER**

Class 4: *Liquids for vehicles and motors, in particular oils, lubricants, additives, coolant, brake fluid.*

Class 7: *Filters and filter systems for motors or engines for the filtration of liquids and gases, in particular oil filters, oil spin-on filters as well as oil filter modules, air filters, fuel filters, in-line fuel filters, in-tank fuel filters, diesel filter modules; centrifuges; filter media of the aforesaid filters.*

Class 11: *Filters and filter inserts, filter elements for oil filters and air filters; cabin air filters, activated carbon filters, tank ventilation filters, urea filters, diesel particulate filters, filters for power steering, filters for braking systems, suspension hydraulic filters, cooling water filters, washer system filters; centrifuges; air-oil separator elements; oil mist separators; air dryer box and/or air dryer box for drying gases by means of liquid absorbents; filters for erosion machines; filter media of the aforesaid filters.*

Class 12: *Filters and filter systems for vehicles, and filter elements for the filtration of liquids and gases, in particular oil filters, oil spin-on filters as well as oil filter modules, air filters, fuel filters, in-line fuel filters, in-tank fuel filters, diesel filter modules; cabin air filters, activated carbon filters; tank ventilation filters, urea filters, diesel particulate filters, filters for power steering, filters for braking systems, suspension hydraulic filters; cooling water filters, washer system filters; centrifuges; air-oil separator elements; oil mist separators; air dryer box and/or air dryer box for drying gases by means of liquid absorbents; filters for erosion machines; filter media of the aforesaid filters.*

Class 37: *Repair, maintenance services for motors, engines and vehicles.*

UK 1444881

(filed on 29 September 1990

and completed its registration procedure on 21 August 1992)

**MANN
FILTER**

Class 7: *Filters for gaseous and liquid substances, air, gases, fuels and oils, for engines and vehicle engines intended for fixed installation; filter inserts, wholly or partially formed from paper, cardboard, felt, kieselguhr and diatomaceous earth and ceramic substances, and from cloths, woven articles and knitted articles formed from metals as well as from natural and synthetic fibres; parts for all the aforesaid goods; all included in Class 7.*

EU 4754453

(filed on 22 November 2005

and completed its registration procedure on 15 March 2007)



Class 4: *Liquids for vehicles, motors and engines, namely industrial oils, non-chemical additives for fuels and propellants.*

Class 7: *Filters for motors, engines or machines, for the filtration of liquids and gases, in particular oil filters, oil change filters and oil filter modules, air filters, fuel filters, inline fuel filters, intank fuel filters, diesel filter modules; diesel soot filters; cooling water filters, activated carbon filters, tank ventilation filters, filters for steering hydraulics, filters for brake hydraulics, filters for chassis hydraulics, windscreen water filters; filter elements being exchangeable parts for filters, for use in filter housings for the aforesaid filters; centrifuges; filters for erosion machines; oil mist separators; air separator elements; drying agent boxes for de-oiling gas flows.*

Class 11: *indoor air filters; drying agent boxes and chambers for drying gases using liquid-absorbing substances; drying agent boxes for drying gas flows.*

Class 12: *Filters for land vehicles and filter elements being exchangeable parts for filters, for use in filter housings for the filtration of liquids and gases.*

EU 4534641

(filed on 11 July 2005 and completed its registration procedure on 26 February 2009)

MANN

Class 4: *Liquids for vehicles and motors, in particular oils, lubricants, additives, coolant, brake fluid.*

Class 7: *Filters and filter systems for motors or engines for the filtration of liquids and gases, in particular oil filters, oil spin-on filters as well as oil filter modules, air filters, fuel filters, in-line fuel filters, in-tank fuel filters, diesel filter modules; centrifuges; filter media of the aforesaid filters.*

3) The significance of the respective dates given above is that (1) all the Opponent's marks constitute earlier marks in accordance with section 6 of the Act, and (2) they are all subject to the proof of use conditions contained in section 6A of the Act, their respective registration procedures all having been completed more than five years before the publication of the Applicant's mark.

4) The Opponent is represented by Forresters IP LLP. The Applicant is represented by The Trade Marks Bureau. The Opponent claims that the mark applied for is highly similar to the earlier marks, that it is registered for highly similar goods and services, and that there consequently exists a likelihood of confusion, including a likelihood of association between them. The Applicant filed a notice of defence and counterstatement, denying the grounds of opposition, and requiring proof of use of all the earlier marks relied on. The period during which genuine use of the marks must be proved ("the relevant period") is 17 March 2013 to 16 March 2018.

5) Only the Opponent filed evidence. The Applicant filed written submissions during the evidence rounds. Neither party requested a hearing, and the Opponent filed written submissions in lieu of attendance at a hearing. I therefore give this decision after a careful review of all the papers before me.

The evidence

6) In a witness statement of 5 November 2018 Mr Jörg Engels states that he is the Opponent's Director of Brand Management for the Automotive Aftermarket. His further statements can be summarised as follows:

7) The Opponent develops, produces and distributes liquid and air filter systems, intake systems and thermal management components. Additional products includes power train and engine plastic components, such as manifolds, ducts and cylinder head covers with integrated functions for the automotive industry, and aftermarket filter elements for maintenance and repair of motor vehicles under several brands, including MANN FILTER. About 90% of the Opponent's annual sales, which in 2017 were listed at € 3.892 billion, related to activity in the automotive industry. Its company and its subsidiaries have more than 80 locations worldwide and in 2017 employed over 20,000 people throughout the world. Whilst the first goods produced by the company were fabric air filters in Ludwigsburg, today, more than 7 decades later, it is the global market leader for filtration, with locations on all continents.

8) Mr Engels says that rather than provide proof of use in relation to all EU member states, he will provide information in relation France, Germany, Spain and the UK. He provides the following tables of sales figures in respect of the relevant period:

Country	Year	Net Sales (Euros)
France	2013	29,597,040
France	2014	25,643,108
France	2015	28,622,650
France	2016	31,277,507
France	2017	35,879,848
France	2018 (to end September)	25,443,029

Country	Year	Gross Sales (Euros)
Germany	2013	76,246,322
Germany	2014	74,539,666
Germany	2015	76,715,317
Germany	2016	83,221,813
Germany	2017	86,877,729
Germany	2018 (to end September)	66,833,049

Country	Year	Gross Sales (Euros)
Spain	2013	55,185,244
Spain	2014	61,007,538
Spain	2015	63,272,779
Spain	2016	64,332,900
Spain	2017	67,232,273
Spain	2018 (to end September)	53,269,174

Country	Year	Net Sales (GBP)
United Kingdom	2013	23,659,657
United Kingdom	2014	43,120,190
United Kingdom	2015	42,279,326
United Kingdom	2016	43,199,321
United Kingdom	2017	43,028,172
United Kingdom	2018 (to end September)	36,234,664

Mr Engels continues:

“The products market under the MANN FILTER trade mark, (and here I refer generally to all four trade marks for which proof of use is required - thus I include the MANN trade mark, MANN FILTER,  and ) include filters and filter systems for motors or engines, fuel filters, in tank fuel filters, diesel fuel filter modules, centrifuge filters, cabin air filters, filters for power steering braking systems, hydraulic suspension, oil mist separators and filters and filter systems for vehicles to include in tank fuel filters, diesel filter modules, cabin air filters activated carbon filters, tank ventilation filters, dieselparticulate filters and the like.”

9) Mr Engels supports the information he gives above with 27 exhibits containing sample invoices, advertising and promotional materials and catalogue excerpts for the French, German, Spanish and UK markets respectively, and evidence of representation at trade Exhibitions aimed at these markets, all relating to the relevant period. I shall refer to these exhibits, as appropriate, in the course of my assessment.

Proof of use

10) At paragraph 3 of its written submissions of 1 March 2019 the Applicant submits that *“It should firstly be noted that the majority of the evidence is shown in French, German and Spanish. The Opponent’s evidence not in English must be struck out....”*. While it is true that the information which can be drawn from documents in foreign languages is obviously restricted by linguistic considerations, this does not mean that they are of no probative value. Thus, the types of product supplied under the invoices to customers in Germany and Spain can be deduced from the abbreviations preceding the product numbers given in the invoices, together with the key provided from the relevant catalogue. The advertisements shown in French on pages 3 and 9 of Exhibit JE2 clearly correspond to those shown in an English version on page 1 of Exhibit JE23; and so on.

11) At paragraph of 16 of its written submissions of 1 March 2019 the Applicant, having referred to the UK-related invoices, brochures, advertisements, catalogues and other materials in the Opponent’s evidence, contends that *“the Tribunal should restrict the Opponent’s goods, according to the proof of use, to ‘oil filter elements; oil filters; secondary spin-on fuel filters; air filter elements; diesel particle filters, air filters, urea emission filters for vehicles; vehicle filters’ ”*. In so doing the Applicant appears to concede that there has been genuine use of the Opponent’s marks in respect of those goods. In its written submissions in lieu of attendance at a hearing the Opponent rejects the restriction of the goods and services on which it can rely to those listed by the Applicant, insisting that *“the Opponent has shown use of its earlier trade marks in relation to all goods and services covered”*. Mr Engels does not explicitly specify which marks have been used in connection with which goods, so it seems one must take him as asserting that all have been used on all the goods and services of the respective specifications.

12) There is no evidence that the Opponent has provided any of the goods in any of its specifications in Class 4. There is no evidence that the Opponent has provided any of the services in any of its Class 37 specifications. Mr Engels states that about 90% of the Opponent’s annual sales in 2017 related to activity in the automotive industry. The material provided in Exhibit JE1 includes a reference to ventilation and

air conditioning systems and water treatment systems, but no more specific or concrete evidence relating to such goods is provided in the Opponent's evidence. With the exception of cabin air filters, which I shall consider later, the products which are proper to Class 11 do not include those automotive filter products covered by the Opponent's evidence. Similarly, the goods proper to Class 12 do not include those automotive filter products covered by the Opponent's evidence, the latter being proper to Class 7. I shall have more to say on this later.

13) In its written submissions of 1 March 2019 the Applicant appears to have accepted that – in respect only of the goods listed by the Applicant – there has been genuine use of all the earlier marks with the exception of EU4534641: *“Furthermore, the Opponents evidence does not prove any use of the term MANN without any other elements. Subsequently, the Tribunal should strike out the Opponent's claims in accordance with the earlier EU Trade Mark Registration No. 4534641 MANN.”*

14) Insofar as the Applicant has apparently conceded that there has been genuine use of the Opponent's earlier marks (with the exception of EU4534641) in respect of the goods listed by the Applicant, I consider the concession to be a sensible and justified one. For the avoidance of doubt, however, and in order to take into consideration other items I found referred to in the evidence, and so as to provide clarity as to the particular marks in respect of which use is found, I will describe my findings on what marks have been used and which goods they have been genuinely used on.

15) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (*“Walton”*) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009]

ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the

form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a

genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

[.....]

118. *The law with respect to genuine use in the Union.* Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark “in the Union”. In this regard, the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:

(9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]-[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50].

16) The Applicant suggests that in my assessment of genuine use the vehicle filters on which the Opponent has shown use should be restricted to oil filter elements, oil filters, secondary spin-on fuel filters, air filter elements, diesel particle filters, air filters

and urea emission filters. In addition to the products listed by the Applicant I identified only a few further items in the evidence showing products supplied by the Opponent in the relevant period: spin on oil filters, spin on fuel elements, spin on filters for secondary flow or combined primary secondary flow, spin on lubricating oil filters, and cabin air filters. These do not appear to expand very significantly on the list compiled by the Applicant.

17) None of the earlier marks appear on any of the invoices; but the catalogues in which the products are listed show use of EU 4754453 on the product packaging of the invoiced goods (see page 1 of Exhibit JE6, page 97 of Exhibit JE9, page 7 of Exhibit JE15 and page 53 of Exhibit JE22). The mark is also consistently and prominently used in the Opponent's advertising and promotional material. I find that the Opponent has used EU 4754453 on all the following products for use in land vehicles: oil filter elements, oil filters, secondary spin-on fuel filters, air filter elements, diesel particle filters, air filters, urea emission filters, spin on oil filters, spin on fuel elements, spin on filters for secondary flow or combined primary secondary flow, spin on lubricating oil filters, and cabin air filters.

18) Whenever the Opponent's brand is referred to in the text of the advertising and promotional material – which is frequently – and in the catalogues in which the products at issue are listed, it is always and without exception written as MANN-FILTER. This usage is constant and invariable in the texts of all the material filed for all four of the EU countries represented in the evidence. The use of the hyphen has become a very hit-and-miss affair in modern English usage. I think that many consumers, including those who encounter the mark regularly, would not be able to say with certainty, unless they happened to be actually looking at the mark at the time, whether there was a hyphen or simply a gap between the words MANN and FILTER in the Opponent's mark. Even if they noticed, they would not, in my view, attribute any distinctive significance to the presence or absence of the hyphen¹; they would regard it as the same mark. Accordingly, I find that the Opponent has also used EU 4473187 on all the products for use in land vehicles which I have listed in paragraph 17, above.

¹ See the observations of Mr Richard Arnold, QC (as he then was) sitting as the Appointed Person in *Nirvana Trade Mark*, BL O/262/06 at paragraphs 33-34.

19) Although the sales figures reproduced in paragraph 8 above do not contain a break-down by product, viewing the evidence in the round, including the evidence of sales and product promotion in France, Germany, Spain and the UK, and the information provided in Mr Engels' witness statement, and applying the principles identified by Arnold J in points 1-11 of his summary of the relevant law in *Walton*, I am satisfied that there has been genuine use in the EU of both EU 4754453 and EU 4473187 during the relevant period on all the products I have listed in paragraph 17. I therefore think it appropriate to begin my assessment of the competing marks by comparing the Applicant's mark with EU 4754453 and EU 4473187, before then going on to consider the other earlier marks more briefly.

A fair specification

20) In paragraphs 17 and 18 above I have found genuine use of both EU 4754453 and EU 4473187 in respect of a range of automotive filter parts for the filtration of air, oil and fuel in the oil, fuel and exhaust systems of vehicle engines. I bear in mind that a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration²; and that, in framing a fair specification I must identify and define not the particular examples of goods or services for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify in accordance with to the perceptions of the average consumer³.

21) The Opponent's specification in Class 7 for EU 4473187 begins "*Filters and filter systems for motors or engines for the filtration of liquids and gases, in particular ...*". The Opponent's specification in Class 7 for EU 4754453 begins "*Filters for motors, engines or machines, for the filtration of liquids and gases, in particular ...*". In both cases, the general description is followed by a list of examples, some of which expressly describe specific products for which I have found use, and some not. The respective examples, however, do not in any case limit the generality of the opening words. In the case of EU 4754453 the specification in Class 7 also expressly includes *filter elements being exchangeable parts for filters, for use in filter housings*

² See *Maier v Asos Plc* [2015] EWCA Civ 220 at paragraphs 56 and 60.

³ See *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.

for the aforesaid filters; however, I consider that these elements are in any case covered by the generality of the opening words of the specifications of both marks in Class 7.

22) Many terms of the specifications in Class 7 are repeated in Classes 11 and 12 of EU 4473187 and in Class 12 of EU 4754453. With the exception of *cabin air filters*, which are proper to Class 11, and which are included in the specification in Class 11 of EU 4473187, filters for the motors or engines of land vehicles are proper to Class 7 rather than Classes 11 or 12. Nevertheless, since the specifications in Class 12 expressly refer to filters for land vehicles, I consider that goods falling within them for which genuine use has been shown may be relied upon⁴. This point is not of any practical significance, however, since I consider that all the goods for which I have found genuine use (including urea filters, which are expressly mentioned in Class 12 of EU 4473187) are in any case covered by the specifications in Class 7 of both the earlier marks. The filters proper to Class 7 also include those used in motors and engines other than for land vehicles; since I have found use only in relation to those for use in in land vehicles, it is appropriate to limit the specification accordingly.

23) Bearing all this in mind, I consider the following to be fair specifications:

EU 4473187

Class 7: *Filters and filter systems for motors or engines of land vehicles for the filtration of liquids and gases, in particular oil filters, oil filter elements, oil spin-on filters as well as oil filter modules, air filters, air filter elements, fuel filters, secondary spin on fuel filters, diesel filter modules, urea emission filters.*

Class 11: *Cabin air filters*

EU 4754453

Class 7: *Filters for motors or engines of land vehicles, for the filtration of liquids and gases, in particular oil filters, oil filter elements, oil spin on filters,*

⁴ In taking this view I bear in mind the observations of the Court of Appeal in *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA), Arnold J in *Omega 1* [2010] EWHC 1211 (Ch) and *Omega 2* [2012] EWHC 3440 (Ch) and Carr J in *Pathway IP Sarl v Easygroup Ltd*, [2018] EWHC 3608 (Ch).

oil change filters and oil filter modules, air filters, fuel filters, secondary spin on fuel filters, diesel filter modules, urea emission filters; filter elements being exchangeable parts for filters, for use in filter housings for the aforesaid filters.

24) I have found that there has been genuine use of EU 4473187 on cabin air filters during the relevant period, and that the Opponent may therefore rely on *cabin air filters* in its specification in Class 11 under this mark. Cabin air filters are not covered in Class 11 of the Opponent's specification for EU 4754453 nor, being proper to Class 11, in any other Class of the specification of that mark, and may not be relied on under that mark. It may be helpful to add, however, that I do not think that this is of any real practical significance in this case. The Opponent's case with regard to comparison of goods rests on its reliance on a range of automotive filter elements and components for the filtration of air, oil and fuel in the oil, fuel and exhaust systems of land vehicle engines. The specifications which I have allowed in Class 7 provide an ample basis for this, even without the inclusion of *cabin air filters*.

Section 5(2)(b)

25) Section 5(2)(b) of the Act reads as follows:

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

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

26) The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case

C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

The average consumer and the purchasing process

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

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

28) Apart from vehicle manufacturers, consumers of the various filters, parts and accessories covered by the Applicant's and the Opponent's specifications will consist either of vehicle owners – whether commercial or private – or businesses which fit parts to automobiles and vehicles (which, in addition to commercial garages may include specialist retailers who are prepared to advise and assist customers with installation and fitting). Many consumers, however, will nowadays prefer to have vehicle parts and accessories fitted for them by garages or specialist retailers. Consumers who fit their own parts and accessories are likely to consist either of motor car enthusiasts or of less well-off consumers (whether private persons or small commercial businesses, e.g. sole traders) who wish to economise on labour costs. In addition to national chains, enterprises of various sizes function as commercial garages fitting parts and accessories, including small businesses and mechanics working as sole traders.

29) There is no specific evidence on how much the products cost. However, in my experience the costs may vary from being not especially high to being very expensive when certain items are purchased for use on more luxurious or specialist vehicles. Therefore, the selection of components for vehicle engines will call for a reasonably high level of attention to ensure that the goods have the required functionality and technical compatibility, are suitable for the particular intended vehicle model, etc. Similar considerations, albeit perhaps to a slightly lower level, will apply to items like tyres or windscreen wipers. No more than a medium degree of care will be paid in the purchase of items such as shaped vehicle covers, and goods such as steering wheel covers will be comparatively casual purchases.

30) Large commercial users of vehicles and large garage chains may obtain components and accessories from the manufacturer or through distributors or wholesale channels. In the case of smaller business or private consumers the goods are most likely to be obtained by self-selection from the shelves of a specialist retail outlet, or from printed or online catalogues, etc., so visual considerations will play an important role in the selection process. Advice may also be sought from retailer or garage staff, adding an aural component to the purchasing process in retail premises. Moreover, small garage businesses, such as sole trader mechanics, are unlikely to maintain large stocks of parts and accessories. They are more likely to

order parts as required by telephone – for example telephoning to make sure that a part is available in a depot or retailer’s stock before setting out to pick it up for a job. Similarly, private consumers may also ring a retailer or garage to check on the availability of an item before visiting to collect it or have it fitted. Thus, both visual and aural factors may play a part in the purchasing process.

Comparison of goods

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

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

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

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

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

33) In the written submissions it filed in the evidence rounds the Applicant provides for each item in the specification of the contested application a detailed and helpful explanation of what the Applicant considers to be the precise nature and purpose of that item, and contrasts this with the precise nature and purpose of the goods relied on by the Opponent, which it characterizes as “... *filters for vehicles that are essential, not optional, for the correct maintenance and operation of vehicle engines*”, adding that “*The purpose of the Opponents goods are to filter air, oils or fuel*”. The Opponent has provided no detailed term-by-term comparison of the goods. Instead, it simply observes in general that the Applicant’s goods “*are aimed at the vehicle market and in some cases more specifically at the automobile market*” and that “*The earlier trade marks cover goods and services which all relate back to the automobile market, vehicle market in general and the motor and engine market, which is of course linked very closely to the vehicle market as motors and engines form parts of vehicles*”.

34) The Applicant contends:

“... *In Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court stated that "complementary" means:*

" ... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for those goods lies with the same undertaking".

21. The term 'indispensable', according to Collins Dictionary, means that something is absolutely essential to another which cannot function without them. The Opponents goods, in particular, are filters for vehicles. Although these products could fall into the general description of spare parts for vehicles this would go against the test for assessing similarity between goods

by automatically labelling them as similar goods because this would encompass of huge arrange of goods which, although could be considered a vehicle spare part, do not have the same nature and purpose, distribution channels, sales outlets, producers, and methods of use.

22. The Tribunal must therefore consider whether the Opponents goods can function without the Applicants goods and vice versa.”.

35) The Applicant further contends that the channels of trade for the Applicant's goods are different from those of the Opponent. The Opponent's vehicle filters, it submits, could be purchased in retail outlets specialising in vehicle spare parts or they could be fitted without selection by the consumer when a vehicle undergoes routine maintenance at a garage. The Applicant's goods, it says, when sold in a retail outlet specialising in vehicle spare parts, would not be sold side-by-side with filters for vehicles; they would be sold on different shelves and different areas of a retail outlet.

36) The Opponent submits that *“It is usual for manufacturers of goods for the automobile market to provide a large variety of goods for various uses on vehicles; and consumers are used to seeing trade marks for different goods linked to the automobile market throughout retail stores such as Halfords. An example may be CONTINENTAL that is well known for providing brake systems, interior electronics, automotive safety goods, power train and chassis components, tachographs, tyres and other parts for the automotive industry. Just as the CONTINENTAL trade mark may be seen to provide a broad range of goods, it can also be concluded that the range of goods covered by the Applicant's mark itself is wide reaching, and again all goods would be available in a retail store such as HALFORDS!”.* The Applicant, by contrast, observes repeatedly in its term-by-term comparison that *“There is no evidence to suggest that [the goods in question] are manufactured by the same manufacturer of filters for vehicles”.* Neither party has filed evidence on this point.

37) In the absence of evidence to assist me, I must form my own view on the similarity or otherwise of the respective goods. In doing so I must consider the

factors set out in the case law outlined above, and am able to draw upon commonly known facts.

38) I begin by observing that the interpretation which the Applicant puts on complementarity in the case law (“*whether the Opponent’s goods can function without the Applicant’s goods and vice versa*”) is too narrow. The test in *Boston Scientific* is whether “*there is a close connection between them [i.e. the goods compared], in the sense that one is indispensable or important of the use of the other in such a way that consumers may think that the responsibility for those goods lies with the same undertaking.*”

39) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’, and therefore similar to a degree, in circumstances where the nature and purpose of the respective goods and services were very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods or services is to assess whether the relevant public are liable to believe that responsibility for the goods or services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander, Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

40) I will make the comparison with reference to the Applicant’s goods. I will go through them term by term, but grouping them together where it is useful and reasonable to do so (see the comments of the Appointed Person in *Separode* BL O-

399-10). The specifications which I have allowed the Opponent in Class 7 are as follows:

EU 4473187

Filters and filter systems for motors or engines of land vehicles for the filtration of liquids and gases, in particular oil filters, oil filter elements, oil spin-on filters as well as oil filter modules, air filters, air filter elements, fuel filters, secondary spin on fuel filters, diesel filter modules, urea emission filters.

EU 4754453

Filters for motors or engines of land vehicles, for the filtration of liquids and gases, in particular oil filters, oil filter elements, oil spin on filters, oil change filters and oil filter modules, air filters, fuel filters, secondary spin on fuel filters, diesel filter modules, urea emission filters; filter elements being exchangeable parts for filters, for use in filter housings for the aforesaid filters.

I consider that the Opponent's case with regard to comparison of goods rests on its automotive filter components for the filtration of air, gases, oil and fuel in the oil, fuel and exhaust systems of land vehicle engines. It will be seen that both the above specifications cover this range of goods. For the sake of brevity, I shall refer below simply to "the vehicle filter elements and components covered by the Opponent's specifications in Class 7".

Shock absorbers for automobiles; brake pads for automobiles; hydraulic circuits for vehicles; brake linings for vehicles.

41) The Applicant points out that the nature and purpose of these goods is respectively: to absorb and damp shock; to enable vehicles to slow down and stop; and to supply hydraulic pressure and fluid to a vehicle's braking components to enable the braking system to operate correctly. It contrasts these with the nature and purpose of the Opponent's vehicle filter elements and components, which it (correctly) describes as being to filter air, gases, oils or fuel. It submits that the goods in question are not usually sold side-by-side and that there is no evidence to

suggest that the consumer will assume that they originate from the same undertaking.

42) I consider that the Applicant takes too narrow a view of consumer perceptions both of complementarity and when comparing the nature and purpose of these goods. The purpose of the comparison is to assess whether the relevant public is liable to believe that responsibility for the goods lies with the same undertaking. Not only professional mechanics but many other consumers will be aware, for example, that filters are used not only in oil, fuel and exhaust systems but also in hydraulic systems, including those used in hydraulic brakes or dampers. Even those who are not so aware will perceive a common general nature and purpose in what one might term “under-the-bonnet” components and parts which, to use the Applicant’s expression, are essential, not optional, for the correct maintenance and operation of vehicle engines. Moreover, I do not think that they will perceive a great difference in nature and purpose between, for example, hydraulic circuits, including hydraulic braking systems, and brake pads or brake linings for vehicles, whether or not they are sold side by side. Bearing all this in mind, I find that there is a high degree of similarity between the vehicle filter elements and components covered by the Opponent’s specifications in Class 7 and the Applicant’s *shock absorbers for automobiles; brake pads for automobiles; hydraulic circuits for vehicles; brake linings for vehicles*.

Undercarriages for vehicles

43) The Applicant submits that the undercarriage of a vehicle is commonly referred to as the 'chassis'; that, for commercial vehicles, a rolling chassis consists of an assembly of all the essential parts of a truck (without the body) to be ready for operation on the road; and that commercial vehicle manufacturers sell "chassis only", "cowl and chassis" and "chassis cab" versions that can be “outfitted” with specialised bodies, including motor homes, fire engines, ambulances, box trucks. It contends: that a vehicle undercarriage, or chassis, has a different use and purpose from the Opponent’s vehicle filter elements and components; there is no evidence to suggest that the manufacturer of a vehicle undercarriage, or chassis, whether rolling

undercarriages or otherwise also manufactures vehicle filters; and that these goods are not sold side-by-side and are not complementary.

44) In making my comparison, however, I bear in mind that the Opponent's vehicle filter components are essential to the operation of the "running gear" of a "rolling chassis", giving rise to a certain degree of complementarity. Furthermore, undercarriages for vehicles would, for example, include sub-frames, which are used extensively on cars and some commercial vehicles. These are parts which periodically require changing and are usually "bolt on". They could be fitted by a garage or, with some care, by a private vehicle owner or small business. As such, they have a degree of similarity with the Opponent's vehicle filter elements and components, in that they would be similarly inspected when a vehicle is undergoing a service, and possibly changed if required – if for instance they showed signs of significant corrosion. They have at least in general terms a common nature and purpose, to the extent that they fall into that less accessible "under-the-bonnet" category of essential components which serve the fundamental operation of a vehicle.

45) It would in my judgment be natural for consumers in the automotive aftermarket for vehicle components not supplied by the original vehicle manufacturer to expect that some brands may specialise in specific parts while others cover a broader range of components, particularly where a brand expands to establish a particular profile for quality, price, durability, etc. for automotive aftermarket components generally. Whether or not they are "sold side by side", I consider that the average consumer will see a likelihood that such products might originate with an undertaking which also provides the vehicle filter elements and components covered by the Opponent's specifications in Class 7. I find that there is at least a medium degree of similarity between the Opponent's vehicle filter elements and components and the Applicant's *undercarriages for vehicles*.

Anti-skid chains; hoods for vehicles; rear view mirrors; bumpers for automobiles; spikes for tyres; tyres for vehicle wheels; non-skid devices for vehicle tyres [tyres]; valves for vehicle tyres [tyres]; windscreen wipers; windshield wipers; windshields; horns for vehicles; turn signals for vehicles.

46) For these (and for all the goods of the Applicant's specification) the Applicant deploys similar arguments with regard to differing purpose and use, channels of trade, complementarity, and lack of evidence that producers of the Opponent's vehicle filters also produce the above goods. Unlike the goods I have assessed in paragraphs 41-45, the above goods do not consist of the more inaccessible under-the-bonnet components essential to the functioning of the engine itself. Nevertheless, while agreeing that their specific functions differ from the specific functions of the Opponent's vehicle filter elements and components, I think they may still be said to share with them a general common purpose and nature in the eyes of the average consumer, insofar as they all serve the basic functioning of the vehicle itself on the road. Here again, bearing in mind the nature of the automotive "aftermarket" for motor vehicle components and accessories, whether or not they are "sold side by side", I consider that the average consumer might well see a likelihood that such products might originate with an undertaking which also provides the vehicle filter elements and components covered by the Opponent's specifications in Class 7.

47) Overall, I consider that there is a medium degree of similarity between the Opponents vehicle filter elements and components and the Applicant's *anti-skid chains; hoods for vehicles; rear view mirrors; bumpers for automobiles; spikes for tyres; tyres for vehicle wheels; non-skid devices for vehicle tyres [tyres]; valves for vehicle tyres [tyres]; windscreen wipers; windshield wipers; windshields; horns for vehicles; turn signals for vehicles.*

Safety belts for vehicle seats; anti-dazzle devices for vehicles; anti-glare devices for vehicles

48) As the Applicant points out, vehicle safety belts are usually installed in a vehicle at the point of vehicle manufacture although it is possible to purchase vehicle safety belts from specialist retail outlets. Anti-dazzle devices for vehicles and anti-glare devices for vehicles are either electronic devices that are installed in a vehicle to control its headlighting system to avoiding dazzling oncoming vehicles, or incorporated into the rear view mirror of a vehicle to enable it to automatically dim in

dark lighting conditions to avoid the driver being dazzled by the headlights of a vehicle from behind. These products are not usually installed by the average consumer in the UK, instead usually being installed at the point of vehicle manufacture or by specialist installers following an accident or fault.

49) Although *safety belts for vehicle seats* do not strictly serve the basic functions of the vehicle itself, I think there is a sense in which, being essential to enable a vehicle to be driven legally on the road, consumer perceptions would tend to place them in the same bracket. Similarly, by virtue of their general nature and purpose of allowing a vehicle to be driven safely I consider that the consumer would also tend to place *anti-dazzle devices for vehicles* and *anti-glare devices for vehicles* in a similar kind of bracket with those goods serving the basic functioning of the vehicle itself on the road. I consider *safety belts for vehicle seats; anti-dazzle devices for vehicles; anti-glare devices for vehicles* to have a medium degree of similarity with the Opponent's vehicle filter elements and components.

Repair outfits for inner tubes; adhesive rubber patches for repairing inner tubes; air pumps [vehicle accessories]

50) The Applicant submits that the purpose and function of these relate to fixing bicycle tyres, that a motor vehicle does not have an inner tube, and that it is therefore clear that these goods are used specifically for bicycle tyres. In fact, however, inner tubes are sometimes used in motor vehicle tyres as a cheap way of repairing punctures. Like the tyres they relate to, I consider them, and the pumps used to inflate them, to have a medium degree of similarity with the Opponent's vehicle filter elements and components.

Hub caps; spare tyre covers; anti-theft devices for vehicles; anti-theft alarms for vehicles; vehicle covers [shaped]

51) These goods differ from those I have considered in paragraphs 46-47 in that, while desirable, they do not serve the essential basic functioning of the vehicle itself on the road. They are optional add-ons. In the absence of submissions o evidence

from the Opponent, I find that they have a low degree of similarity with the Opponent's vehicle filter elements and components.

Sun-blinds adapted for automobiles; cigar lighters for automobiles; luggage carriers for vehicles; upholstery for vehicles; covers for vehicle steering wheels

52) These items serve the comfort or convenience of the driver and passengers rather than the essential functions or efficient and safe operation of the vehicle itself. Their purpose and nature is further removed from the Opponent's vehicle filter elements and components than those I have discussed above. Theoretically, I suppose it might be argued that the Opponent's *cabin air filters* in Class 11 also serve the general purpose of the comfort and wellbeing of driver and passengers. However, although cabin air filters do not relate to the functioning of the engine itself, I think that consumer perceptions, including those of professional mechanics, will tend to bracket them with what I have termed "under-the-bonnet" components such as the Opponent's vehicle filter component in Class 7, and I consider that they do not offer the Opponent's any material advantage over its specifications in Class 7 for the purposes of comparison with the above goods. There is, at best, a low degree of similarity between the Opponent's vehicle filter elements and components in Class 7 and *sun-blinds adapted for automobiles; spare tyre covers; cigar lighters for automobiles; luggage carriers for vehicles; upholstery for vehicles; vehicle covers [shaped]; covers for vehicle steering wheels*.

Comparison of the marks

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

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

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

55) The marks to be compared are shown below:

The opposed mark	The earlier mark EU 4473187	The earlier mark EU 4754453
Manfiter	MANN FILTER	

The figurative element of EU 4754453 does make some contribution to the distinctive character of the mark, but its distinctive character and overall impression lies predominantly in its word element. In both earlier marks the word FILTER is descriptive of filter components, and it is the initial word MANN on which the weight of the distinctive character falls. Nevertheless, the assessment of the similarity between the signs at issue cannot be confined to taking one component of the earlier marks and comparing it with the opposed mark, but rather by examining each of the marks in question as a whole, taking account in particular of their distinctive and dominant elements ⁵. The CJEU has consistently emphasised that with regard to the visual, phonetic or conceptual similarity of the marks at issue the assessment

⁵ See *BGW*, C-20/14, EU:C:2015:714, paragraph 36 and the case-law cited.

must be based on the overall impression created by them. The word FILTER takes up half of both the earlier marks visually, constitutes two of the marks' three syllables aurally, and makes a substantial contribution to the overall impression, both visually and aurally, of both marks, but I do not consider either word to dominate the other in its overall impression. The opposed Mark consists of the one word MANFITER, its distinctive character and overall impression resting in the whole mark.

56) In making my visual comparison of the opposing marks I bear in mind that notional and fair use both of the opposed mark and of EU 4473187 would include use in both upper and lower case⁶, so letter case is irrelevant to the comparison; but I do not anyway consider that letter case in itself would play a significant role in consumer perception of the marks. The opposed mark being a word mark not limited to colour, it would be registered in all colours⁷, lessening the significance of colour in the comparison.

57) There is a well settled rule of thumb in the case law that the consumer normally attaches more importance to the beginnings of word marks. This is no more than a rule of thumb. Each case must be considered on its merits. My assessment must take account of the overall impression created by the marks⁸. In this case I think it is useful to bear it in mind. It is also settled case law that, when perceiving a word sign (or the word element of a figurative sign), a consumer will break it down into elements which, for him, suggest a concrete meaning, or which resemble words

⁶ See *Peek & Cloppenburg v OHIM*, T-386/07 at paragraph 47 and *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, C-291/0 at paragraph 54.

⁷ See *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2014] EWCA Civ 1294 at paragraph 5 and *Starbucks v EUIPO*, T-398/16 at paragraphs 53-54.

⁸ Cf. *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-438/07:

"23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM – Audi (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them."

known to him⁹. I also bear in mind the well-known tendency of the human eye to see what it expects to see and the human ear to hear what it expects to hear¹⁰.

58) Although the opposed mark is written as one word, the consumer will recognise that it begins with the word “Man”, and is followed by a second element which may receive relatively less attention than the beginning of the mark. I think that many consumers may see the second part of the mark as “fitter”; the more observant among them may notice that it is not. I do not consider, however, that the extra N, followed by a gap between the words, in the earlier marks, or the omission of an L in the opposed mark, create substantial visual differences. Overall, I consider there to be a high degree of visual similarity between the opposed mark and EU 4473187. The figurative elements of EU 4754453 do add a further aspect of difference but, as I have already observed, its distinctive character lies very predominantly in its word element, and the colour element is of limited significance. Overall, I consider that the degree of visual similarity between the opposed mark and EU 4754453 can also be described as high.

59) The figurative element in EU 4754453 will have no significance for the pronunciation of the mark. MANN in both earlier marks will clearly be pronounced as the word “man”. FILTER will be pronounced in the normal way. The beginning of the Applicant’s mark will also be pronounced as the word “man”. Of those consumers who actually notice that the second two syllables of the contested mark consist of FITER, it is conceivable that some may pronounce them like the word “fighter”. I think the great majority of these consumers, however, will pronounce them like the word “fitter”. Moreover, as I have observed I consider that many consumers will mis-read FITER as “fitter”, and will pronounce this element of the Applicant’s mark accordingly. Overall, I find there is a high degree of aural similarity between the opposed mark and both earlier marks.

⁹ See the judgments in *ARTI*, T-12/13 paragraph 69, *RESPICUR*, T-256/04, paragraph 57, and *COR Sitzmöbel Helmut Lübke v OHIM — El Corte Inglés (COR)*, T-214/09, paragraph 46 *Vitakraft-Werke Wührmann v OHIM — Krafft (VITAKRAFT)*, T-356/02, paragraph 53

¹⁰ See in this connection the comment of Arnold J at paragraph 120 in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11 on the tendency of the human eye to see what the brain expects it to see.

60) The figurative element of EU 4754453 is of no conceptual significance. In both earlier marks the two N's in the word MANN mean that it will be seen as a surname, but it will also inevitably evoke the concept "man", as will the first syllable of the opposed mark, including where the mark as a whole is seen simply as an invented word. Those consumers who actually notice that the second part of the opposed mark is FITER may see no conceptual content in it, or they may see it as a misspelling of the word "fitter". I have already observed that many consumers will misread the second part of the opposed mark as FITTER. In this case there will be an element of conceptual difference from the earlier marks. It is conceivable that for some consumers MANFITER may evoke the concept of goods being fitted by a man, but the meaning is not a very clear one. Thus, there are potentially elements of both conceptual similarity and conceptual difference between the marks. The question of how the overall conceptual similarity of the marks is to be assessed is not a straightforward one, and I shall return to this point when I come to make my global assessment of the likelihood of confusion.

The distinctiveness of the earlier mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

62) FILTER is clearly descriptive of the Opponent’s vehicle filter elements and components. MANN is neither descriptive nor allusive of them. Overall, EU 4473187 is of average distinctiveness. Though the figurative elements of EU4754453 do make some contribution to its distinctive character, I consider that overall it can still be described as falling within the average range of distinctiveness.

63) On the question of whether the level of inherent distinctive character of the earlier marks has been enhanced through the use made of them I note that the Opponent makes no claim to enhanced distinctiveness in either its notice of opposition or its written submissions. While I have considered the evidence of sales and advertising sufficient to establish genuine use in the EU, and while the relevant UK sales figures are by no means insignificant, it is difficult to assess their impact, and that of the annual UK marketing budget of around £300,000, in the absence of any evidence of the size and structure of the relevant UK market or of market share. I therefore do not consider that it would be appropriate to hold that the already average level of distinctiveness of the earlier marks has been materially enhanced through use in the UK (which is the market on which confusion is to be measured).

Likelihood of Confusion

64) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of

confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

Indirect confusion

65) In its notice of opposition the Opponent pleaded that there was a likelihood of confusion, including a likelihood of association (in other words, including a likelihood of indirect confusion), between the competing marks. When considering indirect confusion it is helpful to bear in mind the observations of Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where he pointed out (at paragraph 16) that although direct confusion and indirect confusion both involve mistakes on the part of the consumer, these mistakes are very different in nature. Direct confusion involves no process of reasoning; it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark, but goes on to conclude from the marks' similarities that they are variant marks or sub-brands belonging to the same proprietor.

66) I think that the competing marks will call one another to mind, and that the consumer will be struck by their similarities. Nevertheless, provided the consumer has consciously recognised and considered the differences between the earlier marks and the Applicant's mark, I do not consider that he is likely to conclude that they belong to the same or related undertakings, even where the goods at issue are highly similar. He will feel intuitively, I think, that replacing MANN with MAN, FILTER with FITER, and running the two together, are not the kind of changes one would naturally expect to find made by a proprietor seeking to expand a brand. The similarity of the marks will be ascribed to coincidence. I find no likelihood of indirect confusion with either of the earlier marks.

67) That leaves the possibility of direct confusion, which does not require a process of conscious reasoning.

Direct confusion

68) I have found that, apart from vehicle manufacturers, consumers of the various components and accessories covered by the Applicant's and the Opponent's specifications in the automotive aftermarket will consist either of vehicle owners – whether commercial or private – or of businesses which fit parts to automobiles and vehicles (which, in addition to commercial garages may include specialist retailers who are prepared to advise and assist customers with installation and fitting). Consumers who fit their own parts and accessories are likely to consist either of motor car enthusiasts or of less well-off consumers (whether private persons or small commercial businesses, e.g. sole traders) who wish to economise on labour costs. In addition to national chains, enterprises of various sizes function as commercial garages fitting parts and accessories, including small businesses and mechanics working as sole traders.

69) Purchases of components by individual members of the motoring public will be intermittent, and they will not purchase the same component frequently. Purchases by garage businesses will obviously be more frequent; but small garage businesses – for example, mechanics operating as sole traders – are unlikely to maintain large stocks of parts and accessories. They are far more likely to obtain parts as they are required for particular jobs and, like private consumers, are most likely to obtain them by selecting them from the shelves of a specialist retail outlet or depot, or by ordering from printed or online catalogues. They are also likely to order parts, as and when required, by telephone – for example, telephoning to make sure that a part is available in a depot or retailer's stock before setting out to pick it up for a job. Similarly, private consumers may ring a retailer or garage to check on the availability of an item before visiting to collect it and fit it themselves, or have it fitted. Thus, both visual and aural factors may play a part in the purchasing process.

70) The Opponent submits that purchases may be made over the telephone in loud environments such as garages. I do not consider it legitimate to posit a loud environment in making my assessment. Such tasks as the ordering of materials and components will normally be performed in an office or quiet area equipped with a computer screen and/or telephone. Sole traders too have businesses to run; even if

their facilities do not include office areas, they will wish to do business effectively and will not, for example, continue to do noisy work while on the telephone. It is not necessary, however, to posit a loud environment in order to see that, even under perfectly normal circumstances, the L in a word like “filter” is very easily swallowed by the speaker or missed by the hearer.

71) The words FITTER and FILTER are also easily confused visually. I have found that although the opposed mark is written as one word, the consumer will recognise that it begins with “Man”, and is followed by a second element which may receive relatively less attention than the beginning of the mark, strengthening the scope for confusion. I have explained why I consider that the conceptual content of the competing marks is not clear-cut. Moreover, neither FITTER nor FILTER is a particularly striking and memorable conceptual hook.

72) I have found that the selection of many of the goods at issue will call for a reasonably high level of attention. A somewhat higher degree of attention may lessen the scope for imperfect recollection but, in my view, it does not cancel it out in this case. I have found both earlier marks to have a medium degree of distinctive character. I must bear in mind that the average consumer 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, that he normally perceives a mark as a whole and does not proceed to analyse its various details, and that the eye tends to see, and the ear to hear, what the brain is expecting. It is the instinctive overall impression of the mark as a whole which is decisive. Bearing in mind my findings on the average consumer and the purchasing process, I consider that in respect of the goods which I have found to have a high or medium degree of similarity with those of the earlier marks there is a likelihood of direct confusion of the opposed mark with both earlier marks for a significant proportion of the relevant public. Where I have found the goods to be of low similarity, the consumer is more likely to ascribe the perceived similarity of the marks to coincidence, and there will be no likelihood of confusion.

The other earlier marks

73) The other earlier marks offer the Opponent no better case than the two marks I have already assessed, but it is appropriate that I should explain briefly why.

EU 4602835 and UK 1444881

74) EU 4602835 and UK 1444881 both consist of the words MANN FILTER reproduced graphically in exactly the same way as in EU 4754453, except that they are simply registered in black, rather than being shown shown in (lighter) yellow against a (darker) green background, thus “inverting” the more customary usage of darker against lighter. However, the contrast of the shades is respected, so that the distinctive character of the “reversed” mark is respected¹¹. Use of a registered mark A in a different form that does not alter its distinctive character, and corresponds to the form in which it is registered as mark B, may constitute use of both registrations¹². Moreover, use of a mark encompasses both its independent use and its use as part of another mark¹³.

75) The Applicant may therefore rely on the use I have found for EU 4754453 as showing use of both EU 4602835 and UK 1444881 too. Both these marks can be described as being of average distinctiveness, and the findings I have made above on the average consumer and purchasing process are equally applicable to these marks. The specifications in Class 7 of both these marks and in Class 11 of EU 4602835 admit of the fair specification I found in Classes 7 and 11 for EU 4473187, and are restricted in the same way by that fair specification – based, as it is, on the goods for which genuine use has been shown. My assessment of the similarity of the marks would correspond in its material particulars to my assessment of EU 4754453. My assessment of the likelihood of confusion under both EU 4602835 and UK 1444881 would produce the same results as under EU 4754453, and would produce the same outcome.

¹¹ For examples see *Hypen GmbH v EU IPO*, T-146/15 and *Menelaus BV v EUIPO*, T-361/13.

¹² See *Bernhard Rintisch v Klaus Eder*, C-553/11

¹³ See *Colloseum Holdings AG v Levi Strauss & Co.*, C-12/12

EU 4534641

76) This mark can also be described as being of average distinctiveness, the findings I have made above on the average consumer and purchasing process are equally applicable to this mark, and its specification in Class 7 admits of the fair specification I allowed for EU 4473187 in this class. However, in respect of the other earlier marks relied on by the Opponent I have explained above why and how I consider that a likelihood of confusion with the Applicant's mark may arise from the *overall impression* created by the marks *as a whole*, and in particular the word element MANN FILTER in its entirety. The absence of the word FILTER gives less scope for imperfect recollection and conceptual confusion, and manifestly creates a much greater visual and aural difference between the Applicant's mark and EU 4473187. After factoring in the other considerations relevant to the global assessment, I would find no likelihood of confusion between the marks.

Outcome

77) The opposition has succeeded in respect of all the goods of the Applicant's application except the following. The application may therefore proceed to registration only for the following goods:

Class 12: *Hub caps; sun-blinds adapted for automobiles; spare tyre covers; cigar lighters for automobiles; anti-theft devices for vehicles¹⁴; luggage carriers for vehicles; upholstery for vehicles; anti-theft alarms for vehicles; vehicle covers [shaped]; covers for vehicle steering wheels*

Costs

78) The Opponent has been almost entirely successful and is entitled to a contribution towards its costs. Costs are awarded on the basis of the scale published in Tribunal Practice Notice 2/2016. I hereby order Shenzhenshi

¹⁴ *Anti-theft devices for vehicles* appeared twice in the original specification. The redundant duplication has naturally been omitted here.

Kanghaoxin Supply Chain Management Ltd to pay MANN+HUMMEL GmbH the sum of £1,400. This sum is calculated as follows:

Opposition fee	£100
Preparing a statement and considering the other side's statement	£400
Preparing evidence	£500
Written submissions	£400

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

Dated 2 August 2019

**Martin Boyle
For the Registrar,
The Comptroller-General**