O/0374/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 3593082, 3593164 & 3593122
BY FITTIPALDI IP HOLDINGS, LLC
IN CLASSES 12, 18, 21, 25, 35, 41 & 42

AND IN THE MATTER OF OPPOSITIONS THERETO
UNDER NOS. 426198, 426199 & 426290
BY CORPA SWITZERLAND AG

AND

IN THE MATTER OF REGISTRATION NOS. 801378346 & 801376808
IN THE NAME OF CORPA SWITZERLAND AG
IN CLASSES 12, 25 & 41

AND APPLICATIONS FOR DECLARATIONS OF INVALIDITY THERETO
UNDER NOS. 504976 & 504977
BY FITTIPALDI IP HOLDINGS, LLC

Background and pleadings

1. On 9 February 2021, Fittipaldi IP Holdings, LLC ("FIH") applied to register the following trade marks in the UK:

eFittipaldi
Application no. 3593082
Priority date: 8 February 2021 (US)
Publication date: 14 May 2021
("FIH's first mark")

FITTIPALDI AUTOMOBILI
Application no. 3593164
Priority date: 8 February 2021 (US)
Publication date: 14 May 2021
("FIH's second mark")

EMERSON FITTIPALDI
Application no. 3593122
Priority date: 8 February 2021 (US)
Publication date: 21 May 2021
("FIH's third mark")

2. Registration of all three marks is sought for the following goods and services:

Class 12: Automobile; vehicle wheels; fitted covers for vehicle steering; vehicle wheels; vehicle wheel rims; vehicle hubs; non-OEM custom vehicle wheels; wheel design inserts and their associated attachments.

Class 18: Leather goods, namely leather purses; luggage.

Class 21: Beverage glassware; drinking glasses.

Class 25: Clothing, namely, hats, jackets, shirts, and shoes; belts made of leather.

Class 35: Promoting sports competitions and events of others; automobile dealerships.

Class 41: Entertainment services, namely, performing and competition in motor sports, events; entertainment services in the nature of professional athletes competing in sports car races; entertainment services in the nature of automobile racing and exhibitions.

Class 42: Motor vehicle parts design services.

3. On 16 August and 20 August 2021, Corpa Switzerland AG ("Corpa") opposed the applications under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The oppositions are directed at all the applied-for goods and services, save for those in class 21. Corpa relies upon the following trade marks:[1]

UK registration no. 801378346
Filing date: 2 October 2017
Priority date: 29 August 2017 (Switzerland)
Registration date: 14 May 2018
("Corpa's first mark")

FITTIPALDI
UK registration no. 801376808
Filing date: 2 October 2017
Priority date: 29 August 2017 (Switzerland)

[1] Corpa's marks are comparable trade marks based upon pre-existing International Registrations designating the EU (under numbers 1378346 and 1376808). On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the EU, comparable UK trade marks were automatically created. The comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

Registration date: 25 April 2018
("Corpa's second mark")

4. Both of Corpa's marks stand registered for the following goods and services, all of which are relied upon for the purposes of the oppositions:

Class 12: Motor cars; electric vehicles; motors and engines for land vehicles; vehicle chassis, vehicle seats, chassis for motor vehicles; automobile bodies; steering wheels for vehicles; vehicle wheels.

Class 25: Clothing, footwear, headgear; shoes; shirts; trousers; overalls.

Class 41: Teaching; organization of sports events and competitions.

5. Given the respective filing/priority dates, Corpa's marks are earlier marks in accordance with section 6 of the Act. As they had not completed their registration processes more than five years before the priority dates of FIH's marks, they are not subject to the proof of use provisions specified in section 6A of the Act. Consequently, Corpa is entitled to rely upon all the goods and services of its marks, without having to demonstrate genuine use.

6. Corpa's pleaded case is that, as a result of the similarity between the competing marks and the identity or similarity between the parties' goods and services, there is a likelihood of confusion on the part of the public, including the likelihood of association.

7. FIH filed counterstatements, denying the claims made. Except for conceding that some of its goods are identical to those of Corpa's marks,[2] it denies that there is any similarity between the parties' goods and services. Moreover, FIH denies that the

[2] At paragraphs 5 and 11, FIH admits that *'automobile'*, *'vehicle wheels'* and *'non-OEM custom vehicle wheels'* in class 12 of the applications are identical to *'motor cars'* and *'vehicle wheels'* in class 12 of Corpa's marks. Further, at paragraphs 6 and 12, FIH admits that *'clothing, namely, hats, jackets, shirts, and shoes'* in class 25 of the applications are identical to Corpa's class 25 goods.

competing marks are similar. Based upon these factors, it disputes the existence of a likelihood of confusion.

8. On 14 June 2022, FIH made applications to invalidate Corpa's marks in full, pursuant to section 47 of the Act. The applications are based upon sections 3(6) and 5(6) of the Act. FIH contends that the parties had a prior business relationship. Corpa is said to have filed/registered the International Registrations from which its UK registrations derive on behalf of Emerson Fittipaldi (a famous racing driver) without his consent. On this basis, FIH submits that Corpa's marks were filed in bad faith and/or constitute an unauthorised act by an agent/representative of Mr Fittipaldi.

9. Corpa filed counterstatements, denying the grounds of invalidation. Save for admitting that its International Registrations resulted in the creation of the UK registrations at issue, Corpa does not admit any of the claims made by FIH in its statement of grounds and puts it to proof thereof.

10. On 7 October 2022, the proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008, the oppositions having previously been consolidated on 23 December 2021.

11. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 27 September 2023. FIH was represented by Ryan Pixton of Kilburn & Strode LLP. Corpa was represented by Stephen Lowry of Barker Brettell LLP.

Relevance of EU law

12. 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

13. FIH's evidence in chief is given in the witness statement of Ryan Pixton, dated 9 January 2023 and four exhibits (REP1 to REP4). Mr Pixton is a Trade Mark Attorney with Kilburn & Strode LLP, FIH's professional representatives. Mr Pixton provides identification for Mr Fittipaldi, an examination report concerning the mark 'EMERSON FITTIPALDI', a letter from Mr Fittipaldi consenting to the use and registration of the mark by FIH, and correspondence from Corpa's representatives to the EUIPO.

14. Corpa's evidence in chief is given in the witness statements of Andre Werner and Patrick Bosshard, dated 9 January 2023 and 19 January 2023, respectively. Mr Werner is a Swiss and European Patent Attorney and Partner at Troesch Scheidegger Werner AG ("TSW"), a position he has held since 1987. His statement is accompanied by one exhibit (AW1), which consists of a letter from him to Mr Bosshard regarding a meeting with Mr Fittipaldi. Mr Bosshard is a Managing Partner of Corpa, a position he has held since 2016. He provides evidence about the relationship between Corpa and Mr Fittipaldi, and a history of the relevant trade mark filings. His statement is accompanied by thirteen exhibits (PB1 to PB13).

15. FIH filed evidence in reply in the form of a second witness statement from Mr Pixton, dated 20 March 2023, and twelve exhibits (REP1 to REP12).[3] This evidence comprises correspondence between the parties, as well as documents from proceedings in the US.

16. I have read all the evidence and will return to it to the extent I consider necessary in the course of this decision.

Overall approach

17. If FIH's applications to invalidate Corpa's marks are successful, Corpa will have no earlier rights to rely upon in its oppositions against FIH's marks. As such, it is

[3] As the first four of these exhibits follow the same labelling regime as the exhibits to Mr Pixton's first statement, I will refer to them as REP1(2) to REP4(2) to avoid confusion.

convenient to first deal with FIH's applications to invalidate Corpa's marks. I will then return to consider Corpa's oppositions, should it become necessary to do so.

Applications to invalidate Corpa's marks

18. Sections 3(6) and 5(6) have application in invalidation proceedings because of the provisions of section 47 of the Act, which states:

> "47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).
>
> […]
>
> (2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).
>
> […]
>
> (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.
>
> […]
>
> (6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.
>
> Provided that this shall not affect transactions past and closed."

Section 3(6)

19. Section 3(6) of the Act reads as follows:

> "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

20. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ,* Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening,* Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening),* Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening),* Case T-507/08, EU:T:2011:46. It summarised the law as follows:

> "68. The following points of relevance to this case can be gleaned from these CJEU authorities:
>
> 1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].
>
> 2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].
>
> 3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the

internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacilik* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

> 10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].
>
> 11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacilik* at [46].
>
> 12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52].
>
> 13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: *Psytech* at [88], *Pelikan* at [54]."

21. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. the balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith.[4]

22. As per the case law cited above, it is for the party alleging bad faith to prove it. The initial evidential burden falls upon FIH: it must present evidence from which a rebuttable presumption of lack of good faith can be drawn.

23. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

> (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

[4] *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)

(b) Was that an objective for the purposes of which the contested application could not be properly filed?

(c) Was it established that the contested application was filed in pursuit of that objective?

24. It is necessary to ascertain what Corpa knew at the relevant date.[5] Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date.[6]

25. In its statement of grounds, FIH says that it is a wholly owned subsidiary of a trust, of which Emerson Fittipaldi (a famous racing driver) is the grantor. It states that, in or around 2017, Mr Fittipaldi was negotiating a deal regarding the sale of electric vehicles under the marks at issue. He was introduced to Corpa, who said that it would file trade mark applications on his behalf. Corpa then filed international registrations designating the EU, in its own name, which later resulted in the comparable UK marks subject to FIH's applications for invalidity. The crux of FIH's bad faith claim is that Mr Fittipaldi did not consent to the international registrations (or the resulting comparable UK marks), and that they were made in knowledge of his lack of consent. If proven, this is an objective for the purposes of which Corpa's marks could not be properly filed.

26. Mr Bosshard says that he was introduced to Mr Fittpaldi in 2017 wherein they entered discussions regarding a sports car project.[7] According to Mr Bosshard, Mr Fittipaldi and his business partner approached Corpa for assistance in acquiring financial investors for the project.[8]

27. On 15 June 2017, Mr Bosshard emailed Mr Fittipaldi to say that he had spoken with a patent attorney and was passing on information regarding the registration of Swiss and international trade marks; Mr Bosshard said that options for proceeding

[5] *Red Bull*
[6] *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).
[7] Witness statement of Patrick Bosshard, §§13 and 15
[8] Bosshard, §16

were to have a telephone conference with the attorney or for Mr Fittipaldi to delegate power to instruct the attorney.[9]

28. Mr Bosshard says that, on 10 August 2017, he, Mr Fittipaldi, his business partner and Mr Werner held a meeting at TSW's office (Mr Werner's law firm).[10] He states that the purpose of the meeting was to discuss the strategy of obtaining protection for 'FITTIPALDI'- and 'F'-derived trade marks.[11] It was allegedly agreed at the meeting that the trade marks would be filed by Corpa for various commercial reasons; this applied to numerous territories, including Switzerland (the territory from which Corpa's comparable trade marks originated).[12] Mr Werner also attests to the meeting taking place on this date; he says that it was his clear impression at the end of the meeting that Mr Fittipaldi agreed to the trade marks being registered in Corpa's name.[13]

29. There is then evidence that Corpa filed applications for the Swiss trade marks on 29 August 2017.[14] On 15 September 2017, Corpa received confirmation from TSW of their registration.[15] Mr Bosshard contacted Mr Fittipaldi by email on 19 September 2017, enclosing "registration of the three trademarks protecting your name" and confirming that "lawyers are now working on the international filing/registration of the same three trademarks".[16] There is also evidence that the international registrations designating the EU upon which the comparable marks are based were registered on 2 October 2017.[17]

30. Mr Brosshard then emailed Mr Fittipaldi on 6 February 2018, reminding him that there were unsettled invoices for three international registrations; it was also said that "[…] we must reorganise everything incl. the trademarks and licensing through the licence holder".[18]

[9] Exhibit REP4(2)
[10] Bosshard, §24
[11] Bosshard, §25
[12] Bosshard, §27
[13] Exhibits PB8 and AW1
[14] Exhibit PB9
[15] Exhibit REP1(2)
[16] Exhibit REP3(2)
[17] Exhibit PB10
[18] Exhibit REP2(2)

31. On 7 March 2018, Mr Bosshard emailed Mr Fittipaldi to say that "the Mexican company using the Fittipaldi trademark paid the invoice today we sent them in November 2017".[19] However, Mr Bosshard also said that there was a substantial unpaid balance, which would need to be settled as soon as possible.

32. A selection of printouts from WhatsApp (the instant messaging platform) has been provided.[20] Mr Bosshard says that the messages are between himself, Mr Fittipaldi and his business partner.[21] The printouts show a group in which a participant called Emerson asked a participant called Patrick (which I do not doubt were Messrs Fittipaldi and Bosshard, respectively) "[…] what category was registered Fittipaldi brand in Mexico ?". Another message from Emerson, dated 24 July 2018, stated:

> "[…] Patrick can you send us the trademark registrations in what country and category's was registered and yesterday I had a personal meeting with the Mexican that want to launch the Fittipaldi driving shoes we want to found exactly what categories was for Mexico […]"

33. Letters from O'Keefe Law, based in Miami, Florida, were sent to Altenburger Ltd regarding "Fittipaldi Trademark Rights" on 16 February and 24 February 2021.[22] Mr O'Keefe states that he represents Mr Fittipaldi. He highlights that no proof of a commercial relationship or permission to use the family name for the registration of trade marks had been provided. Mr O'Keefe also states that Corpa had never been authorised to file any trade marks in its own name.

34. Mr Pixton's evidence shows that Mr Fittipaldi consented to FIH's use and registration of his name as a trade mark in the UK on 7 May 2021.[23]

35. There is also evidence of cancellation proceedings between the parties before the US Patent and Trademark Office between March and July 2022.[24] In the course of

[19] Exhibit REP7
[20] Exhibit PB12
[21] Bosshard, §36
[22] Exhibit REP5
[23] Exhibits REP1 and REP3
[24] Exhibits REP8-REP11

those proceedings, Corpa admitted that it did not have a license agreement (express or implied) with Mr Fittipaldi. It also characterised itself as a fiduciary service provider to Mr Fittipaldi. I note that a trade mark owned by Corpa was cancelled by the USPTO on 2 February 2023.[25] However, I bear in mind that those proceedings concerned a figurative mark not relevant to these proceedings and that they commenced after the relevant date.

36. As the case law above makes clear, bad faith is a serious allegation which must be distinctly proved. The evidence filed in these proceedings is limited. However, it is common ground that Mr Fittipaldi is a Brazilian racing car driver.[26] It is also not in dispute that Corpa and Mr Fittipaldi had business dealings, and that the former was aware that Mr Fittipaldi (whether individually or through one of his companies) wished to register trade marks featuring his name in connection with a sports car business venture. The evidence shows that this was the case before the relevant date (the filing date of Corpa's marks). In my view, filing for trade marks which Corpa knew Mr Fittipaldi was planning on using for a business venture through its commercial relationship with him strikes me as indicative of a departure from accepted standards of honest commercial and business practices. Therefore, I find that FIH has raised a prima facie case of bad faith.

37. Nevertheless, that is not the end of the matter. The burden now shifts to Corpa to rebut that prima facie case. The crux of Corpa's defence is that Mr Fittipaldi consented to the trade marks being filed in its name. Messrs Bosshard and Werner both give narrative evidence that, prior to the relevant date, a meeting was held with Mr Fittipaldi and his business partner. They say that, at the meeting, the parties discussed obtaining protection for 'FITTIPALDI' derived trade marks and that Mr Fittipaldi agreed that these applications would be made in Corpa's name. If their evidence was incorrect or not a true reflection of the matters discussed and agreed in the meeting, this would undoubtedly be a key point for FIH to have challenged, either in its evidence or reply or through cross-examination. However, no such challenge was ever made by FIH. Messrs Bosshard and Werner were both present at the meeting and their narrative

[25] Exhibit REP12
[26] Bosshard, §7; FIH's statement of grounds, §1; Exhibit REP1

evidence on what allegedly transpired is consistent. I have no reason to disbelieve them. In the absence of a direct challenge to this point or any contradictory evidence, I am satisfied, on the balance of probabilities, that the evidence establishes that Mr Fittipaldi authorised Corpa to file the trade marks in its name. As it appears that Mr Fittipaldi consented to Corpa's marks being filed, I find that the prima facie case has been rebutted and that they were not filed in bad faith.

38. I am fortified in this finding by the evidence of the parties' continued dealings. For instance, Corpa contacted Mr Fittipaldi regarding the trade marks on numerous occasions in 2017 and 2018. Moreover, messages were sent from Mr Fittipaldi on WhatsApp to Mr Bosshard in 2018. These messages show Mr Fittipaldi making enquiries about the trade marks so that he could pass certain details on. If no authorisation had been given to Corpa, once Mr Fittipaldi had become aware of the situation, one could reasonably have expected action to have been taken sooner. On the balance of the evidence, it appears that no such action was taken until 2021 at the earliest; letters before action broadly relating to this matter were sent from a law firm in Miami in February of that year. Moreover, no action was taken against the marks at issue in these proceedings until June 2022, after the oppositions had already been filed by Corpa.

39. FIH's claims under section 3(6) are dismissed.

Section 5(6)

40. Section 5(6) of the Act states as follows:

> "(6) Where an agent or representative ("R") of the proprietor of a trade mark applies, without the proprietor's consent, for the registration of the trade mark in R's own name, the application is to be refused unless R justifies that action."

41. In *Mouldpro ApS v EUIPO*, Case T-796/17, the General Court ("GC") summarised the case law about when a party may be regarded as 'agent' or 'representative' of an opponent or applicant for invalidation. The court stated that:

"21. It is apparent from the wording of Article 60(1)(b) of Regulation 2017/1001 that, for an opposition to succeed on that basis, it is necessary, first, for the opposing party to be the proprietor of the earlier mark; second, for the applicant for the mark to be or to have been the agent or representative of the proprietor of the mark; third, for the application to have been filed in the name of the agent or representative without the proprietor's consent and without there being legitimate reasons to justify the agent's or representative's action; and, fourth, for the application to relate in essence to identical or similar signs and goods. Those conditions are cumulative (judgment of 13 April 2011, *Safariland* v *OHIM — DEF-TEC Defense Technology (FIRST DEFENSE AEROSOL PEPPER PROJECTOR)*, T-262/09, EU:T:2011:171, paragraph 61)."

42. The European Courts have also given the following guidance:

(a) The terms 'agent' and 'representative' must be interpreted broadly, covering all kinds of relationships based on a contractual agreement where one party represents the interests of the other. It is sufficient that the agreement or commercial cooperation between the parties gives rise to a fiduciary relationship by imposing on the applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the proprietor of the earlier mark (*EUIPO v John Mills Ltd & Jerome Alexander Consulting Corp.*, Case C-809/18 P, EU: C:2020:902, paragraph 85);

(b) It does not matter how the contractual relationship between the proprietor or principal, on the one hand, and the applicant for the trade mark, on the other, is categorised (*FIRST DEFENSE AEROSOL PEPPER PROJECTOR*, T-262/09, EU:T:2011:171, paragraph 64, and *Moonich Produktkonzepte & Realisierung v OHIM — Thermofilm Australia (HEATSTRIP)*, T-184/12, not published, EU:T:2014:621, paragraph 58);

(c) Nevertheless, some kind of agreement must exist between the parties. A mere purchaser or client of the proprietor cannot be regarded as an 'agent' or as a 'representative' (*FIRST DEFENSE*, paragraph 64);

(d) The misuse of the mark may occur both where the earlier mark and the mark applied for by the agent or representative are identical, and where the marks at issue are similar (*EUIPO v John Mills Ltd*, paragraphs 70-73);

(e) The protection also extends to cases where the goods and services are only similar and not identical (*EUIPO v John Mills Ltd*, paragraphs 98-99);

(f) The specific protection afforded by Article 8(3) is not to be assessed on the basis of whether the similarity between the marks results in a likelihood of confusion (*EUIPO v John Mills Ltd*, paragraph 92);

(g) The assessment of similarity between the goods and services should take all relevant factors into account, including, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*EUIPO v John Mills Ltd*, paragraph 100 and *The Tea Board v EUIPO*, C-673/15 P to C-676/15 P, EU:C:2017:702, paragraph 48).

43. As FIH's claim under this ground is made on the same basis as that under section 3(6), I can deal with it swiftly. The case law referred to above establishes that one of the (cumulative) conditions of a successful claim of this kind is that the application must have been filed in the name of the agent or representative without the proprietor's consent and without legitimate reasons to justify the action. I explained at paragraphs 37 and 38 above that, based upon the evidence filed in these proceedings (including the unchallenged narrative evidence of Messrs Bosshard and Werner) I was satisfied that Mr Fittipaldi authorised Corpa to file the marks at issue in its name. For the same reasons, FIH's claim does not satisfy that condition.

44. FIH's claims under section 5(6) are dismissed.

Oppositions against FIH's marks

Section 5(2)(b)

45. Sections 5(2)(a) and 5A of the Act read as follows:

> "5(2) A trade mark shall not be registered if because -
>
> > (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, […]
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."
>
> "5A 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."

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

> (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
>
> (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

My approach

47. To my mind, Corpa's second mark represents its best case. It is plainly more similar to FIH's marks because it simply consists of the word 'FITTIPALDI', without the stylised font that is not shared by FIH's marks. Moreover, the goods and services of Corpa's marks are identical. As such, I will proceed on the basis of Corpa's second mark, returning to consider its first mark only if it becomes necessary to do so.

Comparison of goods and services

48. In *Canon,* the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment that:

> "In assessing the similarity of the goods or services concerned, […] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

49. Furthermore, the criteria identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity between goods and services also include an assessment as to their users and channels of trade.

50. In *Gérard Meric v OHIM*, Case T-133/05, the 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."

51. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM***,** Case T-325/06, the GC stated that "complementary" means:

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

52. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

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

Whilst on the other hand:

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

53. The goods and services to be compared can be found at paragraphs 2 and 4.

Class 12

54. FIH has conceded that its *automobile[s]*, *vehicle wheels* and *non-OEM custom vehicle wheels* are identical to Corpa's *motor cars* and *vehicle wheels*.

55. Corpa's *electric vehicles* fall within the scope of FIH's broad term *automobile[s]*. As such, these goods are to be regarded as identical in accordance with *Meric*.

56. *Vehicle wheel rims*, *vehicle hubs* and *wheel design inserts and their associated attachments* have a different purpose and method of use to Corpa's *motors and engines for land vehicles*, *vehicle chassis*, *vehicle seats*, *chassis for motor vehicles*, *automobile bodies*, *steering wheels for vehicles* and *vehicle wheels*. However, the respective goods overlap in nature to the extent that they are parts of vehicles. Moreover, they are likely to reach the market through shared trade channels and may be produced by the same undertakings. Users will overlap. Given the parts are different and have different uses, there is no competition between them. Moreover, FIH's goods are not important or indispensable to the use of Corpa's, or vice versa. As such, they are not complementary. Taking all of the above into account, I find that there is between a low and medium degree of similarity between the respective goods.

57. FIH's term *fitted covers for vehicle steering* appears incomplete, since you cannot fit a cover to vehicle steering. In the absence of any submissions to the contrary, I interpret this term to be describing fitted covers for vehicle steering wheels. Although these goods differ in nature, purpose and method of use to Corpa's goods in class 12, they may reach the market through shared trade channels and could be produced by the same undertakings. For example, a car manufacture might produce a range of accessories for their cars, including steering wheel covers, and offer them for sale through their dealerships alongside their vehicles. Alternatively, undertakings who manufacture parts for vehicles, such as steering wheels, may offer fitted covers to match. Users will overlap. The respective goods are not complementary, since steering wheel covers are neither important nor indispensable to the use of Corpa's goods. Balancing all of the above, I find that there is a low degree of similarity between the respective goods.

Class 18

58. FIH's *leather goods, namely leather purses* clearly differ in nature, intended purpose and method of use when compared with Corpa's *clothing*. Given their different purposes, there is no competition between them. However, the respective goods are often produced by the same manufacturers and sold in the same outlets. Therefore, they reach the market through shared trade channels. They also share users. Moreover, they may be aesthetically complementary; they may share a common aesthetic function and jointly contribute to the image of the consumer by creating a coordinated look.[27] Taking all of this into account, I find that there is a low degree of similarity between the respective goods.

59. To my mind, the same finding cannot be made in respect of FIH's *luggage*. These goods also differ in nature, intended purpose and method of use when compared with *clothing*. There is no competition between them. Moreover, whilst I do not discount the possibility that very large retailers or luxury fashion brands may produce and sell luggage and clothing, I do not consider it to be typical in trade. In addition, I do not consider the respective goods to be aesthetically complementary. Although there may be instances where certain luxury fashion brands adorn clothing and items of luggage with the same patterns or designs, I do not consider that to be typical. The respective goods are not complementary in the traditional sense either; clothing and luggage are not important or indispensable to one another. The respective goods may share users, though at a level too general for a finding of similarity overall. In light of all this, I find that the respective goods are dissimilar.

Class 25

60. FIH's has conceded that its *clothing, namely, hats, jackets, shirts, and shoes* are identical to Corpa's class 25 goods.

61. *Belts made of leather* also fall within the broader category of Corpa's *clothing*. As such, these goods are identical under the principle outlined in *Meric*.

[27] *Gitana SA, v OHIM,* Case T-569/11, paragraph 45

Class 35

62. Although it relates to sports competitions, the nature, purpose and method of use of *promoting sports competitions and events of others* differs from Corpa's *organization of sports events and competitions*. The former describes providing promotional services to third parties who organise sports competitions and events, whereas the latter refers to the organising of the sporting event or competition itself. I am not convinced that the respective services reach the market through shared trade channels; they are likely to be provided by different undertakings. Whilst the organiser of a sporting event may promote its own events, they do not typically promote those of third parties. Similarly, an undertaking offering promotional services is unlikely to organise its own sporting events. The respective services are also likely to target different users. FIH's service will be used by the organisers of the competition or event, whilst Corpa's service will be used by those seeking to attend. The services are not interchangeable and, therefore, there is no competition between them. Moreover, although the respective services are important or indispensable to one another, consumers are unlikely to believe that the responsibility for them lies with the same undertaking. As such, they are not complementary. Taking all of this into account, I find that the respective services are dissimilar.

63. *Automobile dealerships* differ in nature, intended purpose and method of use when compared with Corpa's *motor cars* and *electric vehicles*. However, Corpa's goods are integral to automobile dealerships and the connection between these goods and services is such that the average consumer would assume that the responsibility for them lies with the same undertaking. Consequently, I consider the respective goods and services to be complementary. Moreover, they are distributed through the same channels of trade. For example, it is common in trade for vehicles to be sold through dealerships operated by the same (or economically linked) undertakings. Users will also overlap. In light of the above, I find that there is a medium degree of similarity between the respective goods and services.

Class 41

64. It is my view that Corpa's broad term *organisation of sports events and competitions* encompasses FIH's *entertainment services in the nature of professional athletes competing in sports car races*, *entertainment services in the nature of automobile racing and exhibitions* and *entertainment services, namely, performing and competition in motor sports, events*. Therefore, they are identical under the principle outlined in *Meric*. If that is not correct, it remains the case that the services are highly similar, given the clear overlaps in nature, purpose, method of use, trade channels and user, as well as the competitive relationship between them.

Class 42

65. *Motor vehicle parts design services* have a different nature, intended purpose and method of use when compared with Corpa's class 12 goods. It is my view that the respective goods and services also have different trade channels and users. This is because the design services are likely to be provided by different undertakings than those who manufacture them. Although car and parts manufacturers will undoubtedly design their goods, they do not typically provide design services to third parties. The respective goods and services also typically target different users; undertakings producing car parts are likely to purchase FIH's services, whereas members of the general public and other professional users (such as garages and dealerships) will purchase Corpa's goods. There is no material competition between the respective goods and services; it is highly unlikely that a consumer will select to have a vehicle part designed instead of purchasing a part, and vice versa. The design of parts is clearly important or indispensable to the parts themselves. However, I do not consider the respective goods and services to be complementary. This is because consumers are generally not accustomed to undertakings offering vehicles and parts as well as parts design services (to third parties). As such, consumers will not believe that the responsibility for the goods and services lies with the same undertakings. Taking all of this into account, I find that the respective goods and services are dissimilar.

66. I have also considered Corpa's other goods and services, though none puts it in a more favourable position.

67. Some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered.[28] My findings above mean that the opposition must fail in respect of the goods and services I have found to be dissimilar, namely:

Class 18: Luggage.

Class 35: Promoting sports competitions and events of others.

Class 42: Motor vehicle parts design services.

The average consumer and the nature of the purchasing act

68. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 (as he then was) described the average consumer in these terms:

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

[28] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, paragraph 49

69. When assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.[29]

70. The goods and services at issue in these proceedings are available to the general public. However, the parties' goods in class 12 are also likely to be purchased by businesses or professionals, such as, for example, garages.

71. The goods and services are likely to be purchased at varying degrees of frequency and cost. For instance, inexpensive items of clothing are likely to be purchased relatively frequently, whereas cars are occasional purchases which attract a significant outlay. Other goods and services, such as entertainment services, are likely to be somewhere in between. It follows that the average consumer's level of attention will also vary. However, I do not consider the purchasing process of any of the goods and services at issue to be merely casual. In respect of class 12, the average consumer is likely to consider factors such as cost, efficiency, style, size, safety and suitability. The goods in classes 18 and 25 will attract consideration of factors such as style, quality, size and compatibility with other items. When selecting the services in class 35, the average consumer is likely to consider factors such as the quality of service and the range of automobiles on offer. As for class 41, the average consumer is likely to consider the range of events offered, location, cost and ease of access. For these reasons, it is my view that the average consumer is likely to demonstrate at least a medium level of attention during the purchasing process. However, the level of attentiveness will undoubtedly be higher for the goods in class 12.

72. The goods in class 12 are likely to be purchased from the manufacturer or through dealerships and retailers, after viewing information in brochures or on the internet. The goods in classes 18 and 25 will be self-selected from retailers and their online equivalents, after viewing information on shelves and the internet.[30] The services in class 35 will be purchased from the dealership and selected following an inspection of the premises' frontage, after viewing information on websites, or viewing

[29] *Lloyd Schuhfabrik Meyer,* Case C-342/97
[30] In respect of clothing, see the GC's comments in *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50.

advertisements (such as flyers, posters, media campaigns or online adverts). The services in class 41 are likely to be purchased directly from the provider, or through third-party ticketing agencies, after viewing information in brochures or on websites. For all the goods and services, it is my view that visual considerations will dominate the purchasing process. However, I do not discount aural considerations entirely, since the average consumer may discuss the goods and services with sales representatives or receive word-of-mouth recommendations.

Distinctive character of the earlier mark

73. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *WindsurfingChiemsee*, paragraph 51)."

74. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the

goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

75. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, Corpa has filed no evidence of use; accordingly, I have only the inherent position to consider.

76. Corpa's second mark is in word-only format and comprises the word 'FITTIPALDI'. As it is the only element of the mark, the distinctive character lies in the word itself. The word may be perceived as a reference to the racing car driver (a fact which is common ground between the parties in these proceedings). Although there are likely to be consumers who are not aware of the racing car driver, I will proceed on the basis that a significant proportion of consumers are. Fittipaldi is not a common surname in the UK. For these consumers, Corpa's second mark possesses at least a medium level of inherent distinctive character.

Comparison of trade marks

77. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo* 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."

78. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

79. The competing trade marks are as follows:

Corpa's second mark	**FIH's marks**
FITTIPALDI	eFITTIPALDI FITTIPALDI AUTOMOBILI EMERSON FITTIPALDI

Overall impressions

80. Corpa's second mark is in word-only format and comprises the word 'FITTIPALDI'. As it is the only element of the mark, the overall impression lies in the word itself.

81. FIH's first mark is word-only and consists of the word 'eFittipaldi'. Although presented as a single word, consumers will identify the letter 'e' and word 'Fittipaldi'. This is assisted by the natural break created by the capitalisation of the letter 'F'. The overall impression of the mark largely rests in the word 'Fittipaldi'. The letter 'e' also contributes but plays a lesser role.

82. FIH's second mark is in word-only format and consists of the words 'FITTIPALDI AUTOMOBILI'. The words do not combine in any way; each plays an independent distinctive role. As it appears at the beginning of the mark, and for reasons I will come onto below, the word 'FITTIPALDI' is more dominant. The word 'AUTOMOBILI' still provides a contribution, though plays a lesser role.

83. FIH's third mark is word-only and comprises the words 'EMERSON FITTIPALDI'. Consumers who are aware of the racing car driver are likely to recognise this as his full name. For these consumers, the words combine to form a unit and, together, dominate the overall impression of the mark.

Visual comparisons

FIH's first mark and Corpa's second mark

84. Visually, the competing marks are similar because they both contain the word 'FITTIPALDI'/'Fittipaldi'. This is the only element of Corpa's mark and dominates the overall impression of FIH's mark. The use of different letter case is not significant since the registration of word-only marks provides protection for the word itself.[31] The competing marks differ in that FIH's mark contains a letter 'e' at its beginning. This has no counterpart in Corpa's mark. Bearing in mind my assessment of the overall impressions, I find that there is a high degree of visual similarity between the competing marks.

FIH's second mark and Corpa's second mark

85. From a visual perspective, these competing marks are similar due to the shared use of the identical word 'FITTIPALDI'. This is the only element of Corpa's mark and appears at the beginning of FIH's second mark. They differ insofar as FIH's mark contains the additional word 'AUTOMOBILI'. Overall, I find that there is between a medium and high degree of visual similarity between the competing marks.

FIH's third mark and Corpa's second mark

86. Visually, these competing marks are also similar because they both contain the word 'FITTIPALDI'. They differ because FIH's mark contains the additional word 'EMERSON'. This appears at the beginning of FIH's mark but has no counterpart in

[31] *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

Corpa's mark. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

Aural comparisons

FIH's first mark and Corpa's second mark

87. Aurally, the competing marks overlap in the identical pronunciation of the word 'FITTIPALDI'/'Fittipaldi'. This is the only element of Corpa's mark and dominates the overall impression of FIH's mark. The competing marks differ in that FIH's mark contains an additional syllable (i.e. "EE") at its beginning. Overall, I find that there is a high degree of aural similarity between the competing marks.

FIH's second mark and Corpa's second mark

88. These competing marks are aurally similar due to the shared use of the word 'FITTIPALDI', which will be articulated identically. This is the only element of Corpa's mark and appears at the beginning of FIH's second mark. They differ insofar as FIH's mark contains five additional syllables (i.e. "AU-TO-MO-BI-LI"). Bearing in mind my assessment of the overall impressions, I find that there is between a medium and high degree of aural similarity between the competing marks.

FIH's third mark and Corpa's second mark

89. Aurally, these competing marks are also similar due to the identical pronunciation of the word 'FITTIPALDI'. They differ because FIH's mark contains three additional syllables (i.e. "EM-ER-SON"). These appear at the beginning of FIH's mark but are absent from Corpa's mark. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of aural similarity between the competing marks.

Conceptual comparisons

FIH's first mark and Corpa's second mark

90. As outlined previously, the word 'FITTIPALDI' in Corpa's mark will be understood by some consumers as a reference to the racing car driver. This meaning will also be attributed to the word 'Fittipaldi' in FIH's mark. FIH's mark also contains the letter 'e'. Due to the nature of the goods and services at issue and given its widespread use, this is likely to be perceived as an abbreviation for electronic. Due to the shared presence of the word 'FITTIPALDI', I find that there is a high degree of conceptual similarity between the competing marks.

FIH's second mark and Corpa's second mark

91. Again, the word 'FITTIPALDI' will be understood by some consumers as a reference to the racing car driver. This meaning is common to both marks. FIH's mark contains the additional word 'AUTOMOBILI'. This has no recognised meaning in the English language. However, notwithstanding the established principle that consumers normally perceive a trade mark as a whole, consumers will break down the mark into verbal elements which suggest a concrete meaning or resemble words known to them.[32] In this connection, it is my view that the word is evocative of the word automobile, given how strongly it resembles this common English word. Taking into account my assessment of the overall impressions, I find that there is between a medium and high degree of conceptual similarity between the competing marks.

FIH's third mark and Corpa's second mark

92. Again, the word 'FITTIPALDI' in Corpa's mark will be understood by some consumers as a reference to the racing car driver. That same group of consumers is likely to perceive FIH's mark as a whole as being his full name. Both marks contain the same surname, whilst FIH's mark also contains a forename. The competing marks

[32] *Usinor SA v OHIM*, Case T-189/05

also refer to the same individual. If this does not render them conceptually identical, I find that there is at least a medium degree of conceptual similarity.

Likelihood of confusion

93. 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. One such factor 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 mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade marks, 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 mind.

94. 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. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

> "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)."

95. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach.[33] It is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[34] I also bear in mind that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.[35]

96. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson.* The judge said:

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[33] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[34] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17
[35] *Liverpool Gin*

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

97. Earlier in this decision, I concluded that:

- The parties' goods and services are identical or similar to at least a low degree;

- Relevant consumers of the goods and services include members of the general public and businesses or professionals, who will demonstrate at least a medium degree of attention during the purchasing process;

- The purchasing process is predominantly visual in nature, though aural considerations have not been discounted;

- Corpa's second mark possesses at least a medium level of inherent distinctive character;

- The overall impression of Corpa's second mark lies in the word 'FITTIPALDI', being the only element of the mark;

- The word 'Fittipaldi' dominates the overall impression of FIH's first mark, whilst the letter 'e' plays a lesser role;

- The word 'FITTIPALDI' dominates the overall impression of FIH's second mark, whilst the word 'AUTOMOBILI' plays a lesser role;

- The words 'EMERSON FITTIPALDI' dominate the overall impression of FIH's third mark in combination;

- FIH's first mark and Corpa's second mark are visually, aurally and conceptually similar to a high degree;

- FIH's second mark and Corpa's second mark are visually, aurally and conceptually similar to between a medium and high degree;

- FIH's third mark and Corpa's second mark are visually, aurally and conceptually similar to a medium degree (if not conceptually identical).

FIH's first mark and Corpa's second mark

98. I acknowledge that FIH's mark contains the letter 'e' at its beginning and that this is not reproduced in Corpa's mark. Nevertheless, the competing marks are otherwise identical. Taking into account the high degree of overall similarity between them, in addition to the medium level of distinctive character possessed by Corpa's mark, it is my view that the difference created by the additional letter is likely to be insufficient to distinguish FIH's goods and services from those of Corpa. I accept that it appears at the beginning of the mark, a position which is generally considered to have more impact.[36] However, this does not preclude finding a likelihood of confusion in appropriate circumstances.[37] In this case, the competing marks share ten letters, being the entirety of Corpa's mark and making up the dominant part of FIH's mark. The additional letter in FIH's mark plays a lesser role and will either be seen as referring to a characteristic of the goods and services or simply a letter from the alphabet. Taking into account the principle of imperfect recollection, it is considered likely that the average consumer – even when demonstrating a higher level of attentiveness – may not recall the respective marks with sufficient accuracy to differentiate between them. The average consumer could certainly misremember whether the word 'FITTIPALDI'/'Fittipaldi' was preceded by the letter 'e'. Consequently, I find that there is a likelihood of direct confusion. Notwithstanding the interdependency principle, this applies even in relation to the goods and services that are only similar to a low degree.

99. If I am wrong and the average consumer does immediately notice and recall the difference created by the additional letter in FIH's mark, they will also recognise the identical ten letter word 'FITTIPALDI'/'Fittipaldi'. This is the only element of Corpa's mark and is the dominant part of FIH's mark. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in *L.A. Sugar*. I have found that the letter 'e' in FIH's mark will be recognised as an

[36] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[37] See, for example, the GC's judgement in *Bristol Global Co Ltd v EUIPO,* T-194/14.

abbreviation for electronic. Its addition to the common element readily lends itself to a sub-brand or brand extension. In respect of goods and services relating to vehicles and sports racing, FIH's mark is likely to be seen as an alternate brand of Corpa's mark which indicates that the goods and services are, are for, or feature electronic vehicles. As for the other goods (namely, those in classes 18 and 25) FIH's mark is likely to be perceived as an indication that they are available online or consist of an exclusive range which is only available online. Taking all of the above into account, I am satisfied that the average consumer – even paying a higher level of attention – would assume a commercial association between the parties, or sponsorship on the part of Corpa, due to the presence of the identical word 'FITTIPALDI'/'Fittipaldi'. Accordingly, I find that there is a likelihood of indirect confusion. Again, I consider this to apply even in relation to the goods and services that are only similar to a low degree.

FIH's second mark and Corpa's second mark

100. It is clear that the competing marks share an identical word, i.e. 'FITTIPALDI'. This word makes up the entirety of Corpa's mark and dominates the overall impression of FIH's mark, also appearing at its beginning. However, FIH's mark contains the word 'AUTOMOBILI', which has no counterpart in Corpa's mark. Whilst I have found that this plays a lesser role in the mark's overall impression, it still provides a contribution; it is far from negligible, even in circumstances where it alludes to the goods and services. The additional word consists of ten letters and renders the competing marks significantly different in length. In my view, even when the average consumer demonstrates no more than a medium level of attention, it is unlikely to be overlooked. The levels of overall similarity between the competing marks, and the distinctive character of Corpa's mark, are, of course, factors in Corpa's favour. Nevertheless, taking all of the above factors into account, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer to distinguish between them and avoid mistaking the competing marks for one another. As a result, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion, even in relation to identical goods and services.

101. That leaves indirect confusion to be considered. I am conscious not to artificially dissect the competing marks and I acknowledge that the average consumer tends to

perceive trade marks as wholes. I am also mindful that indirect confusion has its limits. However, the word 'FITTIPALDI' is the only element of Corpa's mark and dominates its overall impression. This word appears at the beginning of FIH's mark and dominates its overall impression. Moreover, the word plays an independent distinctive role within FIH's mark, i.e. it has a distinctive significance which is independent of the significance of the whole. It does not combine with the word 'AUTOMOBILI' in any way and FIH's mark is likely to be perceived by the average consumer as consisting of two separate and seemingly unconnected elements. The shared element is identical. Although it is not strikingly distinctive, I am of the view that it is sufficiently distinctive for confusion to occur. I have found that the word 'AUTOMOBILI', albeit not a recognised word in the English language, will be understood as alluding to the word automobile. For the applied-for goods and services relating to cars and racing, it is likely that the average consumer will perceive the inclusion of the word as a brand extension or sub-brand of the 'FITTIPALDI' mark, indicating the nature of those goods and services. Alternatively, and in relation to the applied-for goods that are not directly connected to cars and racing, it is my view that the difference created by the additional word will be seen as indicative of a co-branding or collaborative exercise between the parties. In light of all this, I am satisfied that the average consumer – even when paying a higher level of attention – will assume a commercial association between the parties on the basis of the identical shared element. Consequently, I consider there to be a likelihood of indirect confusion, even where there is only a low degree of similarity between the goods and services.

FIH's third mark and Corpa's second mark

102. Again, these competing marks share the identical word 'FITTIPALDI'. This word is the only element of Corpa's mark and co-dominates the overall impression of FIH's mark. Nevertheless, there are differences between the marks which are unlikely to be overlooked by the average consumer. FIH's mark contains the additional word 'EMERSON'. This word is not replicated in Corpa's mark but co-dominates the overall impression of FIH's mark. It also appears at the beginning of the latter. Moreover, the inclusion of this word means that FIH's mark is greater in length than Corpa's mark. I accept that the competing marks still share reasonable levels of overall similarity and Corpa's mark has a medium level of distinctive character. However, taking all of the

above factors into account, as well as the principles of imperfect recollection and interdependency, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer – even when paying no more than a medium level of attention – to distinguish between them and avoid mistaking Corpa's mark for FIH's mark, and vice versa. Therefore, I find that there is no likelihood of direct confusion, even in relation to goods and services that are identical.

103. Although I have found that the average consumer will notice the difference created by the inclusion of the additional word 'EMERSON', they will also recognise the identical word 'FITTIPALDI'. This is the only element of Corpa's mark and co-dominates the overall impression of FIH's mark. Whether consciously or unconsciously, this will lead the average consumer through the mental process described in *L.A. Sugar*. Whilst the common element appears at the end of FIH's mark and combines with the word 'FITTIPALDI', the unitary meaning conveyed by the mark as a whole, for consumers who are familiar with Mr Fittipaldi, is his full name. Therefore, the difference created by the addition of Mr Fittipaldi's forename readily lends itself to a brand extension or the use of a variant brand, i.e. one mark uses Mr Fittipaldi's full name, whereas another is shortened to his surname only. On this basis, I am satisfied that the average consumer – even paying a higher level of attention – would assume a commercial association between the parties, or sponsorship on the part of Corpa, due to the presence of the identical word 'FITTIPALDI'. Therefore, I find that there is a likelihood of indirect confusion, even for goods and services that are only similar to a low degree.

104. For the avoidance of doubt, I would have also found a likelihood of confusion between Corpa's second mark and FIH's marks where consumers do not recognise 'FITTIPALDI' as a reference to Mr Fittipaldi. For these consumers, the word would be perceived as an invented word with no meaning and would be inherently more distinctive. This points further towards, rather than away from, there being a likelihood of confusion.

105. Corpa's claims under section 5(2)(b) of the Act are partially successful.

Overall outcomes

106. FIH's applications to invalidate Corpa's marks have failed. Subject to any appeal against my decision, Corpa's marks will remain registered in the UK.

107. Corpa's oppositions against FIH's marks have partly succeeded. Subject to any appeal against my decision, FIH's marks will be refused in relation to the following goods and services:

> Class 12: Automobile; vehicle wheels; fitted covers for vehicle steering; vehicle wheels; vehicle wheel rims; vehicle hubs; non-OEM custom vehicle wheels; wheel design inserts and their associated attachments.
>
> Class 18: Leather goods, namely leather purses.
>
> Class 25: Clothing, namely, hats, jackets, shirts, and shoes; belts made of leather.
>
> Class 35: Automobile dealerships.
>
> Class 41: Entertainment services, namely, performing and competition in motor sports, events; entertainment services in the nature of professional athletes competing in sports car races; entertainment services in the nature of automobile racing and exhibitions.

108. FIH's marks will become registered in the UK for the following goods and services, which were not opposed or against which the oppositions have failed:

> Class 18: Luggage.
>
> Class 21: Beverage glassware; drinking glasses.
>
> Class 35: Promoting sports competitions and events of others.

Class 42: Motor vehicle parts design services.

Costs

109. Both parties have succeeded in part. However, Corpa has been fully successful in defending both its registrations and partially successful in opposing all three of FIH's marks. In light of this, I consider that Corpa has enjoyed a greater measure of success. As such, in my view it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016,[38] with an appropriate reduction to reflect FIH's degree of success. In the circumstances, I award Corpa the sum of **£2,580**, which has been calculated as follows:

Preparing statements and counterstatements, and considering FIH's statements and counterstatements[39]	£1,250
Preparing evidence and considering FIH's Evidence	£800
Preparing for and attending a hearing	£800
Subtotal	**£2,850**
Reduction of 20%	*-£570*
Official fees[40]	£300
Total	**£2,580**

[38] These proceedings having commenced after 1 July 2016 but before 1 February 2023.
[39] For three oppositions and two applications for invalidity.
[40] The official fees paid in connection with filing three Form TM7s are not subject to a reduction.

110. I hereby order Fittipaldi IP Holdings, LLC to pay Corpa Switzerland AG the sum of **£2,580**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 26th day of April 2024

James Hopkins
For the Registrar