

O/0745/25

**CONSOLIDATED PROCEEDINGS**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003889921**

**IN THE NAME OF WHEEL PROS, LLC**

**IN CLASSES 12, 16, 25 AND 35**

**AND OPPOSITION THERETO UNDER NO. 600003031**

**BY SCORPION MOTORS LIMITED**

**AND IN THE MATTER OF REGISTRATION NO. UK00003477810**

**IN THE NAME OF SCORPION MOTORS LIMITED**

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO**

**UNDER NO. 506823 BY WHEEL PROS, LLC**

## BACKGROUND AND PLEADINGS

1. On 16 March 2023, Wheel Pros, LLC (“WP”) applied for the trade mark CARCAINE under application no. 3889921 (“the 921 Mark”) in the UK. The application for the 921 Mark was published for opposition purposes on 16 June 2023 and registration is sought for the goods and services set out in Annex 1 to this decision.

2. On 15 September 2023, the application for the 921 Mark was partially opposed by Scorpion Motors Limited (“SM”) under the fast track opposition scheme. The opposition is directed against the goods and services in classes 25 and 35 of the 921 Mark only. SM relies upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and the following trade mark:

CarCaine

UKTM no. 3477810

Filing date 28 March 2020; registration date 9 August 2020

Relying on all goods for which the mark is registered, namely:

Class 25      Sweat bottoms; Sweat jackets; Sweat pants; Sweat shirts; Sweat shorts; Sweat bottoms; Sweat jackets; Sweat pants; Sweat shirts; Sweat shorts; Headwear; Heavy coats; Heavy jackets; Hooded pullovers; Headwear; Heavy coats; Heavy jackets; Hooded pullovers; Tank tops; Tankinis; Tank-tops; Tee-shirts.

(“the 810 Mark”)

3. SM claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

4. WP filed a counterstatement denying the grounds of opposition.

5. On 21 December 2023, WP filed an application for a declaration of invalidity against the 810 Mark. WP relies upon sections 47 and 5(4)(a) of the Act. WP claims to have used the sign CARCAINE throughout the UK since 2013 in relation to all of the goods

and services listed in Annex 1 to this decision. WP claims that use of the 810 Mark would be contrary to the law of passing off.

6. SM filed a counterstatement denying the grounds of invalidation.

7. On 18 March 2024, the proceedings were consolidated and the opposition was converted from a fast track opposition to a standard opposition pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.

8. Neither party requested a hearing, and only WP filed written submissions in lieu. This decision is taken following a careful consideration of all the papers on file.

## **REPRESENTATION**

9. WP is represented by Fieldfisher LLP.

10. SM is represented by Trama Legal, S.R.O.

## **EVIDENCE AND SUBMISSIONS**

11. SM filed undated written submissions on 20 May 2024.

12. WP filed evidence in the form of the witness statement of Lisa Reichenthal dated 15 May 2024, which is accompanied by 34 exhibits (exhibits 1 to 33, and exhibit 52). Ms Reichenthal is the Associate General Counsel of WP.

13. SM filed written submissions dated 16 August 2024.

14. WP filed undated written submissions in lieu of attendance at a hearing on 30 September 2024.

## **RELEVANCE OF EU LAW**

15. 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.

## **DECISION**

### **My Approach**

16. As the earlier right relied upon in the opposition (being the 810 Mark) is subject to challenge by way of an invalidation action, I will assess the merits of the invalidation first. I will then return to deal with the opposition once I have determined to what extent (if at all) the 810 Mark may remain registered.

### **The Invalidation**

17. The relevant parts of section 47 state:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(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.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(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.”

18. Section 5(4)(a) of the Act states as follows:

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

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

19. 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).”

### **Relevant date**

20. SM has not filed any evidence to suggest that it was using the 810 Mark prior to the filing date for that mark and, consequently, I have only the prima facie relevant date to consider. The prima facie relevant date is the date on which the 810 Mark was filed i.e. 28 March 2020.

### **Goodwill**

21. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), goodwill was described in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

22. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

23. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

24. As a preliminary point, in its written submission in lieu, WP states as follows:

“12. Wheel Pros enjoys significant goodwill in the trade mark CARCAINE in the United Kingdom, especially in relation to automotive themed web content (including videos) and related merchandise and accessories, including clothing.” (my emphasis)

For the avoidance of doubt, WP’s claim is limited to the goods and services relied upon in its pleadings (see Annex 1 to this decision). There is no mention of automotive themed web content (including videos) in its pleadings (or anything similar). Consequently, WP cannot now seek to rely upon goodwill in relation to those services without applying to amend its pleadings (which it has not done). I will, therefore, only consider the scope of the invalidation as pleaded.

25. Ms Reichenthal gives evidence that WP was founded in 1996 in Colorado. It acquired an automotive lifestyle brand called Hoonigan on 2 September 2021. She explains that a former employee coined the phrase CARCAINE (as a play on the addictiveness of cars for automotive enthusiasts) in 2013, but it was first used as a brand on apparel in 2016. Ms Reichenthal states that it was not until 2018 that it was first used on automotive parts. There are various print outs from websites which show products displaying the CARCAINE brand.<sup>1</sup> As of May 2024, CARCAINE branded goods were available to purchase on websites called vantage97.com and throtl.com. These include t-shirts and stickers. Whilst I note that they are .com website, the price is listed in pounds sterling. However, given that the relevant date is some 4 years prior to the dates visible on these screenshots, it is not clear whether these goods would have been available for sale through these sites at the relevant date.

26. CARCAINE branded goods were also available for sale via Amazon.co.uk. I note that t-shirts bearing the sign CARCAINE had 3 reviews and 1 review respectively as of May 2024.<sup>2</sup> They were also available via flitspeed.co.uk and ebay.co.uk. Again, the same problem applies with these websites being in use as of May 2024 (some 4 years

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<sup>1</sup> Exhibits 16,

<sup>2</sup> Exhibit 32

after the relevant date). Further, I note that the only item listed for sale on Ebay is marked as “pre-owned” and “from United States”. This sale is, therefore, not being made by WP or its predecessor in title, but by a third party and the third party who originally purchased the product (presumably from WP) is a US-based customer. WP operates a US-based website which, as of May 2024, was offering CARCAINE branded goods (such as stickers, t-shirts and hoodies) for sale.<sup>3</sup> There are pages obtained from the Wayback Machine Archive which confirms that the products were listed as far back as 2018. Ms Reichenthal states that although the website is a US-based page and the prices are listed in dollars, goods have been shipped to the UK since 2016. She does not state how many or with what frequency.

27. A page taken from a catalogue has also been provided with a title “Hoonigan Holiday 2016 – December Page 2”, which shows t-shirts, hoodies and a “licence plate” which all display the word CARCAINE, in a stylised font.<sup>4</sup> The language in the catalogue suggests that this is aimed at the US market rather than the UK market (i.e. reference to “holiday” instead of Christmas and “licence plate” instead of registration plate). Prices are also listed in dollars.

28. Various examples are provided of CARCAINE being used on social media (including YouTube).<sup>5</sup> Some of these videos have received as many as 1.8million views. However, whilst these videos were originally posted as far back as 2018, the viewer numbers are accurate as of May 2024. Consequently, it is not clear how many views these posts/videos would have attracted by the relevant date. Further, there is no evidence as to what proportion of these viewers would have been from the UK. In any event, use in relation to, for example, a YouTube series is not use in relation to the goods/services relied upon by WP in these proceedings.

29. Ms Reichenthal has exhibited the results of a Google search carried out in May 2024 for the period prior to 1 January 2020 for the term CARCAINE.<sup>6</sup> This shows the results referring to Hoonigan. However, as these results are not limited by

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<sup>3</sup> Exhibit 33

<sup>4</sup> Exhibit 17

<sup>5</sup> Exhibits 19, 20, 21, 22, 23, 26, 27, 28, 29 and 30.

<sup>6</sup> Exhibit 25

geographical region, nor do they actually show use of the sign in relation to the goods/services relied upon, these do not carry much evidential value.

30. There is evidence of 4 purchase orders for CARCAINE goods in evidence. However, these all have “ship to” addresses in the United States.<sup>7</sup> They do not, therefore, demonstrate any trade in the UK.

31. There are photographs provided of the Hoonigan stand at the 2023 Players Classic motorsport event.<sup>8</sup> Most of the photographs are of the mark HOONIGAN, but there are some examples of signs bearing the word CARCAINE. However, I note that this event took place after the relevant date.

32. In WP’s submissions in lieu, it relies upon the fact that goodwill can be established in the UK within a short timeframe and even prior to the sale of any physical goods where there is sufficient publicity. I note that this line of argument was not raised until written submissions in lieu and so SM has not had an opportunity to comment upon it. In any event, I do not consider that it takes WP’s case any further forward.

33. I accept that it is possible for goodwill to be established in a short period of time where there is sufficient publicity, typically around a new mark being used by an existing business.<sup>9</sup> However, I do not consider that WP has proven that to be the case here. This is because whilst WP is clearly a successful business, as is Hoonigan, and its founder (Mr Block) clearly had a large following, there is a lack of UK-specific evidence to enable me to assess how established those businesses were in the UK at the relevant date.

34. For example, Ms Reichenthal has provided examples of the locations of retailers selling WP’s goods in the UK, but this is only accurate as of May 2024 (some 4 years after the relevant date). I have no way of knowing how many (if any) of these retailers were selling WP’s goods prior to the relevant date.<sup>10</sup> Similarly, the online evidence

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<sup>7</sup> Exhibit 18

<sup>8</sup> Exhibit 52

<sup>9</sup> *BBC v Talbot* [1981] FSR 228

<sup>10</sup> Exhibit 04

(such as follower numbers and viewer numbers) is not UK-specific; I have no way of knowing how many (if any) of these viewers are UK consumers. There is evidence that Mr Block appeared on *Top Gear*, and collaborated with *Top Gear* on making a film which was the most watched video *TopGear* has ever placed on YouTube.<sup>11</sup> This is, in my view, the high point of the evidence in this regard. However, even if I accept that Mr Block had a reputation in the UK for automotive-related videos/online content, there is very little evidence (as explained above) which demonstrates the sign relied upon being publicised to UK customers specifically, whether in association with Mr Block or otherwise.

35. There is an absence of evidence that sets out the extent of WP's trade in the UK prior to the relevant date in relation to the goods and services relied upon. This is important because the law of passing off protects a business with a small goodwill, but does not protect a goodwill of trivial extent.<sup>12</sup> As Mr Thomas Mitcheson KC, sitting as the Appointed Person, concluded in *Smart Planet Technologies, Inc. v Rajinda Sharma*:<sup>13</sup>

“...a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

36. It is also important to bear in mind that the burden of proving a protectable goodwill is on WP. In my view, when taking the evidence as a whole into account, it is insufficient to demonstrate that WP had a protectable goodwill in the UK at the relevant date or that the sign CARCAINE was distinctive of that goodwill for the relevant goods/services. Further, on the evidence before me, I am unable to find that the sign relied upon would have been publicised amongst the UK relevant public to such an extent that it would have acquired goodwill in the way claimed by WP in its written submissions in lieu prior to the relevant date.

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<sup>11</sup> Exhibit 12

<sup>12</sup> *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

<sup>13</sup> BL O/304/20

37. The application for invalidation based upon section 5(4)(a) of the Act is dismissed.

### **The Opposition**

38. I will now consider SM's opposition against the 921 Mark.

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

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

(a)...

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

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

40. Section 5A of the Act is as follows:

“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.”

41. Given its earlier filing date, the 810 Mark qualifies as an earlier mark pursuant to section 6 of the Act. As the 810 Mark had not completed its registration process more than 5 years prior to the application date for the 921 Mark, it is not subject to the use provisions of section 6A of the Act. Consequently, SM can rely upon all of the goods identified, without having to show that the 810 Mark has been put to genuine use for those goods.

42. 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 greater 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 to mind the earlier mark, is not sufficient;

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

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

### Comparison of goods

43. The competing goods are as follows:

<b>SM's goods (opponent's goods)</b>	<b>WP's goods (applicant's goods)</b>
<u>Class 25</u> Sweat bottoms; Sweat jackets; Sweat pants; Sweat shirts; Sweat shorts; Sweat bottoms; Sweat jackets; Sweat pants; Sweat shirts; Sweat shorts; Headwear; Heavy coats; Heavy jackets; Hooded pullovers; Headwear; Heavy coats; Heavy jackets; Hooded pullovers; Tank tops; Tankinis; Tank-tops; Tee-shirts.	<u>Class 25</u> Clothing; footwear; headwear; t-shirts; tops; tank tops; shirts; jackets; hoodies; pants; shorts; bottoms [clothing]; clothing for children; caps; beanies; socks.  <u>Class 35</u> Online retail store services in relation to vehicle parts and accessories; online

	<p>retail stores in relation to automotive parts and accessories; online retail store services featuring clothing; online retail store services in relation to stickers, bumper stickers, stickers [stationery], adhesive stickers, stickers [decalcomanias], car stickers and decorative stickers for cars; online retail store services in relation to clothing, footwear, headwear, t-shirts, tops, tank tops, shirts, jackets, hoodies, pants, shorts, bottoms [clothing], clothing for children, caps, beanies and socks; online retail store services in relation to wheels for cars, trucks and tractors, automobile wheels, automotive vehicle wheels, wheels, vehicle wheels, hubs for vehicle wheels, rims for vehicle wheels, alloy wheels for vehicles, light metal wheels for vehicles, parts and fittings therefor, wheels for land vehicles, automotive parts and accessories, namely, grilles, automotive body kits, boosts, suspensions, engine and engine parts, brakes, electronics, intakes, interiors and drivetrains, automobile tires, land vehicles and structural parts therefor, vehicle parts and accessories, caps for wheel rims, ornamental hub caps for vehicles, lug nuts for vehicle wheels, steering wheels for vehicles, grilles for vehicles, vehicle wheel accessories, namely skirts and spinners.</p>
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44. 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:

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

45. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

46. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

### Class 25

#### *Clothing.*

47. The majority of the terms in SM's specification would fall within this broader term. Consequently, the goods are identical on the principle outlined in *Meric*.

#### *Footwear.*

48. These goods overlap in purpose and method of use with SM's goods to the extent that they are all worn on the body, for the purposes of protecting the body from the elements. However, they differ in nature. Clearly, the users will overlap. There is also likely to be some overlap in trade channels, as the goods can all be sold by fashion retailers, albeit they are likely to be in different sections of those stores. There is no competition, and I do not consider them to be complementary as one is not important or indispensable for the other.<sup>14</sup> Consequently, I consider there to be a medium degree of similarity between the goods.

#### *Headwear; tank tops.*

49. These terms appear identically in SM's specification.

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<sup>14</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

*T-shirts.*

50. This term is plainly identical to “Tee-shirts” in SM’s specification, although worded slightly differently.

*Tops.*

51. There are various terms in SM’s specification which fall within this term, such as “tank tops”. Consequently, I find them to be identical on the principle outlined in *Meric*.

*Shirts.*

52. This term is identical on the principle outlined in *Meric* to “sweat shirts” in SM’s specification.

*Jackets.*

53. This term is identical on the principle outlined in *Meric* to “sweat jackets” in SM’s specification.

*Hoodies.*

54. In my view, this term is interchangeable with SM’s “hooded pullovers”. Consequently, I consider them to be identical.

*Pants.*

55. This term is identical on the principle outlined in *Meric* to “sweat pants” in SM’s specification. If I am wrong in this finding, and this term is intended to refer to a type of underwear (as opposed to an alternative word for trousers), then the goods will overlap in nature, purpose, method of use, user and trade channels and will be highly similar.

*Shorts; bottoms [clothing].*

56. These terms are identical on the principle outlined in *Meric* to “sweat shorts” in SM’s specification.

*Clothing for children.*

57. There are a number of terms in SM’s specification which would include versions of the goods for use by children (such as “sweat bottoms”, “hooded pullovers”, “tee-shirts”). Consequently, I consider these goods to be identical on the principle outlined in *Meric*.

*Caps; beanies.*

58. These terms fall within the term “headwear” in SM’s specification and are, therefore, identical on the principle outlined in *Meric*.

*Socks.*

59. These goods overlap in purpose, nature and method of use with the goods in SM’s specification as they are all used to cover parts of the bodies for warmth (albeit different parts) and may be made of the same materials (such as cotton, wool etc.). The user of the goods is plainly the same. In my view, they are all likely to be sold by the same retailers, resulting in an overlap in trade channels. Consequently, I consider these goods to be highly similar.

### Class 35

*Online retail store services in relation to vehicle parts and accessories; online retail stores in relation to automotive parts and accessories; online retail store services in relation to stickers, bumper stickers, stickers [stationery], adhesive stickers, stickers [decalcomanias], car stickers and decorative stickers for cars; online retail store services in relation to wheels for cars, trucks and tractors, automobile wheels, automotive vehicle wheels, wheels, vehicle wheels, hubs for vehicle wheels, rims for*

*vehicle wheels, alloy wheels for vehicles, light metal wheels for vehicles, parts and fittings therefor, wheels for land vehicles, automotive parts and accessories, namely, grilles, automotive body kits, boosts, suspensions, engine and engine parts, brakes, electronics, intakes, interiors and drivetrains, automobile tires, land vehicles and structural parts therefor, vehicle parts and accessories, caps for wheel rims, ornamental hub caps for vehicles, lug nuts for vehicle wheels, steering wheels for vehicles, grilles for vehicles, vehicle wheel accessories, namely skirts and spinners.*

60. I have no detailed submissions from SM as to why it considers these services similar to the goods in its own specification. Clearly, these are all retail services which relate to goods not covered by SM's specification. The nature, purpose and method of use of the goods and services plainly differ. I have no evidence before me to suggest that these goods and services are usually sold through the same trade channels. There is no competition or complementarity. Consequently, I consider the goods and services to be dissimilar.

*Online retail store services featuring clothing; online retail store services in relation to clothing, footwear, headwear, t-shirts, tops, tank tops, shirts, jackets, hoodies, pants, shorts, bottoms [clothing], clothing for children, caps, beanies and socks.*

61. These services are all likely to be provided through the same trade channels as the goods of SM, to the same users. Plainly, the nature, method of use and purpose of the goods and services differ. In my view, there is at least between a low and medium degree of similarity between the goods and services. However, where the goods to which the services relate are the same as those in SM's specification, there will also be complementarity, resulting in a medium degree of similarity between the goods and services.

### **The average consumer and the nature of the purchasing act**

62. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary

according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

63. 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.”

64. The average consumer for the goods and services will be a member of the general public. SM submits that the level of attention paid during the purchasing process will be low. I disagree. The goods and services are likely to be purchased reasonably frequently, although they are certainly not everyday purchases. They will also vary in price. However, factors such as materials, aesthetics and fit are likely to be considered when purchasing the goods and location, range of products and customer service standards when purchasing the services. Consequently, I consider that the average consumer will pay a medium degree of attention when purchasing the goods and services.

65. The goods are likely to be self-selected from the shelves of a retail outlet or an online equivalent. The services are likely to be purchased following perusal of signage at physical premises or online equivalents. Consequently, visual considerations are likely to dominate the purchasing process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

## Comparison of trade marks

66. It is clear from *Sabel* 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 marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

68. The respective trade marks are shown below:

<b>The 810 Mark (the opponent's mark)</b>	<b>The 921 Mark (the applicant's mark)</b>
CarCaine	CARCAINE

69. Both marks are word only marks. The overall impression resides in the word itself.

70. Visually, the marks both consist of the same letters in the same order. They differ only in the capitalisation in the 810 Mark which separates those letters into two distinct

words (CAR and CAINE), whereas in the 921 Mark they are presented as a single word. In my view, the marks are visually highly similar.

71. Aurally, both marks will be articulated as two syllables: CAR CANE. They are, therefore, aurally identical.

72. Conceptually, WP has filed evidence to show that the word CARCAINE has a meaning referring to addiction to collecting cars.<sup>15</sup> If this meaning is known by the average consumer then the same conceptual meaning can be attributed to both marks. If not, then they will be viewed as invented words. In my view, the latter is more likely. In any event, the marks are either conceptually identical or the conceptual position is neutral.

### **Distinctive character of the earlier mark**

73. 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-2779, 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

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<sup>15</sup> Exhibit 23

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).”

74. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

75. SM has not filed evidence of use and, consequently, I have only the inherent position to consider. The word CarCaine is, in my view, likely to be understood either as a portmanteau of the words car and cocaine (as suggested by WP) or as an invented term with no clear meaning. In the former, the combination of these words is still unusual and the mark will be attributed between a medium and high degree of distinctive character. In the latter, the earlier mark will be distinctive to a high degree.

### **Likelihood of confusion**

76. 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 them 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 marks may be offset by a greater degree of similarity between the goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier 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 he has retained in his mind.

77. I have found as follows:

- a. The goods and services vary from being identical to similar to between a low and medium degree (except to the extent that I have found them to be dissimilar).
- b. The average consumer for the goods and services is a member of the general public who will pay a medium degree of attention during the purchasing process.
- c. The purchasing process for the goods and services will be predominantly visual, although I do not discount an aural component.
- d. The marks are visually highly similar, aurally identical and conceptually identical or neutral (depending on whether any meaning is attributed to them by the average consumer).
- e. The 810 Mark is inherently distinctive to either between a medium and high degree or to a high degree.

78. In my view, the capitalisation of the 810 Mark which results in it being more readily identified as two conjoined words (as opposed to one invented word) is likely to be overlooked by the average consumer. Consequently, I consider there to be a likelihood of direct confusion for all those goods and services that I have found to be similar. Where the goods and services are dissimilar, the opposition under section 5(2)(b) of the Act must fail.<sup>16</sup>

79. The opposition based upon section 5(2)(b) of the Act is partially successful.

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<sup>16</sup> *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

## CONCLUSION

80. The application for invalidation against the 810 Mark is unsuccessful and, subject to any appeal, the 810 Mark may remain registered in its entirety.

81. The opposition against the 921 Mark succeeds in relation to the following goods and services, for which (subject to appeal) the application is refused:

Class 25      Clothing; footwear; headwear; t-shirts; tops; tank tops; shirts; jackets; hoodies; pants; shorts; bottoms [clothing]; clothing for children; caps; beanies; socks.

Class 35      Online retail store services featuring clothing; online retail store services in relation to clothing, footwear, headwear, t-shirts, tops, tank tops, shirts, jackets, hoodies, pants, shorts, bottoms [clothing], clothing for children, caps, beanies and socks.

82. The opposition against the 921 Mark is unsuccessful in relation to the following services, for which (subject to appeal) the application may proceed to registration along with the unopposed goods:

Class 35      Online retail store services in relation to vehicle parts and accessories; online retail stores in relation to automotive parts and accessories; online retail store services in relation to stickers, bumper stickers, stickers [stationery], adhesive stickers, stickers [decalcomanias], car stickers and decorative stickers for cars; online retail store services in relation to wheels for cars, trucks and tractors, automobile wheels, automotive vehicle wheels, wheels, vehicle wheels, hubs for vehicle wheels, rims for vehicle wheels, alloy wheels for vehicles, light metal wheels for vehicles, parts and fittings therefor, wheels for land vehicles, automotive parts and accessories, namely, grilles, automotive body kits, boosts, suspensions, engine and engine parts, brakes, electronics, intakes, interiors and drivetrains, automobile tires, land vehicles and structural parts therefor, vehicle parts and accessories, caps for wheel rims, ornamental hub caps

for vehicles, lug nuts for vehicle wheels, steering wheels for vehicles, grilles for vehicles, vehicle wheel accessories, namely skirts and spinners.

83. I have set out the specification for which the 921 Mark may proceed to registration in Annex 2 to this decision.

## **COSTS**

84. SM has been entirely successful in the invalidation and partly successful in the opposition. Consequently, it is entitled to an award of costs in its favour based upon the scale published in Tribunal Practice Notice 1/2023. However, I have made an appropriate reduction for the only partial success in the opposition. With this in mind, I award SM the sum of **£1,300**, calculated as follows:

Preparing forms and considering the forms filed by WP	£350
Considering WP's evidence	£500
Preparing written submissions	£350
Official fee for opposition	£100
<b>Total</b>	<b>£1,300</b>

85. I therefore order Wheel Pros, LLC to pay Scorpion Motors Limited the sum of **£1,300**. This sum is to be paid within 21 days of the expiry of the appeal proceedings or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 11<sup>th</sup> day of August 2025**

**S WILSON**  
**For the Registrar**

## ANNEX 1

### Class 12

Wheels for cars, trucks and tractors; automobile wheels; automotive vehicle wheels; wheels; vehicle wheels; hubs for vehicle wheels; rims for vehicle wheels; alloy wheels for vehicles; light metal wheels for vehicles; parts and fittings therefor; wheels for land vehicles; automotive parts and accessories, namely, grilles, automotive body kits, boosts, suspensions, engine and engine parts, brakes, electronics, intakes, interiors and drivetrains; automobile tires; land vehicles and structural parts therefor; vehicle parts and accessories; caps for wheel rims; ornamental hub caps for vehicles; lug nuts for vehicle wheels; steering wheels for vehicles; grilles for vehicles; vehicle wheel accessories, namely skirts and spinners.

### Class 16

Stickers; bumper stickers; stickers [stationery]; adhesive stickers; stickers [decalcomanias]; car stickers; decorative stickers for cars.

### Class 25

Clothing; footwear; headwear; t-shirts; tops; tank tops; shirts; jackets; hoodies; pants; shorts; bottoms [clothing]; clothing for children; caps; beanies; socks.

### Class 35

Online retail store services in relation to vehicle parts and accessories; online retail stores in relation to automotive parts and accessories; online retail store services featuring clothing; online retail store services in relation to stickers, bumper stickers, stickers [stationery], adhesive stickers, stickers [decalcomanias], car stickers and decorative stickers for cars; online retail store services in relation to clothing, footwear, headwear, t-shirts, tops, tank tops, shirts, jackets, hoodies, pants, shorts, bottoms [clothing], clothing for children, caps, beanies and socks; online retail store services in relation to wheels for cars, trucks and tractors, automobile wheels, automotive vehicle wheels, wheels, vehicle wheels, hubs for vehicle wheels, rims for vehicle wheels, alloy wheels for vehicles, light metal wheels for vehicles, parts and fittings therefor, wheels for land vehicles, automotive parts and accessories, namely, grilles, automotive body kits, boosts, suspensions, engine and engine parts, brakes, electronics, intakes,

interiors and drivetrains, automobile tires, land vehicles and structural parts therefor, vehicle parts and accessories, caps for wheel rims, ornamental hub caps for vehicles, lug nuts for vehicle wheels, steering wheels for vehicles, grilles for vehicles, vehicle wheel accessories, namely skirts and spinners.

## ANNEX 2

### Class 12

Wheels for cars, trucks and tractors; automobile wheels; automotive vehicle wheels; wheels; vehicle wheels; hubs for vehicle wheels; rims for vehicle wheels; alloy wheels for vehicles; light metal wheels for vehicles; parts and fittings therefor; wheels for land vehicles; automotive parts and accessories, namely, grilles, automotive body kits, boosts, suspensions, engine and engine parts, brakes, electronics, intakes, interiors and drivetrains; automobile tires; land vehicles and structural parts therefor; vehicle parts and accessories; caps for wheel rims; ornamental hub caps for vehicles; lug nuts for vehicle wheels; steering wheels for vehicles; grilles for vehicles; vehicle wheel accessories, namely skirts and spinners.

### Class 16

Stickers; bumper stickers; stickers [stationery]; adhesive stickers; stickers [decalcomanias]; car stickers; decorative stickers for cars.

### Class 35

Online retail store services in relation to vehicle parts and accessories; online retail stores in relation to automotive parts and accessories; online retail store services in relation to stickers, bumper stickers, stickers [stationery], adhesive stickers, stickers [decalcomanias], car stickers and decorative stickers for cars; online retail store services in relation to wheels for cars, trucks and tractors, automobile wheels, automotive vehicle wheels, wheels, vehicle wheels, hubs for vehicle wheels, rims for vehicle wheels, alloy wheels for vehicles, light metal wheels for vehicles, parts and fittings therefor, wheels for land vehicles, automotive parts and accessories, namely, grilles, automotive body kits, boosts, suspensions, engine and engine parts, brakes, electronics, intakes, interiors and drivetrains, automobile tires, land vehicles and structural parts therefor, vehicle parts and accessories, caps for wheel rims, ornamental hub caps for vehicles, lug nuts for vehicle wheels, steering wheels for vehicles, grilles for vehicles, vehicle wheel accessories, namely skirts and spinners.