

O-548-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3044455 BY
FOWLERS OF BRISTOL LIMITED**

TO REGISTER THE TRADE MARK:

MOTOZONE

FOR SERVICES IN CLASS 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600000117 BY
AUTOZONE PARTS, INC.**

BACKGROUND

1) On 27 February 2014 Fowlers of Bristol Limited (“the Applicant”) applied to register the trade mark **MOTOZONE**. The application was published for opposition purposes on 28 March 2014 for the following services:

Class 35: Retail services including online retail store services related to power sports vehicles including motorbikes, all-terrain vehicles, quad bikes, over water crafts and vehicles, snowmobiles, and parts, fittings and accessories for all of the aforementioned items.

2) The application is opposed by AutoZone Parts, Inc. (“the Opponent”) under the fast track opposition procedure. The opposition, which is directed against all the services in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the Opponent relies upon the following goods and services for the following two Community Trade Mark (“CTM”) registrations respectively:

CTM no. 8133134 which was applied for on 3 March 2009 and for which the registration process was completed on 12 January 2010:



Class 1: Parts and fittings for automobiles, namely brake fluid.

Class 4: Parts and fittings for automobiles, namely lubricants, greases and oils for engines.

Class 35: Presentation for sale provided to retail customers and to consumers of parts and fittings for automobiles; retailing by any medium of parts and fittings for automobiles, business information and consultancy by any medium to consumers of parts and fittings for automobiles.

Class 38: Providing access to databases for on-line searches of parts and fittings for automobiles

CTM no. 8133092 which was applied for on 03 March 2009 and for which the registration process was completed on 21 January 2010:

AUTOZONE

Class 35: Presentation for sale for retail customers and consumers of parts and accessories for automobiles; retail by any means of parts and accessories for automobiles. Commercial information and advice via any media for consumers of parts and accessories for automobiles.

Class 38: Providing access to databases for on-line searching of parts and accessories for automobiles

3) The significance of the respective dates on which the opponent's marks were applied for and on which their registration process was completed is that (1) both the opponent's marks constitute an earlier mark in accordance with section 6 of the Act, and (2) neither is subject to the proof of use conditions contained in section 6A of the Act, their respective registration procedures having been completed less than five years before the publication of the Applicant's mark.

4) The Applicant filed a counterstatement, denying the grounds of opposition.

5) Rule 62(5) (as amended) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) ("the Rules") states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. Both sides filed written submissions in lieu of a hearing.

6) The Applicant attaches to its submissions various print-outs from dictionaries, websites and copies of trade mark registrations. This material constitutes evidence. In order to be considered in these proceedings it would need to have been filed in evidential format, i.e. accompanied by a witness statement, statutory declaration or affidavit. Rules 20(1)-(3) (as amended) of the Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4), which does, reads:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

The net effect of the above is that parties are required to seek leave in order to file evidence (other than proof of use evidence which is not pertinent in these proceedings) in fast track oppositions. In a letter of 11 September 2014 the parties were referred to the guidance at paragraph 7 of Tribunal Practice Notice 2/2013 and advised that any request for leave to file evidence should be submitted on or before 25 September 2014. No leave was sought in respect of these proceedings. Accordingly, material attached by the Applicant to its submissions which should have been filed in evidential format has not been admitted as evidence in these proceedings, and I have taken no account of it in reaching my decision.

Section 5(2)(b)

7) 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".

The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

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

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

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

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

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

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

10) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the

purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

11 The specification in Classes 35 and 38 of the Opponent’s figurative mark CTM No. 8133134 is substantially the same as that in Classes 35 and 38 of its word mark CTM No. 8133092. The “fittings” in the Class 35 specification of 8133134 is in any case covered by the “parts” of 8133092, and “business information and consultancy by any medium” is in practice synonymous with “commercial information and advice via any media”. However, the figurative element in CTM 8133134 takes it further away from the opposed word mark. The goods in Classes 1 and 4 of CTM No. 8133134 are also further away from the services of the specification of the Applicant’s mark than the Opponent’s services in Class 35. For these reasons, if the opposition does not succeed on the basis of CTM No. 8133092 it cannot succeed on the basis of CTM No. 8133134. In the interests of procedural economy, therefore, since the figurative mark offers the Opponent no advantage, I shall make my comparison on the basis of CTM No. 8133092.

12) The services to be compared are:

Those of the applied for mark:

Class 35: Retail services including online retail store services related to power sports vehicles including motorbikes, all-terrain vehicles, quad bikes, over water crafts and vehicles, snowmobiles, and parts, fittings and accessories for all of the aforementioned items.

Those of the Opponent’s CTM no. 8133092:

Class 35: Presentation for sale for retail customers and consumers of parts and accessories for automobiles; retail by any means of parts and

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

accessories for automobiles. Commercial information and advice via any media for consumers of parts and accessories for automobiles.

Class 38: Providing access to databases for on-line searching of parts and accessories for automobiles

13) The services in question are, essentially, retailing. But it is important when making the comparison to consider what is being retailed. Power sports vehicles include automobiles used in power sports. Accordingly, parts and accessories for power sports vehicles will include parts and accessories for automobiles. The Applicant's *retail services including online retail store services related to parts, fittings and accessories for power sports vehicles* therefore includes both the Opponent's *retail by any means of parts and accessories for automobiles and presentation for sale for retail customers and consumers of parts and accessories for automobiles*. They are identical under the guidance in *Meric*. Retail services often involve providing customers with information and advice. *Retail services including online retail store services related to parts, fittings and accessories for power sports vehicles and commercial information and advice via any media for consumers of parts and accessories for automobiles* are therefore highly similar.

14) Since power sports vehicles may themselves be automobiles, there will be a reasonable degree of similarity between the Applicant's *retail services including online retail store services related to power sports vehicles* and the Opponent's *retail by any means of parts and accessories for automobiles and presentation for sale for retail customers and consumers of parts and accessories for automobiles and commercial information and advice via any media for consumers of parts and accessories for automobiles*. In the light of the obvious complementarity between vehicles and their parts and accessories it is natural for the average consumer to expect to find retail services related to automobiles provided by the same undertaking which provides retail, presentation for sale, commercial information and advice relating to parts and accessories for automobiles.

15) *All-terrain vehicles* might include automobiles like four-by-fours, and thus share the analysis I have made in paragraphs 13 and 14. There is less similarity with regard to the Applicant's retail services in respect of power sports vehicles other than automobiles, and with parts and accessories for such vehicles. For example, there is some overlap in nature, purpose and users, and some degree of competition between retail of parts and accessories of automobiles and parts and accessories of [power sports] motorbikes. Although retail services related to motorbikes and their parts and accessories are not always provided by the same undertakings as those providing services in respect of spares and accessories for automobiles, they are often provided by the same undertakings, and the average consumer will be aware of this. There is a medium degree of similarity between *retail by any means of parts and accessories for automobiles* and *retail services including online retail store services related to parts, fittings and accessories for [power sports] motorbikes* and I consider that this also applies, perhaps to a slightly lesser degree, to retail services in respect of the motorbikes themselves. However, there will be less similarity with retail services in respect of the other power vehicles named in the Applicant's specification. The average consumer would not expect to find *retail services related to quad bikes, over water crafts and vehicles, snowmobiles*, or their parts and

accessories, provided by the same undertaking which provides *retail, presentation for sale, commercial information and advice relating to parts and accessories for automobiles*. For services in respect of *quad bikes, snowmobiles, and their parts and accessories*, having regard to nature, purpose, method of use and channels of trade, the similarity would be low. For services in respect of *over water crafts and vehicles, and their parts and accessories*, the similarity would be very low.

16) A person seeking parts or accessories for an automobile may check out the online database operated by a retail service provider to sell its own stock, or s/he may consult a database operated independently of any particular retailer to allow users to locate potential suppliers of the items sought. To the extent that the Applicant's specification covers retail services relating to automobiles and parts and accessories for them, there will be a degree of competition (or complementarity) and overlap in users, nature and purpose, between the Applicant's *online retail store services related to parts, fittings and accessories for power sports vehicles* in Class 35 and the Opponent's *providing access to databases for on-line searching of parts and accessories for automobiles* in class 38. There is a reasonable degree of similarity.

The average consumer and the purchasing process

17) 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.”

18) The average consumer in this case could be a member of the general public or a business or professional sportsman seeking the relevant retail, information or advice services. Advertisements in relevant publications, online sources, such as specialist blogs and websites and search engines, and word-of-mouth may all play a role in the selection of the services concerned; where they are provided in retail premises, signage may also have some role. The selection process will be predominantly a visual one, but aural aspects will not be ignored in my comparison of the marks. The consumers' choice of retail, information and advice services will be based on product quality and range, relevant technical expertise and information, after-sales service, warranty, etc., so the selection of the outlet through which the services are obtained will involve a fairly substantial degree of consideration. The

average consumer's level of care and attention in selecting the services will not be lower than the norm, and in many cases will be higher.

The distinctiveness of the earlier mark

19) 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 *Windsurfing Chiemsee 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).”

20) The earlier mark consists of two elements: AUTO and ZONE, conjoined. AUTO is most often used as a prefix to modify other words. It is frequently used as an abbreviation for “automobile” or “automotive”, and it can be used to modify other words, so as to indicate a connection with automobiles or activities with an automotive connection. The primary meaning of ZONE is a region, area, or section characterized by some distinctive feature or quality. When modified by AUTO, and encountered in connection with the services at issue, the resulting word AUTOZONE, though not directly descriptive, will tend to evoke in the mind of the average consumer the idea of an area characterized by automotive connections. Given this allusive quality, the mark is of low to moderate distinctiveness.

Comparison of the marks

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

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

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

22) The marks to be compared are shown below:

The Applicant's mark	The earlier mark CTM No. 8133092
MOTOZONE	AUTOZONE

23) In paragraph 20 I have already analysed how the elements AUTO and ZONE combine in the Opponent's CTM No. 8133092. Used in combination in this way, neither the AUTO nor the ZONE element dominates the other in terms of overall impression. The distinctiveness of AUTOZONE lies more in the mark as a whole. In a similar way, when encountered in connection with the services at issue, the average consumer will perceive MOTO as qualifying ZONE. Some may perhaps see MOTO as in MOTOCROSS with its associations with power sports. However, despite the absence of an "R", I think it will generally be seen as MOTOR, or a truncated form of MOTOR. In any event, when modified by MOTO, the resulting word MOTOZONE will tend to evoke in the mind of the average consumer the idea of an area characterized by motor vehicle associations. Used in combination in this way, there is a blend of meaning and significance; neither the MOTO nor the ZONE element plays a dominant or distinctive role in the mark.

24) Both marks consist of eight letters, the last six of which are identical. The opening letters, however, are markedly different. Overall, the marks have a moderate degree of visual similarity.

25) Both marks consist of three syllables, the last two of which are identical. Although the initial syllables are in both cases followed by the same consonant, the pronunciation of the initial syllables is different, the initial M of the Applicant's mark in particular making a clear difference. Overall, the marks have a moderate degree of aural similarity.

26) I have already described how the elements of both marks combine to produce a blend of meaning and significance, and how the Applicant's mark will tend to evoke in the mind of the average consumer the idea of an area characterized by motor vehicle associations, and the Opponent's mark the idea of an area characterized by

automotive connections. This creates a good degree of conceptual overlap or similarity. However, the concept is in each case allusive of the services at issue – a point I will return to when considering whether there exists a likelihood of confusion.

Likelihood of confusion

27) 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.

28) I have found the services of the Applicant's specification to be identical or similar to those of the Opponent in Class 35. Bearing in mind the allusive quality of the Opponent's mark, I have found it to be of low to moderate distinctiveness. I have found moderate visual and aural similarity between the Opponent's and the Applicant's marks, and a good degree of conceptual overlap or similarity. However, this shared conceptual content derives entirely from the fact that both marks are allusive of the services at issue. This allusion to the nature of the services themselves means that consumers will rely on other factors to indicate the origin of the goods. In this case, given my findings on the average consumer and the purchasing process, I consider that the visual and aural differences in the marks will mean that the average consumer will clearly be able to differentiate them (even taking into account imperfect recollection) and will not directly confuse the marks, even for services that are identical. Moreover, the differences are sufficient to rule out the likelihood that the Applicant's mark might, for example, be seen as a brand variant. The factors combined indicate to me that there will be no indirect confusion. In my view the average consumer will simply consider that two different firms have made use of allusive word combinations in the context of different marks. The opponent is no better position for the services which are not identical. **The opposition fails in its entirety.**

29) I found that the wording of the Applicant's Class 35 specification also covered services of only a medium or low degree of similarity, as well as those which are identical, or have a reasonable degree of similarity, with those of the Opponent. The Applicant is in an even stronger position here; there is no likelihood of confusion

Costs

30) The Applicant has been successful and is entitled to a contribution towards its costs. I hereby order AutoZone Parts, Inc. to pay Fowlers of Bristol Limited the sum of £600. This sum is calculated as follows:

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

The above sum should 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 17th day of December 2014

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