

**O/0959/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003606121**

**BY CAP CITY MUFFLER LLC**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**CAT SECURITY**

**IN CLASSES 7, 9, 12, 16, 21, 25, 37, 38**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO**

**UNDER NO. 429543**

**BY COMPAGNIE D'AFFRETEMENT ET DE TRANSPORT C.A.T.**

## BACKGROUND AND PLEADINGS

1. On 08 March 2021, Cap City Muffler LLC (“the applicant”) applied for the trade mark shown on the cover page of this decision, in the UK (“the contested mark”). The application, which claims a priority date of 08 September 2020, was published for opposition purposes on 24 September 2021 in respect of the following goods and services:<sup>1</sup>

**Class 7:** *Parts and accessories for motors and engines.*

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

**Class 12:** *Vehicle parts and accessories.*

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

**Class 21:** *Beverageware and containers.*

**Class 25:** *Clothing.*

**Class 37:** *Vehicle services, repair and maintenance.*

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

2. On 22 December 2021, the application was opposed by COMPAGNIE D’AFFRETEMENT ET DE TRANSPORT C.A.T. (“the opponent”) based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade marks (“the earlier marks”) and all of the goods and services covered by the same, as shown below:<sup>2</sup>

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<sup>1</sup> The specification in class 9 was restricted following the filing of a Form TM21B on 10 May 2022.

<sup>2</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM or IR covering the EU. As a result of the opponent having IRs (EUTM) being protected as at the end of the Implementation

UK00909769696 (“the word-only earlier mark”)

CAT

Filing date: 28 February 2011; Registration date: 05 August 2011; Priority date: 25 February 2011, claimed from French trade mark no. 11/3809733.

**Class 37:** *Maintenance and repair for automobiles and motorcycles; Finishing and preparation of automobiles and motorcycles; Assembly and fitting of parts and fittings for automobiles and motorcycles; Vehicle and car wash; Cleaning of automobiles and motorcycles; vehicle repair; tuning stations for automobiles and motorcycles; all the aforesaid services being exclusively offered in relation to logistical for automobiles industry.*

**Class 39:** *Logistics for the automobiles industry (vehicles, motorcycles, spare parts and fittings therefore and goods) including in particular railway, road, air or water transport; vehicle storage of spare parts and fittings for automobiles, transit services, warehousing services; Garaging of automobiles and motorcycles, inspection of vehicles, spare parts and components of automobiles prior to the transport thereof; Freight and freight brokerage of automobiles and motorcycles, spare parts and fittings therefore and goods; hiring of transport vehicles, for the requirements of automobiles logistical services, and more particularly the transport of vehicles, motorcycles, spare parts and components of automobiles and motorcycles; Information services in connection with storage and transportation of vehicles, spare parts, components of automobiles and goods; All the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.*

**Class 42:** *Diagnostic stations and testing of automobiles and motorcycles, the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.*

UK00904270716 (“the figurative earlier mark”)

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Period, comparable UK trade marks were automatically created. The comparable trade marks shown here are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law and retain their original filing dates.



Filing date: 03 February 2005; Registration date: 01 July 2010

Seniority claimed from application number 1272980 with filing date of 01 October 1986.

**Class 12:** *Vehicles; apparatus for locomotion by land, air or water.*

**Class 39:** *Transportation and storage; Transporting of people and/or goods from one place to another; Freightage; Freight brokerage [forwarding]; Transport of passengers and/or goods by rail, by road, by air, by water or by pipeline; Storage of goods; Rental of transport vehicles, warehouses and garages; Inspection of vehicles or goods before transport; Provision of information relating to the transport and storage of goods; All the aforesaid services being exclusively offered in relation to logistical services for the motor industry.*

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

4. By virtue of their filing date (or priority date), the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to Section 6 of the Act. As the earlier marks had been registered for more than five years at the priority date of the contested mark, they are subject to the use conditions pursuant to Section 6A of the Act. Accordingly, the opponent made a statement that it has used the word-only earlier mark in relation to all of the registered services, and the figurative earlier mark in relation to the registered services in class 39 only. Furthermore, in its statement of grounds the opponent states that it *“has used the earlier trade marks for over 60 years in respect of a wide range of services in the field of vehicle logistics and transportation”* and that the services offered *“include not only the provision of vehicle logistics and*

*transportation services, but also associated services such as vehicle repair, maintenance, cleaning and preparation.”*

5. The applicant filed a counterstatement, denying the claims made and putting the opponent to proof of use in relation to all of the services for which the opponent claims that the earlier marks have been used. Although the applicant conceded the existence of some overlap between the respective goods and services, it did not state which goods and services it considers to be similar or dissimilar and pointed out that since the earlier marks are subject to proof of use, until such time as use is proved, the scope of protection afforded to the opponent is not defined.

6. The opponent is represented by Sipara Limited. The applicant is represented by Forresters IP LLP. Only the opponent filed evidence. Neither party requested a hearing, and only the applicant filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

## **THE EVIDENCE**

7. The opponent’s evidence came in the form of two witness statements, one from Nathalie Huet, and another from Stuart Martin Warren dated 4 October 2023 and 10 October 2023, respectively. Ms Huet is the opponent’s legal director, whereas Mr Warren is the managing director of CAT-UK, a wholly owned subsidiary of the opponent which is responsible for the opponent’s UK-based activities. Their witness statements are only a vehicle for introducing copies of previous witness statements they gave in relation to different opposition proceedings with accompanying exhibits. Ms Huet’s previous witness statement is dated 17 October 2022 and is accompanied by 9 exhibits labelled NH1-NH9, whereas Mr Warren’s previous witness statement is dated 14 October 2022 and is accompanied by 7 exhibits labelled SMW1-SMW7.

8. I do not intend to summarise the evidence at this stage, but I confirm that I have given due consideration to all of the documents filed.

## **RELEVANCE OF EU LAW**

9. 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**

### **Proof of use**

10. Section 6A of the Act states:

“(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

(c) 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.”

11. Section 100 is also relevant, which reads:

“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.”

12. The relevant period in which genuine use must be established is the five-year period ending with date of the priority claimed for the application for registration: 9

September 2015 to 08 September 2020. As the earlier marks subject to proof of use are both comparable marks, use within the EU (including the UK) is relevant for the totality of the five-year relevant period, which falls prior to IP Completion Day (i.e. 31 December 2020).<sup>3</sup>

13. 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 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 Bunderversvereinigung 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 Merken 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].

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<sup>3</sup> See paragraph 7 of Part 1, Schedule 2A of the Act.

(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].”

14. With regards to assessing use within the EU (which is relevant due to the earlier marks being ‘comparable marks’), I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU found that while use of a Community trade mark in one member state could suffice to establish genuine use in the Community, “*all facts and circumstances*” should be considered including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.<sup>4</sup>

### The evidence

15. In its submissions in lieu, the applicant criticises the approach taken by the opponent of filing evidence linked to a different opposition that relates to a different

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<sup>4</sup> See also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (paragraphs 228-230) and Case T-398/13, *TVR Automotive Ltd v OHIM* (paragraph 57)

five-year period and says that the evidence filed should be treated as being of very little weight. The applicant also argues that the previous oppositions in which the evidence was originally filed was withdrawn, and that the question of the evidence provided by the opponent was not reviewed or discussed in relation to that opposition. I have checked the file relating to the previous opposition (consolidated cases nos. 431383 and 431384) and I found that a decision in that opposition was indeed issued on 7 August 2023 (B-O/0749/23) dealing, among other things, with the issue of proof of use of the same earlier marks relied upon in the present proceedings. The applicant's statement about the previous opposition being withdrawn is therefore inaccurate. Further, whilst I accept that the recycling of the evidence from another case may have reduced the opponent's costs, I do not think that it necessarily affects my overall conclusion on genuine use. Consequently, I will give the evidence the weight I think it deserves bearing in mind that the overlap between the relevant period in this opposition and that in oppositions nos. 431383 and 431384 might be partial. Therefore, I refuse to consider the fact that the evidence is recycled when assessing the weight to be afforded to the opponent's evidence.

16. Ms Huet provides the following evidence.

- A. The opponent is a transport and logistics company based in France that operates worldwide in particular in the EU and in the UK. It was founded in 1957 by the car manufacturer Renault and was originally intended to provide shipping and logistics services for Renault as they entered the USA automotive market.
- B. By 2001, the opponent had become a leading independent supplier of transport and logistics services with a focus on services provided to the automotive industry. A survey of vehicle logistics in Europe for the period 2020/2021 conducted by the Association of European Vehicle Logistics describes Groupe CAT as "*one of the **European independent leaders** in automotive logistics services including transport, distribution, preparation, customisation*" and states that "*Groupe CAT possesses one of the **largest owned fleets in Europe** for car transportation with 1,600 trucks and 2,300 rail wagons*".<sup>5</sup>

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<sup>5</sup> NH1

- C. Ms Huet states that in 2019 the opponent employed around 8,800 people in 27 countries and delivered around 7.3 million vehicles. The opponent's cargo logistics division, which includes delivery of motorcycles, delivered around 33 million parcels and **100,000 motorcycles around the EU** in 2019.
- D. Copy of a page (undated) from the opponent's website [www.groupecat.com](http://www.groupecat.com) shows that the opponent has over **50 vehicle logistics and transport centres** in the EU, 5 of which are in the UK, and over **50 cargo logistics and transport centres**, the vast majority of which are in Spain and Poland.<sup>6</sup>
- E. The opponent operates in different countries through operating companies, such as CAT UK Services Ltd in the UK, and C.A.T. España Fletamentos y Transportes SA in Spain. Ms Huet confirms that the operating companies use the earlier marks with the opponent's permission and in compliance with branding guidelines.
- F. Ms Huet splits the services provided by the opponent in the following categories:
- (i) **Vehicle logistics.** This includes working with vehicle manufacturers to plan logistical management and vehicle movements; ensuring safe transportation, inspection, cleaning, mechanical functioning and overall quality of all vehicles; dealing with all import, customs requirements and registration of transported vehicles; and providing vehicle repair and servicing of vehicles.
  - (ii) **Supplier management.** The opponent operates as a logistic provider of third-party goods (e.g. spare parts) and services to clients, and provides management of those services and goods to clients.
  - (iii) **Distribution/transportation/storage.** The opponent provides transportation and distribution of vehicles nationally and internationally.

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<sup>6</sup> NH2

This means moving vehicles from point of import or from place of manufacture to either the opponent's own secure storage compounds, or the client's storage compounds or elsewhere as required. The opponent also provides storage compounds where vehicles can be safely stored for onward transportation and in which a range of other vehicle services are provided, including washing, protection, preparation, maintenance, repair and fitting of accessories.

- (iv) **Cargo services.** These services relate to transportation of automotive parts and components, as well as motorbikes. The majority of these services are provided by road, but the opponent also offers transport by rail and sea. The opponent also provides associated logistical services such as warehousing and customs agency services and advising on transport schemes for particular clients' needs.

The services at (i) to (iii) are said to be provided in relation to both new and used vehicles. Copies of pages from the opponent's website dated May 2020 and May 2021 describe the opponent as having two divisions, namely "**vehicle logistics**" which handles the physical and administrative management of new or used private, commercial and agricultural vehicle flows, and "**cargo logistics**" which coordinates the physical and administrative management of automotive parts, components, accessories and motorbikes.

- G. The opponent uses the earlier marks on the website [www.groupecat.com](http://www.groupecat.com) as well as on invoices, transportation vehicles (truck and vans in particular), facility signage, company uniforms, and items of merchandising such as pens, calendars and other promotional material. Some examples (undated) are provided below:<sup>7</sup>

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<sup>7</sup> NH7





H. The **global turnover** of the opponent for the financial years 2020-2021 was **€1,000 million in 2020 and €1,300 million in 2021 for vehicle logistics services** and **€350 million in 2020 and €350 million in 2021 for cargo division services**. Ms Huet says that these figures include some turnover which relates to services provided under different brands although she confirms that the percentage of turnover relating to services provided under other brands is very small in the context of the overall turnover.

I. Samples of invoices are provided, however, the identity of the customer and some of the financial details have been redacted. Additionally, the invoices are in French or Spanish but have not been translated. Nevertheless, I can see that the services described include the handling, transportation, cleaning and maintenance of vehicles.<sup>8</sup>

17. In addition to the above, Mr Warren provided more UK-specific evidence including the following:

J. CAT-UK has commercial sites around the UK including in Birmingham, Solihull, Atherstone, Liverpool, Humberside, Southampton, Purfleet, Rockingham and Avonmouth. These sites relate to compounds for vehicle storage and vehicle

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<sup>8</sup> NH8

preparation and repair, as well as hubs for transport of vehicles, and management offices. In the UK some of CAT-UK's operations are sub-contracted to other companies fully owned by the opponent, for example Carlson Vehicle Transfer Ltd ("CVI") (who provides additional transport and compound services) and STVA UK Limited ("STVA") (who provides additional transport services). CVT and STVA have been conducting business under different trade marks, and are being incorporated gradually, since 2018 into the same branding as CAT-UK.

K. CAT-UK has traded under the earlier trade marks since 1986-1987, uses the earlier trade marks with the consent of the opponent, and is obliged to follow branding guidelines set out by the opponent.

L. CAT-UK provides the following services under the earlier trade marks in the UK:

(i) **“Finished vehicle logistics”**. This include (a) supply chain management – CAT-UK manages the entire logistical and transport process for third parties; (b) pre-delivery inspections – once CAT-UK has accepted a vehicle from the factory or import point, it will inspect the vehicle, repair any damage, prepare the vehicle to UK specific standards, valet the vehicle and transport it; (c) Accessory fitment and personalisation; (d) pre-delivery inspection and repair within manufacturer approved facilities and (e) remarketing support - CAT-UK offers the same services (as set out above) in relation to remarketing of second hand or used vehicles, not just in relation to newly registered vehicles.

(ii) **"Commercial vehicles"**. This include (a) specialist preparation - CAT-UK provides accessory fitment and personalisation specific to commercial vehicles, so this might involve the addition of beacons, roof bars, ladder racks, parking sensors, telematics etc., but also the provision of administrative services such as vehicle taxation and registration; (b) rectification - CAT-UK provides a range of repair and

renovation services, particularly for fleet or demonstration vehicles, and also rental returns and end of lease vehicles. This range would include the provision of mechanical and electrical repairs, bodywork repairs and MOTs; (c) custom delivery - CAT-UK provides transportation services for bulk or individual vehicle movements, including via auctions.

- (iii) **"Compound management and storage"**. CAT-UK provides third party car dealers with storage of vehicles at secure sites around the UK, and also manages the movement, checking, allocation and transportation of those vehicles as required by the client.
- (iv) **"Demonstrator fleet management"**. CAT-UK provides services relating to the management of fleet vehicles, from arrival to preparation, registration and delivery, both for new and used vehicles.
- (v) **"Specialist Events Support"**. CAT-UK specialises in the preparation and delivery of vehicles from manufacturers for use in specialist events. For example, in the UK, the Opponent has managed vehicles for use in the London Olympics 2012, the Grand National 2018, the RBS Six Nations, the Ryder Cup, the MOTO GP and PGA Tour.

M. The **turnover of CAT-UK**, all of which relates to services provided under the earlier marks **is £16.5 million in 2018, £12.2 million in 2019, just over £11 million in 2020 and just over £12 million in 2021**. Mr Warran states that these figures do not include turnover of activities provided under other trade marks such as those owned by CVT and STVA and that if the additional activities were included, the overall turnover figure for the UK for 2019, by way of example, would be around £60 million.

N. Samples of invoices relating to services provided in the UK for the period 2017-2020 are supplied.<sup>9</sup> The services described on the invoices relate to vehicles and include, among others, storage and port rates; vehicle handling, hire and

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<sup>9</sup> SMW6

storage; valet; fuel; distribution, transport and delivery of vehicles and pre-delivery inspection and work.

### Assessment

18. Before I proceed further, it is important to note that the opponent's statement of use did not include the goods in class 12 listed in the specification of the figurative earlier mark. It follows that although the opponent relied upon these goods, since the applicant has put the opponent to proof of use, the opponent is unable to rely on these goods for which it has not claimed use.

### Form of the mark and genuine use

19. In its submissions in lieu, the applicant contends that the evidence does not show use of the registered figurative mark although it appears to accept that the word-only mark has been used in relation to storage and movement of motorcycles. It states:

*“There are significant differences between the trade mark registered and the trade mark used, including the lack of square outline and circle in the trade mark registered, as compared to that used. In terms of the word mark CAT, the evidence is more solid, however it is difficult to conclude that the mark CAT alone has been used in relation to anything other than storage and movement of motorcycles, given the quality and amount of evidence provided, and bearing in mind the fact that much of the evidence filed relates to evidence that is not linked to the relevant 5-year period.”*



20. I am satisfied that there is sufficient evidence of use of the word-only mark CAT as the main signifier of the origin of the services. The word CAT is used on the opponent's website ([www.groupecat.com](http://www.groupecat.com)), in the names of the relevant companies, namely, COMPAGNIE D'AFFRETEMENT ET DE TRANSPORT CAT S.A,<sup>10</sup> Groupe CAT and UK-CAT, on transportation vehicles, presentations, and marketing material. Although it is true that some of the documents exhibited are dated after the relevant

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<sup>10</sup> Invoices exhibited at NH8

period of 9 September 2015 - 8 September 2020, the evidence shows that the opponent was set up in 1957 under the name Groupe CAT and has been operating under that name since then, and there is evidence of invoices and webpages showing use of the trade mark CAT within the relevant period.

21. Turning to the figurative mark, I shall now consider whether use of the variant logo mark is acceptable use of the mark as registered. For ease of comparison, I reproduce them in the table below:

Registered mark	Mark used
	

22. The earlier figurative mark is registered in black and white, which means that fair and notional use of that mark would include its use in colour.<sup>11</sup> The differences between the marks come down to an additional square outline around the logo and an incomplete circle.

23. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under Section 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

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<sup>11</sup> See *Specsavers International Healthcare Ltd & Ors v Asda Stores Ltd* [2014] EWCA Civ 1294, paragraph 5, and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, paragraph 47

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM. VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

24. In *Hyphen GmbH v EU IPO*, Case T-146/15, the General Court (“GC”) held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.



25. In this instance, the addition of a square outline and an incomplete circle around the registered mark is not sufficient to alter the distinctive character of the registered mark, which lies in the letters “C-A-T” and their arrangement – these are the elements to which the target consumer’s attention will be drawn and which are identically reproduced in the mark as used. Accordingly, I find that use of the mark shown in evidence constitutes use of an acceptable variant of the earlier figurative mark.

26. The next question is whether the evidence adduced proves genuine use of the earlier marks during the relevant period. In the present case, it is clear that the opponent has been running a successful automotive logistics business under the earlier marks for over 60 years and has made a large-scale commercial use of the earlier marks in France and in the EU, including the UK, as demonstrated by the presence of the marks on invoices, marketing material, trucks, websites, and items of merchandising. The UK turnover figures for services supplied by the opponent (or with the opponent’s consent) under the earlier marks is nearly £30 million in the two-year period 2018-2019 (which falls within the relevant period) and £11 million in 2020 - a good proportion of the latter is likely to have been generated in the 9 months before the end of the relevant period in September 2020. Admittedly, it is not clear what proportion of the global turnover of €1,000 million (for vehicle logistics services) and €350 million (for cargo division services) relates to revenue generated by the provision of services in the EU before September 2020, however, given that the number of operating logistics and transport

centers is much higher in the EU than in the UK, the turnover generated in the EU must be significantly higher than that generated in the UK.

27. Taking into account the highly specialised nature of the services concerned, the significant turnover generated under the earlier marks, the extensive geographical areas in which the services have been provided, including France, Spain and the UK, and the frequency of use of the marks, I have no hesitation in concluding that the opponent has made genuine use of both earlier marks for services relating to vehicle logistics, transportation and storage. However, I must now decide on a fair specification.

28. 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.”

29. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the

services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

30. The strategic report for the year ended 31 December 2021 indicates that CAT- UK's core business is vehicle compound management and operations for major automotive manufacturers and states that two key drivers for the company's turnover are the volume of vehicles imported and distributed and the volume of vehicles handled through CAT-UK Services Limited's centres.<sup>12</sup>

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<sup>12</sup> SMW5

31. The client presentation says that the main activities provided by the opponent includes finished vehicle logistics and associated value added services, in addition to spare parts logistics and motorcycles. It conveniently summarises the services offered as “*Transport and distribution by road or rail - Preparation of new or second-hand vehicles - Pre-delivery inspection & refurbishment- Services for private or commercial cars*”.<sup>13</sup> It also refers to “sample compound activity tasks” including vehicle quality checks, 30/60/90 day maintenance checks and vehicle washing, and indicates that all vehicle refurbishment activities are carried out under one roof, with the relevant equipment including paint booths, lathe, wet blast cabinet and painting oven, compressors, air systems and dust extracts. Finally, the invoices refer to storage and port rates; vehicle handling, hire and storage; valet; fuel; distribution, transport and delivery of vehicles and predelivery inspection and work.

#### *The word-only earlier mark*

32. I shall consider the word-only mark first. This mark covers a range of services in classes 37, 39 and 42 which are restricted by the limitation “*all the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.*” The limitation fairly reflects the specific sector of the market that is targeted by the opponent’s services, namely that of automotive manufacturers, automotive dealers and fleet operators.

33. I am satisfied that the following services in class 37 are either services in relation to which the opponent has used the earlier mark, or belong to the same group or category as those for which the mark has been used: *Maintenance and repair for automobiles and motorcycles; Finishing and preparation of automobiles and motorcycles; Assembly and fitting of parts and fittings for automobiles and motorcycles; Vehicle and car wash; Cleaning of automobiles and motorcycles; vehicle repair; all the aforesaid services being exclusively offered in relation to logistical for automobiles industry.* This leaves *tuning stations for automobiles and motorcycles.* The opponent did not provide an explanation of what these services cover. Oxford dictionary defines tune as, inter alia, “*transferred. To set (a machine, etc.) in order for*

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<sup>13</sup> SMW1

*accurate working (local); to adjust. In modern use, to adjust (an engine or part) to improve its efficiency or some other attribute; also with the vehicle or craft*". There is no reference in the evidence to the term "tuning", and Mr Warren did not provide any example of the opponent supplying these services. Consequently, I consider that the opponent has not used the mark in relation to *tuning stations for automobiles and motorcycles* and cannot rely on that term.

34. Turning to the services in class 39, I am satisfied that the following services are either services in relation to which the opponent has used the earlier mark, or belong to the same group or category as those for which the mark has been used: *Logistics for the automobiles industry (vehicles, motorcycles, spare parts and fittings therefore and goods) including in particular railway or road transport; vehicle storage of spare parts and fittings for automobiles, transit services, warehousing services; Garaging of automobiles and motorcycles, inspection of vehicles, spare parts and components of automobiles prior to the transport thereof; hiring of transport vehicles, for the requirements of automobiles logistical services, and more particularly the transport of vehicles, motorcycles, spare parts and components of automobiles and motorcycles; Information services in connection with storage and transportation of vehicles, spare parts, components of automobiles and goods; All the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.*

35. There is no evidence of the opponent providing logistics for the automobiles industry using air or water transport. Further, I consider transport by air or water to belong to a different category compared to transport by railway or road. Hence, I find that the opponent cannot rely on the term *logistics for the automobiles industry (vehicles, motorcycles, spare parts and fittings therefore and goods) including in particular air or water transport* in class 39.

36. Finally, *freighting and freight brokerage of automobiles and motorcycles, spare parts and fittings therefore and goods*. The word "freight" is defined as "*goods transported in bulk by truck, train, ship, or aircraft*"; it is clear that the opponent provides freighting services as its main operation is vehicle transport services. The opponent did not provide an explanation of what freight brokerage covers, but I understand that the purpose of a freight broker is to act as a middleman and liaise between shippers

and carriers to arrange the movement of freight. There is no evidence of the opponent providing an intermediary service to the automotive industry. Further, I consider that these types of services do not belong to the same group or category as those for which the mark has been used. The opponent cannot rely on *freight brokerage of automobiles and motorcycles, spare parts and fittings therefore and goods*.

37. The word-only earlier mark is also registered for *Diagnostic stations and testing of automobiles and motorcycles, the aforesaid services being exclusively offered in relation to logistical services for the automotive industry* in class 42. The invoices refer to some of the services provided as TEST BATERIA, which I understand is the Spanish equivalent of car battery test. The evidence also suggests that the opponent provides testing of vehicles as part of its pre-delivery inspection and repair any damage of vehicles in order to prepare the vehicles to UK specific standards, including mechanical and electrical repairs and MOTs. I consider that these types of services belong to the same group or category as those for which the mark has been used. The opponent can rely on these terms.

#### *The figurative earlier mark*

38. The figurative mark covers *Transportation and storage; Transporting of people and/or goods from one place to another; Freighting; Freight brokerage [forwarding]; Transport of passengers and/or goods by rail, by road, by air, by water or by pipeline; Storage of goods; Rental of transport vehicles, warehouses and garages; Inspection of vehicles or goods before transport; Provision of information relating to the transport and storage of goods; All the aforesaid services being exclusively offered in relation to logistical services for the motor industry* in class 39. There is no evidence of the opponent providing services consisting of transport of people or passengers, freight brokerage [forwarding], and transport of goods by air, by water or by pipeline. With the exception of these services for which no use has been shown, I consider that the opponent has used the mark in relation to all the remaining services and can rely upon them.

39. With that in mind, I consider a fair specification for the word-only earlier mark to be:

**Class 37:** *Maintenance and repair for automobiles and motorcycles; Finishing and preparation of automobiles and motorcycles; Assembly and fitting of parts and fittings for automobiles and motorcycles; Vehicle and car wash; Cleaning of automobiles and motorcycles; vehicle repair; all the aforesaid services being exclusively offered in relation to logistical for automobiles industry.*

**Class 39:** *Logistics for the automobiles industry (vehicles, motorcycles, spare parts and fittings therefore and goods) including in particular railway, road transport; vehicle storage of spare parts and fittings for automobiles, transit services, warehousing services; Garaging of automobiles and motorcycles, inspection of vehicles, spare parts and components of automobiles prior to the transport thereof; Freightage of automobiles and motorcycles, spare parts and fittings therefore and goods; hiring of transport vehicles, for the requirements of automobiles logistical services, and more particularly the transport of vehicles, motorcycles, spare parts and components of automobiles and motorcycles; Information services in connection with storage and transportation of vehicles, spare parts, components of automobiles and goods; All the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.*

**Class 42:** *Diagnostic stations and testing of automobiles and motorcycles, the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.*

40. I consider a fair specification for the figurative earlier mark to be:

**Class 39:** *Transportation and storage; Transporting of goods from one place to another; Freightage; Transport of goods by rail or by road; Storage of goods; Rental of transport vehicles, warehouses and garages; Inspection of vehicles or goods before transport; Provision of information relating to the transport and*

*storage of goods; All the aforesaid services being exclusively offered in relation to logistical services for the motor industry.*

**Section 5(2)(b)**

41. 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.”

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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

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

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

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

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

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

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

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

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

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

### **Comparison of goods and services**

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

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

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

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

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

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

46. In *Gérard Meric v OHIM* Case T- 133/05, the GC stated that:

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

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

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

48. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services

are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

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

49. Whilst on the other hand:

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

50. In light of my findings above, the competing goods and services are as follows:

The applicant’s goods and services	The opponent’s services
<b>Class 7:</b> <i>Parts and accessories for motors and engines.</i>	
<b>Class 9:</b> <i>Audio and video recordings; not for use in the casino of gaming industry; electronic publications.</i>	
<b>Class 12:</b> <i>Vehicle parts and accessories.</i>	
<b>Class 16:</b> <i>Printed materials; paper materials, namely, containers of paper for packaging.</i>	
<b>Class 21:</b> <i>Beverageware and containers.</i>	
<b>Class 25:</b> <i>Clothing.</i>	

<p><b>Class 37:</b> <i>Vehicle services, repair and maintenance.</i></p>	<p><b>The word-only earlier mark</b></p> <p><b>Class 37:</b> <i>Maintenance and repair for automobiles and motorcycles; Finishing and preparation of automobiles and motorcycles; Assembly and fitting of parts and fittings for automobiles and motorcycles; Vehicle and car wash; Cleaning of automobiles and motorcycles; vehicle repair; all the aforesaid services being exclusively offered in relation to logistical for automobiles industry.</i></p>
<p><b>Class 38:</b> <i>Providing information to others via a computer network.</i></p>	
	<p><b>The word-only earlier mark</b></p> <p><b>Class 39:</b> <i>Logistics for the automobiles industry (vehicles, motorcycles, spare parts and fittings therefore and goods) including in particular railway, road transport; vehicle storage of spare parts and fittings for automobiles, transit services, warehousing services; Garaging of automobiles and motorcycles, inspection of vehicles, spare parts and components of automobiles prior to the transport thereof; hiring of transport vehicles, for the requirements of automobiles logistical services, and more particularly the transport of vehicles, motorcycles, spare parts and components of automobiles and motorcycles; Information services in connection with</i></p>

	<p><i>storage and transportation of vehicles, spare parts, components of automobiles and goods; All the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.</i></p> <p><b>The figurative earlier mark</b></p> <p><b>Class 39:</b> <i>Transportation and storage; Transporting of goods from one place to another; Freighting; Transport of goods by rail or by road; Storage of goods; Rental of transport vehicles, warehouses and garages; Inspection of vehicles or goods before transport; Provision of information relating to the transport and storage of goods; All the aforesaid services being exclusively offered in relation to logistical services for the motor industry.</i></p>
	<p><b>The word-only earlier mark</b></p> <p><b>Class 42:</b> <i>Diagnostic stations and testing of automobiles and motorcycles, the aforesaid services being exclusively offered in relation to logistical services for the automotive industry.</i></p>

Class7

51. The opponent states that the applicant's *Parts and accessories for motors and engines* are ancillary to the opponent's services.

52. The opponent's services cover *Maintenance and repair for automobiles and motorcycles; Assembly and fitting of parts and fittings for automobiles and motorcycles* in class 37. Although the applicant's term does not limit the goods in any way, it is in class 7 and the Nice class heading for class 7 is as follows: "*Machines, machine tools, power-operated tools; motors and engines, except for land vehicles; machine coupling and transmission components, except for land vehicles; agricultural implements, other than hand-operated hand tools; incubators for eggs; automatic vending machines*". Further, the explanatory note explains class 7 does not include, in particular, motors and engines for land vehicles.

53. In *Altecnic Ltd's Trade Mark Application* the Court of Appeal decided that "*the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods.*"

54. In *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), the late Mr Justice Carr considered whether it was appropriate to take the class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods/services shown in the evidence. After considering the judgments of the High Court in the *Omega 1* [2010] EWHC 1211 (Ch) and *Omega 2* cases [2012] EWHC 3440 (Ch), the judge stated that in his (provisional) view, the class number should be taken into account where the meaning of the disputed term is not otherwise sufficiently clear and precise. In particular the judge stated that where "*the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services.*"

55. See also *Multi-Access Limited v Guangzhou Wong Lo Kat Great Health Business Development Co Limited* [2019] EWHC 3357 (Ch).

56. In this case the term "*parts and accessories for motors and engines*" could refer to goods in numerous classes, however, since the applied-for goods are in class 7, I

consider that they exclude parts and accessories for motors and engines for land vehicles. On that basis, I cannot see any overlap with the opponent's services, which relate to cars and motorcycles (which are land vehicles) and are provided to the automotive sector.

57. The opponent's services (being essentially logistics services including transport, storage, distribution, preparation, repair and maintenance of land vehicles and spare parts) and the applicant's goods (being essentially parts and accessories for motors and engines for machines other than land vehicles) have a different nature, purpose and method of use. They relate to different sectors of the market and reach consumers through different distribution channels, namely logistics/transport companies (for the opponent's services) and manufacturers of parts and accessories for machines other than land vehicles (for the applicant's goods). The goods and services target different users, namely the automotive sector (for the opponent's services) and members of the general public and businesses purchasing parts and accessories for machines other than land vehicles (for the applicant's goods), are not complementary in any possible way and are not in competition. In this connection, it must be noted that complementarity is not possible where users are different such as in this case – see Case T-237/21. These goods are **dissimilar**.

### Class9

58. The opponent states that the applicant's *Audio and video recordings; not for use in the casino or gaming industry; electronic publications* are similar to the opponent's services because being the goods unrestricted as to their content, the recordings and publications can relate to the opponent's services.

59. If the opponent's submission was correct, which I do not accept, it would follow that audio and video recordings and publications are similar to any conceivable goods and services in any class because they can cover the same subject matter. That is not the correct approach. The opponent's services (being essentially logistics services including transport, storage, distribution, preparation, repair and maintenance of vehicles and spare parts) and the applicant's goods (being essentially audio and video recordings and electronic publications) have a different nature, purpose and method

of use and reach consumers through different distribution channels, namely logistics/transport companies (for the opponent's services) and publishing/production companies (for the applicant's goods). The goods and services are not complementary in any possible way and are not in competition. Although the applied-for goods can target the same automotive sector to which the opponent provides its services, for example a car manufacturer or car dealer can subscribe to the applicant's electronic publications and also use the opponent's services to distribute and move vehicles, that is a very limited overlap and does not justify a finding of similarity. These goods are **dissimilar**.

### Class12

60. The opponent states that the applicant's *vehicle parts and accessories* are similar to the services covered by the earlier marks because the latter relate to vehicles, including the fitting of vehicle parts.

61. I agree with the opponent that the closest clash here is with the earlier *maintenance and repair for automobiles and motorcycles and assembly and fitting of parts and fittings for automobiles and motorcycles*. However, it must be noted that the opponent's specification is limited to services exclusively offered in relation to logistical services for the automotive industry. This means that the user of the applied-for goods - namely a member of the general public or a garage who purchases the applicant's *vehicle parts and accessories* in order to carry out the vehicle's repairs and the fitting of the parts and accessories - is not the same as that of the opponent's services. This is because the opponent's services are limited to services exclusively offered in relation to logistical services for the automotive industry, and the user of the opponent's services is a car manufacturer or a car dealer who, as shown by the evidence, uses the opponent's *maintenance and repair for automobiles and motorcycles and assembly and fitting of parts and fittings for automobiles and motorcycles* in the context of automotive logistics services, that is to say, as part of an holistic service that includes the transport, storage, inspection, repair, customisation and distribution of the vehicles the car manufacturer or car dealer manufactures or sells. The goods and services have a different nature, purpose and method of use and reach consumers through different distribution channels, namely logistics/transport

companies (for the opponent's services) and car manufacturer (for the applicant's goods). Further, they are neither complementary nor in competition. These goods are **dissimilar**.

#### Class16

62. The opponent states that the applicant's *Printed materials; paper materials, namely, containers of paper for packaging* are similar to the opponent's services because being the printed material unrestricted as to their content, they can relate to the services of the earlier marks. It also states that the applicant's packaging containers are similar to the opponent's transportation and logistics services because they are ancillary and complementary to these services.

63. First, the fact that printed materials can be used in promotional activities aimed at advertising the opponent's own services, including print merchandising, does not make the goods and services similar. Second, even if containers of paper for packaging can be used when performing some of the services covered by the earlier mark, for example, transport of spare parts, or can be subject to transport, or delivery, this is not in itself a reason to find similarity. The opponent's services (being essentially logistics services including transport, storage, distribution, preparation, repair and maintenance of vehicles and spare parts) and the applicant's goods (being essentially printed materials and paper materials) have a different nature, purpose and method of use. They reach consumers through different distribution channels, namely logistics/transport companies (for the opponent's services), and advertising/packaging companies (for the applicant's goods). Further they are neither complementary nor in competition. Although the applied-for goods can target the same automotive sector to which the opponent provides its services, that is a very limited overlap and does not justify a finding of similarity. These goods are **dissimilar**.

#### Class21

64. The opponent states that the applicant's *Beverageware and containers* are expected merchandising/licensing products issued by transportation and vehicles companies and are complementary to the opponent's services. First, there is no

evidence that these goods are “*expected merchandising/licensing products issued by transportation and vehicles companies*” and I have certainly no evidence to suggest that it is in any way common in the market for such an overlap to exist. Second, the fact that the applied-for goods can be used as items of merchandising to promote the opponent’s services does not make the goods and services similar from a trade mark perspective, bearing in mind the relevant criteria set out by the case-law. The opponent’s services (being essentially logistics services including transport, storage, distribution, preparation, repair and maintenance of vehicles and spare parts) and the applicant’s goods (being essentially drinking utensils) have a different nature, purpose and method of use. They target different users, namely car manufacturers or car dealers (for the opponent’s services) and members of the general public (for the applicant’s goods) and reach consumers through different distribution channels, namely logistics/transport companies (for the opponent’s services), and manufacturers of beverageware (for the applicant’s goods). Further the goods and services are neither complementary nor in competition. These goods are **dissimilar**.

#### Class25

65. The opponent states that the applicant’s *Clothing* are expected merchandising/licensing products issued by transportation and vehicles companies and are complementary to the opponent’s services. It also states that many transport companies provided uniform to their staff.

66. First, my previous findings about merchandising apply here. The opponent’s services (being essentially logistics services including transport, storage, distribution, preparation, repair and maintenance of vehicles and spare parts) and the applicant’s goods (being essentially items of clothing) have a different nature, intended purpose and method of use. They target a different public, namely car manufacturers or car dealers (for the opponent’s services) and members of the general public (for the applicant’s goods), and are distributed through different channels, namely logistics/transport companies (for the opponent’s services), and manufacturers of clothing (for the applicant’s goods). Finally, the goods and services are neither complementary nor in competition with each other. The fact that transport companies might provide uniform to their staff means that the opponent (which is a logistics and

transport company) could be the user of the applicant's clothing goods. Hence, the opponent's argument is misconceived because it does not even mean that the user of the opponent's transport services (i.e. car manufacturers and car dealers) is the same user of the applicant's goods. But even if I were to accept that a car manufacturer (i.e. the user of the opponent's services) could purchase uniforms for its staff (which would also make it the user of the applicant's clothing goods) this is a very limited overlap and does not justify a finding of similarity. These goods are **dissimilar**.

### Class37

67. The applicant's *Vehicle services, repair and maintenance* in class 37 is unlimited and covers services offered in relation to logistical for automobiles industry. As such these services are identical to the opponent's *Maintenance and repair for automobiles and motorcycles all the aforesaid services being exclusively offered in relation to logistical for automobiles industry* (as covered by the earlier word-only mark). These services are **identical**.

### Class38

68. The opponent states that the applicant's *Providing information to others via a computer network* is similar to the opponent's services because it is unrestricted and can "relate" to the opponent's goods and services. The opponent also states that these services are ancillary and complementary to the services of the earlier mark.

69. I am not sure what the opponent means when it claims that the applicant's services can relate to the opponent's services and that the services are complementary as it did not really explain in which way these services overlap. As regard the claim that the applicant's information can relate to the goods and services of the earlier mark, once again, if the opponent's submission was correct, which I do not accept, it would follow that providing information to others via a computer network is similar to any conceivable goods and services in any class, because the information can cover any type of goods and services. Likewise, I can only guess that the claim that these services are ancillary and complementary to the services of the earlier mark means that a provider of the services covered by the earlier mark can transmit information to

other via computer network about its own business and commercial activities; however, that would apply to any business providing any conceivable type of goods and services and cannot be correct. Furthermore, the opponent seems to interpret the services at issue as equivalent to providing business information via a website which would be proper to class 35, not class 38. Hence, I reject the opponent's submissions.

70. The opponent's services (being essentially logistics services including transport, storage, distribution, preparation, repair and maintenance of vehicles and spare parts) and the applicant's services (being essentially telecommunication services) clearly differ in nature, intended purpose and method of use, reach consumers through different distribution channels, namely logistics/transport companies (for the opponent's services), and provider of telecommunication services (for the applicant's services) and are neither complementary nor in competition with each other. Although the applied-for services can target the same automotive sector to which the opponent provides its services, that is a very limited overlap and does not justify a finding of similarity. These services are **dissimilar**.

71. In *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.

72. Since some similarity of goods and services is essentially for an opposition based on Section 5(2)(b) to be successful, the opposition fails in relation to these goods and services in class 7, 9, 12, 16, 21, 25 and 38 which I found to be dissimilar to the opponent's services. From now onward I will only refer to the identical services in class 37, and the word-only mark which covers those services.

## **Average consumer**

73. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

74. The parties’ identical services in class 37 are maintenance and repair for automobiles and motorcycles being exclusively offered in relation to logistical for automobiles industry. The average consumer of these services is a business operating in the motor industry, for example a car manufacturer or car dealer. When selecting the services, the business consumer will take a number of factors into account including cost, efficiency, security and accessibility of the services. Consequently, I consider that a high degree of attention will be paid during the purchasing process for the services.

75. The services are likely to be selected from websites, following the perusal of marketing material or as a result of word-of-mouth recommendations. Consequently, both visual and aural considerations are likely to play a part.

## **Comparison of marks**

76. 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.”

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

78. The respective marks are shown below:

<b>The application</b>	<b>The opponent's mark</b>
<b>CAT SECURITY</b>	<b>CAT</b>

79. The opponent's mark is a word-only mark that consists solely of the word 'CAT'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

80. The application is also a word-only mark consisting of two words, being 'CAT SECURITY'. The word 'CAT' will be understood as a reference to a feline animal. When

it is viewed on services that relate to maintenance and repair of vehicles offered in relation to logistical for the automobiles industry, the word 'SECURITY' will be seen as referring to the fact that the services ensure the safety and security of the relevant vehicles. Consequently, I consider that 'CAT' will be viewed as the primary indicator of origin and will dominate the overall impression of the mark, with 'SECURITY' playing a lesser role.

### **Visual similarity**

81. Visually, the marks are similar to the extent that they coincide in the three-letter word 'CAT' which is the only element of the opponent's mark, and the most distinctive element of the application. The marks differ in the presence of the eight-letter word 'SECURITY' in the application, which is longer than the word 'CAT'. However, bearing in mind that consumers tend to focus on the beginning of marks, and that the differentiating element 'SECURITY' is placed at the end of the application and is less distinctive than the shared element 'CAT', I consider the marks to be visually similar to a medium degree.

### **Aural similarity**

82. Aurally, the pronunciation of the signs coincides in the word 'CAT', present identically in both signs, and to that extent the marks are aurally similar. The pronunciation differs in the word 'SI-KJU-RI-TI' of the application, which has no counterpart in the opponent's mark. I consider the marks to be aurally similar to a medium degree.

### **Conceptual similarity**

83. Conceptually, the UK public will perceive the common element 'CAT' as meaning a small animal that is often kept as a pet or another feline of the cat family, i.e. a tiger, a lion, etc (Collins online dictionary). The element 'SECURITY' of the application refers to *'all the measures that are taken to protect a place, or to ensure that only people with permission enter it or leave it'* (Collins Dictionary online). The marks are conceptually similar to the extent that they have the dominant element 'CAT' in common which will

convey the same meaning in both marks. Although the word ‘SECURITY’ introduces an additional concept in the application, it is less distinctive and plays a lesser role. Overall, I consider the marks to be conceptually similar to a high degree.

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

84. 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).”

85. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

86. The earlier mark consists of the word 'CAT'. The word 'CAT' is a common word in the English language, but it does not describe any characteristics of the relevant services, which, in the present case, are maintenance and repair for vehicles being exclusively offered in relation to logistical for the automobiles industry. Consequently, the inherent distinctiveness of the mark is medium. The opponent submits that this distinctiveness has been enhanced through the use made of the mark.

87. When considering whether the inherent distinctiveness of the mark has been enhanced, it is the perception of the UK consumer that I must consider. Mr Warren has provided evidence of UK turnover for services provided under the earlier marks which amount to £16.5 million in 2018, £12.2 million in 2019, just over £11 million in 2020 and just over £12 million in 2021 – that is the overall turnover for the UK operations, not just for the services which I found to be identical. Furthermore, it is only the turnover generated before the relevant date of 8 September 2020 that is relevant for the purpose of the assessment I am required to carry out; that would amount to nearly £40 million in the three years prior to the relevant date.

88. Although Mr Warren states that CAT-UK has traded under the earlier trade marks since 1986-1987, there is no indication of the extent of the opponent's UK commercial activities prior to 2018. The 2021 presentation indicates widespread coverage of the road and rail network in the UK, but it also indicates that this coverage is achieved through the use of fleets from CVT and STVA, which are owned by Groupe CAT UK, and Mr Warren says that the turnover generated under these other brands would be £60 million which is higher than that generated under the earlier marks for the same period.

89. There is no evidence of advertising, and Ms Huet stated that the opponent and its operating companies advertise their services under the earlier marks primarily relying on their longstanding reputation in the field to attract new businesses. Lastly, it is not clear from the evidence how big is the market in which the opponent operates and what share of the UK market the opponent enjoys. Taking the evidence as a whole, I find that, while it is sufficient to demonstrate genuine use, it falls short of establishing that the distinctiveness of the word-only earlier mark had been enhanced through use to any material extent.

## Likelihood of confusion

90. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

91. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

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

92. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

93. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

94. Earlier in this decision I found that:

- The services are identical.

- The average consumer for the services is a business operating in the motor industry, who will pay a high degree of attention during the purchasing process.
- Both visual and aural considerations are likely to play a part in the selection of the services.
- The competing marks are visually and aurally similar to a medium degree, and conceptually similar to a high degree.
- The earlier mark is distinctive to a medium degree.

95. I keep all these findings in mind when considering whether a likelihood of confusion exists.

96. The opponent's primary case is that there is a likelihood of indirect confusion. It states:

“The opponent claims that the average consumer will perceive the later CAT SECURITY as predominantly a CAT trade mark. The word “security” merely describes the nature of the goods and services and function as a descriptor of the word CAT. The average consumer will view the word SECURITY as being an indicator of functional information, rather than as an indicator of trade origin.”

97. The applicant did not address the likelihood of confusion as the gist of the applicant's argument is that the goods and services are dissimilar.

98. In my view, taking into account the identity of the services at issue and their specialist nature, the medium degree of distinctiveness of the earlier mark ‘CAT’, the independent distinctiveness of the shared element ‘CAT’ within the application, and propensity of the word ‘SECURITY’ to be perceived separately from the element ‘CAT’ as a word referring to characteristics of the services, for example, that the services are supplied within the provision of secure transit for vehicles, or in relation to high value vehicles requiring more security, or in order to ensure the safety and security of all the vehicles transported before delivery, I consider that the high level of attention paid

during the selection of the services is not sufficient to avoid the average consumer incorrectly assuming that the application is a variant mark used by the opponent. There is a likelihood of indirect confusion.

### **Revised specification**

99. I have found that the opposition is successful in relation to *Vehicle services, repair and maintenance* in class 37 insofar as these services can target the same sector targeted by the opponent's *maintenance and repair for automobiles and motorcycles; all the aforesaid services being exclusively offered in relation to logistical for automobiles industry*. In this connection, it must be noted that services can be defined by their recipient i.e. where a service is targeted at a particular sector (see *Omega Engineering Inc v Omega SA* [2012] EWHC 3440 (Ch) at paragraph 49 referring to earlier reasoning set out in *MERLIN Trade Mark* BL O/043/05 [1997] R.P.C. 871 at paragraph 29).

100. My finding on the likelihood of confusion is based on the propensity of the applied-for services in class 37 to include services designated by the earlier mark for whose consumers there is a likelihood of confusion.

101. Tribunal Practice Notice (1/2012) on partial refusals states:

#### **"3.2.2 Defended Proceedings**

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services.

This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective."

102. I have given some thought to whether it is necessary to consider if the specification applied-for could be amended so that it would in practice satisfactorily exclude occasions for confusion on the part of consumers who are not users and/or recipients of logistical services for automobiles industry. In this case, I think it is possible to devise a specification which would achieve this object by adding a "save for" type of exclusion. In accordance with TPN 1/2012, paragraph 3.2.2, I consider that a revised specification would be:

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

103. This excludes occasions for confusion on the part of consumers since the services covered by the marks at issue would be intended for different publics, and the recipients of the respective services would be different.

## **OUTCOME**

104. The opposition succeeds only to the limited extent that the applicant's mark is refused registration in respect of the originally applied-for:

**Class 37:** *Vehicle services, repair and maintenance.*

105. It may, however, proceed to registration for suggested alternative:

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

106. The opposition fails for the goods and services listed below which might proceed to registration:

**Class 7:** *Parts and accessories for motors and engines.*

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

**Class 12:** *Vehicle parts and accessories.*

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

**Class 21:** *Beverageware and containers.*

**Class 25:** *Clothing.*

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

107. Even though the applicant's mark is refused registration in respect of the originally applied-for services in class 37, I have formulated a revised specification in relation to which the mark can proceed to registration. Standing back and assessing the proceedings as a whole, I consider that the applicant is the successful party and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £800 as a contribution towards its costs. The sum is calculated as follows:

Preparing a counterstatement:	£250
Reviewing the other party's evidence:	£300
Written submissions:	£250
Total:	£800

108. I therefore order COMPAGNIE D'AFFRETEMENT ET DE TRANSPORT C.A.T. to pay Cap City Muffler LLC the sum of £800. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 8<sup>th</sup> day of October 2024**

**TERESA PERKS**  
**For the Registrar**