

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2022351
BY MULTIPART DISTRIBUTION LIMITED
TO REGISTER A TRADE MARK IN CLASSES
7, 9, 11, 12 16, 35, 39 & 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 49991 BY BAYERISCHE MOTOREN WERKE AG**

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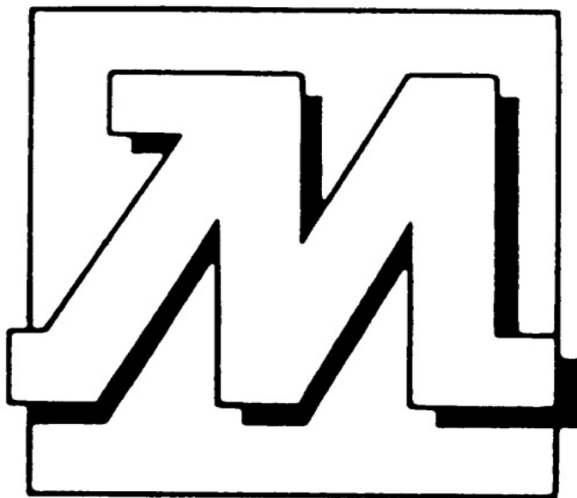
**IN THE MATTER OF Application No 2022351
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**IN THE MATTER OF Opposition Thereto
Under No 49991 by Bayerische Motoren Werke AG**

BACKGROUND

1. On 31 May 1995 Multipart Holdings Limited (now Multipart Distribution Limited, following assignment) applied to register the following trade mark:-



in Classes 7, 9, 11, 12, 16, 39 and 42 for the following specifications of goods and services:-

Class 7

Gaskets; oil seals; all being for use in engines and motors; parts and fittings for engines and motors; cylinder heads; water pumps; crankshafts; camshafts; connecting rods; engine blocks; valve gear; pistons and piston rings; cylinder liners; turbo-chargers; shell

bearings; filters; oil pumps; fuel injectors; fuel pumps; starters; alternators; exhaust pipes and silencers; bearings; parts and fittings for all the aforesaid goods.

Class 9

Electrical apparatus and instruments; starter motors; alternators; fuses; alarms; audio apparatus; batteries; all for motor vehicles; fire extinguishers; parts and fittings for all the aforesaid goods.

Class 11

Lighting, heating and air conditioning apparatus and devices; headlights, rear lights; indicator and marker lights, reflectors; bulbs; all being for vehicles; air conditioners; heaters; lighting apparatus; parts and fittings for all the aforesaid goods.

Class 12

Radiators; propshafts; all being for use in motor land vehicles; truck cabs; body parts; body panels; doors and bonnets; interior trim parts of automobiles; windscreens; windscreen wipers; mirrors for vehicles; glass panels for land vehicles; seats for vehicles; seat belts; gearboxes; clutches; brake linings and shoes; brake drums; brake cylinders; brake discs and disc pads; air brake equipment; hydraulic brake equipment; axles; steering gears and joints; bumpers suspension linkages and joints; springs; shock absorbers; vehicle warning horns; engines; parts and fittings for all the aforesaid goods

Class 16

Printed matter; printed publications; periodical publications; books; instructional manuals; instructional and teaching manuals; all relating to motor vehicle spare parts.

Class 35

Business and commercial management and assistance; contract management; business consultancy; technical planning; computerised stock management; provision of information and analysis of information relating to the control, procurement, supply and distribution of stock; ordering; acceptance; processing and purchasing of stock; stock control; data processing; computerised accounting services; pricing; inventory funding; selling and invoicing; promotional, advertising and marketing services; all relating to spare parts for motor land vehicles.

Class 39

Warehousing; storage; distribution; packing; collection; transportation and delivery of goods by land, sea and air; arranging for the transportation of goods; packaging and crating services; removal services; the logistics of warehousing; the logistics of storage, distribution, packing, collection, transportation, delivery, packaging, crating and removal services all relating to spare parts for motor land vehicles.

Class 42

Computer services; leasing of access time to a computer database; computerised information and advisory services; consultancy; analysis and development services, all relating to computer programs packages; updating and maintenance of computer program packages; technical and engineering services relating to computer hardware and to all the aforesaid services; all relating to spare parts for motor land vehicles.

2. The application was subsequently accepted by the Registrar because of distinctiveness acquired through use and because of prior rights in Registrations Nos 1530997 (6093, 7398) and others. It was advertised in the Trade Marks Journal.

3. On 15 July 1999 Bromhead & Co on behalf of Bayerische Motoren Werke Aktiengesellschaft filed a Notice of Opposition. In summary the grounds were:

- i. Under Section 5(1), 5(2)(a) and 5(2)(b) of the Act because the mark applied for is identical with or similar to the following marks owned by the opponents which cover identical or similar goods and services and a likelihood of confusion exists on the part of the public - UK registration Nos 1200339, 1200343, 1200344, 1200345, 1215335 and UK application No 2139247 and European Community Trade Mark application Nos. 82420, 82859, 82883 and 130724. Details of these trade marks are at Annex 1 to this decision.
- ii. Under Section 3(3)(b) of the Act because use of the mark applied for by the applicant would lead to deception or confusion of the public.
- iii. Under Section 5(3) of the Act because the trade mark applied for is similar to the above mentioned trade marks owned by the opponent and is to be registered for some goods which are not similar to those for which the opponent's marks are registered and those earlier trade marks have a reputation so that use of the applicants mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier marks.
- iv. Under Section 5(4)(a) of the Act by virtue of the law of passing off.
- v. Under Section 5(4)(b) of the Act because the opponents trade marks are well known trade marks within the meaning of Article 6 ter of the Paris Convention and the provisions of Section 56 of the Act apply.
- vi. Under the Registrar's discretion.

4. On 14 September 1999 the applicants through their agents, Trade Mark Owners Association Limited, filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour and have filed evidence. The matter came to be heard on 12 October 2001 when the applicant for registration was represented by Mr Tritton of

Counsel, instructed by Trade Mark Owners Association and the opponents by Mr Hamer of Counsel, instructed by Bromhead & Co.

Opponent's Evidence

5. This consists of two statutory declarations, one each from Graham Coleshill and Gerhard Schlegtendal, dated 22 May 2000 and 29 May 2000.

6. Mr Coleshill is the Legal Manager of BMW (GB) Limited, a position he has held for eight years. He explains that BMW (GB) Limited is a wholly owned subsidiary of Bayerische Motoren Werke Aktiengesellschaft, the opponent.

7. Mr Coleshill refers to Exhibit GC1 to his declaration which, he states, comprises details of total sales of BMW cars in the UK bearing the "M marks" for the years 1983 to 1997. In 1994, the last full year prior to the application date for the mark in suit, the exhibit shows that 45,820 cars were wholesaled, of which 1,082 were "M cars". Mr Coleshill adds that BMW dealerships are found throughout the UK and he lists 27 towns and cities as examples.

8. Turning to promotion issues, Mr Coleshill states that his company widely advertises the range of products of BMW, including goods bearing the "M marks", throughout the UK via television, magazine advertising, hand-outs and promotional events. He adds that BMW products have been advertised in the following magazines:-

PUBLICATION	CIRCULATION IN 1995
Auto Car	80,123
Complete Car	40,089
BBC Top Gear	150,316
Economist	318,255

9. Mr Coleshill goes on to state that BMW's products bearing the M marks have been available for viewing annually in the UK at the Motor Show in Birmingham or London since at least 1984 and that publicity is also given through media track days and golf events.

10. Next, Mr Coleshill refers to a number of Exhibits to his declaration:-

- i. Exhibit GC 2 - which is a copy of a 1986 brochure entitled "BMW M Technic" - "sports accessories for the individualist" which refers to "M technic" accessories and components.
- ii. Exhibit GC 3 - comprising a copy of a 1986 brochure entitled "BMW M Style" showing a range of "BMW M Style" clothing.
- iii. Exhibit GC 4 - a copy of a 1985 price list for "BMW M Style" goods (largely clothing but also other goods which include umbrellas, bags, sunglasses, wallets and document folders).

- iv. Exhibit GC 5 - comprising a copy of an undated BMW dealer merchandiser (letters to prospective purchasers) promoting the “M Technic” range.
- v. Exhibit GC 6 - which consists of copies of inserts from a 1986 dealer after sales marketing kit showing a wide range of vehicle parts and accessories sold under the “M Technic” mark.
- vi. Exhibit GC 7 - a copy of a folder cover bearing the mark subject to registration No 1215335.
- vii. Exhibit GC 8 - comprising a copy of a customer brochure promoting goods under the “M Technic” mark.
- viii. Exhibit GC 9 - a copy of a 1993 customer brochure promoting the “BMW M Model” range of cars, containing reference to M Power engines.
- ix. Exhibit GC 10 - copies of colour advertisements used in the UK for the BMW M model series range, showing cars from registration years “Y” to “K”.
- x. Exhibit GC 11 - a list of quotations from BMW advertisements for the BMW M Model series range from 1985 to 1999.

11. Mr Schlegtendal is the ~Communication Manager of BMW M GmbH, a division of BMW AG.

12. Mr Schlegtendal states that the M mark was first used by the opponent in 1978 on its M1 car and that use has been constant since that date. He adds that the marks BMW M Power and M Power were first used in 1983 for cars in the Formula One and Two racing teams, after which the marks were used on the engine chassis of all BMW M cars. He explains that since its introduction, the BMW M Power mark has been used extensively as a communication tool.

13. Turning to the M Technic mark, Mr Schlegtendal states that from 1984 to 1988 this mark was used on car kits designed to give a more sporty character and that sales literature showing the mark was produced.

14. Mr Schlegtendal goes on to explain that every M series car had/has an “M mark” both on the back of the cars and also in their interiors. He states that, in Great Britain, the numbers of M series cars sold between 1990 and 1995 was as follows:-

MODEL	1990	1991	1992	1993	1994	1995
M635 Csi coupé (E24)	13	1				
M3 Cabrio (E30)	23	1	2			
Ms Lim (E30)	74	36	27	3	0	1
M850 Csi coupé (E31)				29	57	43
M5 Lim (E34)	192	127	101	108	88	90
M3 Cabrio (E36)					203	345

M3 Coupe (E36)	265	800	696
M3 Lim (E36)			393

15. Mr Schlegtendal states that goods bearing the M marks have always been included in BMW's exhibition appearances, since the introduction of the marks and he adds that M cars are always indicated as the high performance cars of BMW.

16. Mr Schlegtendal refers to a 1999 customer survey but this is after the relevant date, the results are in German and it is not clear where and with whom the survey was conducted.

17. Next, Mr Schlegtendal refers to following Exhibits to his declaration; including the following:-

- i. Exhibit GS 3 - a copy of a 1987 UK brochure for M3, M5 and M635 CSi cars.
- ii. Exhibit GS 4 - comprising a copy of a UK brochure for the M3 car which refers to use of the M3 marks in 1987.
- iii. Exhibit GS 5 - a copy of a 1990 UK brochure for the M3 car.
- iv. Exhibit GS 6 - a copy of a 1990 sales leaflet for the M3 car.
- v. Exhibit GS 7 copies of several UK advertisements for M series cars covering "C" to "K" car registrations.
- vi. Exhibit GS 11 - copies of extracts from a 1994 publication entitled "Days to the Top" which shows the M Power mark on cars, engines and shirts.
- v. Exhibit GS 12 - an audio tape and accompanying booklet entitled "BMW M Power Sounds", produced in 1989.

Applicant's Evidence

18. This consists of a statutory declaration by Brian Sneyd, dated 11 December 2000. Mr Sneyd is the Managing Director of Multipart Universal, a division of the applicants.

19. Mr Sneyd explains that the mark applied for has its origins in an earlier similar device, which was used in the UK from about 1980 to 1995. Use of this device, in brochures and other materials is shown at Exhibit BS 1 to Mr Sneyd's declaration. In 1994 Mr Sneyd's company decided to introduce a new version of the Multipart "M" logo and at Exhibit BS 2 to his declaration is a copy of a letter dated 27 April 1994 introducing the new logo, which is again similar to the mark applied for.

20. Mr Sneyd states that the mark, the subject of the present application, was first used on his company's products in January 1995 and it maintained some of the key elements of the same device which his company, and its predecessors, had been developing since the 1980's. At

Exhibit BS 3 to Mr Sneyd's declaration are examples of the use of the mark in suit from 1995, 1996 and later dates eg in relation to clutches and exhaust systems.

21. Next, Mr Sneyd states that his company have provided a complete range of products and services since the 1980's under cover of the old and, since 1995, the new "M" logo. He provides the following turnover figures for his company's products sold under the mark for the years 1995 to 1999.

YEAR	£
1995	137,700,000
1996	137,300,000
1997	135,800,000
1998	144,200,000
1999	151,500,000

He adds that these figures include export sales and that his company exports around 20% of its goods and services under their trade mark to over 120 countries.

Opponent's Rule 13(11) Evidence

22. This consists of a statutory declaration by Jeremy Hemmings, dated 31 August 2000, who is the Group Account Director for the BMW account at WCRS Limited, the advertising company which produces advertisements for BMW (GB) Limited.

23. Mr Hemmings states that WCRS have produced advertisements for vehicles manufactured by BMW AG and sold by BMW (GB) Limited under the M trade marks since 1981. He then provides a complete list of the advertisements for vehicles bearing the M marks which WCRS Limited produced for BMW (GB) Limited from 1981 to 1999.

Applicant's Rules 13 (11) Evidence

24. This comprises a statutory declaration dated 2 February 2001 by Alan McBray, a trade mark agent employed by Trade Mark Owners Association who act for the applicant.

25. Mr McBray states that he has read the statutory declaration made by James Hemmings and dated 31 August 2000 but, in the absence of any illustration or depiction of the "M" mark in the declaration or any reference to the publication alleged to bear the said logo, the applicants are unable to furnish a constructive response.

Opponent's Rule 13 (11) Evidence (in reply)

26. This consists of a statutory declaration, dated 16 March 2001, by Michael David Spicer a trade mark agent with Bromhead & Co, who act for the opponent.

27. In response to Mr McBray's comments in the statutory declaration of 2 February 2001, Mr Spicer wishes to make it clear that the purpose of Hemming's declaration was merely to

avoid any hearsay objections being made against the opponent's original evidence. Hence, the further evidence is meant to be read in conjunction with the original evidence which include examples of the "M" Mark.

28. This concludes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

29. Firstly, I dismiss the ground of opposition based upon the Registrar's discretion which, of course, is not provided for under the 1994 Act.

30. Next, I deal with the ground of opposition based upon Section 3(3)(b). There have been numerous decisions by the Trade Marks Registry which indicate that it considers an objection under this head to be one based upon Absolute Grounds. I am fortified in this approach by the following passage from Kerly's Law of Trade Marks and Trade Names (Thirteenth Edition) at page 202, paragraph 7-165, which in relation to Section 3(3)(b) states:-

"..... it is an absolute not a relative ground of refusal. It is concerned with deceptiveness which is apparent within the mark itself as opposed to deception caused by the similarity of one mark to another."

31. At the hearing, Mr Hamer argued that, as BMW has an M series of cars, the use of the letter M is likely to be taken as a reference to a product or service which has something to do with motor cars and that this may be seen as an indication of the nature of the goods or services and in particular their suitability for or use in relation to the M series of BMW motor cars. It seems to me that this is a relative grounds objection "dressed up" as absolute grounds. There is nothing inherently deceptive about the letter M in relation to the goods and services covered by the application and no evidence has been put forward to that effect. Accordingly, I dismiss this ground of opposition.

32. Next I turn to the ground of opposition based upon Section 5(2)(b) of the Act (it was agreed at the hearing that Section 5(1) and Section 5(2)(a) of the Act did not apply). Section 5(2) reads as follows:-

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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."

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

"6-(1) In this Act an "earlier trade mark" means:-

- (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)
- (c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

34. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

35. The opponent is relying upon ten registrations or applications (six UK and four European Community marks) in relation to Section 5(2). However, not all of these marks qualify as "earlier trade marks" and I am unable to take account of the following marks in relation to Section 5(2):-

- (i) UK application number 2139247 (M Power), the filing date of which, 16 July 1997, post-dates 31 May 1995, the application date for the mark in suit.
- (ii) European Community Trade Mark application number 82420 (M) which has been refused by the Office for the Harmonisation of the Internal Market.
- (iii) European Community Trade Mark registration number 82859 (M5), the registration of which is only effective from 1 April 1996 (the filing date) and which post dates the application date for the mark in suit.
- (iv) European Community Trade Mark registration number 82883 (M3), the registration of which is only effective from 1 April 1996 (the filing date) and which post dates the application date for the mark in suit.
- (v) European Community Trade Mark registration number 130724 (M Series), the registration of which is only effective from 1 April 1996 (the filing date) and which post dates the application date for the mark in suit.

36. This leaves five registrations on which the opponent may rely; number 1200343 which comprises the letter and word M TEAM and is registered in Class 25; number 1200339 which comprises the letters and word BMW M POWER and is registered in Class 12; number 1200344 consisting of the letter and word M TECHNIC and is registered in Class 9; number 1200345 comprising of the letter and word M TECHNIC, in a slightly stylized format, and is registered in Class 12; and number 1215335 which is a figurative mark limited to the colours

blue, purple, red and silver, comprising a three pillared device which rests at an angle to and is conjoined with the letter M. This mark is registered in Class 12.

37. The mark in suit consists of a slightly stylised letter M with a small element of shadowing behind and as filed, was first used by the applicant in January 1995, a relatively short period before the relevant date of 31 May 1995, with use consistently being alongside the word MULTIPART. According to Mr Hamer this explains why the opponent has been unable to bring forward any evidence of actual confusion in the market place. I think Mr Hamer has a point and I do not intend to give any significant weight to the lack of evidence in relation to actual confusion.

38. The reputation of a mark is an element to which importance may be attached in Section 5(2) considerations and in this regard Mr Hamer drew my attention to the evidence filed in relation to the opponent's use and promotion of their marks. Having given careful consideration to the evidence filed, it seems to me to demonstrate that through their sales, advertising and promotional activities the opponents (BMW) have used the secondary trade marks M SERIES, M3 and M5. Whereas specific information relating to the extent of sales, the promotion and use of these aforementioned marks is available in the evidence submitted, evidence of repute in relation to those marks upon which the opponent is entitled to rely under Section 5(2) is very much lacking. The evidence filed amounts to little more than evidence of use of those marks. No turnover or precise sales details have been provided in relation to the M Team, BMW M Power, M Technic or the composite pillar/letter M mark have been provided, and similarly there are no details in relation to the advertising and promotion of these marks. While it is claimed that the mark subject to registration number 1215335 (the composite mark, limited to colour) appears on every M SERIES car sold, it seems to me that the model designation number e.g. 3 or 5, is always incorporated and I have no independent evidence in relation to the recognition or repute of this mark. Unlike M3 or M5, it does not appear to be a mark under which the goods are actually sold or promoted.

39. While I have no doubt that the opponent has a real presence in the market place, the evidence filed does not demonstrate a reputation in the registrations upon which the opponents are entitled to rely under Section 5(2). To conclude, I do not consider that the opponents have established a reputation in their marks for the purposes of this ground. I must therefore compare the mark applied for and the opponent's registrations on the basis of normal and fair use.

40. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion. I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of goods in question and how they are marketed.

41. As mentioned earlier in this decision, the mark applied for consists of the letter M with a slight element of stylization with some shadowing behind the letter. The opponent's relevant

registrations consist of the letter and word M TEAM (No. 1200343), the letters and word BMW M POWER (No. 1200339), the letter and word M TECHNIC (Nos. 1200344 and 1200345) and a composite mark consisting of a device and the letter M (No. 1215335).

42. How then should I approach the comparison of the marks? At the hearing Mr Hamer argued that the letter M was the dominant and distinctive element of the opponent's registrations and the letter M was common to the marks and would link them together in the customers mind thus increasing the likelihood of confusion through imperfect recollection. On the other hand, Mr Tritton submitted that the letter M in the opponent's registrations was a non-distinctive element which was subject to disclaimer and that the opponent could not seek to monopolise the letter M through these registrations, which should be considered in their totality.

43. While it is right, in my view, to give additional weight to arbitrary features and reduced weight to descriptive or non-distinctive features in assessing the impact a mark has in the mind of the average customer, marks must be considered in their totality. Furthermore, the separate elements within the opponents registrations for the letters and words M TEAM, M POWER, and M TECHNIC are all relatively non-distinctive and it is in their totality that those marks, comprising registrations number 1200343, 1200339, 1200344 and 1200345, are distinctive. Turning to the opponents registration number 1215335, this mark contains a prominent and distinctive coloured device element in addition to the non-distinctive letter M. In my view, the presence of disclaimers in the opponent's registrations is not a significant factor as I do not consider the letter M to be the dominant element within their marks.

44. I turn now to Mr Hamer's submission that as the letter M is common to the opponent's registrations, it would link them together in the mind of the customer and increase the likelihood of confusion through imperfect recollection. In a recent unreported decision of the Appointed Person - In the matter of Application No. 2070392 (SRIS Ref O/411/01) to register a series of four trade marks in the name of The Infamous Nut Company Ltd in Classes 29 and 31 and in the matter of Opposition thereto under No. 47392 by Percy Dalton (Holdings) Ltd, paragraphs 35, 36 and 37, Professor Ruth Annand stated that:-

"It is impermissible for section 5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponent.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by section 6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (*ENER-CAP Trade Mark* [1999] RPC 362).

In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a "family of marks" in the proprietorship and use of the opponent (*AMOR*, Decision no. 189/1999 of the Opposition Division, OHIM OJ 2/2000, P. 235). However, that has not been shown by the evidence to exist in the

present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31."

I would only add that, in the present case, the opponent's evidence has not demonstrated enhanced distinctiveness in relation to their earlier trade marks and no evidence is before me on the overall state of the register.

45. I now go on to compare the mark in suit with the opponent's earlier marks. On a visual comparison it seems to me that the opponents letter plus word registrations ie. numbers 1200343, 1200339, 1200344 and 1200345, have a different visual impact. While the letter M is a common element, the words within the opponent's marks are at least as prominent visually and take up a greater proportion of the overall mark. I see no reason why the word elements in the opponent's marks would be overlooked or marginalised and in totality the marks are visually different to the mark applied for. The opponent's composite mark (number 1215335) has a considerable visual impact with the three pillared device element, conjoined to the letter M, striking the eye with the overall effect being accentuated by the colour combination. In my view, this mark is also visually distinct from the applicants.

46. On the consideration of aural use, in relation to the opponent's letter plus word registrations, the opponent's case depends on the proposition that the word element within the registrations is insufficient to indicate a different trade origin when the respective marks are considered in their totality. However, I can think of no satisfactory explanation as to why the opponent's marks would be shortened to the letter M in oral use or why the word elements would be marginalised or ignored. In totality the mark applied for sounds quite different to the opponent's letter and word registrations. The opponent's composite mark, in my view, has a primarily visual identity and the impact of the device element, which has the effect of making the mark into a stylised logo, should be taken into account, especially as the opponent has not shown that the letter M, per se, is distinctive of its goods.

47. I now turn to a conceptual comparison of the marks. The mark applied for comprises a stylised letter of the alphabet within a plain border, whereas the opponents' letter and word marks contain the same letter of the alphabet and additional letters and a word (BMW M POWER), or additional words (M TEAM), (M TECHNIC) which conceptually, gives them a different and invented totality. Conceptually, the opponent's composite registration has the impact of a stylised, coloured logo. I would add that a single letter of the alphabet has very slender inherent distinctive character as a trade mark. Accordingly small differences, such as the stylisation present in the applicant's mark and the opponents registration No 1215335, are more likely to be sufficient to distinguish such marks. Accordingly, I believe all the opponents marks to be quite different on a conceptual basis.

48. I must now go on and take into account the goods and services covered by the specifications of the respective marks. The application in suit is made in a number of classes for goods and services which can be summarised as car spare parts, accessories for cars and services relating to cars. As the application includes car spare parts in Class 12, the opponents registrations in Class 12, which include car parts, (registrations number 1200339, 1200345 and 1215335) cover the same goods. I do not lose sight of the fact that the opponent's earlier registrations also include number 1200343 and 1200344 but I do not believe that the existence

of these registrations places the opponent in any stronger position. I would only add that registration number 1200343 is in respect of clothing in Class 25 which, in my view, clearly covers goods dissimilar from the goods specified by the applicant.

49. Next, I go on to consider the category of goods in question and how they are marketed. At the hearing, Mr Tritton submitted that the relevant public or customer for car parts and accessories etc. was generally the car trade ie. garages, dealers and distributors. He argued that, in consequence, the customer was sophisticated and there was a relatively low risk of confusion. While there is force in Mr Tritton's submission, it seems to me that the customer for the goods would also include car owners generally, many of whom fit parts or accessories to their cars, especially replacement parts in the nature of windscreen wipers. However, I believe Mr Tritton makes a valid point in relation to the care with which such goods are purchased. Even when purchasing relatively straightforward replacement items such as windscreen wipers the customer needs to know the make and model of the vehicle and the year of manufacture. With more complex items it is also often necessary to know the engine size and type. In my view the relevant customer for the goods in issue needs to be relatively careful and discerning and this reduces the scope for confusion.

50. On a global appreciation, taking into account the relevant factors I have come to the conclusion that while some people encountering the applicant's mark may think it reminiscent of the opponent's earlier marks it does not follow that a likelihood of confusion exists among the average customer for the goods or services. While the respective specifications of goods cover the same and similar goods, the visual, aural and conceptual differences in the marks combined with the category of goods in question and how they are marketed, means that the possibility of confusion amongst the relevant customer is sufficiently remote that it cannot be regarded as a likelihood. The case under Section 5(2) fails.

51. I now turn to the grounds of opposition under Section 5(3) of the Act which states:-

5.-(3) A trade mark which -

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

The term "earlier trade mark" is defined in Section 6 of the Act, which is set out earlier in this decision.

52. The opponent has earlier registration (number 1200343 in Class 25) for goods which are not identical or similar to the goods and services specified in the application in suit. However,

as I have already found that the opponent's do not have a reputation in the United Kingdom in this mark and there is no likelihood of confusion under Section 5(2), the opponent has, in my view, no stronger case under Section 5(3) of the Act and the opposition on this ground fails.

53. Finally, I consider the ground of opposition under Section 5(4) of the Act which at the hearing was pursued in relation to passing off and on the basis that the opponent's marks are entitled to protection as well known trade marks under Article 6 of the Paris Convention and Section 56 of the Trade Marks Act 1994.

54. Section 5(4) reads as follows:

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

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

55. The law on the common law tort of passing off is clearly set out by Geoffrey Hobbs QC, acting as the 'Appointed Person', in *Wild Child* [1998] 14 RPC, 455:

"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 *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 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:

- (i) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (ii) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (iii) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

56. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

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

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent

intent, although a fraudulent intent is not a necessary part of the cause of action."

57. Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date (31 May 1995); (i) they had acquired goodwill under their mark, (ii) that use of the applicant's mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

58. I now go on to consider the evidence filed in these proceedings, summarised earlier in this decision, taking into account the submissions put forward at the hearing. I will consider these under the three main headings of Goodwill, Misrepresentation and Damage.

GOODWILL

59. Earlier in this decision I found that on the basis of their sales, advertising and promotional activities the opponents have a goodwill in a trade in the sporting versions of their cars identified by the secondary trade marks M SERIES, M3 and M5, as well as the primary mark BMW. Cars are high profile and expensive products in which, in general, the public have a relatively high degree of awareness and in my view, the opponent's reputation would extend to spare parts and accessories for these cars. However, the evidence submitted does not demonstrate that the opponent has a reputation in the letter M (solus), or even clear use of the letter M (solus) as a trade mark. While Mr Schlegendal in his declaration of 29 May 2000 on behalf of the opponent refers to a 1999 customer survey in relation to "the BMW M", this survey is well after the relevant date, the results are in German and it is not clear where (in which country) and with whom the survey was conducted. Accordingly, I cannot give it any weight.

60. In the recent case of South Cone Inc. v Jack Bessant, Dominic Greensmith Kenmy Gary Stringer (a partnership) 16 May 2001, Pumfrey J. in considering an appeal from a decision of the Registrar to reject an opposition under S5(4)(a) said:

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

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

61. To sum up, the evidence shows that the opponents have a reputation in the trade marks M

SERIES, M3 and M5. However, I am unable to infer that the opponent has a reputation in the letter M (solus).

MISREPRESENTATION

62. There is no evidence of fraudulent intent and no evidence of actual confusion in the market place. Accordingly, I must consider misrepresentation in the context of fair and notional use. Earlier in this decision, in relation to the Section 5(2) ground, I found that the customer for the relevant goods ie. car parts and accessories, would be careful and discerning as even when purchasing relatively straightforward replacement items such as windscreen wipers the customer needs to know the make and model of the vehicle and the year of manufacture and with more complex items it is also often necessary to know the engine size and type. These considerations are also relevant to Section 5(4). Given that the opponent's reputation lies in different marks it seems to me that the manner in which trade in the goods is carried on and the nature of the customer makes it unlikely that confusion or deception will occur among a substantial number of the public.

DAMAGE

63. In light of my findings above I cannot conclude that there is a likelihood of damage to the opponent. The ground of opposition based on passing off therefore fails.

64. I turn now to the opponent's claims that their trade marks are entitled to protection as well known marks under Article 6 of the Paris Convention and Section 56 of the 1994 Act.

65. Section 56 of the Act states:-

"56.-(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who -

- (a) is a national of a Convention country, or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to Section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section."

66. On the evidence filed, it seems to me that the opponent's case on the present ground is no stronger than in relation to the Section 5(2), Section 5(3) and passing off grounds. The opponents have not discharged the onus upon them and the opposition under Section 5(4) fails.

67. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay them the sum of £750. This sum is 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.

Dated this 10 day of December 2001

JOHN MACGILLIVRAY
For the Registrar
the Comptroller-General

NUMBER : 1200343 REGISTRATION EFFECTIVE : 26 JANUARY 1983

MARK:- M TEAM

Disclaimer:

Registration of this mark shall give no right to the exclusive use, separately, of the letter “M” and the word “Team”.

SPECIFICATION OF GOODS:

Class 25:

Overalls, T-shirts and caps for wear, all for men.

Proprietor: Bayerische Motoren Werke Aktiengesellschaft

NUMBER: 1200339 REGISTRATION EFFECTIVE : 22 JULY 1983

MARK:- BMW M Power

Disclaimer:

Registration of this mark shall give no right to the exclusive use of the letter and word “M Power”

SPECIFICATION OF GOODS:

Class 12:

Motor-cars and motor-cycles; and parts and fittings included in Class 12 for all the aforesaid goods.

Proprietor: Bayerische Motoren Werke Aktiengesellschaft

NUMBER: 1200344

REGISTRATION EFFECTIVE : 26 JANUARY 1983

MARK:- M Technic

Disclaimer:

Registration of this mark shall give no right to the exclusive use, SEPARATELY, OF THE LETTER “M” and the word “Technic”.

SPECIFICATION OF GOODS:

Class 9:

Instruments for measuring and indicating road speed, engine speed, pressure, temperature liquid level and electrical data.

Proprietor: Bayerische Motoren Werke Aktiengesellschaft

NUMBER: 1200345

REGISTRATION EFFECTIVE : 26 JANUARY 1983

MARK:-

M Technic

Disclaimer:

Registration of this mark shall give no right to the exclusive use, separately, of the letter “M” and the word “Technic”.

SPECIFICATION OF GOODS:

Class 12:

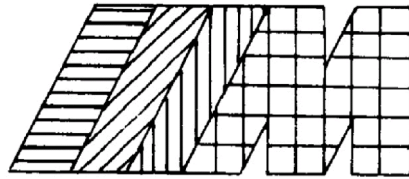
Parts included in Class 12 of land vehicles.

Proprietor: Bayerische Motoren Werke Aktiengesellschaft

NUMBER: 1215335

REGISTRATION EFFECTIVE : 12 OCTOBER 1983

MARK:-



Disclaimer:

Registration of this mark shall give no right to the exclusive use of the letter "M".

Mark claim/limit:

The Trade Mark is limited to the colours blue, purple, red and silver as shown in the representation on the form of application.

SPECIFICATION OF GOODS:

Class 12:

Motor-cars and parts therefore included in Class 12.

Proprietor: Bayerische Motoren Werke Aktiengesellschaft

NUMBER: 2139247

FILING DATE : 16 JULY 1997

MARK:- M POWER

Special Circumstances:

Proceeding because of distinctiveness acquired through use.

Consent

By Consent Nos M668502, B1574100 (6164, 1821) and another.

SPECIFICATION OF GOODS AND SERVICES

Class 7

Motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); parts and fittings for all the aforesaid goods.

Class 8

Hand tools, hand operated; lifting jacks, hand operated.

Class 9

Computers and computer software for use with motors and engines, motor electronics apparatus, computers and computer software for use in vehicles; electronic storage media including CD-ROMS, magnetic discs and tapes; video and audio cassettes; motorcycle helmets; protective eye pieces; sunglasses; all relating to motorised land vehicles and parts and fittings therefore.

Class 12

Motor land vehicles; motors and engines for land vehicles; machine coupling and transmission components for land vehicles; parts and fittings for all the aforesaid goods.

Class 14

Badges of precious metal; jewellery; horological and chronometric instruments.

Class 16

Manuals, information sheets; magazines; posters; transfers (decalcomanias); all relating to motorised land vehicles.

Class 18

Leather and imitations of leather, and goods made of these materials (included in ?Class 18); trunks and travelling bags; umbrellas and parasols.

Class 25

Clothing, footwear, headgear.

Class 26

Badges for wear, not of precious metal; buttons.

Class 27

Carpets, including carpets for automobiles.

Class 28

Games and playthings.

Class 37

Repair and maintenance of vehicles and motors; advisory services relating to vehicle and motor repair and maintenance.

Proprietor: Bayerische Motoren Werke Aktiengesellschaft

NUMBER: 82420 REGISTRATION REFUSED

MARK:- M

SPECIFICATION OF GOODS:

Class 12:

Vehicles and parts thereof.

Class 28:

Models of vehicles and parts thereof.

Proprietor: Bayerische Motoren Werke Aktiengesellschaft

NUMBER: 82859 REGISTRATION EFFECTIVE: 1 APRIL 1996

MARK:- M5

SPECIFICATION OF GOODS:

Class 12:

Vehicles and parts thereof.

Class 28:

Models of vehicles and parts thereof.

Proprietor: Bayerische Motoren Werke Aktiengesellschaft

NUMBER: 82883 REGISTRATION EFFECTIVE: 1 APRIL 1996

MARK:- M3

SPECIFICATION OF GOODS:

Class 12:

Vehicles and parts thereof.

Class 28:

Models of vehicles and parts thereof.

Proprietor: Bayerische Motoren Werke Aktiengesellschaft

NUMBER: 130724 **REGISTRATION EFFECTIVE: 1 APRIL 1996**

MARK:- **M SERIES**

SPECIFICATION OF GOODS:

Class 12:

Automobiles and parts thereof.

Class 28:

Model vehicles and parts thereof.

Proprietor: Bayerische Motoren Werke Aktiengesellschaft
