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TRADE MARKS ACT 1993
IN THE MATTER OF APPLICATION No 2045659
BY PAUL NEVILLE HENDRICKS
TO REGISTER THE TRADE MARK
BENZ BOOM ROCK SOUL AND DEVICE
IN CLASSES 9,18, 25 & 41

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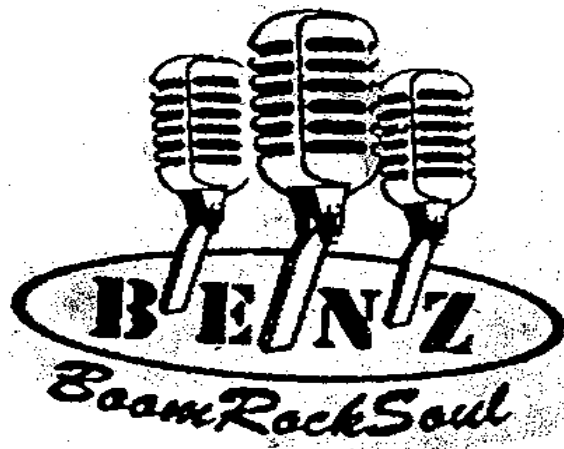
AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 45455
BY DAIMLERCHRYSLER AG

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BACKGROUND

On 21 November 1995, Paul Neville Hendricks of 21 Clitherow Road, Brentford, Middlesex, TW8 9JT applied under the Trade Marks Act 1994 for registration of the following trade mark:



In respect of the following goods:

Class 9: "Photographic, cinematographic, magnetic data carriers, recording or recorded discs."

Class 18: "Leather or imitation leather goods, travelling bags, bags, umbrellas."

Class 25: "Clothing, footwear, headgear; articles of sports clothing, articles of leisurewear, articles of outerwear and underwear, shorts, T-shirts, tops, bathrobes, swimwear, dresses, jeans, trousers, dancewear, jackets, sweatshirts, sweatbands, sweat pants, jogging suits, pullovers, jerseys, shirts, vests, headbands, wristbands, gloves, mittens, socks, tights, baseball, football, basketball, ice hockey, skiing, surfing and skateboarding wear, caps, ties, scarves, belts, bandanas."

Class 41: "Live entertainment services provided by musicians and/or pop groups."

On the 19 September 1996 Daimler-Benz AG and Mercedes-Benz AG filed notice of a joint opposition to the application. Prior to the hearing all the rights and liabilities of the opponents were assumed by DaimlerChrysler AG, the legal successor to the joint opponents. This

decision has been written on the basis that there is a single opponent. The grounds of opposition are:

- 5 1) The opponent manufactures and retails a wide range of goods, e.g. motor vehicles, aircraft, transportation systems, computer systems and accessories and other goods. They have established an extensive goodwill in all the above products and services on a worldwide basis since the first use in the nineteenth century.
- 10 2) The opponent has registered the trade mark MERCEDES BENZ with and without device elements and/or non-distinctive words in a wide range of classes including classes 1 to 12, 14, 16 to 18, 20 to 22, 24 to 28, 34 to 37, 39, 41 and 42. The opponent offers a wide range of goods and services through their respective distribution networks, including audio goods, leather goods, clothing and entertainment.
- 15 3) The applicant's trade mark has as a prominent element the word BENZ which is an essential part of the notorious mark MERCEDES BENZ and is the trade mark common to the opponent and all its subsidiaries (Daimler-Benz Aerospace, Daimler-Benz Industrie, Daimler-Benz Interservice and Mercedes-Benz among others) and thus use by the applicant is likely to deceive and cause confusion among members of the general public and visitors to the UK. As such, it should be refused under Section 20 5(2)(b) of the Trade Marks Act 1994.
- 25 4) The application should also be refused under Section 5(3) of the Trade Marks Act 1994 because the use of the applicant's mark takes unfair advantage of, and is detrimental to, the distinctive character and/ or repute of the mark MERCEDES-BENZ.
- 30 5) The opponent and its subsidiaries have established an unparalleled level of goodwill in their marks and use of a distinctive, essential part of their marks, by the applicant is likely to cause deceit and confusion among members of the general public and visitors to the UK. The application should therefore be refused under Section 5(4)(a) of the Trade Marks Act 1994.
- 35 6) The application should be refused under Section 3(3) of the Trade Marks Act 1994 because it is of such nature as to deceive the public as to the origin and / or quality of the goods and services offered by the applicant. The word BENZ is a German name and the public would be deceived into thinking that the applicant was German, and the word BENZ is associated with goods and service of the highest quality.
- 40 7) the name BENZ is a rare name in the UK and elsewhere, occurring twice in the London telephone book and is not a common name in Germany. The primary use of the name BENZ in the UK is in connection with the opponent. The applicant has no title in the name BENZ. Furthermore the applicant shows bad faith in seeking to expropriate the name Karl Benz, inventor of the motor car and two stroke engine. For 45 either or both reasons the application should be rejected under Section 3(6) of the Trade Marks Act, 1994.

+ 8) The trade marks DAIMLER-BENZ and MERCEDES-BENZ are well-known marks within the meaning of Article 6bis of the Paris convention and accordingly entitled to protection in the UK. The word BENZ is common to both these famous trade marks and constitutes an essential part thereof. The applicant's use of the word BENZ makes use of the reputation of the opponent in the marks and as such will cause confusion among the general public.

The opponent further requested that the Registrar refuse application number 2045659 in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

The applicant subsequently filed a counterstatement denying all of the grounds of opposition. Both sides ask for an award of costs.

Both sides filed evidence in these proceedings and the matter came to be heard on 24 May 2000 when the applicant was represented by Mr Walters of Trade Mark Consultants Co., and the opponent by Mr Moore of Jensen & Son.

OPPONENT'S EVIDENCE

This consists of three statutory declarations. The first, dated 17 February 1997, is by Mr Jonathan Robert Moorhouse, a part-time technical assistant at Jensen & Son, trade mark agents for the opponent.

Mr Moorhouse states that he examined all the publication of the Autocar magazine dated between 3 November 1993 and 1st November 1995 in order to find instances of the use of the word BENZ without the prefix MERCEDES. He claims that he found fifty such instances and copies are provided at exhibit A. He states that these "include instances by members of the general public in the course of trade to denote products of the opponent".

In fact an analysis of the exhibits shows the following:

WORD	INSTANCES
BENZ	38
BENZS	1
BENZ'S	7
BENZES	3
M/BENZ	1

Further, in the vast majority of cases the items also contained references to, Mercedes-Benz,

Mercedes or Merc. As one would expect from the source, AUTOCAR, all of the references are in relation to cars, and for the most part are accompanied by a photograph of a vehicle.

5 The second statutory declaration, dated 17 February 1997, is by Mr David Simon Moore. Mr Moore is a technical assistant at Jensen & Son, a position he has held for three years. . He states that he carried out a trade mark search of the UK Trade Marks Register using the Marquesa CD Rom system for trade marks of the opponent including the word BENZ. The results of the search are provided at exhibit A, and show a Mercedes-Benz mark registered in virtually every class of product.

10 The third statutory declaration, dated 15 May 1997, is also by Mr David Simon Moore. In this declaration Mr Moore claims that:

15 “Mercedes-Benz is one of the most famous and well-known trade marks in the world and is known to every household in the UK. The products of Mercedes-Benz are referred to by the trade mark BENZ by a large proportion of the world’s population, in particular by people originating from Asia but also in a number of other countries.”

20 At exhibit A Mr Moore provides a schedule of countries where the trade mark BENZ has been registered. The countries are Bangladesh, India, Pakistan, South Africa, South Korea, Sri Lanka, Taiwan, Thailand and the UK. He claims that in addition the mark BENZ is also protected, by international registration, in North Korea, PR China and Vietnam.

25 At exhibit C Mr Moore provides a copy of a page from the newspaper Asian Age. He claims that is the newspaper with the largest circulation in India and that it is “widely available in Great Britain”. The exhibit shows a page from the business section dated 9 April 1994. Below a picture of a motor car is the following:

30 “This realistic design-study of German car maker Mercedes-Benz shows a new SL roadster that is planned to be produced from 1996. This design-study will be shown at the International Automobile Salon in Turin, Italy from April 22 to May 1. Benz has not yet released any technical data on the new roadster.”

35 Mr Moore refers to a questionnaire that was sent to a number of Mercedes-Benz dealerships in the UK. Mr Moore claims that the results of this survey shows:

40 “...that the use of the trade mark BENZ to denote the products of Mercedes-Benz is prevalent in certain areas of the UK and also by certain groups of people, such as those from Asia and the Pacific Rim. There are approximately 1.2 million people in the UK of Asian origin and the majority of these people would refer to the vehicles as a Benz and would identify the name Benz with Mercedes-Benz AG.”

45 The questionnaires referred to are provided at exhibit D to the declaration. Twelve returns were filed. In answer to the question:

“Are you aware of customers referring to Mercedes-Benz products as a BENZ as opposed to a MERCEDES-BENZ? If so, approximately how often does this occur?”

Only four replied in the positive, and their answers to the follow up question where as follows:

“Quite often / very infrequent / Not very often / Very rare - mainly from people originating from Central Asia, Pacific Rim”.

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Mr Moore provides at exhibit E a list of events sponsored by the opponent. These include art exhibitions, music and dance events as well as sporting events. Mr Moore also claims that the opponent sponsors the ATP tennis tour, the German national football team, and a PGA golf tournament in Florida. He claims that these events are shown on television “both terrestrial and satellite”.

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APPLICANTS’ EVIDENCE

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This consists of two statutory declarations. The first, dated 13 November 1997, is by Mr Paul Neville Hendricks the Managing Director of Mr H. Management. He states that he has acted as a consultant for Hendricks Records Ltd (HRL) since 1991 and that HRL are licensed by him to use the mark. He states that his declaration is derived from his own knowledge and a “study of my files and all relevant information and correspondence is in my possession”.

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Mr Hendricks states that he manages popular music groups, one of whom is called BENZ. He states that he has “looked after the group BENZ since July 1993”. He continues:

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“The reason that the group called themselves BENZ was that the three principal members of the group all share the name BEN as part of their names, namely Benedict Spencer Ofoedo (stage name BIG BEN), Benjamin Balogun (stage name TIM SHADE) and Anthony Benedict Thompson (stage name DARK BOY).”

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At document E of exhibit PNH1, Mr Hendricks provides an agreement dated 17 December 1993 between the group BENZ and BMG Records (UK) Ltd. The names of the three principal members of the group are confirmed at paragraph two of the contract.

Mr Hendricks states that he designed the groups’ logo (the mark in suit). He claims that:

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“I used three microphones to represent each member of the band. Along with the name of the group I used the words BOOMROCKSOUL to represent each band members’ input into the music that they produced. The ‘boom’ was Tim Shade, the ‘rock’ was Big Ben and the ‘soul’ was Dark Boy. The distinctive trade mark that I designed (my logo) was designed and was in use by the end of March 1995.”

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Mr Hendricks provides a number of exhibits which shows the use made of the trade mark since this date. He also provides details of the groups record releases all of which, he claims, have featured the trade mark in suit.

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The second declaration, dated 13 November 1997, is by Mr Simon Malvin Walters. Mr Walters is an associate of Trade Mark Consultants, and is the trade mark agent for the applicant.

Mr Walters provides details of research that he says he carried out into the opponent's use of the word BENZ. He states that he carried out a search of the Encyclopaedia Britannica and the opponent's internet site. These provided a biography of Karl Friedrich Benz and a brief history of the Benz company. Having been briefly in competition with the Daimler company, in 1926 the two companies merged and sold vehicles under the Mercedes-Benz mark. At exhibit SMW2 are pages from the opponent's internet site which, Mr Walters claims, show that since 1926 all vehicles produced have been termed Mercedes-Benz and that there is "not one instance of the opponent using the word BENZ alone from this date. The opponent is meticulous in never shortening the names of their motor vehicles to Benz or even to MERC, whether this is in relation to passenger or commercial or motor racing vehicles".

Mr Walters provides details of the opponent's subsidiaries and claims that none are known by the word BENZ. Mr Walters comments on the trade marks of the opponent stating that a number of registrations have disclaimers on the words "MERCEDES" and "BENZ". He also claims that the articles from the magazine Autocar in the opponent's evidence all have a reference to Mercedes-Benz / Mercedes / Merc and that "on some occasions, use the word BENZ as an abbreviation for Mercedes-Benz". He also points out that all references are related to motor vehicles.

Mr Walters makes a number of similar points regarding the rest of the opponent's evidence pointing out claimed weaknesses and deficiencies. In summary these are that the opponent has not proved that:

- the mark Mercedes-Benz is famous or well known.
- a large proportion of the world, particularly in Asia, refer to the mark Mercedes-Benz as BENZ.
- the mark has been registered in all the countries claimed.
- the sponsorships referred to are not under the mark BENZ.
- there are other marks and companies registered in the UK which have the word BENZ as part of the mark or name.

Lastly, Mr Walters claims that the survey is flawed and the claims made are not evidenced by the survey results

OPPONENT'S EVIDENCE IN REPLY

This consists of two further statutory declarations by Mr Derek Moore. The first is dated 13 November 1998 the second 21 December 1998. However, they appear to be identical in every detail.

Mr Moore counters the claims of the applicant regarding the use of the mark BENZ. At exhibit A Mr Moore provides details of a community trade mark, number 140087, which is pending.

This shows that on 1 April 1996 the mark BENZ was applied for in classes 1-42 inclusive.

Mr Moore also claims that the opponent's earlier evidence shows a number of marks including the word BENZ registered. He states that under previous Acts it was impossible to register the name BENZ as it occurs "just over 100 times in the Stuttgart and Berlin telephone directories". At exhibit B Mr Moore provides copies from the 1992 London telephone directory which shows only two entries for BENZ.

Mr Moore states that the commercial vehicles division at Mannheim is still known as BENZ. He claims that exhibit A of the declaration of Mr Jonathan Robert Moorhouse shows advertisements using BENZ on its own. In fact the three instances provided come from the advertisement section of the magazine and show two advertisements (one repeated) placed by private individuals under the MERCEDES section.

Mr Moore claims that the comments made by Jacob J in the Philips v Remington case when the Philips razor head was described as having a MERCEDES-BENZ star should be taken into account. He does not elaborate on what should be inferred, nor does he provide a copy of the comments or a reference as to where they might be found.

At exhibit C Mr Moore provides details of merchandising products about which he claims "Mercedes-Benz dealerships deal extensively in merchandise". The brochure has Mercedes-Benz used frequently throughout, whilst the items appear to mostly have either the star device or the model designation.

Regarding the other companies using BENZ as part of their company name or trade mark Mr Moore provides various reasons why either action has not been taken or details action pending.

That concludes my review of the evidence. I now turn to the decision.

DECISION

At the hearing Mr Moore withdrew the grounds of opposition under Sections 3(3) and 3(6) and also Article 6bis.

I turn first to the ground of opposition under Section 5(2)(b) of the Act which states:-

*5.- (2) A trade mark shall not be registered if because -
(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 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."

An earlier right is defined in Section 6, the relevant parts of which state

6.- (1) In this Act an 'earlier trade mark' means -

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

(b)...

10 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

15 I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the decision of the Court of Justice of the European Communities (ECJ) in the Sabel v Puma case C251/ 95 - ETMR [1998] 1-84. In that case the court stated that:

20 “Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be
25 appreciated globally, taking into account all factors relevant to the circumstances of the case.

30 Global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “there exists a likelihood of confusion on the part of the public” - shows that the perception of the marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally
35 perceives a mark as a whole and does not proceed to analyse its various details.

40 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”

45 I also have regard to the approach adopted by the European Court of Justice in Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (case C-39/97) (ETMR 1999 P.1) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

5 “A global assessment of the likelihood of confusion implies some interdependence
between the relevant factors, and in particular a similarity between the trade marks
and between these goods or services. Accordingly, a lesser degree of similarity
between these goods or services may be offset by a greater degree of similarity
10 between the marks, and vice versa. The interdependence of these factors is expressly
mentioned in the tenth recital of the preamble to the directive, which states that it is
indispensable to give an interpretation of the concept of similarity in relation to the
likelihood of confusion, the appreciation of which depends, in particular, on the
recognition of the trade mark on the market and the degree of similarity between the
mark and the sign and between the goods or services identified.”

Further, I take account of the following guidance of the European Court of Justice in *Lloyd Schuhfabrik Meyer & Co* (1999 ETMR 690) in which the court held that:

15 “For the purposes of ... global appreciation, the average consumer of the category of
products concerned is deemed to be reasonably well-informed and reasonably
observant and circumspect (see, to that effect, *Case C-210/96 Gut Springenheide and
Tusky* [1998]ECR I-4657, paragraph 31). However, account should be taken of the
20 fact that the average consumer only rarely has the chance to make a direct
comparison between the different marks but must place his trust in the imperfect
picture of them that he has kept in his mind. It should be also borne in mind that
the average consumer’s level of attention is likely to vary according to the category of
goods or services in question.”

25 In order to make the global assessment on the similarity of the marks, it is necessary to
consider individual aspects of the question. I propose to firstly consider the similarity of the
goods of the two parties.

30 At the hearing it was common ground that the opponent has registrations which cover similar
if not identical goods to some of those in classes 9, 18 and 25 of the application. It was not
accepted that the services in Class 41 were similar. The opponent’s registrations for goods
and services in the same classes are shown in the table below.

35 A number of the registrations have restrictions applying to them. Where these apply a number
has been shown alongside the trade mark. The restrictions are:



(1) Registration of this mark shall give no right to the exclusive use of the word
“Benz”.



40 (2) Registration of this mark shall give no right to the exclusive use, separately, of the
words “Mercedes” and “Benz”.

(3) Registration of this mark shall give no right to the exclusive use, separately, of the
words “Mercedes” and “Benz” and no right to the exclusive use of the word “Club”.

45 (4) Registration of this trade mark shall give no right to the exclusive use of the word
“Club”.

Class	Applicant's specification	Opponent's registration number, mark and specification
9	Photographic, cinematographic, magnetic data carriers, recording or recorded discs	<p>756395. Mercedes-Benz (1) Nautical, surveying, wireless, measuring, signalling and checking (supervision) apparatus; fire extinguishing apparatus; scientific and electrical apparatus and instruments included in Class 9; but not including calculating machines or accounting machines or any goods of the same description as calculating machines or accounting machines.</p> <p>B1242815. MERCEDES-BENZ. Clothing for protection against accident or injury, thermometers, measuring instruments and measuring devices, spirit levels, optical apparatus and instruments, radio apparatus and equipment, tape-recording and reproduction apparatus, loudspeakers, antennae, cables (electric), alarms.</p>
18	Leather or imitation leather goods, travelling bags, bags, umbrellas.	B1242819. MERCEDES-BENZ. (2) Trunks (luggage), travelling bags, handbags, document cases, brief cases, articles included in Class 18, all made of leather or imitation leather; umbrellas and shooting sticks in the nature of walking sticks.

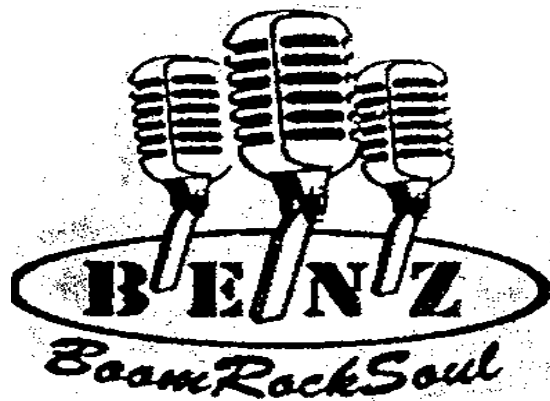
<p>25</p>	<p>Clothing, footwear, headgear; articles of sports clothing, articles of leisurewear, articles of outerwear and underwear, shorts, T-shirts, tops, bathrobes, swimwear, dresses, jeans, trousers, dancewear, jackets, sweatshirts, sweatbands, sweat pants, jogging suits, pullovers, jerseys, shirts, vests, headbands, wristbands, gloves, mittens, socks, tights, baseball, football, basketball, ice hockey, skiing, surfing and skateboarding wear, caps, ties, scarves, belts, bandanas</p>	<p>B1242824. MERCEDES-BENZ. (2). Articles of clothing; but not including footwear.</p> <p>B1528364.</p>  <p>MERCEDES-BENZ CLUB</p> <p>(3) T-Shirts, sweat shirts and polo shirts; shirts; trousers; jackets; coats; dresses; suits; ties (for wear); stockings; shawls, scarves and headscarves; footwear; headgear for wear, hats and caps; all included in Class 25.</p> <p>B1552991.</p>  <p>MERCEDES BENZ CLUB</p> <p>(3). T-shirts, sweat shirts and polo shirts; shirts; trousers; jackets; coats; dresses; suits; ties; stockings; shawls, scarves and headscarves; footwear; headgear for wear, hats and caps; all included in Class 25.</p>
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41	Live entertainment services provided by musicians and/or pop groups	<p>1552992.</p>  <p>MERCEDES BENZ CLUB</p> <p>(4) Publication of printed matter; organisation of information events, relating to the maintenance, restoration and repair of vehicles; driver training events; organisation of motor sporting events, competitions and exhibitions; organisation of social events; all included in Class 41.</p> <p>1274950. MERCEDES-BENZ Training services, adult vocational training and further education, all relating to motor vehicle technology; all included in Class 41.</p> <p>1528365</p>  <p>MERCEDES-BENZ CLUB</p> <p>(4) Publication of printed matter; organisation of information events relating to the maintenance, restoration and repair of vehicles; driver training events; organisation of motor sporting events, competitions and exhibitions; organisation of social events; all included in Class 41.</p>
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5 I now turn to consider the trade marks of the two parties. The opponent has the mark MERCEDES-BENZ registered in each of the Classes shown above. This mark provides the opponent with its best case, and I shall therefore compare this mark with the applicant's mark

For ease of reference I reproduce the applicant's mark below:

For ease of reference I reproduce the applicant's mark below:



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Visually the opponent's mark consists of two words, which are almost invariably hyphenated, and in some instances a device of a three pointed star inside a laurel wreath is also used. In contrast, the applicant's mark consists of the word BENZ with the letters interspersed by three old fashioned microphones, and the words BOOM ROCK SOUL underneath. The only common element being the word BENZ. The dominant feature of the applicant's mark is in my opinion the word BENZ. In the opponent's mark is the first word MERCEDES, is more dominant than the word BENZ. It is accepted that the start of a name assumes the greater importance.

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Clearly the only phonetic similarity is the word BENZ. The opponent's mark has the three syllable word MERCEDES preceding the word BENZ, whereas the applicant's mark has the word BENZ followed by three one syllable words BOOM ROCK SOUL.

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Conceptually, the opponent's mark would be seen as two names. One, MERCEDES, would be recognised as a girls Christian name not only by those familiar with the history of the marque but also by those familiar with fictional works such as "The Count of Monte Cristo". The other, BENZ, would be recognised by historians and motoring enthusiasts as the generally acknowledged inventor of the motor car. The device element of a three pointed star within a wreath provides a reminder of the company's highly successful racing heritage. In contrast the device element and the words BOOM ROCK SOUL give the applicant's mark a clear musical intonation.

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I was invited by Mr Moore to accept the proposition that "...certain members of the public, particularly those of Asian origin and also from other areas of the Pacific rim, habitually shorten the mark MERCEDES-BENZ to BENZ, which we understand is largely because they have trouble with the S sounds in MERCEDES". This, in addition to evidence of use of the term BENZ in magazine articles, he claimed gave the opponent reputation in the word BENZ solus.

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The evidence to back up this assertion is, however, somewhat less than convincing. The copies of articles from the magazine AUTOCAR usually have a reference to MERCEDES-BENZ or simply MERCEDES prior to the use of the word BENZ solus. Given the number of

articles written in the two years of the weekly magazine that was the subject of the opponent's evidence the use of the word BENZ equates to one mention every two issues. The "survey" evidence of the opponent's own dealers is hardly compelling evidence of any separate reputation under the name BENZ.

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As to the use by members of the public of Asian / Pacific Rim origin this is asserted but is not backed by corroborative evidence. The appropriate test is the "average consumer", it is not appropriate to skew the test in favour of a notional person of Asian or Pacific Rim origin unless there is evidence that such a person is likely to be the average consumer. No such evidence has been filed.

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The evidence provided relating to the opponent's trade in goods covered by the specification of the application in suit show use of the "three pointed star" and various model designations but not the use of BENZ solus. Even if I were to accept that the opponent had reputation in the word BENZ solus, and I do not, then that reputation would relate solely to motor vehicles in Class 12.

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Taking into account all of the above, I consider that the trade marks are not similar enough to have given rise to a likelihood of confusion at 21 November 1995 even on goods which are identical. The opposition under Section 5(2) therefore fails.

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For the applicant Mr Walters questioned the position regarding the disclaimers on the majority of the opponent's registrations. In the case of Paco Holdings Ltd applications 2102219 and 2101220 (RPC 2000) the Hearing Officer set out at some length the position regarding disclaimers, concluding at page 466 paragraph 61 :

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"For the reasons given above, I find that the scope of protection of a trade mark under Section 5 may be affected by a disclaimer entered by the proprietor."

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In the case in suit the opponent's marks for goods in Classes 18 and 25 disclaim the word BENZ. The only potential conflicts would therefore be in Classes 9 & 41. However, given my earlier finding I do not need to consider this matter further.

Next, I turn to the grounds of opposition under Section 5(3) which states:

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5 (3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

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(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

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It was common ground at the hearing that the opponent is the Registered Proprietor of a number of trade marks in Class 12, and that the opponent has reputation for motor vehicles. I have already found that the marks are not similar enough to cause confusion if used on identical goods in Classes 18 and 25. Similarly, the applicant's mark is not similar enough to take unfair advantage of the earlier trade mark or be detrimental to its distinctive character or repute, if used on dissimilar goods or services. Therefore, the ground of opposition fails.

Lastly, I consider the other ground of opposition under Section 5(4) which states:

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

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

(b) *by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.*

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

(5) *Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.*

In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

"The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

5 *(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;*

10 *(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and*

15 *(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.*

20 It is common ground that the opponent has goodwill and reputation under the trade mark MERCEDES-BENZ for motor vehicles in Class 12. The opponent asserted that this goodwill and reputation extended to goods covered by the specification of the application in suit and under the word BENZ solus. However, I have found earlier that they have not substantiated either assertion.

25 I have already compared the two marks and found them not to be confusingly similar. The opposition under Section 5(4) therefore fails.

30 The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £935. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

35 Dated this 23 day of August 2000

George W Salthouse
For the Registrar
The Comptroller General