

O/0174/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003606121

BY CAP CITY MUFFLER LLC TO REGISTER:

CAT SECURITY

AS A TRADE MARK IN CLASSES 7, 9, 12, 16, 21, 25, 37 & 38

AND

IN THE MATTER OF THE OPPOSITIONS THERETO

UNDER NO. 429437 BY

CATERPILLER INC.

BACKGROUND AND PLEADINGS

1. On 8 March 2021, Cap City Muffler LLC (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The application was published for opposition purposes on 24 September 2021 and registration is sought for the following goods and services:¹

Class 7: Parts and accessories for motors and engines.

Class 9: Audio and video recordings; not for use in the casino of gaming industry; electronic publications.

Class 12: Vehicle parts and accessories.

Class 16: Printed materials; paper materials, namely, containers of paper for packaging.

Class 21: Beverageware and containers.

Class 25: Clothing.

Class 37: Vehicle services, repair and maintenance; none of the aforesaid offered in relation to logistical for automobiles industry.

Class 38: Providing information to others via a computer network.

2. The applicant’s mark is derived from eight different trade marks registered by the applicant in the United States of America. These eight US marks all share the same

¹ It is noted that the specification for which the applicant initially sought registration for was limited by the filing of a TM21B on 10 May 2022. Additionally, the specification was limited further as a result of the decision of this Tribunal under case number BL O/0959/24 dated 8 October 2024. For the avoidance of doubt, the specification listed here reflects the specification for which registration is presently sought.

filing date, being 8 September 2020. As such, the applicant's mark benefits from this date as a priority date in the present proceedings.

3. On 20 December 2021, the applicant's mark was opposed by Caterpillar Inc. ("the opponent"). The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). In respect of the section 5(2)(b) and 5(3) grounds, the opponent relies on the following mark:



UK registration no. 915167711²

Filing date 1 March 2016; registration date 2 February 2017

Relying on some goods and services, being those discussed below.

("the opponent's mark")

4. Under the section 5(2)(b) ground, the opponent claims that the marks are highly similar and that the goods and services for which registration is sought are identical and/or highly similar to those in classes 6, 7, 9, 12, 16, 21, 25, 37 and 38 of the opponent's mark's specification (all of which are set out in **Annex 1** of this decision). As such, the opponent claims that there exists a likelihood of confusion between the marks on the part of the relevant public.
5. Under the section 5(3) ground, the opponent claims that as a result of its extensive use and significant investment in its mark, it enjoys a significant reputation in the goods and services listed in **Annex 2** of this decision. Further, the opponent claims

² The opponent's mark is a comparable mark based upon an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

that the marks are similar and, as such, the relevant public would believe that the marks originate from the same undertaking or that there is an economic connection between them. Therefore, use of the applicant's mark would, without due cause, take unfair advantage of the earlier mark's reputation and that would cause detriment to the distinctive character of the same.

6. Under the section 5(4)(a) ground, the opponent relies on two earlier unregistered signs. The first sign, being 'CAT', is claimed to have been used throughout the UK since the 1950s. The second sign, being that shown immediately below, is claimed to have been used throughout the UK since 1988.



7. In respect of both of these signs, the opponent claims to have used them for the following list of goods:

“Construction, mining, agricultural, forestry, earth moving machines and equipment and related products; land vehicles; power generation products, including motors and engines; parts and fittings for all the aforesaid goods.”

8. As a result of the use of the above signs in respect of the above goods, the opponent claims to have obtained a substantial goodwill in the UK. As a result, any use of the applicant's mark has the capacity to cause deception and confusion, including inducing customers into believing that the goods/services supplied by the applicant's mark emanate from, or are associated with, the opponent. The opponent claims that this would cause damage to the opponent's business.

9. The applicant filed a counterstatement wherein it made a series of denials in respect of the claims against it. That being said, it did indicate that it accepted that there was some overlap in the goods and services at issue, though it did argue that this did not equate to a complete overlap, a point, it said, it would discuss further during the course of these proceedings.
10. The applicant is represented by Forresters IP LLP and the opponent is represented by Hogan Lovells International LLP. Only the opponent filed evidence. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

12. The opponent's evidence came in the form of the witness statement of Ms Lia Yasmin Young dated 16 February 2024. Ms Young is Associate General Counsel, Head of Global Trademarks for the opponent and its group of companies, a position she has held since 1 November 2023. She is employed by a subsidiary company of the opponent, being Caterpillar UK Limited, and has been with the opponent in various roles since January 2007. Prior to this, she worked for a subsidiary company of the opponent, being Perkins Engines Company Limited, since December 1997. Ms Young's statement is accompanied by 10 exhibits, being those labelled LYY1 to LYY10, and was adduced to support the opponent's claim to enjoy a reputation in its mark and goodwill in its business.

13. I do not intend to summarise the evidence filed by the opponent in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Section 5(2)(b): legislation and case law

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

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

(a) [...]

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

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

15. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

16. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

- (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

17. The opponent’s mark qualifies as an earlier trade mark under the above provisions. However, the opponent’s mark had not completed its registration process more than five years before the filing date of the applicant’s mark. As such, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on all of the goods and services highlighted in its notice of opposition.

18. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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 might 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

19. The applicant's goods and services can be found at paragraph 1 above. The opponent's goods and services can be found in Annex 1 of this decision.

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"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".

21. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

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

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) 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.”

23. I have set out above that the applicant has accepted that some of the goods and services at issue are similar but argued that some are not. While it set out in its counterstatement that it would expand upon this throughout the course of these proceedings, it did not do so. While I must bear in mind that there is a concession that some of the goods and services are identical or similar, it does not apply to all of the goods and services at issue. As a result, it is necessary for me to undertake a goods and services comparison in the ordinary way.

24. The opponent has filed submissions in respect of the goods and services comparison. I note that this is in the form of a table wherein the opponent has helpfully sought to identify where the goods and services are identical or similar. While I do not intend to reproduce this here, I confirm that I have given it due consideration in making the following comparison.

Class 7

Parts and accessories for motors and engines.

25. The above term is not limited in any way and can, therefore, cover any type of parts and accessories for any type of motor or engine that is used for any purpose. On this point, I note that the opponent's specification includes the following term:

“Machines and engines and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lawn care, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management.”

26. I consider that the parts aspect of the opponent's term duly falls within the unlimited term of the applicant. As a result, I consider that these goods are identical under the principle outlined in *Meric*.

Class 9

Audio and video recordings; not for use in the casino or gaming industry.

27. In considering the above term, I am of the view that it may cover recordings of audio or video that are either stored digitally via a downloadable file or on optical

discs, such as a CD or a DVD. As such, I am of the view that the term “recording discs“ represents the opponent’s best case. I consider that the goods differ in purpose and method of use on the basis that the applicant’s goods cover CDs or DVDs already preloaded with content whereas the opponent’s are blank discs with capacity to be recorded on to. That being said, there is an overlap in nature as both goods can be said to cover CDs or DVDs. Further, while I do not consider it necessarily common in the trade for a producer of CDs or DVDs with content already stored on them to also provide blank discs for users to record their own content on, I consider that the goods will be sold in close proximity to one another in stores, i.e. on the same or adjacent shelves in electronic goods sections. As such, I find that there is some degree of overlap in trade channels. I consider that the user for these goods will overlap also. Lastly, while the goods are not complementary, there may be a degree of competition between them. I say this because someone looking to consume audio or video content may either buy the applicant’s goods or may seek the opponent’s good upon which they can burn content on to themselves. Taking all of this into account, I consider that these goods are similar to between a low and medium degree.

Electronic publications.

28. The above goods of the applicant are digital goods that can cover online newspapers and other forms of periodical publications. I note that the opponent’s specification includes the term “newspapers and periodical publications”. As a term in class 16, this covers physical goods, not digital. That being said, I still consider these goods are similar. This is because while their natures and methods of use differ, they overlap in purpose on the basis that they both aim to provide publications to the end user, albeit via different methods. As for trade channels, it is my understanding that newspaper publications also provide their publications online via electronic publications meaning that there is some overlap here. As for user, it is my understanding that someone who reads a newspaper physically may also read a newspaper, or other type of periodical publication online. Further, there

may be a degree of competition between the goods on the basis that some users may elect to read a physical newspaper over a digital one, and vice versa. Taking all of this into account, I find that these goods are similar to a medium degree.

Class 12

Vehicle parts and accessories.

29. I note that the opponent's specification includes the following terms in class 12:

"Parts and fittings included in class 12 for land vehicles, agricultural machinery and earth moving machinery, namely, gaskets, cranks, camshafts, engines, bearings, rods, liners, transmissions for land vehicles and structural, repair and replacement parts therefore; tires for vehicle wheels; tracks for vehicles; horns for vehicles; mirrors for vehicles; brakes for vehicles."

30. While the presence of the word 'namely' limits the first term listed above to the goods that follow it, I still consider that this term falls within the applicant's goods which are not restricted in any way. This is because all of those listed goods are part and accessories to vehicles. Further, the remaining terms listed above also all cover parts and accessories for vehicles. Therefore, I find that all of these goods are identical under the principle outlined in *Meric* with the applicant's term.

Class 16

Printed materials; paper materials, namely, containers of paper for packaging.

31. Respectively, I consider that the above goods fall within the opponent's terms of "printed matter" and "paper and cardboard". These goods are, therefore, identical under the principle outlined in *Meric*.

Class 21

Beverageware and containers.

32. As goods in class 21, the above can cover beverageware and containers made of glass, porcelain or earthenware. As such, the above term can be said to fall within the opponent's term of "glassware, porcelain and earthenware not included in other classes" (also in class 21) which duly covers beverageware and other containers so long as they are made of the listed materials. As a result, I consider that these goods are identical under the principle outlined in *Meric*.

Class 25

Clothing.

33. The opponent's specification includes the term "clothing, footwear, headgear". Plainly the applicant's term falls within the opponent's and, as such, these goods are identical under the principle outlined in *Meric*.

Class 37

Vehicle services, repair and maintenance; none of the aforesaid offered in relation to logistical for automobiles industry.

34. The limitation of the above service is such that it means that the applicant's services cannot be used in relation to logistical repairs or maintenance for the automobile industry. As such, the above term cannot be said to cover the repair or maintenance of automobiles such as cars used on the road. While this is noted, I am of the view that the above term can cover repair and maintenance services for vehicles that are used in various other industries such as construction, mining, paving and agriculture. On this point, I note that the opponent's specification

includes the term “service, maintenance, and repair of land vehicles, earth moving, earth conditioning, material handling, construction, mining, paving, agricultural, and forestry vehicles, equipment, and machinery, engines, and power generation equipment, and control units for the aforementioned” (also in class 37). I consider that the broad nature of the applicant’s term and the fact that the opponent’s term does not cover use in relation to logistics for the automobile industry means that the applicant’s service encompasses the opponent’s. As a result, I find that these goods are identical under the principle outlined in *Meric*.

Class 38

Providing information to others via a computer network.

35. The above term is a telecommunication service for the provision of information over a computer network. Given that the opponent’s specification includes the broad term “telecommunications” at large (also in class 38), I find that these services are identical under the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

36. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

37. The goods and services at issue will be selected by members of the general public at large or professional users that operate in various trades (such as the automotive,³ construction, mining and forestry industries, amongst others). The varying goods and services are likely to be available across a number of different providers, including general or specialist retailers and the provider of the goods/services directly. In all scenarios, the goods and services may also be selected online via the retailers’/providers’ websites.

38. For the most part, members of the general public will select the goods and services whilst giving greater consideration to the visual component. I say this because the goods are likely to be self-selected by the consumer either after taking them from shelves, seeing an image of them on a website or selecting them from a list of goods. As for the services, these are likely to be selected from lists or pamphlets or via menus viewed on websites. I appreciate that there may also be an aural component to the selection process for all goods and services in the form of word-of-mouth recommendations or advice from sales assistants. In respect of the latter point, I will say that the aural component may play a greater role for some goods and services. For example, vehicle parts and repair services may only be selected after discussions with mechanics and, as such, the goods or services selected may not ever be seen by the end consumer but, instead, selected aurally.

39. As for the goods and services that are selected by professional users, I am of the view that for the most part, this will follow the same selection process as that of the general public, namely one where the visual component dominates but also, in some circumstances, the aural component will dominate (on the basis that

³ While the applicant’s class 37 services cannot be said to relate to the automotive industry, both its and the opponent’s class 12 goods can be.

professional users are just as likely to seek repair of vehicles). That being said, I am of the view that in some circumstances (such as when selecting machines and vehicles for use in various industries), an equal degree of attention will be paid to both the visual and aural components. For example, when selecting large machines for use in forestry, for example, the consumer is likely to inspect the goods visually but also engage in detailed discussions with sales assistants.

40. Given all that I have said above, it should come as no surprise that the cost and frequency of selection for the goods and services at issue will vary quite considerably from cheap goods that are selected frequently (such as socks, being goods encompassed by the parties' "clothing" terms) to expensive and infrequently selected goods such as parts for large and very complex machines or vehicles that are used in the mining, construction or forestry industries.

41. In terms of the level of attention paid, I consider that this will vary quite considerably. I do not intend to go over each and every consideration for the various range of goods and services at issue, however, I will briefly discuss the lowest and highest ends. On the lower end of the scale, I consider that goods such as "clothing" can include casual goods such as socks that will be selected at a relatively low degree of attention. On the other end of the scale sits parts for large and complex machines for use in forestry, mining or construction. While I appreciate that the goods at issue cover parts for these machines only, the complex nature of the machines/vehicles are such that any parts for the same are likely to still be expensive goods that are required for a very specific purpose. When selecting them, the user will likely pay a higher degree of attention as they will be important to the user's operation of their machines/vehicles and, in turn, are important to the running of that user's business operation. Between these two ends of the scale, I consider that the goods and services will range in the level of attention they attract but, for the most part, they will likely be at a medium degree on the basis that they are ordinary selections that are unlikely to be selected casually.

Comparison of the marks


42. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

43. 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.”

44. It would be wrong, therefore, to artificially dissect the trade marks, 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.

45. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
	<p data-bbox="1002 472 1238 501">CAT SECURITY</p>

46. I note that I have detailed submissions from the opponent as to the similarity of the marks. While I have given the submissions due consideration, I will refrain from discussing them any further during this comparison. On this point, I note that the submissions run through an ordinary comparison of the mark, however, they include several references to other decisions of both this Tribunal and those in other jurisdictions. In short, I am not bound by any of these decisions and my comparison of the marks will be made based on my own assessment of the marks before me.

47. As for the applicant, I note that it has denied that the marks at issue are highly similar and pinned this on the fact that its own mark does not include the highly distinctive yellow triangle and because its own mark includes the word 'SECURITY' whereas the opponent's does not.

Overall impression

48. The applicant's mark is a word only mark that consists of the words 'CAT SECURITY'. For reasons I will come to discuss when considering the concepts of the marks, I consider that the word 'SECURITY' plays a lesser role in the overall impression of the mark. As such, the word 'CAT' plays the greater role in the overall impression of the mark.

49. As for the opponent's mark, this is a figurative mark that consists of the word 'CAT' presented in a large black typeface. While the typeface used is standard, the lower parts of each letter have been removed in order to accommodate a large yellow triangle. While that may be the case, the letters are still clearly identifiable meaning that the removal of these parts is likely to have a negligible impact on the mark as a whole. As for the applicant's submission as to the impact of this element, I disagree that it is a highly distinctive element of the mark. I say this because it is merely a basic geometric shape and while it will not be ignored, it will play a lesser role. As such, I find that the word 'CAT' plays the greater role in the overall impression of the mark.

Visual comparison

50. In respect of the visual comparison, I note that the applicant's mark is a word only mark meaning that it can be used in any standard typeface. In my view, this extends to the typeface used in the opponent's mark, though I appreciate that it does not cover the way in which the bottoms of the letters have been removed. Whilst this may be the case, it is not legitimate for me to perform a comparison between the marks by considering specific ways in which the word might be presented. However, the point here is that the applicant's mark is not limited to any particular script and therefore the typeface in the opponent's mark does not provide a point of distinction in itself.⁴

51. Visually, the marks share the word 'CAT'. This is the sole verbal element of the opponent's mark and is the first element of the applicant's. On this point, I remind myself that the beginnings of marks tend to have more impact than their ends.⁵ The marks differ in the presence of the word 'SECURITY' in the applicant's mark and the yellow triangle. While these elements play lesser roles in their marks, they

⁴ See the decision of the Appointed Person in *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraphs 23 and 34.

⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

are still points of visual difference. Lastly, I appreciate that I have found that the stylisation used towards the bottom of the letters 'CAT' in the applicant's mark play a negligible role, they still carry some visual weight. Taking all of this into account, I find that the marks are similar to a medium degree.

Aural comparison

52. As I have set out above, 'SECURITY' plays a lesser role in the applicant's mark. This is because the goods and services for which the applicant seeks to protect the mark at issue may relate to security. That being said, I remind myself of the case of *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) wherein Phillip Harris, sitting as the Appointed Person, stated that descriptiveness of an element does not render it aurally invisible. As a result, I find that the applicant's mark will be pronounced in full, consisting of five syllables that will be pronounced in the ordinary way. As for the opponent's mark, this consists of just one syllable that will, again, be pronounced in the ordinary way. While the one syllable in the opponent's mark is identical to the first syllable in the applicant's mark, the remaining four syllables in the applicant's mark have no counterpart in the opponent's mark. While the marks have considerable points of difference, the identical beginnings will not be ignored and, as such, I find that the marks are aurally similar to a medium degree.

Conceptual comparison

53. The opponent submits that its own mark will either be regarded as the famous brand or as referring to the feline animal. In respect of the former point, I remind myself of the case of *Ravensburger AG v OHIM*, Case T-243/08 wherein the GC stated:

"27.... The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of

confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway), not published in the ECR, paragraphs 50 and 51).”

54. Further, in *Retail Royalty Company v Harringtons Clothing Limited* (Case BL O/593/20), Phillip Harris, as the Appointed Person, considered the argument that the letters “AE” had, through their use, acquired an independent conceptual significance which would mean that the average consumer would always perceive them as meaning “AMERICAN EAGLE”. He said:

“74. The Opponent is trying to equate reputation in a trade mark sense with conceptual meaning. They are not the same thing. Reputation can mean different things, and in trade mark law the term is sometimes used loosely, but in this context, it concerns the factual extent to which a sign is recognised by a significant part of the public as a *trade mark* [original emphasis].

75. In contrast conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trademark acknowledgement) or a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken. Whilst a trade mark’s reputation might evolve or be converted into a conceptual meaning (possibly to its detriment in terms of genericity), it needs to be properly proven.

76. It is true that there are cases where an extensive reputation has been parlayed into conceptual meaning (for example C-361/04 P *PICASSO/PICARO* and C-449/18 *MESSI*) but these are the exception rather than the rule and depend on their own facts. Furthermore, the “reputation” element in those cases related to the fame attached to the names of the individuals for their roles in

society, rather than specifically to a trade mark function. In other words, it was a different sort of reputation.”

55. Accordingly, it is not correct to attribute to the opponent’s mark a ‘brand’ meaning in the way claimed in its submissions. That being said, I do agree with the latter point made by the opponent in that the word ‘CAT’ in its mark will be understood as a reference to the feline animal.⁶ As for the applicant’s mark, being ‘CAT SECURITY’, I find that this will carry no unitary meaning and, instead, consumers will understand it as a combination of two well-known words. The first, ‘CAT’, having the same meaning as the opponent’s mark, namely a reference to a feline animal. The second, ‘SECURITY’, will be understood as *the state of being secure* or a reference to *precautions taken to ensure against theft or espionage*.⁷ While the applicant’s goods and services do not expressly cover security, some of them are those that could reasonably be said to cover security goods/services (for the example, *electronic publications* could be issued on the topic of security and, further, the class 38 *provision of information* service could also reasonably be said to cover security information). For such goods, ‘SECURITY’ could be considered descriptive. Even where this is not the case, I consider that the word ‘SECURITY’ may indicate the nature of the applicant’s business operation.⁸ For the avoidance of doubt, it is for these reasons that I found this word to play a lesser role in the applicant’s mark.

56. In comparing the marks, the shared use of ‘CAT’ will clearly be a point of conceptual identity. This identity will be offset to some degree by the word ‘SECURITY’, however, given the meaning associated with ‘SECURITY’, either as a description of the type of goods/services offered (relating to security) or an

⁶ On this point, I note that ‘CAT’ is short for the name of the company, being ‘CATERPILLER’. However, as I have discussed in this section of my decision, any knowledge of the opponent’s brand does not factor in to the assessment I must make here.

⁷ <https://www.collinsdictionary.com/dictionary/english/security>

⁸ While I appreciate that, as per the case of EMILIANA (Case BL O/052/22), conceptual comparisons are usually done without reference to the goods or services at issue. However, in the present case, I am of the view that the connection I have discussed here will inevitably impact upon the concept associated with the word ‘SECURITY’.

indication of the type of business operation conducted, I consider that its impact on the conceptual comparison will not be all that significant. As a result, I find that these marks are conceptually similar to between a medium and high degree.

Distinctive character of the opponent's mark

57. 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).”

58. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a

characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced through use and, on this point, I note that the opponent has filed evidence of use. I will, therefore, consider whether this evidence is sufficient to give rise to a finding that the distinctiveness of the opponent's mark has been enhanced through use. Before doing so, I will consider the inherent position.

59. As I have discussed above, the opponent's mark is a figurative one which is made up of the word 'CAT' presented in a large black and standard typeface. That being said, the bottom part of the letters in this word have been removed to accommodate for a yellow triangular device. Clearly, the distinctiveness of this mark lies in its word element, being 'CAT' and I do not consider that the stylistic elements will contribute to any material degree beyond that created by this word. While 'CAT' has no meaning in the context of the goods and services relied upon by the opponent, it is an ordinary word with a well-known meaning. As such, I do not consider that it is particularly remarkable from a trade mark perspective. Taking all of this into account, I find that the opponent's mark enjoys a medium degree of inherent distinctive character.

60. I turn now to consider whether there exists an enhanced degree of distinctive character. The evidence before me is extensive and spans approximately 300 pages of evidence. I say this not as a criticism of the opponent but to demonstrate the fact that, in the present decision, it would not be possible for me to discuss the entirety of the evidence in full detail. Instead, my intention is to merely discuss the most salient points that are relevant to the present decision.

61. Before proceeding to consider the evidence and how it impacts upon this assessment, I will first make reference to the fact that the opponent's evidence makes reference to decisions of the EUIPO and this Tribunal in respect of previous

findings regarding the size of the opponent's brand in both the EU and the UK.⁹ While this is noted, the assessment I must make here is to be based on the evidence before me and not previous decisions of any tribunal. As such, the decisions filed by the opponent has no impact on my decision and I will say no more about them.

Summary of the evidence

62. The core business activities of the opponent are confirmed in evidence to be construction and mining equipment, power systems, diesel and natural gas engines, industrial gas turbines and diesel-electric locomotives. It is also confirmed that the opponent is a manufacturer of vehicles and machinery (and parts thereof) for a range of industrial applications. Alongside these core business activities, the opponent confirms that it also sells a successful line of complementary products such as apparel, workwear, footwear as well as merchandise such as cups, mugs and glasses.

63. In terms of the size of the opponent's brand, I note that its evidence confirms that the global sales and revenue figures for the opponent's brand in 2020 stood at \$47.1 billion. In respect of its market share in construction equipment manufacturers' in that same year, the opponent enjoyed a 13% market share, being the largest amongst its competitor brands.¹⁰ Additionally, the evidence confirms that the opponent's brand has consistently ranked amongst the top 100 'Best Global Brands' by Interbrand over a number of years. In 2021, 'CAT' was listed as the 82nd best global brand.¹¹ While the points that speak to the size of the opponent's brand are on a global scale, I note that the narrative evidence confirms that the UK represents one of the largest bases for the opponent's brand outside of the US.¹² On this point, I note that as at the relevant date, the opponent

⁹ See LYY10 and paragraphs 79 to 93 of the witness statement of Ms Young.

¹⁰ See paragraph 57 of the witness statement of Ms Young and LYY6.

¹¹ See page 3 of LYY9

¹² See page1 of LYY3

employed over 10,000 people in the UK and operated out of 20 UK-based locations.

64. In addition to all of the above, the opponent has provided extensive evidence as to marketing. I do not intend to summarise this evidence in full but note that it includes promotional materials from prior to the relevant date, evidence of the opponent's social media accounts, press releases, information surrounding a podcast, a summary of the opponent's rewards and recognition and information regarding the opponent's attendance at various international trade shows.¹³

65. Press coverage of the opponent's brand is also discussed and, again, I note that this is extensive. I note that a range of articles are provided¹⁴ and while I have no intention to discuss these in full, I note that they include coverage from a range of different types of UK publications, including those that specialise in construction (such as 'New Civil Engineer' and 'Construction News') as well as local news (such as 'The Leicester Mercury' and 'The Northern Echo') and nationwide news publications (such as The Express, The Sunday Telegraph and The Times). It is noted that the majority of this coverage is from prior to the relevant date with some evidence provided dating as far back as 1998.

66. While there is additional evidence speaking to the size of the opponent's brand on the global stage, it is clear to me from that which I have discussed above that the opponent operates a very large and successful business operation, both globally and across the UK. While that may be the case, given the disparate range of goods and services relied upon under the present ground, the question before me in the present assessment is how this use relates to the same. On this point, I note that the opponent has provided specific evidence of use that covers a wide range of different areas of its business. While some of this evidence is of no real assistance

¹³ See LYY7

¹⁴ See LYY8

to the present assessment,¹⁵ some of it is. As such, I will proceed to discuss only the evidence that is relevant to the present assessment. In doing so, I consider it necessary to break my assessment down into sub-headings for ease of reference.¹⁶

Parts and fittings for industrial machines and vehicles and power systems, including engine parts, machine and vehicle attachments, hydraulics, consumables and maintenance parts and undercarriages.

67. In respect of these goods, I note the opponent has not only provided the annual UK turnover figures for between 2015 and 2020¹⁷ but it has also provided a range of printouts that show these goods as being available for sale in the UK and bearing the opponent's mark.¹⁸

68. The turnover figures are set out as being *figures in excess of* and are as follows:

Year	Net UK sales (\$)
2015	87,000,000
2016	83,000,000
2017	78,000,000
2018	89,000,000
2019	77,000,000
2020	67,000,000
Total:	481,000,000

¹⁵ . For example, the opponent has provided extensive evidence as to vehicles themselves which are not at issue under the present ground because the identity found in respect of the opponent's goods in class 12 relate to parts and fittings, not the vehicle goods themselves.

¹⁶ In doing so, I confirm that any conclusion eventually reached is still to be based on the evidence as a whole.

¹⁷ Whilst figures for 2021 are provided, the relevant date for the present assessment 8 September 2020, being the priority date for the applicant's mark.

¹⁸ See pages 46 to 56 of LYY3

69. While the printouts that accompany these figures are from after the relevant date, the narrative evidence confirms that they were all available to purchase in the UK as at the relevant date. I have no reason to disbelieve the opponent's claim that these figures relate to such goods and will proceed as such.

Servicing

70. The opponent confirms that it offers repair, maintenance and support services throughout the UK. Information regarding these services is provided via printouts from the opponents' website.¹⁹ This evidence is undated and I note that no turnover figures have been provided in respect of these services. However, given the size of the opponent's business operation, I see no reason to doubt the claim that the opponent offers repair and maintenance services for all of its vehicular or machinery goods. Given the size of the turnover in respect of the parts alone, I consider it reasonable to infer that the business operation in respect of these services is also likely to be substantial.²⁰

Clothing

71. As at the relevant date, the opponent claims that it sold both workwear and lifestyle/fashion clothing in the UK. Photographs of such products are shown and I note that these include t-shirts (both long and short sleeved), jackets, sweatshirts, vests, polo shirts, hoodies, trousers, leggings and shorts.²¹ Additionally, printouts from the opponent's website and third party retailers ASOS, Screwfix, Mammoth Workwear and Bodyguard Workwear (amongst others) are provided that show goods such as those listed above as well as bobble hats, belts, boots (including safety boots) and a range of workwear goods such as working jackets and trousers. I note that the majority of these goods all bear the opponent's mark or are listed as

¹⁹ LYY4

²⁰ In making this finding, I consider it reasonable to conclude that the specialist nature of the opponent's goods is such that their repair, maintenance or installation are likely conducted by the opponent itself.

²¹ See paragraph 50 of Ms Young's witness statement and LYY5

being 'CAT' branded products. On this point, I note that some of the workwear goods feature protective qualities (such as steel toe boots) that are natural to class 9, not class 25.²²

72. In respect of these goods, the following sales and marketing figures have been provided. As was the case with the turnover discussed for the opponent's parts, the figures provided below are to be taken as figures *in excess of* the figures actually listed.

Year	Net UK retail sales (\$)	UK marketing spend (\$)
2017	3,960,000	99,000
2018	5,150,000	128,000
2019	5,590,000	139,000
2020	4,317,000	107,000
Total:	15,057,000	473,000

Drinkware

73. The topic of drinkware is addressed relatively briefly in the opponent's evidence. No sales figures for these goods are provided but extracts from catalogue dated between 2016 and 2020 are. These catalogues confirm what is stated in the narrative evidence in that the opponent offered goods such as water bottles, mugs, flasks and cups, all of which bearing the opponent's mark.

Assessment of the evidence

74. Taking all of this evidence into account, it is clear that the opponent operates a very large operation in respect of the parts and fittings for vehicles/machines, being goods found in classes 7 and 12. In short, the turnover for this area of the business

²² See, for example, pages 3, 5 and 6 of LYY5

was, between 2015 and 2020, in excess of \$481 million. I appreciate that these figures are in US dollars and that the relevant date sitting in September 2020 means that some of the 2020 figures will be irrelevant. However, these figures are still significant and point to a very successful and consistent business in such goods. As for the evidence regarding the servicing of vehicles and machines, I am of the view that while it is limited, it is reasonable to infer (on the basis of the size of the parts and fittings sector of its business) that this is also represents a significant arm of the opponent's business operation. In my view, the opponent's mark enjoys an enhanced degree of distinctive character in respect of the goods and services associated with this side of the opponent's business. I consider that the use before me is such to conclude that, for these goods and services, the opponent's mark enjoys a high degree of distinctive character.

75. Turning to the clothing goods sold by the opponent, I remind myself that this arm of the business enjoyed a turnover of over \$15 million over four years with a marketing spend of \$473,000. On this face of it, these figures appear large. However, when measured against the size of the clothing market in the UK,²³ they are not necessarily significant to the point that they can be said to point to an enhanced degree of distinctive character. In addition, they are not demonstrative of a longstanding level of use. Additionally, I remind myself that some of the goods shown are protective footwear goods natural to class 9. The lack of breakdown of how the turnover can be said to relate to class 25 goods specifically is a further point in support of my finding that the use before me is not as significant as it first appears to be. Taking all of this into account, I do not consider that the evidence in respect of clothing is sufficient to warrant a finding that the opponent's mark enjoys an enhanced degree of distinctive character beyond its inherent level.

76. In light of the vague nature of the evidence regarding the opponent's drinkware goods, I consider that the same finding to that reached in the preceding paragraph

²³ I have no evidence on this point but it is likely one that attracts annual turnover in the billions of pounds.

applies to these goods also, namely that the opponent's mark does not enjoy an enhanced degree of distinctiveness. On this point, I accept that the opponent clearly sold drinkware prior to the relevant date, however, the evidence lacks sales or marketing figures for the same. In my view, to make a similar inference to the one I have above regarding repair services would be unreasonable in these present circumstances. I say this because drinkware is clearly an activity that is wholly unrelated to the opponent's actual areas of focus, being vehicles, machinery and parts and fittings for the same. Therefore, I cannot reasonably say that the association between such goods is logical to suggest that the drinkware sector of the opponent's brand must have enjoyed a high level of use simply because the parts and fittings area did.

77. Lastly, I note that there is no evidence in respect of the opponent offering for sales any goods of services in classes 9, 16 and 38 (being the goods and services that remain at issue here subsequent to my goods and services comparison above). As such, there can also be no enhanced degree of distinctive character for such goods and services.

78. To confirm, I find that the following goods and services enjoy a high degree of enhanced distinctive character:

Class 7: Parts and accessories for motors and engines.

Class 12: Vehicle parts and accessories.

Class 37: Vehicle services, repair and maintenance; none of the aforesaid offered in relation to logistical for automobiles industry.

79. However, the position with respect of the remaining goods and services relied upon under the present ground is that my finding in respect of the inherent distinctiveness remains, namely that they are distinctive to a medium degree.

Likelihood of confusion

80. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their minds.

81. I have found the goods and services at issue to be either identical or similar to varying degrees, including to between a low and medium degree. The average consumer base is formed of members of the general public and professional users operating in different industries. The consumers will pay varying degrees of attention when selecting the goods and services at issue and this will range from low to high. For the most part, the selection process will be visual, but an aural component will not be ignored. Further, in some instances, the aural element may play an equal or even a dominant role. In respect of the marks at issue, I have found them to be visually and aurally similar to a medium degree and conceptually similar to between a medium and high degree. Lastly, I have found that the opponent's mark possesses a medium degree of inherent distinctiveness. However, for some goods and services (being those listed at paragraph 78 above),

this has been enhanced to a high degree due to the use made of the opponent's mark.

82. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I consider that the average consumer would misremember or inaccurately recall which mark was which. I say this because whilst the word 'SECURITY' is present in the applicant's mark, its impact on the mark is limited (and in some instances could be seen as descriptive) and, therefore, consumers will not look to pin their recollection on that word. Instead, they will pin their recollection on the shared word, being 'CAT'.²⁴ As such, I consider that consumers will misremember which mark included the word 'SECURITY' and which did not. Consequently, I consider that there exists a likelihood of direct confusion. While I appreciate that some goods were found to be similar to a degree that sits on the lower end of the scale, this was not outright low. In short, I do not consider this to be so low so as to offset the degree of similarity between the marks, especially in light of the shared use of their dominant elements, being 'CAT'. As such, I consider that my finding of confusion applies to all goods and services at issue. Further, for these same reasons, I consider that this finding of direct confusion also applies regardless of the level of attention paid by the consumer. Lastly, for the avoidance of doubt, I find that the finding applies regardless of whether the opponent's mark is viewed on goods or services for which it enjoys an enhanced degree of distinctiveness of not.

83. Alternatively, if I am wrong and the average consumer notices the differences between the marks, I will proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

²⁴ While the stylistic differences may be noticed, the point remains that the recollection will be pinned about the actual word itself, not the ordinary geometric shape.

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that 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. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

84. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

85. I note that in its submissions, the opponent claims that this case falls within categories (a) and (b) of the examples listed above. Firstly, it claimed that the common element 'CAT' is so strikingly distinctive that the consumer would assume that no-one else but the opponent would use it. Further, the addition of 'SECURITY' is such that it simply adds a non-distinctive element of the kind that consumers would expect to find in a sub-brand or brand extension. Dealing with these arguments in turn, I will say that I do not consider that 'CAT' is so strikingly distinctive that the consumer would believe that only one undertaking would use it. I appreciate that for some goods and services the opponent's mark will enjoy a high degree of distinctive character, however, I do not consider that this necessarily means that 'CAT' is so strikingly distinctive that it would lead to the conclusion put forward by the opponent.

86. While the first argument of the opponent fails, it is the second argument where I consider that its claim succeeds. I note that I have said that 'CAT' is not so strikingly distinctive that consumers would only believe one undertaking would use it, however, I am of the view that the 'CAT' element will be seen as the indicator of origin for both 'CAT' and 'CAT SECURITY'.²⁵ On this point, I remind myself that some of the applicant's goods and services are broad enough to cover goods/services that relate to security and, as such, the addition of 'SECURITY' will be viewed as a non-distinctive addition. Even where 'SECURITY' is not allusive or descriptive of the goods and services of the applicant, consumers will (whether rightly or wrongly) view the addition as a clear indication of the type of business

²⁵ This is the case regardless of whether the stylistic elements of the opponent's mark were noticed or not. Additionally on this point, I consider that 'CAT' retains an independent distinctive role and independent trade mark significance in the applicant's mark.

operation of the 'CAT SECURITY' brand, i.e. one that relates to security. As a result, I find that when consumers are confronted with 'CAT' and 'CAT SECURITY', they will consider it logical that the undertaking known as 'CAT' has added the word 'SECURITY' in order to indicate the nature of its sub-brand, being one that relates to security goods. As for the stylistic differences between the marks, I consider that this will simply be put down to the marks being alternative marks used by the same undertaking in different contexts. For example, the word only mark may be used in promotional materials or press releases where the stylised mark would be that used on packaging. Consequently, I consider that there exists a likelihood of indirect confusion between the marks. Further, for the same reasons, I have set out above when considering direct confusion, I find that the outcome of indirect confusion also applies for goods that are similar to a lower degree, where goods/services are selected with a high degree of attention and regardless of whether the opponent's mark is viewed on goods or services that enjoy an enhanced level of distinctiveness, or not.

87. The present ground succeeds in full meaning that the applicant's mark will be refused registration for all goods and services applied for. However, for the sake of completeness, I will now proceed to consider the remaining grounds of the opposition.

Section 5(3)

88. Section 5(3) of the Act states:

"5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the

later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

89. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and*

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).

90. In considering the present ground, I remind myself that the opponent relies on the same mark that it did above. While that may be the case, the opponent relies on a different set of goods and services under the present ground, being those set out in Annex 2 of this decision. These goods and services reside in classes 7, 12 and 37 only.

91. The opponent's mark is a comparable mark based on an earlier EUTM owned by the opponent. As such, EU use prior to IP Completion Day (being 31 December 2020) may be relevant to the issue of reputation. While that may be the case, the opponent's evidence has a particular focus on the UK so I do not consider that the issue as to EU use is of any real relevance here.

92. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar.²⁶ Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the applicant's mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

²⁶ As per my comparison of the marks under the section 5(2)(b) ground above, this condition has been satisfied.

Reputation

93. I have already summarised the opponent's evidence in respect of its class 7 and 12 goods²⁷ and class 37 services when considering the issue of enhanced distinctiveness at paragraphs 62 to 73 above. I rely on that same evidence for the purpose of my present assessment. I do not intend to repeat that summary here but, briefly, I remind myself that for its class 7 goods, the opponent's turnover between 2015 and 2020 was at least \$481 million. As for its class 37 services, I found it reasonable to infer that this is also a sizeable business operation given the size of the opponent's business operation in respect of the parts and fittings for vehicles/machines. In respect of these goods and services, I am content to conclude that the evidence provided is sufficient to demonstrate that the opponent enjoys a strong level of reputation. While this reputation may extend to goods and services beyond those that I have assessed above, I consider that for the purpose of this assessment it is sufficient to simply find that the opponent's reputation for these goods and services vests in the following:

Class 7: Parts and accessories for motors and engines.

Class 12: Vehicle parts and accessories.

Class 37: Vehicle services, repair and maintenance; none of the aforesaid offered in relation to logistical for automobiles industry.

94. As for the other class 12 goods that cover actual vehicle goods, I appreciate that these were not subject to my assessment above. However, I can summarise that evidence briefly by referring to the turnover figures provided in the evidence which shows that, between 2015 and 2020, the opponent enjoyed a level of sales in the UK in excess of the following figures:

²⁷ I refer here only to the parts and fittings goods in class 12 of the opponent's specification.

Year	Net UK sales (\$)
2015	356,000,000
2016	307,000,000
2017	332,000,000
2018	405,000,000
2019	314,000,000
2020	176,000,000
Total:	1,890,000,000

95. I note that in its evidence, the opponent confirms that these figures cover a range of different vehicles goods such as articulated trucks, asphalt pavers, compactors, dozers, excavators, off-highway trucks and various types of loaders, amongst others. All of these vehicles are those that can reasonably be said to be those used in agriculture, compaction, construction, demolition, earth conditioning, earth moving, forestry and mining, amongst others.

96. In considering this evidence alongside the evidence I have summarised at paragraphs 62 to 66 above regarding the opponent's brand, generally, it is clear to me that the level of use shown is exceedingly high. Clearly, a significant part of the relevant public would be aware of this use and, as such, I am content to conclude that the opponent's mark enjoys a very strong level of reputation in the following class 12 goods:

"Vehicles for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management."

Link

97. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

98. Under the section 5(2)(b) ground of my decision, I found that the marks at issue are visually and aurally similar to a medium degree and conceptually similar to between a medium and high degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

99. Under the section 5(2)(b) ground, I found either identity or a degree of similarity in respect of all of the applicant's goods and services. That same finding does not automatically apply here because the opponent's reputed goods are more limited than those assessed above. For example, the reputed goods do not include those in classes 21 or 25 which I ultimately found identical to the applicant's class 21 and 25 goods. That being said, I remind myself that the reputed goods and services formed the basis of my findings of identity in respect of the applicant's goods and services in classes 7, 12 and 37. As such, I make those same findings here.

100. As for the applicant's goods and services in classes 9, 16, 21, 25 and 38, I find that these are dissimilar to the reputed goods of the opponent. In short, the opponent's reputed goods and services all differ in nature, method of use, purpose with all of the remaining goods and services of the applicant. As for trade channels, it is clear to me that the goods and services in classes 9, 16 and 38 do not share any overlap with the opponent's reputed goods and services. As for those goods

in classes 21 and 25, I appreciate that the opponent itself also sells clothing and drinkware goods meaning that, clearly, some undertakings do sell goods in classes 7 and 12 as well as goods in class 21 and 25. That being said, I have nothing before me to suggest that this is common in the trade and, therefore, I am unwilling to find that there is an overlap in trade channels between such goods and services. In terms of user, I appreciate that there may be some overlap on the basis that users of the opponent's reputed goods and services are inevitably going to be those that also use the goods and services in classes 9, 16, 21, 25 and 38 on the basis that their respective user bases are so broad. However, in my view, this is not sufficient by itself to give rise to a finding that these goods and services are similar to any degree. As such, I find them dissimilar.

The strength of the earlier mark's reputation.

101. I have found that the opponent's mark enjoys a strong reputation in the following goods and services:

Class 7: Parts and accessories for motors and engines.

Class 12: Vehicle parts and accessories.

Class 37: Vehicle services, repair and maintenance; none of the aforesaid offered in relation to logistical for automobiles industry.

102. Further, I have found that the opponent's mark enjoys a very strong reputation in the following goods:

Class 12: Vehicles for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas

exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management.”

The degree of the earlier mark’s distinctive character, whether inherent or acquired through use.

103. Inherently, I have found the mark to be distinctive to a medium degree. In respect of enhanced distinctiveness, I have found that the class 7 goods, the parts and fittings in class 12 and class 37 services enjoy a high degree of distinctive character. While I have not conducted an assessment on this point for the remaining class 12 goods (being those listed at paragraph 102 above), I am of the view that the sheer size of the business operation surrounding these goods is sufficient to give rise to a finding that the opponent’s mark enjoys a very high degree of distinctive character in respect of the same.

Whether there is a likelihood of confusion

104. I have found that the marks at issue are likely to be directly and indirectly confused with each other in respect of identical or similar goods and services. Under the present ground, this same finding can be said to apply in respect of the applicant’s goods and services in classes 7, 12 and 37.

105. The above being said, I remind myself there are some goods and services of the application that are dissimilar to the reputed goods and services of the opponent. On this point, I remind myself that where there is no similarity between goods and services, there can be no confusion under an ordinary section 5(2)(b) assessment. However, the provisions of section 5(3) offer additional protection which takes into account the repute and distinctiveness of the earlier marks. For example, some marks are so distinctive and well-known that there is likely to be some confusion almost irrespective of the goods or services on which the marks

are used. In this particular case, therefore, I am required to consider whether the average consumer would be caused to believe that the user of 'CAT SECURITY' for the dissimilar goods and services is connected to the user of the opponent's mark.

106. Despite my findings regarding the strength of the opponent's reputation, the high level of distinctiveness enjoyed by the opponent's mark and the levels of similarity between the marks, I am of the view that the distance between the remaining goods and services is such that the consumer will not consider the marks to share an economic connection. In short, I see no logical rationale as to why the consumer would, in the present scenario, believe the applicant's mark was connected to or originated from the opponent. As a result, I do not consider that there exists any likelihood of confusion (be that direct or indirect) in respect of the dissimilar goods and services of the applicant.

Conclusion on link

107. Where I have found confusion, I consider that a link between the marks is inevitable. As such, I find that there is a sufficient link between the marks in respect of the applicant's goods in classes 7, 12, and 37. That being said, I am of the view that were there is no confusion (being the applicant's class 9, 16, 21, 25 and 38 goods and services), I do not consider that a link would be made. My reasons follow.

108. I bear in mind that the way the opponent has pleaded its case under the present ground is that the link and damage results from the consumers being confused as to the origin of the goods and services. Given that I have found no confusion for the dissimilar goods and services of the applicant, it follows that the opponent's claim in respect of a link and damage fails. That being said, even if I were to consider link in the ordinary way, it would offer no advantage to the opponent. I say this because the reputed goods and services of the opponent and the class 9, 16,

21, 25 and 38 goods and services of the applicant are just too distant from one another to the point that, despite the size of the opponent's reputation, the consumer would not be caused to wonder if they were connected and neither would they bring the opponent's mark to mind when confronted with the applicant's. Instead, the consumer would simply disregard any connection because of the distance between the goods and services.

109. As a result of what I have said above, the present ground may proceed to the issue of damage. However, this is only in relation to the applicant's goods and services in classes 7, 12 and 37.

Damage

110. The opponent has pleaded that use of the applicant's mark would, without due cause, lead to an unfair advantage in favour of the applicant and cause a detriment to the distinctive character of the opponent's mark.

Unfair Advantage

111. I bear in mind that unfair advantage has no effect on the consumers of the opponent's goods and services. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to select the goods and services of the applicant's mark than they would otherwise have been if they had not been reminded of the opponent's mark.

112. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and

Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

113. In the present case, I have found that there would be a link between the marks on the basis that they would wrongly believe the marks to derive from the same undertakings. In such circumstances, I consider it inevitable that use of the applicant's mark in respect of those goods and services would give rise to an unfair advantage. This is on the basis that the consumers may engage the goods or services of the applicant based on the strength of the reputation of the earlier mark, without the applicant needing to go to the effort and expense of promoting and marketing its goods or services itself.

114. The applicant would have a defence if it could establish that it had a due cause in filing for its marks. However, no arguments have been put forward to this effect. The applicant's use is not, therefore, with due cause.

115. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. The section 5(3) ground of the present opposition, therefore, succeeds in relation to the applicant's goods and services in classes 7, 12 and 37.

Section 5(4)(a)

116. Section 5(4)(a) of the Act reads as follows:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

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

117. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

118. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt &

Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

119. I am of the view that I can deal with the present ground briefly. I say this because the opponent claims that its business enjoys goodwill in respect of goods similar to those for which I have already found there to exist a strong or very strong reputation. On this point, I note that the goods relied upon under the present ground are as follows:

"Construction, mining, agricultural, forestry, earth moving machines and equipment and related products; land vehicles; power generation products, including motors and engines; parts and fittings for all the aforesaid goods."

120. While not worded identically to the goods in class 12 relied upon under the section 5(2)(b) and 5(3) grounds, I consider that they clearly describe the same goods. The parts and fittings goods formed the basis of both my section 5(2)(b) and 5(3) assessments above and the vehicle goods formed the basis of my finding under section 5(3) only. Following similar reasons to those given under my assessment of the evidence at paragraphs 74 to 78 and 94 to 96 above, I find that the evidence before me is sufficient to give rise to a finding that the opponent's business enjoys a very strong level of goodwill in respect of these same goods and services.

121. For similar reasons to those given in both my section 5(2)(b) and 5(3) assessments in respect of confusion above, I consider that this level of goodwill is sufficient to give rise to a finding of misrepresentation in respect of the applicant's goods and services in classes 7, 12, and 37. In such circumstances, I consider damage is easily foreseeable via a diversion of sales.

122. The above being said, I consider that regardless of the size of the opponent's goodwill, the distance between the remaining goods and services (being those in classes 9, 16, 21, 25 and 38) is too far for the opponent to overcome. Again, I say this for similar reasons to those I have discussed under the section 5(3) ground of this decision above. As such, I consider that the present ground fails against the goods and services in classes 9, 16, 21, 25 and 38.

CONCLUSION

123. The opposition succeeds in full and, subject to any successful appeal of my decision, the applicant's mark is refused registration for all of the goods and services applied for.

COSTS

124. The opponent has succeeded in full and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1,500 as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the applicant's counterstatement:	£300
Filing evidence:	£600

Filing written submissions in lieu	£400
Official fees:	£200
Total:	£1,500

125. I hereby order Cap City Muffler LLC to pay Caterpillar Inc. the sum of £1,500. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 26th day of February 2025

A COOPER
For the Registrar

ANNEX 1

Class 6

Metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metals; ironmongery; small items of metal hardware; pipes and tubes of metal; safes; ores; fastening, securing and sealing devices made principally or wholly of metal; fasteners of common metal; metal fastening anchors [for securing pictures to walls]; door seals of metal; window seals of metal; piston seals of metal; fixing devices of metal; anchoring devices of metal; door holding devices of metal; window protection devices of metal; retaining [fixing] devices of metal plugs, straps, clips, nuts, bolts, screws, rings, pins, washers, seals, ties, nipples, bindings of metal, bungs, caps, closures made principally or wholly of metal, parts and fittings for all the aforesaid goods; collars, clamps, couplings, hooks, links, nails, pegs, rivets, guards, tanks, drain plugs, cotter pins, drawbar pins, clevis pins, locking pins, eye bolts, snap rings made principally or wholly of metal; thread inserts made principally or wholly of metal; rain traps and drain caps made principally or wholly of metal; pipe extensions deflectors made principally or wholly of metal; grids plates track hardware made principally or wholly of metal; vices made principally or wholly of metal; welding rods made principally or wholly of metal; cable and wire made principally or wholly of metal; pipes and tubing made principally or wholly of metal; chains, slings pulleys made principally or wholly of metal; badges made principally or wholly of metal; bells made principally or wholly of metal; locks and padlocks made principally or wholly of metal; number plates made principally or wholly of metal; knobs of metal; non-luminous and non-mechanical signs made principally or wholly of metal; non-luminous and non-mechanical signalling panels made principally or wholly of metal; reinforcing materials of metal; parts and fittings included in class 6 for land vehicles, agricultural machinery and earth moving machinery, namely, bolts, metal pipe clips, metal sealing, gaskets and rings, metal pipe collars, metal bolts, metal pipe connectors, metal caps for tubing ends, metal pipe fittings; parts and fittings included in class 6 for land vehicles, agricultural machinery and earth moving machinery, namely, metal cylinders for compressed gas or liquids, sold empty, metal threaded

fasteners, metal fasteners, namely, bolts, rivets, screws, metal gaskets, metal hardware, namely, nuts, metal hardware, namely, washers, metal hose clamps, metal hose couplings and fittings; metal couplings for use with hydraulic hoses; metal reinforced hoses; metal reinforced hydraulic hoses; wire braid hoses; spiral wire hoses; metal hoses; machine parts, namely, metal retention systems for securing ground engaging tools for heavy machinery.

Class 7

Machines and engines and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lawn care, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); engines, machines and other installations for oil-field and gas-field exploitation and parts therefor as far as covered by class 7; agricultural instruments other than hand operated; ground engaging teeth for use on buckets for use on earth moving machinery; machinery for earth moving, earth conditioning and material handling, namely, backhoe loaders, skid steer loaders, multi terrain loaders, integrated tool carriers, wheel loaders, track excavators, wheeled excavators and structural, repair and replacement parts for all the foregoing, structural, repair and replacement parts for engines for all the foregoing; machinery for earth moving, earth conditioning and material handling, namely, front shovels, telescoping material handlers, track material handlers, wheeled material handlers, track-type tractors, pipelayers, track loaders, landfill compactors, soil compactors, wheel dozers, motor graders, industrial tractors, wheel tractor-scrapers and structural, repair and replacement parts for all the foregoing, structural, repair and replacement parts for engines for all the foregoing; machinery for earth moving, earth conditioning and material handling, namely, forest machines, track skidders, wheeled skidders, track feller bunchers, wheeled feller bunchers, forwarders, track harvesters, knuckleboom

loaders, vibratory soil compactors and structural, repair and replacement parts for all the foregoing, structural, repair and replacement parts for engines for all the foregoing; machinery for earth moving, earth conditioning and material handling, namely, soil compactors, vibratory asphalt compactors, pneumatic compactors, asphalt pavers, track asphalt pavers, screeds, cold planers, road reclaimers, windrow elevators, soil stabilizers, underground mining loaders, waste handlers and structural, repair and replacement parts for all the foregoing, structural, repair and replacement parts for engines for all the foregoing; attachments, namely, asphalt cutters, augers, backhoes, blades, block-handling tools, hydraulic booms, buckets, cold planers, compactors, vibratory compactors, couplers, crushers, cutting jaws, de-limbers, forks, pallet forks, grapples, hammers, hoppers, lift groups, all of the foregoing for use with machinery for earth moving, earth conditioning and material handling; attachments, namely, lifting hooks, material handling arms, multi-processors, plows, pulverizers, pulverizing jaws, rakes, rippers, saws, scarifiers, scoops, shears, snow blowers, snow plows, snow wings, all of the foregoing for use with machinery for earth moving, earth conditioning and material handling; attachments, namely, stump grinders, thumbs, tillers, trenchers, truss booms, all of the foregoing for use with machinery for earth moving, earth conditioning and material handling; marine engines; industrial engines; diesel engines; gas engines; natural gas engines; valves (part of machines); spark plugs; air filters (parts of machines or engines); water regulators (parts of machines); oil filters; couplings other than for land vehicles; assembly presses; starters; pumps; diggers; excavators; bulldozers; loaders; fellers; bunchers; scrapers (part of earth moving machines); pavers; agricultural machines; engines for industrial, marine and other applications, and parts therefor; engines for electric, industrial, diesel, gas and natural gas generators and generators sets, and parts therefor; cutting machines; compactors; skidders; filters (parts of machines and engines); belts (parts of machines, motors and engines); blades (parts of machines); earth moving machines; road marking machines; road making machines; lifting machines; agricultural apparatus and instruments; steam rollers; forestry machines; pipe laying machines; compacting machines; buckets for earth moving machines; hydraulic jacks; welding machines and apparatus; forestry machines for harvesting, extracting, loading and transporting timber; jet

engines not for land vehicles; ground engaging machines; air cleaning filters (parts of machines or engines); pavement profilers; scarifiers to break up surfaces, in particular, topsoil and pavement; motor graders; fuel/air ratio controls; fuel nozzles; water separators; cultivating and harvesting machines, threshing machines, heading machines, reaping machines, binding machines, mowing machines; harrows; ploughs and rakes; draining machines; diggers (machines); aeronautical engines; agitators; air condensers; alternators; anti-friction bearings for machines; anti-friction pads for machines; anti-pollution devices for motors and engines; axles for machines; ball rings for bearings; bearing brackets for machines; bearings; belt conveyors; belts for machines; belts for motors and engines; blades (parts of machines); seal group assemblies (parts of machines), in particular, seal rings and elastomeric torus members; sealing joints (parts of engines); engines and motors for boats; brake linings other than for vehicles; brake segments other than for vehicles; brake shoes other than for vehicles; brushes (parts of machines); carburetors; compressed air machines; compressed air pumps; compressors (machines); condensing installations; connecting rods for machines, motors and engines; control cables for machines, engines or motors; control mechanisms for machines, engines or motors; current generators; control panels for generator sets; cutters (machines); cutting machines; cylinder heads for engines; cylinders for machines; cylinders for motors and engines; drilling bits (parts of machines); drilling heads (parts of machines); drilling machines; drilling machines; drills; dynamo belts; dynamo brushes; dynamos; engines, other than for land vehicles; fan belts for motors and engines; fans for motors and engines; fuel conversion apparatus for internal combustion engines; fuel economisers for motors and engines; gear boxes other than for land vehicles; gears, other than for land vehicles; grinding machines; guards (parts of machines); hammers (parts of machines); pneumatic hammers; mechanically operated hand held tools; handling apparatus for loading and unloading; hoists; holding devices for machine tools; mechanical discharging hoppers; jacks (machines); lawnmowers (machines); lift belts; lifting apparatus; loading ramps; lubricating pumps; lubricators (parts of machines); machine fly wheels; machine wheels; apparatus for machining; metal working machines; spray guns for paints; painting machines; pistons; pneumatic transporters;

presses; pulleys; pumps (machines); rammers (machines); reduction gears other than for land vehicles; mechanical shovels; shaft couplings; bearings for transmission shafts; speed governors for machines, engines and motors; spraying machines; superchargers; tarring machines; threading machines; threshing machines; transmission chains and shafts, other than for land vehicles; transmissions for machines; turbines other than for land vehicles; turbocompressors; valves (parts of machines); vehicle washing installations; vulcanisation apparatus; washing apparatus; waste disposers (machines); watering machines; parts and fittings for all the aforesaid goods; parts and fittings included in class 07 for land vehicles; agricultural machinery and earth moving machinery, namely, starting motors, alternators, pistons, cylinder heads, turbochargers, lubricating systems parts, air compressors and blocks not for land vehicles; silencers; air pumps; fuel economisers for motors and engines; exhausts; cranks; mufflers (parts of machines); exhaust caps; radiators and radiator caps; alternators; pistons; cylinder heads; turbochargers; lubricating systems parts; air compressors and blocks; replacement parts for earth moving machinery and diesel engines; welding apparatus; automatic vending machines; petrol pumps; cutting torches; electric welding apparatus; welding apparatus; combines, windrowers, balers, disc mowers and conditioners, sickle mowers and conditioners, bale accumulators and structural, repair and replacement parts for all of the foregoing, mufflers (parts of machines), silencers, fuel economisers, exhausts, hydraulic apparatus for land vehicles, mechanical engine parts for land vehicles, air compressors for land vehicles.

Class 9

Electrical, electronic, apparatus and instruments, namely electrical adaptors, electrical amplifiers, electrical connectors, electrical couplings, electrical fuses and electrical locks; scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking, (supervision), life saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; mobile phones; spectacles; sunglasses; magnetic data carriers; recording discs; mechanisms for coin-

operated apparatus; cash registers, calculating machines, computer software, computer software that provides real-time, integrated business management intelligence by combining information from various databases and presenting it in an easy-to-understand user interface, data processing equipment including computers; wireless sets (complete), television sets (complete), fire extinguishing apparatus; testing apparatus and instruments; electric cable and wire; computer hardware; control units; operator interfaces; security equipment; GPS equipment; equipment for remote operation, control, and monitoring of earth moving, earth conditioning, material handling, construction, mining, paving, agricultural, and forestry vehicles, equipment, and machinery, engines, power generation equipment, and off-highway trucks; cables; conduits, switches, pressure switches, connectors, jump leads, fuses, circuit testers, voltage testers; fuse holders, transformers, battery testing apparatus for sale in kit form; thermostats, pressure and temperature indicators, gauges, levelling apparatus and instruments; tape measures and rules; microscopes, tachometers; monitoring apparatus and displays; diagnostic apparatus and instruments; meters, thermometers; alarms, horns, flasher units, reflectors, mirrors, aerials, battery chargers; weighing apparatus and instruments; computer programs; calculators; CD Rom games; electrical couplings; levels; electrical locks; radios; batteries; battery starters; speed checking apparatus and instruments; battery cables; connectors for sale in kit form; electrical terminals; switches; water temperature regulators, probes; ammeters; battery testers, terminals, gas detectors; flow meters; ohmmeters; pressure measurement tools; battery ground strap connectors; battery tie down connectors; conduit and wire protectors; emergency jump start apparatus, emergency jump start receptacle assemblies; voltage converters; parts and fittings for all the aforesaid goods; parts and fittings included in class 9 for land vehicles, agricultural machinery and earth moving machinery namely, amplifiers for wireless communications, antennas, antennas for wireless communications apparatus, audio equipment for vehicles, namely, stereos, speakers, amplifiers, equalizers, crossovers and speaker housings, batteries for vehicles, computer hardware and software, computer software that provides real-time; all the foregoing excluding music recordings or video recordings of musicals; parts and fittings included in class 9 for land vehicles,

agricultural machinery and earth moving machinery namely, integrated business management intelligence by combining information from various databases and presenting it in an easy-to-understand user interface, devices for wireless radio transmission; all the foregoing excluding music recordings or video recordings of musicals; parts and fittings included in class 9 for land vehicles, agricultural machinery and earth moving machinery namely, electric control panels, electric luminescent display panels, electric relays, electronic and optical communications instruments and components, namely, optical transmitters, electronic and optical communications instruments and components, namely, optical receivers, electronic and optical communications instruments and components, namely, digital transmitters; all the foregoing excluding music recordings or video recordings of musicals; parts and fittings included in class 9 for land vehicles, agricultural machinery and earth moving machinery namely, electronic control systems for machines, global positioning systems, laser object detectors for use on vehicles, navigation apparatus for vehicles in the nature of on-board computers, radios for vehicles, voltage regulators, voltage stabilizers, voltmeters; all the foregoing excluding music recordings or video recordings of musicals; telecommunications equipment; eyeglasses; sunglasses; computer software for testing, monitoring, and operating vehicles, engines, equipment, machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; computer software for testing, monitoring, and operating vehicles, engines, equipment, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; computer software for paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; computer

software in the field of statistical analysis, data analysis, predictive analysis, and job site office management and planning; computer software for selecting delivery location and tracking delivery status of packages, freight, and job site materials; equipment and parts therefor for locating, positioning, and controlling machines, engines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; equipment and parts therefor for locating, positioning, and controlling machines, engines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; equipment for remote operation, control, and monitoring of engines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; equipment for remote operation, control, and monitoring of engines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management.

Class 12

Vehicles for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; locomotives; railcars; engines and air intake and exhaust assemblies for land vehicles; and parts and fittings for all of the foregoing goods; apparatus for locomotion by land, air or water; tractors and tractor engines; haulage trucks and trailer wagons; vehicles for mining, paving, agriculture, forestry, earth conditioning and material handling, namely, articulated trucks, off highway trucks, underground mining

trucks, off highway tractors; internal combustion fork lift trucks; electric fork lift trucks; electric pallet movers, manual pallet movers; locomotives; agricultural tractors; structural, repair and replacement parts for engines for the foregoing vehicles; vehicle chassis; tires for vehicle wheels; wheels; tracks for vehicles; trucks; dump trucks; land vehicles incorporating loading, compacting, pipe laying and grading apparatus; tire valves; exhaust caps; radiators and radiator caps; hydraulic circuits and hydraulic adapters; couplings for land vehicles; air pumps (vehicle accessories); horns for vehicles; mirrors for vehicles; mudguards, mud flaps, spray guards, spray flaps; seats and seat belts; windscreen wipers and windscreen wiper blades, anti-skid apparatus; anti-skid chains; brakes for vehicles; brake linings for vehicles; vehicle covers; parts and fittings for all the aforesaid goods; parts and fittings included in class 12 for land vehicles, agricultural machinery and earth moving machinery, namely, gaskets, cranks, camshafts, engines, bearings, rods, liners, transmissions for land vehicles and structural, repair and replacement parts therefore; starting motors, alternators, pistons, cylinder heads, turbochargers, lubricating system parts, brake blocks for land vehicles; connecting hoses for vehicle radiators.

Class 16

Paper and cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; newspapers and periodical publications; memorandum books, ballpoint pens, telephone indices, pencils, desk calendars; paper stationery; cardboard articles, namely cardboard packaging, cardboard containers, cardboard boxes, cardboard cartons; books; drawing sets; graphic representations; graphic reproductions; greeting cards; book markers; covers (stationery); decalcomanias; diagrams; document files; erasing products; envelopes; filtering materials (paper); printed forms; hand books; holders; index cards; letter trays; magazines (periodicals); maps; modelling materials; photographs; pictures; plans; scrap books; school supplies

(stationery); writing instruments; wrapping paper; stickers; crayons; paper towels; children's books; photograph albums (made of leather or of imitation leather).

Class 21

Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush making materials; articles for cleaning purposes; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; articles for scouring and polishing; cups, mugs and glasses; gloves for household purposes; buckets; watering devices; parts and fittings for all the aforesaid goods.

Class 25

Clothing, footwear, headgear; articles of outerclothing; t-shirts and sweatshirts; caps, hats, ties (for wear), overalls (for wear), jackets, coats, bathing suits, beach clothes, dressing gowns, gloves (clothing), trousers, vests, night wear pajamas, belts, scarves, shorts, sweat pants, sweat shirts, wrist bands, mittens rain wear.

Class 37

Building construction; engineering construction; repair and installation services relating to vehicles, equipment, machines, engines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lawn care, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; installation and maintenance of apparatus for oil-field and gas-field exploitation, and for energy production; service, maintenance, and repair of land vehicles, earth moving, earth conditioning, material handling, construction, mining, paving, agricultural, and forestry vehicles, equipment, and machinery, engines, and power generation equipment, and control units for the aforementioned; machinery installation,

maintenance, and repair; rental and leasing of engineering, earth moving, earth conditioning, farming, material handling, construction, mining, paving, agricultural, and forestry vehicles, equipment, and machinery, as well as engines, generators and power generation equipment; remanufacturing of engines, transmissions, power train components, power generation units, land vehicles, earth moving and conditioning machinery, material handling machinery, agricultural machinery, paving and construction equipment, electronic components of the foregoing, and consumer electronics; repair, servicing, and maintenance of vehicles, engines, equipment, machines, machine tools, and control units and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; repair, servicing, and maintenance of vehicles, engines, equipment, machines, machine tools, and control units and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring and vegetation management; machinery installation; rental of equipment, machines, and machine tools for use in compaction, construction, demolition, earth conditioning, earth contouring, earth moving, lifting, marine propulsion, material handling, mining, paving, pipelaying, and road building and repair, site preparation and remediation, and tunnel boring; remanufacturing of vehicles, engines, machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; remanufacturing of vehicles, engines, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; providing searchable computer databases, websites, and online information services relating to renting of equipment, machines, machine tools and parts therefor for use in compaction, construction, demolition, earth conditioning, earth contouring, earth moving, lifting, mining; providing searchable computer databases, websites, and online information services relating to repair and maintenance of

vehicles, equipment, machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; providing searchable computer databases, websites, and online information services relating to renting of equipment, machines, machine tools, and parts therefor, for use in paving, pipelaying, road building and repair, site preparation and remediation, tunnel boring; providing searchable computer databases, websites, and online information services relating to repair and maintenance of engines and power generation equipment; providing searchable computer databases, websites, and online information services relating to repair and maintenance of vehicles, equipment, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring and vegetation management; rental store services in relation to earthmoving, construction, oil and gas extraction and mining machines and equipment, motors and engines, machine tools, machine coupling and transmission components and parts, fittings and components for the aforesaid.

Class 38

Telecommunications; communications by computer terminals; communications by fibre optic networks; computer aided transmission of messages and images; electronic mail; rental of telecommunication equipment; rental of message sending apparatus; information about telecommunication; providing public subscribers directory information for GPS navigation; providing access to GPS navigation services via satellite transmission.

ANNEX 2

Class 7

Machines and engines and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine, material handling, mining, mulching, oil and gas distribution, exploration and production, paving, pipelaying, power generation, road building and repair, site preparation and remediation and vegetation management; machine tools; parts and fittings for all the aforesaid goods; parts and fittings included in class 07 for land vehicles.

Class 12

Vehicles for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; engines and air intake and exhaust assemblies for land vehicles; and parts and fittings for all of the foregoing goods.

Class 37

Repair and installation services relating to vehicles, equipment, machines, engines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lawn care, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; installation and maintenance of apparatus for oil-field and gas-field exploitation, and for energy production; service, maintenance, and repair of land vehicles, earth moving, earth conditioning, material handling, construction, mining, paving, agricultural, and forestry vehicles, equipment, and machinery,

engines, and power generation equipment, and control units for the aforementioned;
machinery installation, maintenance, and repair.