

O/0824/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF THE REQUESTS FOR PROTECTION
IN THE UK FOR THE INTERNATIONAL REGISTRATIONS

WO0000001724318 AND WO0000001725487

IN CLASSES 9, 35, 36, 37 AND 42

BY AUTOGURU AUSTRALIA PTY LTD

AND THE OPPOSITIONS THERETO UNDER NUMBERS 443460 AND 443461,

RESPECTIVELY, BY CUMMINS FILTRATION INC

Background and Pleadings

1. On 14 December 2022, AutoGuru Australia Pty Ltd ('the Holder') applied for protection in the UK for the following two International Registrations ('the Contested Marks'):

Contested Mark i) WO0000001724318



International Registration date: 14 December 2022

Designation date: 14 December 2022

The request for UK protection was published for opposition purposes on 14 July 2023

Base registration: 2159105, filed in Australia

UK protection is sought for the following goods and services, the opposed terms underlined:

Class 9:

Computer software; computer firmware; firmware; computer hardware; computer programs; computer systems.

Class 35:

Business organisation; business management of call centres; business services relating to technology transfer; retail services connected with the sale of food, drinks, confectionery, motor vehicle parts, tools and accessories; business information management involving the collection and reporting of fueling and other purchase data associated with fleet vehicle usage; business management of a

vehicle fleet for others; business consultancy in the field of vehicle fleet management.

Class 36:

Commercial fleet card services; computerised financial services; charge card and stored value card services; electronic payment and funds transfer services; credit card services; debit card services; vehicle fleet management services in the nature of facilitating and arranging vehicle financing and loans; discount card services (financial services); providing rebates at participating establishments of others through use of a membership card; insurance; motor insurance; motor vehicle insurance services; vehicle insurance services; warranty insurance services.

Class 37:

Repair of motor vehicles; motor vehicle maintenance and repair; cleaning of motor vehicles; servicing of motor vehicles; maintenance and repair of motor vehicles; vehicle maintenance; servicing of commercial vehicles; vehicle repair; vehicle service stations (refuelling and maintenance); advisory services relating to the repair of motor vehicles; car maintenance; garage services for vehicle maintenance; maintenance and repair of vehicles; maintenance or repair of automotive vehicles.

Class 42:

Computer software design; software-as-a-service; computer software development; computer support services [programming and software installation, repair and maintenance services]; advisory and information services relating to the design and development of computer hardware and peripherals; computer support services (programming and software installation, repair and maintenance services); installation and maintenance of computer software; installation of computer software; maintenance of computer software.

Contested Mark ii) WO0000001725487

FLEETGURU

International registration date: 14 December 2022

Designation date: 14 December 2022

The request for UK protection was published for opposition purposes on 7 July 2023

Base registration: 2159104, filed in Australia

UK protection is sought for the following goods and services, the opposed terms underlined:

| |
|---|
| <p>Class 9: <i>Computer software; computer firmware; firmware; computer hardware; computer programs; computer systems.</i></p> |
| <p>Class 35: <i>Business organisation; business management of call centres; business consultation services in the area of technology transfer; <u>retail services connected with the sale of food, drinks, confectionery, motor vehicle parts, tools and accessories</u>; business management information services involving the collection and reporting of fueling and other purchase data associated with fleet vehicle usage; business management of a vehicle fleet for others; business consultancy in the field of vehicle fleet management; business consultation, information and advisory services regarding fleet management services.</i></p> |
| <p>Class 36: <i>Commercial fleet card services in the nature of charge card services or charge card payment processing; computerised financial services; charge card and stored value card services; electronic payment and funds transfer services; credit card services; debit card services; providing credit facilities for use by the public and the motoring industry; discount card services (financial services); providing rebates at participating establishments of others through use of a membership card; insurance; motor insurance; motor vehicle insurance services; vehicle insurance services; warranty insurance services.</i></p> |
| <p>Class 37: <i><u>Repair of motor vehicles; motor vehicle maintenance and repair; cleaning of motor vehicles; servicing of motor vehicles; maintenance and repair of motor vehicles; vehicle maintenance; servicing of commercial vehicles; vehicle repair; vehicle service stations (refuelling and maintenance); advisory services relating to the</u></i></p> |

repair of motor vehicles; car maintenance; garage services for vehicle maintenance; maintenance or repair of automotive vehicles.

Class 42:

Computer software design; software-as-a-service; computer software development; computer support services (computer hardware, software and peripherals advisory and information services); computer support services (programming and software installation, repair and maintenance services); installation and maintenance of computer software; installation of computer software; maintenance of computer software.

2. On 5 October 2023, Cummins Filtration Inc ('the Opponent') filed oppositions to the requests for UK trade mark protection: OP443460 and OP443461, respectively.
3. Both oppositions are based on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').
4. For both oppositions, the Opponent relies upon the following earlier right for the claim under section 5(2)(b):

UK00000875960

Fleetguard.

Filing date: 22 February 1965

Date of entry in register: 22 February 1965

Publication date: 4 August 1965

The application and registration of this mark pre-date the enactment of the Act, which is why the filing date and date of entry in the register are one and the same. I note that the registration was renewed on 23 January 2020.

Registered for the following goods, all of which are relied upon for both oppositions:

Class 12:

*Engines for land vehicle propulsion and parts thereof included in Class 12,
silencers for engines for land vehicle propulsion*

A note on the Opponent's claims as pleaded

5. At this point, I note that the Opponent has purported to oppose a number of terms which are not present within the specifications of the Contested Marks, namely: Class 35: 'retail services for petroleum products [...] and automotive goods'.¹ For obvious reasons, references to these terms will, therefore, be disregarded.
6. Section 5(2)(b)

The claims under this ground are directed at some of the Holder's services:
OP443460 – the services underlined in the specification for Contested Mark i)
OP443461 - the services underlined in the specification for Contested Mark ii)

The Opponent's pleading is essentially the same for each action. It is claimed that both the parties' marks and respective goods/services are highly similar, leading to a likelihood of confusion. The Opponent claims that it has made genuine use of its earlier mark in respect of all of the goods for which it is registered.

Section 5(4)(a)

7. The Opponent claims that it has used its earlier sign throughout the UK since at least 1965 for the following goods and services:

Parts for vehicles [sic] engines, parts for vehicles, fuel filters, air filters for light commercial motor vehicles, lube filters for engines, fuel/water separators, hydraulic filtration systems for engines, fuel cell for engines, transmission filtration

¹ Opponent's Form TM7 (Notice of opposition and statement of grounds), at [Q8], [Q9] and [Q4] (for both oppositions).

for engines, coolants and chemicals for motor vehicles and engines, predictive maintenance services for motor vehicles and engines.

8. The Opponent claims that its business has acquired goodwill through the use of this sign for the goods and services listed; and that the Holder's use of its marks would amount to misrepresentations to the relevant public who will mistakenly attribute the Holder's services to the Opponent, resulting in damage by way of dilution of the sign and loss of sales. It is claimed that this, therefore, amounts to passing off. The passing off claim is directed against the same services opposed pursuant to section 5(2)(b), i.e. those underlined above at [1].

9. The Holder filed Defences and Counterstatements for the respective oppositions, pleading the same for both actions:

It denies the claims against it in their entirety and puts the Opponent to proof of use in respect of all of the goods for which the earlier mark stands registered.

10. The Opponent is represented by Haseltine Lake Kempner. The Holder is represented by McDaniels Law. Both parties filed evidence, as follows:

- The Opponent's evidence is from Graeme Milner, Regional Business Manager for the UK & Ireland at the Opponent company. Mr Milner's Witness Statement is dated 6 April 2024 and is accompanied by ten exhibits: GM01 – GM10.
- The Holder's evidence is from Eden Shirley, Chief Executive of the Holder company. Mr Shirley's Witness Statement is dated 6 June 2024 and is accompanied by ten exhibits: ES1 – ES10.

11. The Holder also filed written submissions during the evidence round. A hearing was neither requested nor thought necessary and both parties filed written submissions in lieu thereof. I confirm that I have read all of the evidence and submissions, to which I will refer to the extent necessary.

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.

DECISION

Earlier mark

13. In accordance with section 6 of the Act, the Opponent's mark is an earlier mark by virtue of its filing date, which fell before the designation date of the Holder's registration. I note that registration of the earlier mark was renewed on 23 January 2020. If, given the passage of time, there were to be any doubt over the reliability of the recorded dates of filing and registration for the earlier mark, then its status as an earlier mark can be alternatively substantiated by its renewal date, which also preceded the designation date of the Holder's registration.

Preliminary matter:

A note on the consequence of a finding of no genuine use

14. I note that the Holder has made several references to 'revocation', in its written submissions on the matter of genuine use.² It argues that, should the Opponent's evidence fail to demonstrate genuine use, then the mark 'must be revoked'.³ This is incorrect. The instant case is an opposition action, not a revocation action. In an opposition action where the matter of genuine use is at stake, the consequence of a finding of no genuine use is that the Opponent is prevented from relying upon

² Holder's written submissions of 10 June 2024, [15] and [17]; Holder's written submissions in lieu of a hearing, [13].

³ As above.

that mark (to the extent that use has not been found) for its section 5(2)(b) pleading. The outcome is not that the mark is automatically revoked. An application for a *revocation* on the grounds of non-use is an entirely different legal action. There is no application for revocation currently pending against the earlier mark.

The Opponent's evidence

15. A fairly small number of pages within the evidence comprise several 'screenshots' which have been reduced in size to fit a single A4 page, rendering the text illegible due to the very small font size and poor resolution. These pages will not be taken into account.

16. I note the following from the Opponent's evidence:

(a) Mr Milner has given narrative evidence that the Opponent is 'a world leader in the design, manufacture and distribution of heavy-duty filtration products, having operated in the industry for over 50 years'; and that it is has been world leader in the design, manufacture and distribution of filtration systems for vehicle engines for the past five decades'.⁴ He states that the Opponent has 'been trading throughout the United Kingdom, directly and via a dense network of authorised distributors since the 1960s'.⁵ It is stated that the mark has been used 'in connection with a wide range of vehicle and motor filtration goods' as well as 'related maintenance and technical support services'.⁶ Further, Mr Milner states that the 'Fleetguard brand has become highly recognisable in the industry and synonymous with the very high level of quality and innovation of the products and services' that the Opponent offers.⁷

(b) Turnover figures have been provided 'for the UK in the period December 2017 – December 2022', reproduced thus:⁸

⁴ Witness Statement of G. Milner, [1] and [8].

⁵ As above, [9].

⁶ Witness Statement of G. Milner, [5] and [6].

⁷ As above, [11].

⁸ Witness Statement of G. Milner, [14].

Turnover (GBP):

| 2017 | 2018 | 2019 | 2020 | 2021 | 2022 |
|----------------|-------------------|-------------------|-------------------|-------------------|-------------------|
| £15 million | £16-17 million | £15-16 million | £16-17 million | £16-17 million | £19-20 million |

These figures are clearly approximations rather than precise sums. A breakdown of the figures by product/service would have been helpful. For the purposes of the section 5(2)(b) ground, a breakdown of the figure for 2017 by month would have been useful given that only a small portion of the relevant period fell within that year, i.e. 15-31 December 2017.

(c) Wayback' prints⁹ from the website of the Opponent, cumminsfiltration.com, have been provided.¹⁰ There are five examples, dated, respectively: 22 August 2018; 17 September 2019; 21 April 2020; 4 March 2021; and 17 May 2022. I note that, for three of the examples, (all of which pre-date IP Completion day), the menu/options bar at the top of the page has buttons for 'English' and 'Europe'. It is not clear whether the 'English' option is intended for customers based in the UK (or England, at least), or simply English-speaking customers, which would target, inter alia, the USA and Australia. That said, the 'Europe' option may also be intended for UK consumers, given that the UK is a country within the continent of Europe; and, up to 31 December 2020, it was an EU Member State. In the example dated 4 March 2021, the menu/options bar has buttons for 'English' and 'North America', and no button for 'Europe'. In all five examples, the Fleetguard mark features either in the top right corner of the page, or on the products themselves in photographs. The following goods are either shown or mentioned, although no prices or product specifications are provided for them:

- Lubricating oils;
- A 'Filter Service Kit';
- Cooling System Cleaner;
- Hydraulic filters;
- Cabin air filters are mentioned, although no particular product is detailed;

⁹ Copies of archived webpages from the web archiving service, The Wayback Machine.

¹⁰ Witness Statement of G. Milner, [12]; Exhibit GM01.

- Fleetguard air dryers;
- An array of bottles, containers, and cylindrical goods that I understand to be filters, are shown under the heading ‘See all our new products released in 2019’.

The example dated 17 May 2022 includes the following text:

- ‘Always Use Genuine Parts – Fleetguard Air Dryers are 1st Fit Quality’.
- ‘Contact your Fleetguard Distributor Partner for further information on pricing’.

These examples include a button in the toolbar for ‘Where to buy’, presumably linked to details of stockists of the Opponent’s goods.

(d) Fourteen Wayback prints from the websites of stockists of Fleetguard products have also been provided.¹¹ It is convenient to summarise the salient details in the following table:

| Date: | Business/location of target market: | Goods featured: | Use of earlier mark: |
|--|--|---|---|
| Pages dated: 4 Nov 2017; 9 Aug 2020; 5 Dec 2021; and 28 Nov 2021. | Truckstop Group. URL ends ‘co.uk’. UK-based. | ‘Headline’ text indicates that the supplier is a specialist ‘in supplying and distributing quality truck parts’. Categories listed: <ul style="list-style-type: none"> • Air brake components; • Air conditioning and cooling; • Body, Panels and mirrors; • Braking; • Clutch and gearbox; | Fleetguard mark features alongside marks of other brands. |

¹¹ Witness Statement of G. Milner, [12]; Exhibit GM01.

| | | | |
|--|--|---|--|
| | | <ul style="list-style-type: none"> • Electrical; • Filtration <p>However, there is no indication of what particular goods are available under each brand.</p> | |
| Pages dated: 26 Oct 2017; 20 Jan 2019; 1 Nov 2020; and 16 May 2022. | Fleetfactors. URL ends 'co.uk'. A graphic of a UK map marked with the company's branches indicates that it has outlets throughout a large section of the UK. | An array of cylindrical goods of varying sizes that I understand to be filters displayed under the text 'Truck & Trailer Parts'. | Fleetguard mark is shown on the goods. |
| Pages dated: 19 Jul 2017; 1 Apr 2019; and 29 Jun 2020. | Dingbro.com. Head Office address shown in the footer indicates UK-based company (Aberdeen, Scotland). | Under the category 'Filters', there is a hyperlink to Fleetguard products. The URL in the address bar indicates that the filters are categorised under 'truck filters'. | 'Fleetguard' is one of two brands of products listed under 'Filters', and hyperlinked. |
| Pages dated: 29 Jul 2016; and 24 May 2022. | Inlinefilters.co.uk. UK-based. | Headline text 'UK's Only Source on the Web for Commercial, Plant, Agricultural, Marine Filters – And Much More. | A large number of brands is listed, including Fleetguard. |

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|--|--|--|--|
| | | However, there are no particular examples of Fleetguard goods are shown. | |
|--|--|--|--|

(e) Four screenshots of an ‘interactive map’ on the Opponent’s website have been provided to demonstrate the locations of ‘authorised Fleetguard dealers throughout the UK’.¹² The examples show the results of a ‘Find a dealer’ search for: Birmingham, Newcastle, Scotland and London, respectively. The accompanying UK maps pinpoint the dealers in the relevant area by way of ‘balloon’ markers. For each of the four geographical areas, the nearest 25 outlets are marked on the map. The dealers are listed on the left-hand side of the map, although only the first two on the list are visible. Particular dealers identified are: HGV Direct (branches in Birmingham, Dartford and Slough); Truckstop Group (Worcestershire); Fleet Factors Ltd (branches in Gateshead and Durham); and Dingbro Ltd (two branches in Scotland).

f) A selection of invoices has been provided to support the UK sales figures (noted above at (b)) showing sales of the Opponent’s products sold under the Fleetguard brand ‘in the relevant territory for the period 2017-2022’, with the unit prices and sums due redacted.¹³ The number of units is provided for each invoice, which I presume to denote individual goods as opposed to boxes containing multiples of those goods. The Opponent’s mark does not appear anywhere on the invoices, albeit the invoices for November 2022 appear to have been issued by the undertaking ‘Fleetguard UK Limited’.

It is convenient to summarise the salient information in the following table:

| Date: | Goods purchased: | Customer/territory: |
|--------------|---|--|
| 18 Dec 2017 | Various air, fuel and lubricant filters; air filter radial seal; fuel/water separator; fuel separator. The invoice notes ‘28 units’. | Allspares Auto Ltd, Bridgend (Wales, UK) |

¹² Witness Statement of G. Milner, [13]; Exhibit GM02.

¹³ As above, [15]; Exhibit GM03.

| | | |
|-------------|---|---|
| 9 Nov 2017 | Various air filters; fuel filter; hydraulic filter; 'FWS Spin-on Stratapore'. The invoice notes '12 units'. | Truckstop, Worcestershire. (UK) |
| 9 Nov 2017 | Air filter; fuel filter spin-on; fuel filter; 'FWS Spin-on'; hydraulic filter' 'Combo spin-on'. The invoice notes '12 units'. | Truckstop, Worcestershire. |
| 3 Jan 2018 | Air filter; fuel/water separator; Hydraulic filter The invoice notes '17 units'. | Largo Plant Services Ltd, Norwich (UK) |
| 22 Oct 2019 | Only product codes are shown. However, when cross-checked with invoices which specify the goods, I am satisfied that the product codes are for filters of various kinds. For example, 'LF' appears to be the prefix denoting 'oil filters'; 'FS' appears to denote 'fuel separators'. The invoice notes '862 units'. | Filtration Control Ltd, Northampton (UK) |
| 24 Oct 2019 | As above. The invoice notes '984 units'. | Filtration Control Ltd, Northampton (UK) |
| 9 Jan 2020 | As above. The invoice notes '7 units'. | Merlin Diesel Systems, Preston (UK) |
| 10 Jan 2020 | As above. The invoice notes '55 units'. | McHugh Components Ltd, Dublin (Eire, so not UK use) |
| 6 July 2021 | Lube Service Part; Air Filter Kit; Various fuel filters; 'Air Filter– Radial Seal primary'; Oil filter Spinon; 'Fuel separator cartridge plastic'; 'Oil filter Cellulose Spinon ¹⁴ '; 'Fuel Separator Spinon Stratapore'; 'Hydraulic Spin-On Wire Mesh'; Air/Oil Separator; Fuel Separator Cartridge; Various water filters. | Appears to be an internal invoice from the Opponent's 'UK Logistics Centre' to 'Cummins Diesel Wellingborough'. |

¹⁴ It is presumed that this is intended to read 'spin-on'.

| | | |
|-----------------------------|---|---|
| | 565 units are listed | |
| 10 Jun 2021 | Various air, water and fuel filters; filter seals; filter cartridges; air, oil and water filter 'spinons'. 16 units are listed. | Vertiv Infrastructure Limited, Bedford (UK) |
| 3 Nov 2022 | Various air filters and fuel filter cartridges. 7 units are listed. | LCP Engineering Ltd, Bournemouth (UK) |
| 3 Nov 2022 | Various air filters and air filter systems; oil filter spin-on; Various oil filter cartridges; fuel filter cartridges; fuel separator spinon. 26 units are listed. | Partic Motor Spares Ltd, Newark (UK) |
| 4 Nov 2022 | Fuel filter spinon; 'Hydraulic spinon synthetic'; mounts and housings for air systems; Fuel separator spin-ons; 'Hydraulic spinon wire mesh'; Fuel separator cartridges. 123 units are listed. | Dingbro Limited, Inverness (UK) |
| 4 Nov 2022 (x2 invoices) | Various air, fuel and oil filters; oil filter seals and cartridges. 7 units are listed on one invoice; 27 units listed on the other | Partic Motor Spares Ltd, Newark (UK) |
| 4 Nov 2022 | Various air, fuel and oil filters; fuel separators 22 units are listed | Inline Filters, Cornwall (UK). |
| 7 Nov 2022 | 'Air filter – any shape w/unique media'. 1 unit listed | Fleet Factors, Hull (UK). |

(g) Mr Milner states that the Opponent has spent 'substantial resources in advertising and promoting its FLEETGUARD Mark throughout the UK', however no figures have been provided in respect of such expenditure.¹⁵ Exhibit GM04 comprises excerpts from 'products brochures published for the UK and Europe' said to show 'consistent use of the FLEETGUARD mark in relation to our [the Opponent's] products and services'.¹⁶ Five undated one-page images are provided, two of which appear to be

¹⁵ Witness Statement of G. Milner, [16].

¹⁶ As above; Exhibit GM04.

electronic proofs rather than contemporaneous examples taken from published sources directed at consumers. All five examples bear the Fleetguard mark; either prominently in the top left corner, or at the bottom of the page. No detail is provided as to when and where the catalogues were published, nor their 'reach'.

Two of the examples are very similar; both comprise a photograph of a jerry-can bearing the label 'ES Compleat OAT Coolant', which I understand to be an engine coolant. The mark is shown on the product itself. I note that both include the 'strap-line'/laudatory wording rendered in emboldened text at the foot of the page: 'Nothing Guards like Fleetguard. Visit fleetguard.com or contact your local distributor'.

Two examples comprise a close-up photograph of a gloved hand positioning a cylindrical object, that I understand to be a filter of some sort, in/amongst the workings of what is presumed to be a vehicle. The mark is clearly visible on the filter itself. The above-mentioned 'strap-line' is present at the foot of each page. In addition, I note the following text at the top of the respective pages: 'Your one-stop-shop for truck and LCV filtration'; and 'Your one stop shop for Volvo and Renault applications'.

The final example comprises a photograph of a cylindrical object, which I consider likely to be a filter of some sort, being handed backwards from one hand to another in the manner of a baton in a relay race. The backdrop appears to be a section of track in an athletics stadium. The mark has prominent placement below the photograph. The 'strap-line' at the top of the page reads 'Time for a change.'

(h) Wayback prints of web pages have been adduced to demonstrate the Opponent's advertising and promotional efforts.¹⁷ One of the examples is illegible, by reason of the material having been reduced to a very small size; and will not be considered. Where the material is legible, it is convenient to set out the salient details as follows:

| Date: | Website/undertaking; territory: | Use of the mark: |
|----------------|---|--|
| 18 Oct 2021 | Filtration-ltd.co.uk (UK-based supplier) | The 'pathway' from the home page indicates that there is a dedicated section for goods under the Fleetguard brand, headed 'Fleetguard' in emboldened text. |

¹⁷ As above, [17]; Exhibit GM05.

| | | |
|-----------------------|--|--|
| | | <p>I note the following text:</p> <p>‘The Fleetguard Brand, defining quality filtration products since 1963, is among the most recognised filter brands in the United States and around the World. Today the Fleetguard brand represents more than just oil filters for the air intake system to the exhaust system. [...] With a full line of air, fuel, water and hydraulic filters. [...] Fleetguard offers over 12,000 products under its broad family of brands’.</p> |
| <p>7 Oct 2022</p> | <p>Holmfilters.com (UK-based undertaking in Horsham)</p> | <p>The ‘pathway’ from the home page indicates that there is a dedicated section for goods under the Fleetguard brand.</p> <p>I note the following text:</p> <p>‘Fleetguard is a well-recognised brand of Cummins Filtration and Holm is one of UK’s leading providers of Fleetguard equivalent filters’.</p> <p>‘Holm offers Fleetguard filter equivalents and service filter kits for all plant and construction vehicles. Our full range of OEM equivalent filters can replace:</p> <ul style="list-style-type: none"> • Fleetguard Adblue Filters • Fleetguard Air Filters • Fleetguard Breather Filters • Fleetguard Oil Filters • Fleetguard Fuel Filters • Fleetguard Hydraulic Filters • Fleetguard Transmission Filters |

| | | |
|-------------|--|--|
| | | <ul style="list-style-type: none"> • Fleetguard Cabin Filters • Fleetguard Power Steering Filters • Fleetguard Coolant Filters • Fleetguard Fuel/Water Separator Filters • Fleetguard Oil/Air Separator Filters |
| 10 Aug 2022 | <p>A website of the Opponent.</p> <p>'cummins.com/eu/parts'</p> <p>Unclear whether this is directed to the UK given that the UK was no longer an EU Member State at this time.</p> | <p>The 'pathway' from the home page indicates that there is a dedicated section for goods under the Fleetguard brand.</p> <p>An array of goods, that I understand to be filters, are shown; all bearing the mark.</p> |
| Undated | <p>A page comprising a letter, headed 'Information for our Distributor partners regarding our claims policy!', with the salutation 'Dear Customer'.</p> <p>Signed off by the Opponent's Director of Sales for the UK and Ireland.</p> <p>I am unable to discern when and where this was published.</p> | <p>No use of the mark shown, or mention of the Fleetguard brand.</p> |

(i) Screenshots from social media channels have been provided.¹⁸ It is convenient to summarise the salient details in the following table:

| Date: | Social media platform/territory: | Use of the mark: |
|--|---|--|
| Undated, but I note the text 'Joined 21 May 2013'. ¹⁹ | Youtube.com I am unable to discern the territory in which the account was set up, or the proportions of '5.73k subscribers' and '3,467,095 views' attributable to the UK within the relevant period. | Mark displayed prominently. I note the text 'Since 1963, Fleetguard has offered a complete line of filters specifically engineered for a wide range of systems'. A link to 'fleetguard.com' is included. |
| Undated, but I note a 'Copyright Notice' dated 2024. | Facebook account for UK-based supplier 'Inline Filters'. | Two posts, dated 4 September 2017 and 3 August 2017, respectively, captioned 'New Product Bulletin' announce 'New Filters from Fleetguard'. The images posted appears to be lists of products (precise details illegible due to the very small size and poor resolution) headed 'Europe, Middle East Parts'. The mark appears prominently in the top left corner. Each post has one 'like'. Further similar 'bulletins' for Fleetguard are shown dated, respectively, 1 May 2019, 8 April 2020, 6 April 2020, 3 April 2020, 27 October 2020, 7 October 2020, 4 September |

¹⁸ Witness Statement of G. Milner, [17]; Exhibits GM05 -GM06.

¹⁹ Exhibit GM05.

| | | |
|--|--|--|
| | | 2020, 9 October 2021 and 8 November 2016. Each post has one 'like'. |
| Undated, but featured post indicates '2yr' which I take to be circa 2 years prior to the Opponent printing the page for its exhibit. | Linkedin.com account for company 'Filtration Ltd', which other parts of the evidence confirms is UK-based. 3,347 followers, though unclear what proportion are referable to the relevant period for POU. | Features post with the hashtag presented in very large, emboldened font '#FleetguardFriday'. 10 viewers/followers have 'reacted' to the post and it has been reposted 6 times. A photo of an array of jerry cans and filters bearing the mark is shown. |
| Undated, but latest post indicates '5yr', which take to be circa 5 years prior to the material being printed for the exhibit. | LinkedIn account for 'Geraint Nadin'. Territory and no. of followers unknown. Unclear whether business or personal account. | Featured post comprises an advertisement for Fleetguard 'cabin air filters' for aircraft. The mark appears prominently in the bottom left of the advertisement. There are 5 'reactions' and 3 'reposts'. |
| Undated, but video indicates 130 views as at '6 years ago'. | Youtube.com | Featured post comprises advertisement for Fleetguard filters available from 'Malpas online'. I note text: 'Over 1100 Fleetguard oil, hydraulic, air, fuel filters and other parts available 24 Hrs at www.malpasonline.co.uk |

| | | |
|--|--|---|
| | | No 'likes' or 'shares' are apparent, but there are 130 'views'. |
|--|--|---|

(j) Exhibit GM07 is introduced as evidence to support the statement that Fleetguard products have been showcased at UK tradeshows.²⁰ Three screenshots from Facebook, dated 15 October 2019, 4 December 2022 and 5 December 2022, respectively, appear to chronicle/promote Fleetguard's attendance at: an event called 'Watson Truck & Supply in Hobbs'; and 'LAMMA show', at the NEC in Birmingham NEC 10-11 January 2023. Photographs and text indicate that the NEC event is focused on agricultural vehicles and machinery, with Fleetguard showcasing its 'filtration' goods. 'Lamma Show' has itself commented on the post thus: 'Whether you run tractors, sprayers, windrowers or combines, you can always depend on the advanced technology and legendary quality of Fleetguard filtration products to protect your equipment'. An accompanying photograph shows a trade stand displaying an array of Fleetguard filters and what appear to be Fleetguard branded water flasks for promotional purposes. The Opponent's mark is shown clearly and prominently on the trade stand itself and on a large poster.

(k) Mr Milner has given narrative evidence that, in 1986, the Opponent 'became the first filtration supplier to achieve the Ford Q1 certification and has continuously invested in achieving the very top certifications for its Fleetguard Goods/Services'.²¹ No further detail is given to explain what this certification is. Exhibit GM08 is said to comprise 'examples of the internationally recognised certifications achieved by CFI [the Opponent] for its FLEETGUARD Goods/Services'.²² The first example appears to be a certificate for 'Cummins Filtration Quimper France' (which I presume to be a branch of the Opponent based in France) to show that the branch operates its 'Management System' in accordance with the management standards set by 'ANSI National Accreditation Board' in the field of 'Design and manufacturing of filtration systems, components and reservoirs'. On the face of it, this does not say anything about the goods or services themselves, but rather the organisation of the business

²⁰ Witness Statement of G. Milner, [17]; Exhibit GM07.

²¹ As above, [18].

²² Witness Statement of G. Milner, [18]; Exhibit GM08.

(albeit in France). My view is that the certificate merely shows that the management of a French branch of the Opponent complies with the national standard in France. To my mind, while the management might be satisfactory, this does not reveal anything about the quality of the Opponent's goods/services under the Fleetguard brand. It also says nothing about the use of the mark, or attractive force of the brand in the UK.

The second example comprises Wayback prints, dated 4 August 2020, of pages from the Opponent's website showing a list of 'certificates' identified only by reference numbers and the countries/states to which they relate. The UK is not listed.

(l) Mr Milner has given narrative evidence that 'Over the years, the FLEETGUARD Mark has been recognised in the industry as synonymous with the very best quality products and is renowned worldwide and in the UK, where CFI [the Opponent] is strongly implanted'.²³ Exhibit GM09 is said to comprise examples of 'praises' received for the Fleetguard brand.²⁴ A Wayback print, dated 10 April 2018, from the website of UK-based supplier 'Filter Services (UK) Ltd' has been provided, from which I note the following text:

'Fleetguard Filters are class-leading filtration systems for many diverse applications, and Filter Services are the main suppliers of these products.'

'Why Choose Fleetguard Filters?'

The manufacturer of Fleetguard filters is part of an engine manufacturer; rather than just designing aftermarket replacement parts for engines, our products are designed in conjunction with engine design and manufacture.

[...]

'This means that our filters are designed to perform well in real-world conditions. As Fleetguard are the only filter brand that are so closely aligned with engine development, the filters are simply the best in the world.'

Their filters don't merely reach the standard of OEM equipment, they exceed. This means that if you run diesel engines as part of a fleet, you can rest assured that the filter systems will ensure reliability; Fleetguard filters are backed by a

²³ Witness Statement of G. Milner, [19].

²⁴ As above; Exhibit GM09.

comprehensive warranty that ranks amongst one of the best in the world. This is owed to the fact that we take a systems approach to manufacturing; rather than just supplying parts, we are concerned with the maintenance cycle of diesel systems’.

I note from the Wayback print, dated 7 October 2022, of the website of UK-based supplier ‘Holm’ the following text:

‘Fleetguard is a well-recognised brand of Cummins Filtration and Holm is one of the UK’s leading providers of Fleetguard equivalent filters.’.

The Holder’s evidence

17. The Holder’s evidence, for the most part, focuses on the use of its mark in Australia. The assessments that I must make for each ground are concerned only with the UK market.

The Section 5(2)(b) ground

Proof of use

18. I will begin by assessing whether there has been genuine use of the Opponent’s mark.

Relevant legislation

19. Section 6A of the Act states:

‘6A(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(b) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered,

or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.'

20. Section 100 of the Act states:

'100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.'

21. In the instant case, the relevant period for the purposes of considering the matter of genuine use is 15 December 2017 to 14 December 2022.

Relevant case law

22. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

'105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the Court of Justice of the European Union ('CJEU') in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundesvereinigung*

Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale

of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

23. Proven use of a mark which fails to establish that ‘the commercial exploitation of the mark is real’ because the use would not be ‘viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark’ is, therefore, not genuine use.

Assessment of genuine use

24. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²⁵

25. In assessing the body of evidence available to me, I bear in mind the case of *Awareness Limited v Plymouth City Council*, Case BL O/236/13, in which Mr Daniel Alexander Q.C. (as he then was) as the Appointed Person stated that:

‘22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.’

²⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

26. I also bear in mind the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person stated that:

'21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.'

27. My view is that the totality of evidence succeeds in demonstrating that the Opponent has used its mark within the UK, mainly for various air, water, fuel and oil filters for vehicles. The number of invoices provided in respect of UK custom is fairly modest. However, the invoices punctuate the period between 18 December 2017 and 7 November 2022 fairly evenly, and they demonstrate bulk orders, placed by a range of UK-based suppliers, dispersed throughout the UK. The vast majority of the goods are various types and models of air, fuel and lubricant filters. Repeat custom is evident. Excerpts from the websites of four of the 'repeat' customers (Truckstop Group; Fleetfactors; Dingbro; and InlineFilters) demonstrate that they are stockists of Fleetguard-branded goods. Furthermore, the dates of the excerpts indicate that, for all four of these UK undertakings, these commercial relationships have subsisted for several years. Pages (dated October 2021 and October 2022, respectively) from the websites of Filtration Ltd and Holm filters, both UK-based suppliers, each have a dedicated section/page for Fleetguard products. The evidence by way of maps showing the locations of UK 'dealers' of Fleetguard goods demonstrate significant coverage of the UK, by a notable number of dealer 'branches'.
28. The values presented as the UK sales figures are impressive (albeit approximate), all being in the eight figures, showing a fairly steady increase from approximately £15 million in 2017 to £19-20 million in 2022. Although the figures have not been broken down by product or service, almost every concrete example of goods sold or held out for sale features filters. I, therefore, consider it reasonable to infer that the sales figures, at least for the most part, likely relate to sales of filters.
29. Several examples of web content from UK suppliers of Fleetguard products include laudatory comments highlighting goods under the brand as being of a particularly high quality. For example, Filter Services (UK) Ltd describes the goods as 'class-leading filtration systems' and refers to Fleetguard as 'the only filter brand that are [sic] so closely aligned with engine development, the filters are simply the best in the world'.
30. Several suppliers also underline the longevity of the Fleetguard brand, identifying it as one of the most recognised brands of filters. Filtration Ltd, for example, (on

web pages dated 10 April 2018 and 18 October 2021), notes that Fleetguard has been ‘defining quality filtration products since 1963’ and that it ‘is among the most recognised filter brands [...] around the world’. Further, UK-based supplier Holm Filters includes the following praise on its webpage (dated 7 October 2022): ‘Fleetguard is a well-recognised brand of Cummins Filtration and Holm is one of UK’s leading providers of Fleetguard equivalent filters’. I find that the examples of laudatory comments, from a range of third parties (i.e. UK-based suppliers) indicate use of the mark which is fairly dispersed throughout the UK.

31. My view is that the evidence, as a whole, demonstrates that the Opponent has made genuine use of its mark for the relevant period.

Fair specification

32. I now consider for which goods the earlier mark has been put to genuine use. The Opponent’s mark stands registered, and proof of use has been requested, in respect of the following goods:

Class 12:

Engines for land vehicle propulsion and parts thereof included in Class 12, silencers for engines for land vehicle propulsion

33. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

‘In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.’

34. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

‘245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range

of goods or services within the scope of the terms describing the goods or services for which its mark is registered.'

35. There does not appear to be anything in the evidence to demonstrate that there have been sales of complete engines, or engine silencers, made under the mark. As noted above, the vast majority of the evidence demonstrates sales of filters of various kinds. It is within my knowledge and experience as an ordinary member of the public, having owned and used motor vehicles, that many of the examples of filters in the evidence are parts of vehicle engines/engine systems; for example, oil filters. Furthermore, I note Mr Milner's narrative evidence that the Opponent is considered a world leader in filtration systems for vehicle engines. Although the evidence also demonstrates use of the mark in respect of filters other than those for engine systems, such goods are not present in the registered specification.

36. In the light of the foregoing, I consider a fair specification of the Opponent's Class 12 goods to be the following:

Parts of engines for land vehicle propulsion, namely filters.

37. Consequently, this is the specification upon which the Opponent may rely for its two oppositions pursuant to section 5(2)(b).

Section 5(2)(b) oppositions

Relevant legislation

38. 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.'

Relevant case law

39. The following principles are derived from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98; *Matratzen Concord GmbH v OHIM*, Case C-3/03; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04; *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 they have kept in their mind, and whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of the goods and services

40. The goods and services to be compared are as follows (the opposed terms being the same for each opposition):

| <u>Opponent:</u> | <u>Holder:</u> |
|---|---|
| <p><u>Class 12:</u> <i>Parts of engines for land vehicle propulsion, namely filters.</i></p> | <p><u>Class 35:</u> <i>retail services connected with the sale of motor vehicle parts, tools and accessories.</i></p> <p><u>Class 37:</u> <i>Repair of motor vehicles; motor vehicle maintenance and repair; cleaning of motor vehicles; servicing of motor vehicles; maintenance and repair of motor vehicles; vehicle maintenance; servicing of commercial vehicles; vehicle repair; vehicle service stations (refuelling and maintenance); advisory services relating to the repair of motor vehicles; car maintenance; garage services for vehicle maintenance; maintenance or repair of automotive vehicles.</i></p> |

41. Section 60A of the Act provides:

(1) 'For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.’

42. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties’ goods and services must be taken into account:

‘[23] 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’.

43. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.²⁶ In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (‘GC’) described “complementary” in the following terms: “[...] 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”.²⁷ 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.

44. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281²⁸, identified the following factors for assessing similarity of the respective goods and services:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

²⁶ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

²⁷ Paragraph 82.

²⁸ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

- (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.

45. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

‘The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.’

46. Case law establishes that ‘... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise’ but “Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.’²⁹

47. The Opponent’s submission on the matter of the similarity of the goods and services is premised on the Opponent’s specification as registered, rather than the

²⁹ *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch).

revised specification that I have arrived at based on the evidence of use, and is as follows:

*Retail services for motor vehicle parts, tools and accessories and automotive goods' are highly similar to the goods of the Opponent's Earlier Mark being retail services for goods wholly contained within *engines for land vehicle propulsions and parts thereof*' of the Opponent's earlier mark'.³⁰*

48. However, the brevity and generality of the submissions is such that they would not have assisted greatly had the registered specification been retained, in any event.

49. The Holder's submissions are also brief:

'The Applicant's goods and services are aimed at a very specific market, being companies that run fleets of vehicles and specifically the fleet managers within those companies [...]. [...] the Opponent's goods seem to be primarily offered to vehicle mechanics and the motor trade [...].³¹ It is submitted that 'the trade channels in which the parties operate are markedly different'.³² It is argued that the user of the Holder's services 'is more likely to be a professional working within the corporate world at management level with responsibility for a large fleet of vehicles' while users of the Opponent's goods are more likely to be personnel working on the vehicles themselves.³³

'The goods provided by the Opponent are categorised as engine related products to make a vehicle push or drive forward. It is evident that there is no overlap between the goods and services, particularly since the Applicant provides services, while the Opponent offers goods'.³⁴

Class 35

³⁰ Opponent's written submissions in lieu of a hearing, [83.1].

³¹ Holder's written submissions of 10 June 2024, [10].

³² As above.

³³ Holder's written submissions of 10 June 2024, [10].

³⁴ As above, [11].

Contested term: *retail services connected with the sale of motor vehicle parts, tools and accessories.*

50. When comparing goods against the retailing of goods, I bear in mind *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, in which the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

51. I also note that on the basis of the European court's judgments in *Sanco SA v OHIM*,³⁵ and *Assembled Investments (Proprietary) Ltd v. OHIM*,³⁶ upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*,³⁷ Geoffrey Hobbs QC (as he then was) sitting as the Appointed Person in the MissBoo case,³⁸ concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the Holder's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

³⁵ Case C-411/13P.

³⁶ Case T-105/05, at paragraphs [30] to [35] of the judgment.

³⁷ Case C-398/07P.

³⁸ *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14; see paragraph 9 of that ruling.

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

52. The Holder's offering is a service, the acts of which are the bringing together and making available of motor vehicle parts, tools and accessories. The Opponent's offering is goods, namely filters for land vehicles. I will, first, compare the Holder's service in so far as it relates to motor vehicle parts; i.e. the Opponent's filters (being engine parts for land vehicles) versus retail of motor vehicle parts. The goods to which the Holder's retail services relate will encompass the Opponent's goods. The Opponent's goods are used for filtration of oil and fuel etc in land vehicles. The parties' offerings will, therefore, clearly differ in purpose and method of use. Users will necessarily overlap given that, in many cases, filters will be purchased from retailers of those goods (as opposed to wholesalers or private sellers). Trade channels will inevitably overlap given that the goods to which the retail services relate will be accessed/purchased from the same stores and websites. In my view, although the Opponent's goods will be necessary to deliver the retail services in respect of those goods, the average consumer will unlikely consider the provider of the retail service to also be the producer of those goods. I find the parties' offerings to have a low level of similarity.

53. I now compare the Holder's retail services in respect of 'motor vehicle' tools to the Opponent's goods. Their purposes and methods of use will differ in the manner described above at [52]. The Opponent's goods cannot be said to be tools for motor vehicles and, therefore, will not be goods to which the Holder's service relates. That said, I consider users to overlap because typical purchasers of filters will likely be users of tools used to work on motor vehicles. Trade channels may overlap somewhat, given that some retailers of vehicle parts (which encompasses filters) might also sell tools for use when working on vehicles. There is not complementary between the goods and services, neither being necessary or important for each other. All things considered, I find a very low level of similarity between the parties' offerings.

54. I now compare the Holder's retail services in respect of 'motor vehicle' accessories to the Opponent's goods. It is my understanding that accessories for motor vehicles encompass items added to vehicles to, inter alia, enhance its appearance, comfort or to add some sort of non-essential function. Examples include, inter alia: 'dash-cams'; anti-theft devices; seat covers; roof racks; floor mats. The parties' offerings will differ in purpose and method of use. To my mind, filters will typically be purchased by professionals, e.g. the auto repair and maintenance trade, although the ultimate users will be the owners of the vehicles in which the filters are installed. Retail services for car accessories, will be used, predominantly, by the general public. Users may overlap to a limited extent. Trade channel overlap is, in my view, unlikely but not impossible. I do not find complementarity, neither party's offering being useful or important for the other. In the light of the foregoing, I find the goods and services to be dissimilar. In case I am wrong about that, I consider that any similarity between the parties' offerings would be, at best, very low.

Class 37

Contested terms: *Repair of motor vehicles; motor vehicle maintenance and repair; servicing of motor vehicles; maintenance and repair of motor vehicles; vehicle maintenance; servicing of commercial vehicles; vehicle repair; car maintenance; garage services for vehicle maintenance; maintenance or repair of automotive vehicles; vehicle service stations ([...] maintenance)*

55. The Holder's services entail the repair, maintenance or servicing of motor vehicles. Their purpose, therefore, is to keep motor vehicles in good working order. Although both parties' offerings relate to motor vehicles, their core purposes and methods of use are different. I have already noted that the Opponent's filters will, typically, be purchased by professionals, i.e. the auto repair/maintenance trade. That said, the ultimate users of the goods are the owners/users (whether general or professional) of the vehicles in which the filters have been installed. The Holder's services will be engaged by the owners/users of motor vehicles, which will include both the general public and those operating vehicles in a professional capacity. Users will, therefore, overlap in this regard. Trade channels will overlap to the extent that a change of oil filter is performed as part of a vehicle maintenance/servicing or repair

service. In my experience as an ordinary member of the car-owning public, the customer invoice for the work done typically enumerates the cost of the vehicle parts replaced (in this case, oil filters), as well as the cost of the labour in replacing them. Filters are indubitably necessary when delivering a car maintenance/repair service requiring a filter change. Whilst many auto repair centres are independent (i.e. not under a particular vehicle brand), it is my understanding that some vehicle repair/maintenance services *are* offered by the vehicle dealerships themselves. In this case, the goods and services are complementary because the parts fitted as part and parcel of the service will be 'branded' parts from that particular dealership. All things considered, I find a medium degree of similarity between the goods and services.

Contested term: *advisory services relating to the repair of motor vehicles*

56. The Holder's services are, to my mind, part and parcel of vehicle repair services to the extent that the car mechanic, for example, will diagnose a fault and advise the customer how it could be remedied. Users and trade channels will, therefore, overlap as described above at [55]. However, where the service provided is a standalone advice (for example, merely diagnosing a fault) I do not consider the goods and services to be complementary. A consumer seeking *mere advice* on an auto repair matter will not find a filter to be important or necessary in that regard, even if the advice is about filters. That is because receiving advice, as a standalone service, does not require anything else. I find a low level of similarity between the goods and services.

Contested term: *cleaning of motor vehicles*

57. The parties' offerings have distinct purposes: filtration of oil/fuel etc in a motor vehicle's engine versus making the vehicle clean. Methods of use will differ. The end users will be the same. Trade channels will be distinct. In my view, providers of car cleaning services do not typically sell filters (or, indeed, any parts for motor vehicles). I do not consider the parties' offerings to be in a competitive or complementary relationship. I find the goods and services to be dissimilar.

Contested term: *vehicle service stations (refuelling)*

58. The Holder's services are typically provided by what are referred to generally as 'petrol stations', even though other fuels beside petrol, such as diesel, are also provided. Purposes and methods of use will differ. User overlap is inevitable given that any motor vehicle with an engine that runs on fossil fuel will require both filters and fuel. Such inevitable overlap is, in my view, not particularly remarkable. Trade channels will be separate. The parties' offerings are neither competitive nor complementary, neither being substitutable or necessary/useful for the other. I find the goods and services to be dissimilar.

59. Some similarity between the parties' goods and services is essential in order to find a likelihood of confusion between the parties' marks. In the case of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

'49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover, I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity'.

60. The opposition against the services that I have found to be dissimilar, therefore, fails at this point. For clarity, the services that I have found to be dissimilar are:

Class 37:

cleaning of motor vehicles; vehicle service stations (refuelling)

61. The opposition remains 'live' for the following services:

| |
|--|
| <p>Class 35: <i>retail services connected with the sale of motor vehicle parts [...] tools and accessories</i></p> |
| <p>Class 37: <i>Repair of motor vehicles; motor vehicle maintenance and repair; servicing of motor vehicles; maintenance and repair of motor vehicles; vehicle maintenance; servicing of commercial vehicles; vehicle repair; vehicle service stations ([...] maintenance); advisory services relating to the repair of motor vehicles; car maintenance; garage services for vehicle maintenance; maintenance or repair of automotive vehicles.</i></p> |

Average consumer and the purchasing act

62. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word “average” denotes that the person is typical. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

63. The Opponent’s filters will be purchased predominantly by professionals, such as auto repair businesses, with a smaller number of purchases made by the general public. I consider that the purchasing act will, in many cases, be primarily visual, with the goods likely being selected from catalogues or listings (whether hard copy or online). However, an appreciable number of purchases will have an aural aspect. For example, a Motor Factors (physical shop) does not typically display all vehicle parts in stock on the shop floor, in which case the prospective purchaser might request a particular filter from the shop assistant. My view is that where the filters are self-selected, (from a catalogue or listing, for example) the purchaser will likely pay at least a medium level of attention during the purchasing process. Factors influencing the purchasing process will include: the compatibility of the filter

with the engine for which it is intended; the grade of fuel or oil, as the case may be, used for the vehicle in question.

64. My comments above at [63] on the average consumer will necessarily also apply to the average use of retail services in so far as they relate to the selling of filters and motor vehicle tools or accessories. In this case, the purchasing act will be primarily visual because the retail service will be engaged by way of browsing the retailer's website or physical store. I do not discount an aural aspect where, for example, a purchaser asks a staff member about the range of filters available, or whether a particular tool or accessory is in stock. Engaging a retail service can amount to a mere casual browse of the range of goods available, without necessarily committing to a purchase. On the other hand, a purchaser might look closely at the product specifications of particular filters, tools or accessories in mind, before committing to a transaction. In the former scenario, the level of attention paid will be fairly low. In the latter example, the purchaser will be more focused, paying at level of attention of at least medium.

65. I now consider the average consumer of the relevant services in class 37 which, broadly speaking, concern the repair and maintenance/servicing of motor vehicles. With the exception of the term 'servicing of commercial vehicles', which is, as the wording indicates, aimed at businesses, I find that a significant proportion of purchasers will be the general public, i.e. ordinary owners of vehicles for domestic use. A number of consumers will be professional customers whose vehicles are for business use. In my experience as an ordinary member of the car-driving public, many average consumers will typically take their car to the nearest or most convenient service-provider for repairs or maintenance. The purchasing act will, in many cases, be visual; e.g. where a consumer sees a garage/repair centre in the street or advertised on television or in printed matter. There will be an aural aspect where a service-provider is engaged after 'word of mouth' recommendation. I recognise that there will be another group of consumers who will take their cars to be repaired by a 'branded' repair/service centre for the brand of the car in question, e.g. a Mercedes owner might take their car to the nearest 'Mercedes' garage. In either case, I find that the consumer will unlikely pay a particularly high level of

attention when deciding whether to engage the service. I consider that no more than a medium level of attention will be paid.


66. Where the purchaser is a professional, the level of attention paid may be higher. Vehicles used in trade are, generally speaking, subjected to heavier use than domestic vehicles, which likely necessitates more frequent repair and maintenance. A professional purchaser, to my mind, is, therefore, more likely to 'shop around' for a service-provider bearing in mind, inter alia: value for money; or, how fast their turnaround is in terms of completing repairs quickly. In such instances, I find that a level of attention in the medium to high range will likely be paid.

Comparison of the marks

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

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

68. The marks to be compared are:

| | |
|---------------|---|
| Earlier sign: | Holder's marks: |
| Fleetguard | <p>(i) WO0000001724318</p>  <p>Fleet Guru</p> <p>(ii) WO0000001725487</p> <p>FLEETGURU</p> |

69. The Opponent's submissions on the competing marks, based on the visual, aural and conceptual planes of comparison, can be summarised as follows:

- Comparison against Holder's mark (i)

Visually speaking, it is argued that the marks are highly similar. The presence of the 'additional stylisation', by way of the device atop the word 'FleetGuru' in the Holder's mark, is said to amount to a difference insufficient to 'detract from the highly similar words 'FLEETGURU v FLEETGUARD'.³⁹

Aurally speaking, it is argued that the marks are 'phonetically similar', by virtue of the shared 'FLEETGU' element.⁴⁰

The Opponent argues that the level of conceptual similarity is very high, owing to the identical 'FLEET' element, understood as a group of vehicles under the same ownership. It is argued that the conceptual difference by way of 'guard' (conveying 'protection') versus 'guru' (conveying 'expertise') will have less focus than the shared 'Fleet' element, owing to their 'low distinctiveness'.⁴¹

³⁹ Opponent's written submissions in lieu of a hearing, [76.1].

⁴⁰ As above, [76.2].

⁴¹ Opponent's written submissions in lieu of a hearing, [76.3].

- Comparison against Holder's mark (ii)

It is submitted that the marks are visually highly similar.⁴²

The Opponent's submissions on the levels of aural and conceptual similarity are the same as for the Holder's Mark (i).⁴³

The overall impression of the marks:

70. The earlier mark is a word mark⁴⁴ comprising the single element 'Fleetguard'. The average consumer will readily observe that the 'word' is a coalescence of the words 'Fleet' and 'guard'. I find that the coalescence of the two recognisable word elements accords unity to the mark such that its overall impression resides in the mark as a whole, with neither the 'fleet' nor the 'guard' portion having dominance over the other.

71. I will address the Opponent's earlier mark ii) first. This mark is also a word mark; comprising the single element 'FLEETGURU'. The average consumer will recognise the 'word' as a coalescence of the words 'Fleet' and 'guru'. For reasons analogous to those above at [70], I find that the overall impression resides in the mark as whole, with neither the 'fleet' nor the 'guru' portion having dominance over the other.

72. The Opponent's earlier mark i) is a composite mark with both text and a device. I respectfully disagree with the Opponent's description of the mark as, essentially, a

⁴² Opponent's written submissions in lieu of a hearing, [76.4].

⁴³ As above, [76.5] – [76.6].

⁴⁴ In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

'[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).'

word mark.⁴⁵ The Holder has stated that the figurative element of the mark represents the characters 'A' and 'G' and that these characters are the 'distinctive element' of the mark.⁴⁶ With respect, I also disagree with this characterisation of the figurative element. The device/figurative element comprises two circular shapes, positioned side-by-side, each having a pointed 'protrusion'; the first circular shape having a curved parallel line above it, the second having a curved parallel line below it. I accept that the positioning of the protrusion on the first circular shape might be seen as suggestive of a lower-case letter 'a' by some average consumers, although I consider it to be somewhat unlikely. The second circular shape is, in essence, the first circular shape, albeit rotated ninety degrees counter-clockwise. To my mind, it is difficult to conceive of this second shape being seen as a lower-case letter 'g'. I find that it more readily suggests the letter 'o' rendered in cursive script, though I consider the likelihood of that to also be low. Even if the curved line below the second circular shape is intended to form the 'tail' of a lower-case 'g', then, in my view, the average consumer is unlikely to appreciate this, particularly given the presence of the same curved line above the first circular element. I find that a large proportion of average consumers would likely perceive the figurative element merely as an arrangement of concentric shapes and parallel lines, rather than either combination of characters 'ao' or 'ag'. My view is that the eye will be drawn first to the text element 'FleetGuru', given that, generally speaking, word elements 'speak louder' than devices. This 'word' will be perceived in the manner described above at [71]. The device will nevertheless be registered visually owing to its size and positioning above the word 'FleetGuru'. I find that the overall impression resides in the mark as a whole, with the word element 'Fleetguru' playing the dominant role.

73. I will first consider the comparison to the Holder's mark (i). I find that the shared characters 'Fleet', being the first portion of the word elements in both marks, must give rise to some level of visual similarity. I agree with the Opponent that the words 'Fleetguard' and 'FleetGuru' can be said to be highly similar. However, I consider that the device, owing to its prominent positioning and relative size, cannot be said

⁴⁵ Opponent's written submissions, [76.1].

⁴⁶ Holder's counterstatement for OP443460, [10] – [11].

to play a minor role within the overall impression of the mark. Although, generally speaking, word elements tend to 'speak louder' than devices, I consider the device element to be a point of visual difference that will be readily noticed by the relevant public. My view is that the marks are visually similar to a medium degree.

74. I agree that there is a level of aural similarity between the marks, and I consider it to be at least medium. To my mind, the marks are reasonably short, and the difference in aural length ('Fleetguard's' two syllables versus 'FleetGuru's' three) will be perceived aurally.

75. I disagree with the Opponent's submission that the level of conceptual similarity is 'very high'. Although the 'Fleet' element will, for both marks be ascribed the meaning suggested, my view is that the distinct meanings of 'guard' and 'guru' cannot lead to finding such a close conceptual alliance between the marks. The Opponent seems to be suggesting that the distinctive element of the marks is 'Fleet'. My view is that, whilst the elements 'guard' and 'guru' might not be particularly distinctive (given that 'guard' is at least somewhat allusive of filters to the extent that they 'filter out' material from liquids/gases; and 'guru' simply alludes to expertise, which could be said about any undertaking, irrespective of its offering), 'Fleet' is not particularly distinctive for the Opponent's goods, either. I consider that the 'fleet' element is the more strongly allusive part of either party's mark in that it alludes to the vehicles in which the goods will be fitted, or in respect of which the service will be performed. For each of the marks, I find that the two word elements form a unit and that the distinctive character, therefore, resides in the marks as a whole. My view is that the Opponent's mark will be understood by the relevant public, as conveying the idea of reliable filtration products which help to protect the systems of any vehicle that could form part of a fleet; haulage vehicles being one example, another being delivery vans. I find that the Holder's mark 'FleetGuru' will likely be perceived by the Opponent's customers as an undertaking with particular expertise in the supply of motor vehicle parts and repair services, particularly concerning vehicles of the sort likely to be owned in 'fleets' (often haulage vehicles). I find the marks to have a medium level of conceptual similarity.

76. I now consider the Holder's mark (ii). I find the parties' marks to be: highly visually similar; aurally similar to at least a medium degree; and conceptually similar to a medium degree.

Distinctive character of the earlier mark

77. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

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

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

78. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

79. The Opponent has submitted that 'Fleetguard' has a 'normal' level of inherent distinctiveness because it has '[no] direct meaning' for any of the goods/services at stake.⁴⁷ It is further submitted that the inherent position has been enhanced to a 'high' level of distinctiveness owing to the use that has been made of the mark, which is borne out by the evidence.⁴⁸

80. I will first consider the inherent position. The elements 'fleet' and 'guard' are ordinary English words with which the average UK consumer will be familiar. They will be understood in the manner described above at [75]. Whilst 'Fleetguard' cannot be said to be a frank description of filters for vehicle engines, I find it to be somewhat allusive of both the functionality of filters and of vehicles in general. Filters are used to separate particles from liquids and, to that extent, can be said to 'guard' against contamination/mixing of substances. I find that the word 'fleet', to the extent that it denotes a collection of vehicles under the same ownership, is somewhat allusive of the commercial use of vehicles. However, in my view, the joining together of these two elements into a single 'word' (Fleetguard) results in a mark with a 'normal' or average degree of inherent distinctive character. I am, therefore, in agreement with the Opponent's assessment in this regard.

81. I now consider whether the mark enjoys an enhanced level of distinctiveness. I have noted that the evidence reveals a consistent high regard for the quality of 'Fleetguard' filters among a range of third parties. Several undertakings appear to hold out the Fleetguard brand as a long-standing, and 'main' or 'leading' supplier of filters, in a market in which there is a large number of brands. To my mind, this indicates a level of awareness of Fleetguard filters within the UK, certainly amongst the professional public, commensurate with an enhanced level of distinctiveness. I consider that the distinctive character of the mark has, by virtue of the use that has been made of it, likely been raised to a higher level, to the upper end of 'medium'.

⁴⁷ Opponent's written submissions in lieu of a hearing, [64].

⁴⁸ As above, [66].

Likelihood of confusion

82. Confusion can be direct or indirect. Mr Iain Purvis Q. C. (as he then was), as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v Back Beat Inc*⁴⁹. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*⁵⁰, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or an economically linked undertaking.

83. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [39]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

84. I have found a number of the Holder’s services to be similar to the Opponent’s goods; ranging from ‘very low’ to ‘medium’. Given that the specification for each Contested Mark is the same, it is appropriate to begin with earlier mark (ii), given that both marks to be compared are word marks. If there is no likelihood of confusion for earlier mark (ii), then there will be no likelihood of confusion for earlier mark (i) because there is a lesser degree of similarity between the parties’ mark. Both are word marks. Visually speaking, the marks are highly similar. They are aurally similar to at least a medium degree. They have a medium level of conceptual similarity. The common element in the parties’ marks is the ‘fleet’

⁴⁹ Case BL O/375/10 at [16].

⁵⁰ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

component, which appears at the beginning of each party's mark: 'Fleetguard' versus 'Fleetguru'. I bear in mind that, generally speaking, the beginnings of words tend to have more visual and aural impact than the ends.⁵¹ However, this is a rule of thumb, rather than an absolute.

85. The Holder has argued that there is no likelihood of confusion, in part, because:

'[...] the use of the word "Fleet" in a trade mark, [sic] sense cannot be presumed to be a mark of origin given the descriptive nature of the term.⁵²

86. It is appropriate, at this point, to refer back to my findings above, at [75] and [80], that 'fleet' is *the more strongly allusive* part of the competing marks, whilst the marks of which 'Fleet' is a constituent part are *somewhat* allusive of goods that will be used with or on commercial vehicles. To say that something is 'somewhat allusive' is not the same as saying that it is 'descriptive' (either wholly or somewhat). The relevant goods/services cannot be said to be 'fleets of vehicles' or commercial vehicles. Allusion and description are not one and the same. It is the combination of the two words into one that results in an average level of inherent distinctive character.

87. I have borne in mind the judgment of the High Court in *Nicoventures Holdings Limited v The London Vape Company Ltd*⁵³ in which the following dictum of Arnold J. was cited with approval:⁵⁴

'[...] what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion'.

88. The judgment in *Nicoventures* nevertheless emphasised that 'such a situation does not preclude a finding of likelihood of confusion, but it is a relevant factor and,

⁵¹ *El Cortes Inglés, SA v OHIM*, cases T-183/02 and T-184/02, [81] – [83].

⁵² Holder's counterstatements for each opposition, [19].

⁵³ [2017] EWHC 3393 (Ch), per Birss J. at [20] – [21].

⁵⁴ *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch). At [43] – [45].

in an appropriate case, it may be decisive'.⁵⁵ I take particular note of the following dictum, further on in the judgment, at [31]:

'The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive (as the Hearing Officer found [...]), it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weight against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed'.

89. The situation considered in *Nicoventures* concerned competing marks whose common element was deemed to be descriptive and, therefore, a non-distinctive element. My view is that the instant case can be distinguished in the following ways:

i. the common element 'fleet' has been found to be the more strongly allusive element of the Opponent's mark, regarding its allusion to the vehicles in which the goods will be fitted. This is not the same as finding 'fleet' to be frankly descriptive of the goods for which the earlier mark is registered.

ii. I also find that the word 'Fleet' is the more strongly allusive constituent of the Holder's mark in its allusion to the vehicles in respect of which the services will be performed, or the tools/accessories used. However, following the above, it cannot be said to be frankly descriptive.

iii. I have found the earlier mark to have a 'normal' or average level of inherent distinctive character, which has likely been enhanced to a point within the upper range of 'medium' by virtue of the use that has been made of it.

iv. I find that, for each mark, the distinctive character resides in its whole, the two coalesced word elements creating a unit. In the earlier mark, the distinctive

⁵⁵ [2017] EWHC 3393 (Ch), per Birss J. at [27].

character arises from the combination of 'Fleet' and 'guard'. The distinctive character of the Contested Mark resides in the combination of 'Fleet' and 'Guru'. In my view, neither mark is divisible in terms of either of the constituent word elements having a dominant and distinctive character.

v. The fact that the 'fleet' element of each word, if taken in isolation, is the lesser distinctive element by virtue of its allusion to commercial vehicles, does not prevent the distinctive character of each mark residing in its whole.

vi. I find that each party's mark, in its own way, has some measure of allusiveness. I have found that 'Fleetguard' will likely be understood as alluding to the filtration/separation properties of the goods, such goods being particularly suitable for commercial vehicles. I have found that 'FleetGuru' will convey the idea of the service-provider having expertise in commercial vehicles in particular.

90. My view is that, despite the high level of visual similarity between the marks, the net effect of the visual, aural and conceptual differences that I have identified is sufficient to prevent one mark from being mistaken for the other. I have found the earlier mark to enjoy a level of distinctive character at the upper level of medium. Its inherent distinctive character resides in the totality of the mark, being the combination of the two word elements. The distinctiveness of the mark has been raised somewhat through use, the Fleetguard brand having gained recognition in the 'filter' trade as a 'go to' for truck filters. However, I have found that the distinctive character of the contested mark arises from its own combination of word elements, which form a unit. Whilst both marks allude to commercial vehicles, the overall idea conveyed by each mark has an appreciable difference. All things considered, I find that there is no likelihood of direct confusion. I find this to be the case, even where a low level of attention might be paid. I have found, at most, a medium level of similarity between the parties' goods/services. I do not consider that the 'interdependency' principle, set out above at [83], comes into play here. The marks have been found to be highly similar along one of the three planes of comparison; and my view is that the impact of the aural and conceptual distinctions, together

with the visual difference that has been noted, is sufficient to support a finding of no likelihood of direct confusion.

91. I now consider whether there is a likelihood of indirect confusion. I note that in the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a ‘proper basis’ for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

92. In *L.A. Sugar Limited v Back Beat Inc*⁵⁶ Mr Iain Purvis Q. C. (as he then was), as the Appointed Person, explained that [my words in parentheses]:

(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.).

⁵⁶ Case BL O/375/10

(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).

93. I bear in mind that the above-mentioned categories are not intended to be exhaustive. The Opponent has submitted the following:⁵⁷

'92.1 the initial and therefore distinctive part of the earlier mark "FLEET" is replicated in the later mark "FLEETGURU" and the marks only differ in [sic] non-distinctive elements (e.g. the final letters "ARD" vs "-RU"; and

[...]

[...] given the imperfect recollection of the average consumer and the average degree of attention with which that consumer will address the transaction, we submit that it is likely the average consumer would assume an economic link with the Opponent and that the Designations are a brand extension of the Opponent's Earlier Mark'.

94. Following my findings on the distinctive characters of the competing marks, I respectfully disagree with this submission. I do not consider the instant case to fall within any of the three categories identified by Mr Purvis. The common element of the marks cannot be said to be particularly striking. The construction of the marks (i.e. the first element 'Fleet' combined with either 'guard' or 'Guru') is such that the second category does not apply. As to the third category, although both marks might be said to comprise two word elements, those two elements are combined to form a unit, with the distinctive character of each mark arising, in its own way, from the combination of word elements. I do not consider it plausible for the average consumer to presume that one or other of the marks is a brand extension of the other. To my mind, there is no commercially sensible rationale for 'Fleetguard', an undertaking responsible for retailing filters for vehicle engines to have a related brand by the name of 'Fleetguru' which retails vehicle engine parts

⁵⁷ Opponent's written submissions in lieu of a hearing, [92] – [93].

and provides auto repairs and maintenance. I can conceive of no other mental process according to which the marks would be presumed to be related brands or to derive from the economically-related undertakings. I can find no proper basis for a finding of a likelihood of indirect confusion.

95. Given that the Holder's Contested Mark i) is a more distant comparator for the Opponent's mark, the opposition directed against that mark must also fail.

96. The oppositions based on section 5(2)(b) of the Act have failed in their entirety.

97. It, therefore, remains for me to proceed to consider the oppositions pursuant to section 5(4)(a).

The Section 5(4)(a) ground: the passing off claim

Relevant legislation

98. Section 5(4)(a) of the Act states:

'(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,

[...]

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.'

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

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

Relevant case law

100. The essential requirements, sometimes referred to as ‘the classical trinity’, for a passing off claim to be made out are set out in the case *Reckitt & Colman Products Ltd, v Borden Inc & Ors* (also known as the ‘Jif Lemon’ case):⁵⁸

‘First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff’.

[my underline added]

Relevant date

101. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C., (as he then was) as the Appointed Person, endorsed the Registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

⁵⁸ [1990] 1 W.L.R. 491 HL, per Lord Oliver at [499].

'43. In *SWORDERS TM O-212-06*, Mr Alan [sic] James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

102. The 'behaviour complained about' is the conduct which amounted to a misrepresentation, whether or not intentional, which deceived or was likely to deceive the relevant public.

103. Neither of the Holder's registrations has a priority date. The evidence filed by the Holder demonstrates trading activity in New Zealand and Australia.⁵⁹ Although Mr Shirley's narrative indicates that the Holder has been investigating bringing its offering to the UK market, nothing in the evidence indicates that any trade has taken place within the UK or that there has been any advertising ahead of a launch.⁶⁰ Therefore, the relevant dates for the purposes of this ground are their designation dates, both being 14 December 2022.

104. For the purposes of the passing off claim, the Opponent claims to have used its mark in respect of the goods and services set out above at [7].

105. The Holder has submitted that the Opponent has failed to demonstrate that its sign has acquired a goodwill or reputation in line with their registered services.⁶¹ To clarify, the Opponent is required to demonstrate goodwill in respect of the goods/services for *which it claims to have used its mark*, rather than the goods/services within its specification as registered.

⁵⁹ Witness Statement of E. Shirley.

⁶⁰ As above, [19] – [22].

⁶¹ Holder's written submissions in lieu of a hearing, [15].

Goodwill

106. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC at [217]:

'What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates'

107. Protectable goodwill must be more than merely trivial. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20, Mr Thomas Mitcheson QC, (as he then was) sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After doing so, he concluded that:

'34. [...] 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'.

108. Goodwill resides in the business and arises by virtue of the trading activity of that business, in respect of the sign upon which that business relies as its earlier unregistered right.

109. As already noted, at [28], the sales figures for the Fleetguard brand are impressive, and its longevity evident. It is clear that there is a significant number of 'Fleetguard' dealerships with a fairly even coverage within the UK territory. I find that the examples of laudatory comments, from a range of third parties (i.e. UK-based suppliers) indicate a consistent high regard for Fleetguard filters, which has subsisted over a period of several years leading up to the relevant date. To my mind, the fact that several UK suppliers hold themselves out as 'main' or 'leading' suppliers of Fleetguard filters likely indicates that Fleetguard is considered a valuable brand for which there is demand. It is clear from the evidence that there is a large number of brands of filters directed to the UK market.⁶² I consider the fact that a supplier has chosen to stock Fleetguard filters, as one of only two brands that it supplies, likely indicative of the attractive force of the Fleetguard brand amongst other brands of filters. It is apparent from the trading names of the suppliers and/or the content of their web pages featuring Fleetguard goods, that the field in which Fleetguard enjoys a reputation is that of filters for vehicles such as trucks, plant and agricultural vehicles.

The relevant public

110. The relevant public in a passing off action comprises 'purchasers or probable purchasers of the goods of the kind in question'.⁶³ The evidence demonstrates that the relevant public will comprise the following groups of professionals: suppliers of Fleetguard goods; haulage businesses; and businesses which own their own haulage vehicles/plant.

111. In the light of the foregoing, I find that the Opponent enjoys a protectable level of goodwill, in the UK marketplace, in respect of oil, fuel, water and air filters for vehicles such as trucks/haulage vehicles, plant and agricultural vehicles, and that the FLEETGUARD sign is distinctive of this goodwill.

⁶² Exhibit GM01, page from website of Inlinefilters.co.uk, dated 24 May 2022.

⁶³ Per Viscount Maugham in *Saville Perfumery v June Perfect* (1941) 58 R.P.C. 147, at [176].

Misrepresentation

112. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

‘There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 RPC 97 at page 101.’

113. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18 (PCC), Mr Iain Purvis QC, (as he then was) as a Recorder of the Court, stated that:

‘54. Mr Aikens stressed in his argument the difference between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone4U.co.uk. Internet Ltd* [2007] RPC 5 at 16-17 Jacob LJ stressed that the former was not sufficient for passing off.’

He concluded at [17]:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally [...] be passing off if there is a substantial number of the latter even if there is also a substantial number of the former’.

114. The onus is on the Opponent to prove that it is deception which moves the relevant public to purchase the Holder's goods/services; I.e. whether, on the balance of probabilities, it is likely that a substantial number of the relevant public will be misled into purchasing the Holder's goods/services in the belief that they are those of or associated with the Opponent.^{64, 65}

115. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance on establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

'Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

⁶⁴ Per Lord Oliver in *Reckitt & Colman v Border* [1990] RPC 340 HL.

⁶⁵ *Sir Robert McAlpine Ltd v Alfred McAlpine* [2004] EWHC 630 (Ch), at [19].

- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action’.

116. The Opponent has submitted the following:⁶⁶

‘109. [...] It is clear that the degree of similarity [of the marks] is such as to give rise to deception among a substantial proportion of the relevant public, and is at least as similar as the signs found to give rise to a misrepresentation in earlier decisions.

110. Given the high level of brand recognition enjoyed by the Earlier Mark, a high number of the Opponent’s actual and potential customers would likely believe that the Opponent has expanded its business, for instance a collaboration with a subsidiary company, to the provision of repair and maintenances [sic] services by garages and mechanics working exclusively [sic] the goods of the Opponent (being part and fitting for vehicles and engines). This amounts to a misrepresentation.’

⁶⁶ Opponent’s written submissions in lieu of a hearing, [109] – [110].

117. The Opponent proceeds to argue that ‘damage would inevitably follow from a misrepresentation of this kind, including by denying the Opponent the chance to exclusively control its goodwill.’⁶⁷

118. At this point, I remind myself that, in order for a passing off action to succeed, the misrepresentation must *deceive* the relevant consumer into transacting. Mere confusion will not suffice.⁶⁸ I bear in mind that confusion may occur without it being an instance of deception.

119. I now consider the parties’ respective fields of activity. I remind myself that there is no requirement that the parties’ businesses operate within the same field.⁶⁹ However, if parties do operate within the same or related fields, that increases the likelihood of a misrepresentation. The Holder’s services comprise the repair and maintenance of motor vehicles (including cars) and the supply of parts for such vehicles. Save for the terms specifically relating to cars, all of the Holder’s services will encompass parts for, and the repair and maintenance of, vehicles typically owned in fleets (e.g. haulage vehicles). The parties’ fields of activity are clearly the same or (in the case of cars) closely related. Oil/fuel/air/water filters for trucks etc are clearly goods to which the Holder’s retail services will relate. Furthermore, the repair and maintenance of trucks and the like will often involve supplying and fitting parts, e.g. the changing of oil filters.

120. I have found that the Opponent enjoys a protectable level of goodwill for the sign ‘Fleetguard’ in respect of various filters for vehicles, particularly trucks and other large vehicles. Taking all relevant matters into account, I consider that a relevant consumer, i.e. an actual or potential customer of ‘Fleetguard’ filters, with an awareness of its reputation as a long-standing and reliable brand, would unlikely assume that there was a trade connection between ‘Fleetguard’ and ‘Fleetguru’. The common element ‘fleet’ has a low level of distinctiveness by virtue of its allusive quality. In my view, it is difficult to conceive of the relevant public being deceived

⁶⁷ Opponent’s written submissions in lieu of a hearing, [112].

⁶⁸ *Marcus Publishing Plc v Hutton-Wild Communications Ltd* [1990] R.P.C. 576 CA, per Dillon LJ at [580].

⁶⁹ *Harrods and Harrodian School* [1996] R.P.C. 501 CA.

into purchasing 'Fleetguru' goods or services, believing them to have a trade connection with the Opponent.

121. Following my finding that there will be deception, there will be no damage.

122. The oppositions pursuant to section 5(4)(a) of the Act have, therefore, failed.

Conclusion

123. The Oppositions have failed in their entirety. The Holder's registration may proceed to UK protection in full.

COSTS

124. The Holder is the successful party and is entitled to a contribution to its costs based on the published scale set out in TPN 1/2023, as follows:

| | |
|---|--------|
| Preparing statements and considering the Opponent's statements (x2): | £350 |
| Preparation of written submissions in lieu of a hearing: | £100 |
| Preparation of evidence and consideration of the Opponent's evidence: | £600 |
| Total: | £1,050 |

125. I have declined to award the full minimum sum of £250 for each opposition, in respect of considering the opposition and preparation of the defence and counterstatement, because there is a great deal of overlap between the two actions. I consider £350 to be an appropriate sum for this head of costs.

126. The sum of £100 awarded in respect of the preparation of written submissions in lieu of a hearing is below the minimum threshold to reflect the following:

- the submissions were brief: of the three pages provided, a full page, essentially, repeated material included in the Holder's counterstatements;
- very little was included in terms of argument;
and
- the submissions demonstrated a number of misunderstandings of the relevant law.

127. I, therefore, order Cummins Filtration Inc to pay to AutoGuru Australia Pty Ltd the sum of £1,050. 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 this case if any appeal against this decision is unsuccessful.

Dated this 9th day of September 2025

N. R. MORRIS

For the Registrar