

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2209306  
BY COLIN J MACGREGOR  
TO REGISTER THE TRADE MARKS:**



**IN CLASSES 9, 41, 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No 50742 BY  
ENTERPRISE RENT-A-CAR COMPANY  
BASED UPON THE EARLIER RIGHTS:**

**ECAR,**



*inter alia*

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF Application No 2209306**  
**by Colin J MacGregor**  
**to register the trade marks:**



**as a series of two marks**  
**(in the second mark of the series**  
**the colours red, grey and black are claimed)**  
**in classes 9, 41 and 42**  
**and**

**IN THE MATTER OF Opposition thereto under No 50742**  
**by Enterprise Rent-A-Car Company**

### **Background**

1) On 21 September 1999 Colin J MacGregor applied to register the above trade marks. The application was published on 24 November 1999 with the following specification:

*software for use by car dealers for managing data on cars for sale, includes production of car data in appropriate formats for print, advertising and web publishing – class 9*

*publishing car descriptions and pictures on the Internet; computer software training services - class 41*

*computer support services for the installation, use and maintenance of software installed on personal computer networks – class 42*

2) On 23 February 2000 Enterprise Rent-A-Car Company filed a notice of opposition to this application.

3) The opponent states that he is the registered proprietor of the following trade mark registrations:

- United Kingdom registration no 1584172 of the trade mark **ECAR** which is registered in respect of the following services: *vehicle fleet management services; information and/or advisory services relating to the aforesaid* – class 35
- United Kingdom registration no 1584173 of the trade mark **ECAR** which is registered in respect of the following services: *vehicle repair and/or maintenance services; rental, loan and/or hire of equipment relating to the aforesaid; information and/or advisory services*

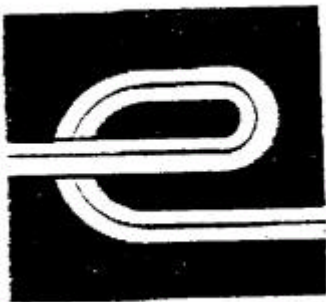
*relating to the aforesaid – class 37*

- United Kingdom trade mark registration no 1560827 of the trade mark **ECARS** which was registered in respect of the following goods: *land vehicles; apparatus for locomotion by land; parts and fittings for all the aforesaid goods; all included in Class 12. This registration has now expired.*
- United Kingdom trade mark registration no 1560829 of the trade mark **ECARS** which is registered in respect of the following services: *vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; reservation and/or booking services for or relating to vehicles; reservation services for vehicle leasing and/or rental; all included in Class 39.*
- United Kingdom trade mark registration no 1560828 of the trade mark **ECARS** which was registered in respect of the following services: *insurance, financial and financing services; financial management services; financial valuations; all the aforesaid relating to vehicles; vehicle financing services; lease purchasing financing; vehicle lease purchase financing services; all included in Class 36. This registration has now expired.*
- United Kingdom trade mark registration no 1545521 of the trade mark:



which is registered in respect of the following goods: *land vehicles; apparatus for locomotion by land; parts and fittings for all the aforesaid; all included in Class 12. The registration includes the following disclaimer: “Registration of this mark shall give no right to the exclusive use of a letter “E””*

- United Kingdom trade mark registration no 1544987 of the trade mark:



which is registered in respect of the following services: *vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; all included in Class 39. The registration includes the following disclaimer: “Registration of this mark shall give no right to the exclusive use of a letter “E””*

- United Kingdom trade mark registration nos 1566075 and 1566076 of the trade mark:



The trade marks were registered in respect of, respectively: *land vehicles; apparatus for locomotion by land; parts and fittings for all the aforesaid goods; all included in Class 12 and vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; reservation and/or booking services relating to vehicles; reservation services for vehicle leasing and/or rental; all included in Class 39. Both registrations have expired.* Both registrations included the following disclaimer: "Registration of this mark shall give no right to the exclusive use, separately, of a letter "e" and the word "Cars"."

- Community trade mark registration no 36525 of the trade mark **ECAR** which is registered in respect of the following goods and services: *land vehicles; vehicles, automobiles and apparatus for locomotion on land; parts and fittings for all the aforesaid goods – class 12; insurance, financial and financing services; financial valuations; all the aforesaid relating to vehicles; vehicle financing services; vehicle lease and lease-purchase financing – class 36; vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle rental and leasing, and reservation services for vehicle rental and/or leasing – class 39.*
- Community trade mark registration no 36343 of the trade mark:



which is registered in respect of the following goods and services: *land vehicles; vehicles, automobiles and apparatus for locomotion on land; parts and fittings for all the aforesaid goods – class 12; land vehicles; vehicles, automobiles and apparatus for locomotion on land; parts and fittings for all the aforesaid goods – class 36; vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle rental and leasing, and reservation services for vehicle rental and/or leasing – class 39.*

- Community trade mark registration no 36335. This registration is for the same goods and services as registration no 36343. The trade mark is the same sign except that it is in the colour green.

4) The opponent states that in relation to trade marks including or comprising the sign trade mark ECAR and/or



that he has a reputation in respect of the rental of cars, sales of cars (including second hand cars), vehicle fleet management services, vehicle maintenance and the provision of information and advice in relation to all the foregoing and also the provision of information and advice concerning vehicles generally. He states that his earlier registrations encompass goods and services that are identical and/or similar to those encompassed by the application in suit. The opponent states that the respective signs are similar or identical. Consequently registration of the trade mark in suit would be contrary to the provisions of section 5(2)(a) and 5(2)(b) of the Act.

5) The opponent states that use of the trade mark in suit would take unfair advantage of an/or be detrimental to the distinctive character and/or repute of his earlier trade marks in relation to any goods or services that are held not to be similar. The opponent states use of the trade mark in suit would dilute the distinctiveness and/or repute his earlier registrations. He states that, consequently, registration of the trade mark in suit would be contrary to sections 5(3)(a) and (b) of the Act.

6) The opponent states that owing to his use of his earlier trade marks and his design and copyright rights registration of the trade mark in suit should be refused pursuant to sections 5(4)(a) and (b) of the Act.

7) The opponent also states that his earlier trade marks are well-known trade marks as per article 6bis of the Paris Convention.

8) The opponent seeks an award of costs.

9) The applicant filed a counterstatement denying the above grounds and seeking an award of costs.

10) Both parties filed evidence.

11) The matter came to be heard on 2 April 2002 when the applicant was represented by Mr Lutkin, of David Lutkin & Associates and the opponent was represented by Ms Rawlence of Roystons.

### **Evidence of the opponent**

12) This consists of a statutory declaration by Judith Diana Rawlence and an affidavit by Raymond T Wagner Jnr.

13) Ms Rawlence's declaration is dated 21 December 2000. Ms Rawlence is a trade mark attorney. She states that she makes her declaration upon the basis of her personal knowledge,

from documents she holds and from information from the opponent. In her declaration Ms Rawlence refers to the various registrations of the opponent. However, she does not mention the following registrations which were referred to in the opponent's statement of case: United Kingdom registration nos 1560827/8/9 and 1566075/6. With the exception of 1560829 all of these registrations have now expired.

14) Ms Rawlence states that the trade mark ECAR has been used in relation to car related goods and services, including car rental services, in the United Kingdom since February 1999. She states that the trade mark ECARS has been used in the United Kingdom since January 1998. Ms Rawlence states that the trade mark:



(hereinafter referred to as the “e” logo) has been used in the United Kingdom since early 1994 in relation to the provision of car related goods and services, including sales of cars, rental of cars and car fleet management services.

15) The evidence of Ms Rawlence does not assist greatly in accessing the merits of the case of the opponent. The various figures she furnishes relate to combined services or goods e.g. she lists together car rental services, car towing services, car breakdown services and reservation services for car rental. Of even more concern to me is her statement that all the figures relate to the use of the “e” logo. The exhibits furnished do not support this use of the logo simpliciter. Exhibit JDR2 shows a composite trade mark with the logo forming the part of a sign which includes the word Enterprise, the word enterprise takes up the majority of the sign. Ms Rawlence also refers to the presence in the advertisement of the trade mark ECAR. In fact ECAR appears as a number plate and is likely to be noticed only by the most hawk-eyed and then it is very doubtful that it would be seen as an indicator of origin. Included in JDR2 is a page from Yellow Pages. The extract is headed ENTERPRISE WON'T TREAT YOU LIKE OTHER CAR RENTAL COMPANIES DO. The “e” logo appears in various parts of the advertisement but for the most part by way of decoration. At the bottom of the page the “e” logo appears next to ENTERPRISE RENT-A-CAR, the latter taking up far more space than the device. The web pages exhibited at JDR3 all emanate from the year 2000, after the relevant date. Again the sign ENTERPRISE is very prominent on the banners. The pages relating to car sales tell me little about the position in the United Kingdom or the European Union, they include a US free phone number and refer to a \$200 cleaning and documentation fee. I cannot see how they can be presumed to relate to the United Kingdom or the European Union. The other pages from the web site again bear prominent reference to ENTERPRISE. There is nothing in the page relating to fleet services that indicates that it relates to the United Kingdom or the European Union. The web page showing a privacy statement gives a US address and a US telephone number. The pages relating to ENTERPRISE fleet service refer to the ASE – this I presume refers to the National Institute for Automotive Service Excellence – a US organisation. Despite the claims of Ms Rawlence the web pages are clearly for US usage, they tell me nothing about the position within the United Kingdom or the European Union. The opponent may well run fleet services and have a discreet car sales business in the USA, this does not tell me the position within the United Kingdom or the European Union. The turnover figures in relation to car fleet management services and information and

advisory services relating to the aforesaid are very limited also. No figure is given for the years 1995 and 1999 and the figures for the years 1996, 1997 and 1998 are, respectively, £11,026, £5,102 and £4,723. These are hardly figures indicating a thriving business in relation to car fleet management services and, of course, I have no way of knowing which trade mark is associated with them. The advertising of jobs exhibited at JDR4 show the “e” logo but the company is clearly identified at ENTERPRISE or Enterprise Rent-A-Car. The various sales invoices bear the “e” logo but also are headed ENTERPRISE RENT-A-CAR UK LIMITED. The invoices appear all to be motor retailers and seem to be for the sale of ex-rental cars. Something that I would consider an adjunct to the car hire business rather than as the normal car retailing enterprise. Finally there is a map showing the locations of ENTERPRISE RENT-A-CAR as of October 2000. The “e” logo appears as a composite trade mark with ENTERPRISE RENT-A-CAR. It also appear as indicator of the places in the United Kingdom where there are locations. Whether such use would be seen as a badge of origin or decoration is a moot point.

16) Ms Rawlence also prays in aid to the opponent’s turnover outside the United Kingdom. Use outside the United Kingdom might bring about knowledge of the opponent to a certain group of persons who have travelled to other countries but that does not greatly assist in demonstrating a reputation within the United Kingdom. The relevance is further lessened by the problem as to what trade mark or trade marks are used in other countries and the exact goods or services to which they relate.

17) The best that can be said of the evidence of Ms Rawlence is that the opponent runs a car hire business in the United Kingdom and that the “e” logo appears in use in relation to it. However, it is often in conjunction with ENTERPRISE and the business is clearly identified as being Enterprise Rent-A-Car. The evidence of use of ECAR in the United Kingdom is limited to its appearance on a car number plate.

18) The affidavit of Raymond T Wagner Jnr is dated 7 March 2001. Mr Wagner is the legal and legislative vice president of the opponent. Effectively Mr Wagner repeats the evidence of Ms Rawlence and, therefore, I need say no more about his affidavit.

### **Evidence of the applicant**

19) This consists of a statutory declaration by Colin James MacGregor dated 7 June 2001. Mr MacGregor is the applicant.

20) Mr MacGregor states that the goods and services of the application in suit are entirely for use by car dealers and would not be used or be seen by members of the public. He states that he is aware of the car rental activities of the opponent under the “e” logo trade mark and a composite trade mark comprising the “e” logo and the words ENTERPRISE RENT-A-CAR. He states that he is not aware of the opponent using these trade marks in the United Kingdom in relation to anything other than car rental.

21) The bulk of Mr MacGregor’s declaration represents submissions rather than evidence of fact. I will say nothing about the submissions here but deal with them, if necessary, in the body of the decision. Mr MacGregor reproduces an advertisement for a car rental company from Yellow Pages which shows use of a letter E.

## **Evidence of the opponent in reply**

22) This consists of a further affidavit by Mr Wagner, dated 5 September 2001. Mr Wagner's affidavit does not represent evidence of fact. It can be characterised as representing submissions, rebuttals of the claims of Mr MacGregor in his declaration and references to his original declaration. Taking into account the nature and content of the affidavit I do not consider that I need to say anymore about it.

## **Decision**

23) I consider that it is best to first consider the evidence of the opponent and what it establishes. As much will hinge upon this. Most of the claims of the opponent can at best be described as optimistic; they might even be classified as extravagant - especially in relation to ECAR. The opponent has established that he runs a car rental service in the United Kingdom, this is accepted by the applicant. In relation to the claims to other areas of business in relation to reputation or goodwill, little is established. The sale of cars is clearly an adjunct to his business of car rental; after a certain mileage cars are no longer hired out. I can find nothing in the evidence that demonstrates that the opponent has a goodwill or reputation in car sales. The selling of no longer required vehicles is a part of the car rental business – it is a disposal of no longer required assets, not an enterprise attracting goodwill in itself. I cannot see that it is different in its nature from ambulance services selling off old ambulances. The goodwill or the reputation lies with the principal service, not in the disposal of redundant assets. That is not to state that an enterprise could not have a parallel goodwill or reputation established, it would depend on the nature of the business and the matter would turn upon the evidence adduced. The Internet evidence in relation to car sales is clearly related to US use and not United Kingdom use. The US evidence emphasises the difference between what happens in the United Kingdom. The US business is headed ENTERPRISE car sales, there is no such separate business for the disposal of cars in the United Kingdom. The US business also has a sales and after-sales service – this would seem key to any car retail service. The invoices of the opponent show the very opposite in the United Kingdom. They are clearly marked “sold used and as is” followed by a lengthy disclaimer on the part of the seller. The cars are sold to dealers, not the public. The advertising figures given in relation to car sales are of a very limited level. No figures are given for 1998 and 1999; for the years 1995, 1996 and 1997 the figures are, respectively, £7,769, £1,602 and £1,932. There is no exhibited evidence to demonstrate which trade mark has been used in this very limited advertising. In relation to the other areas of business which the opponent claims a reputation I can find nothing to support him. If, for instance, he wishes to claim a reputation in vehicle maintenance he should have adduced evidence in relation to this service. He should not have left it as a matter of conjecture and presumption. The evidence of the opponent is also difficult to untangle and draw a conclusion from owing to the use of several trade marks. The evidence shows that the primary trade marks are ENTERPRISE, or ENTERPRISE RENT-A-CAR. There is use of the “e” logo but little evidence of its without being in proximity to other trade marks of the opponent. The use simpliciter is on items of stationery, however, when the stationery is in use – as with the invoices for car sales – ENTERPRISE RENT-A-CAR in some format also appears upon it.

24) In *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; 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."

The evidence which the opponent has adduced also goes to section 5(2) and 5(3) issues. However, these grounds require far stronger evidence of reputation than for the establishment of goodwill (see *General Motors Corporation v Yplon SA Case C-375/97 [2000] RPC 572* and *DUONEBS SRIS 0/048/01*). I cannot find that the evidence of the opponent establishes a reputation in respect of any of the registered trade marks upon which he relies for the purposes of section 5(3) or an "enhanced" protection for section 5(2) as per *Sabel BV v. Puma AG [1998] R.P.C. 199* and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc [1999] E.T.M.R. 1*.

25) Mr MacGregor accepts that the opponent offers car rental services to the public under the "e" logo. This is clearly an admission against interest. However, it does not take the matter very far in relation to the establishment of goodwill. Mr MacGregor's statement is not directed specifically to the relevant date and use of the sign does not establish goodwill as the evidence shows it is used in relation with other matter. Taking into account the strictures of Pumfrey J in *South Cone* I cannot find that the opponent has established a goodwill in relation to any of the signs upon which he relies, even in relation to car rental services. The best case, and I believe the only case, that he has is the use of the "e" logo in relation to car rental services. However, the defects in the evidence militate against finding that the opponent has a goodwill in relation to any of the trade marks upon which he relies. As per *South Cone* the onus was upon the opponent to show through trade and public evidence that the "e" logo enjoyed goodwill. He has failed to do this.

26) Owing to the failure to establish reputation and/or goodwill the grounds of opposition under sections 5(3) and 5(4)(a) must fail. No evidence was furnished in relation to section 5(4)(b) and so this ground of opposition must also be dismissed.

27) The "e" logo of the opponent is so different from the trade mark in suit that the opponent could not have succeeded on any grounds in relation to this earlier right, whatever he had proved in relation to it. There is, also, simply no credible evidential basis for any reputation or goodwill in the United Kingdom ECAR or ECARS. The evidence of the opponent rests upon ECAR appearing on the number plate of a car in a number plate and a web site address [www.ecars.com](http://www.ecars.com) - which from the printouts is aimed at the US market. The evidence and the claims of the opponent, whether by design or accident, have obfuscated the issues. They have tried to use the claimed reputation in the "e" logo to bolster the claim for reputation and goodwill in the trade mark ECAR. Cutting through the smoke and confusion of the evidence of the opponent the case comes to down to the issue of whether the trade marks ECAR and

ECARS and the trade mark in suit are similar and whether the goods encompassed by the respective specifications are similar. The case boils down to a simple section 5(2) issue. Despite the claims of the opponent a section 5(2)(b) issue. The signs are not identical, this is a clear matter of straightforward perception – I am fortified in this by the opinion of Advocate General Jacobs in *S.A. Société LTJ Diffusion v SA SADAS* Case C-291/00 where he concluded that:

“The concept of identity between mark and sign in Article 5(1)(a) of Council Directive 89/104/EEC covers identical reproduction without any addition, omission or modification other than those which are either minute or wholly insignificant.”.

28) The only trade marks where the opponent has any chance of establishing similarity with the trade mark in suit are the ECAR and ECARS registrations. During the hearing, to a question from Mr Lutkin, Ms Rawlence accepted that the case did come down to a section 5(2)(b) issue in respect of the opponent’s earlier rights in United Kingdom trade mark registration numbers 1584172, 1584173 and 1560829 and Community trade mark registration no 36525. Registration no 1560829 is for the trade mark ECARS, the other registrations are for the trade mark ECAR.

29) Section 5(2)(b) of the Trade Marks Act 1994 states:

“Section 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 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.

The term ‘earlier trade mark’ is defined in section 6 of the Act as follows:

“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.”

30) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *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* page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; 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.* page 84, 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* page 224;

(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* page 224;

(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* page 7, 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* page 8, 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* page 224;

(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* page 732, 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* page 9 paragraph 29.

### Comparison of signs

31) The signs to be compared are as follows:

Earlier registrations:

**ECAR**  
**ECARS**

Application in suit:



I do not consider that anything turns upon the colour claim of the second mark in series in the application in suit. Equally I do not consider that that one of the opponent's earlier registration is in the plural or possessive form effects the outcome of the comparison of the signs to any great extent; I, therefore will make the comparison with the ECAR registrations of the opponent. (The specification of the Community trade mark ECAR encompasses that of registration no 1560829 for ECARS making the difference between the signs a matter of purely academic interest.) In oral use the respective trade marks will sound the same. Both parties accepted that the trade marks have the same conceptual association: "e" representing electronic, car for automobile. I, therefore, consider that phonetically and conceptually the respective signs are identical. Visually there are clear differences; the trade mark of the opponent is in normal upper case characters, that of the applicant in a stylised format. However, I do not consider that much turns upon the visual differences; the trade marks are first and foremost defined by their meaning and sound, that is, after all how words work irrespective of the script that they are written in.

**32) Consequent upon the above I find the respective trade marks are similar; indeed I consider that there is a high degree of similarity between them.**

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

33) The goods and services encompassed by the **application in suit** are as follows:

*software for use by car dealers for managing data on cars for sale, includes production of car data in appropriate formats for print, advertising and web publishing – class 9*

*publishing car descriptions and pictures on the Internet; computer software training services - class 41*

*computer support services for the installation, use and maintenance of software installed on personal computer networks – class 42*

34) For the sake of ease of comparison I have combined all the goods and services encompassed by the **earlier registrations** which are under consideration:

*vehicle fleet management services; information and/or advisory services relating to the aforesaid – class 35*

*vehicle repair and/or maintenance services; rental, loan and/or hire of equipment relating to the aforesaid; information and/or advisory services relating to the aforesaid – class 37*

*vehicle rental services; vehicle leasing services; vehicle towing services; vehicle breakdown recovery services; recovery of vehicles; reservation and/or booking services for or relating to vehicles; reservation services for vehicle leasing and/or rental; all included in Class 39.*

*land vehicles; vehicles, automobiles and apparatus for locomotion on land; parts and fittings for all the aforesaid goods – class 12; insurance, financial and financing services; financial valuations; all the aforesaid relating to vehicles; vehicle financing services; vehicle lease and lease-purchase financing – class 36; vehicle rental services; vehicle leasing services; vehicle*

*towing services; vehicle breakdown recovery services; recovery of vehicles; vehicle rental and leasing, and reservation services for vehicle rental and/or leasing – class 39.*

35) In his submissions Mr Lutkin referred to the test formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 282 in relation to the comparison of goods and services:

- (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.

36) Since that decision the European Court of Justice have ruled on this issue in *Canon* where it held that in relation to the assessment of the similarity of goods and/or services, that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. There is no great discrepancy between the two sets of tests recommended, however, the United Kingdom judgement does not cover the issue of goods and/or services being complementary; which was an important plank in the argument of Ms Rawlence in relation to similarity.

37) I will deal first with the following services of the application in suit: *computer software training services; computer support services for the installation, use and maintenance of software installed on personal computer networks*. I can find nothing in the specifications of the earlier registrations that is akin to the aforesaid services. The end users will be those who require assistance with computer software, none of the goods and services of the earlier registrations encompass such users. One would not substitute these services for the goods or services of the earlier registrations. Therefore I do not consider that they are in competition. The nature of the service – assistance in relation to computer software – is alien to the goods and services of the application in suit. Software related services inhabit a very different area of the market to the goods and services of the opponent. Indeed I can find no intersection in relation to any of the criteria set out in *Canon* or *British Sugar* between the respective goods and services.

**38) I, therefore, find that *computer software training services; computer support services for the installation, use and maintenance of software installed on personal computer networks* of the application in suit are neither identical nor similar to the goods and services of the earlier registrations. In relation to these services the opposition must be dismissed as it is necessary for the services to be similar for a finding of likelihood of confusion.**

39) I turn now to *software for use by car dealers for managing data on cars for sale, includes production of car data in appropriate formats for print, advertising and web publishing* of the

application in suit. Ms Rawlence argued that the respective services were similar to the goods and services of the earlier registrations, especially vehicles, as the opponent would be selling the vehicles. I think that it would be ludicrous to state that it is the selling of vehicles in not concomitant to a registration for vehicles. There would be little point in the registration if this was not the case, one has a registration for the goods in order to sell them. Consequent upon this I consider it reasonable to accept that the opponent's specification encompasses the sale of vehicles, which in turn would encompass the sale of vehicles via the Internet for instance. Indeed, the evidence of the opponent shows that he carries out such a business in the USA. However, because the opponent's trade marks encompass a trade in cars and various car related services it does not automatically follow that his goods and services are similar to those under consideration. It is important to consider the specification with care. The software is for those selling cars and the seller of a car is also, other than when the manufacturer, a purchaser of the car. The sales of cars by the opponent in the United Kingdom has been made, from the evidence, to car dealers who then, presumably, sell the cars on. In such a case the seller and purchaser of a car are inextricably intertwined. Consequently the end users of the respective goods and services are quite likely to be the same. However, this in itself proves little. One does not assume that anti-freeze is similar to a car simply because the end user is the same. In considering the end user, and avoiding an extreme form of reductionism, it is necessary to consider the use. The use is to a greater extent the true test of the user; otherwise one could reduce all goods to being used by or for humans. The use of the software is to manage dealers' sales of cars, it is a business tool. So here the user is the person seeking software to manage his business in relation to maintaining a data base and producing formats for advertising. Fundamentally the software is a business tool; it is for use in the running of a car sales business it is not actually selling cars. The thing that it sells – to the purchaser – is a way of running his business in an effective manner. Viewed from this perspective I do not see how it intersects with any of the goods or services encompassed by the earlier registrations in a meaningful way. Ms Rawlence made much reference to the complementary nature of the respective goods and services. I consider that where the complementary nature is of importance then there must be a mutually dependant relationship or a symbiotic relationship. Each must depend upon the other, like computer hardware and software. In the instant case the sale of cars is not dependant on what is essentially business management software; one can sell them without such software, it is not like the car and the tyre dependency. In a symbiotic or mutually dependant relation each part of the relationship is dependant upon the other. The software is dependant on the existence of cars to sell but software is always dependant on some exterior factor; whether it be task specific or operational software.

40) In considering this issue I think it is also a useful indicative test, although certainly not a definitive one, to consider if one would be looking in a similar area of "Yellow Pages" for the respective goods and services. In the case of the goods of the applicant one would be looking under software, computers or business services or something akin. One would not look in any similar area in relation to the goods and services of the opponent.

**41) Taking into account all the above I find that *software for use by car dealers for managing data on cars for sale, includes production of car data in appropriate formats for print, advertising and web publishing* of the application in suit is neither identical nor similar to the goods and services of the earlier registrations. In relation to these services the opposition must be dismissed as it is necessary for the services to be similar for a finding of likelihood of confusion.**

42) I turn now to the final services encompassed by the application in suit, namely: *publishing car descriptions and pictures on the Internet*. The service applied for is a publishing service. The specification does not give rights in the sale or renting of cars. It is a service that could be given via print media e.g. in a magazine for cars; although not in the instant case as the specification does not encompass this. There is nothing in the specifications of the earlier registrations that can be considered to be akin to publishing, regardless of the media employed. However, the opponent has registrations that encompass a variety of vehicle related goods and services. Goods and services that he might well advertise and make available via the Internet; from the evidence he already provides goods and services via the Internet in the USA. If he is using the Internet to promote his wares the opponent is in fact advertising. The specification of the application in suit under consideration does not encompass advertising services. Such services are appropriate to class 35 (the class heading does limit and define the services, see the decision of the Court of Appeal in *Reliance Water Controls Ltd v Altecnic Ltd* – A3/2000/3800). Consequently the applicant is not seeking cover for advertising either his own product or the products of others. Although it could be that other parties will use his electronic publishing service to advertise; just as they might advertise in a magazine or newspaper. I consider it useful not to be led astray by the electronic nature of the publishing service. It is a publishing service, the means that it uses are secondary to its purpose. Is there anything akin to a publishing service in the specifications of the earlier registrations? I do not consider that there is. The argument of the opponent appears to boil down to the fact that the publishing service relates to vehicles and his business also relates to vehicles. Is this enough to make the respective goods and services similar? The users of the respective services and goods could be the same, people wishing to trade in cars. This is as far as the respective goods and services intersect. The fact that goods and services might have the same user does not make them the same; otherwise one would end in a position of considering car wax and car batteries similar. There is a superficial similarity with certain of the goods and services encompassed by the registrations of the opponent. However, when one delves further into the nature of the services of the application in suit and the goods and services of the earlier registrations and analyses them according to the criteria of the European Court of Justice one finds that any similarity is indeed superficial and dissipates like morning mist under the rays of the sun. I do not consider that applying the criteria of *Canon*, or even those of *British Sugar*, that I could come to the conclusion that the respective goods and services are similar.

**43) I, therefore find that *publishing car descriptions and pictures on the Internet* of the application in suit is neither identical nor similar to the goods and services of the earlier registrations. In relation to these services the opposition must be dismissed as it is necessary for the services to be similar for a finding of likelihood of confusion.**

## **Conclusion**

44) In considering likelihood of confusion I have borne in mind the interdependency principle in relation to goods/services and signs as per *Canon*. However, that the respective signs are undoubtedly very similar cannot assist the opponent. The respective goods and services have to be similar. As Mr Hobbs QC, sitting at the appointed person, in *Raleigh International* (SRIS O-253-00) stated:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate

differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences."

Ms Rawlence prayed in aid to *Pfizer Ltd v Eurofood-Link (UK) Ltd* [2000] ETMR 896 in relation to the issue of similarity of goods and services. I do not consider that that case assists the opponent. The issue I have to decide is whether under the criteria set down for analysing whether goods and/or services are similar. Using these criteria I have found that they are not and so the case must fail.

45) Mr Lutkin made reference to what he considered the lack of distinctiveness of the earlier registrations. Taking into account European jurisprudence the distinctiveness of the earlier sign needs to be considered in making a global assessment. In the instant case I do not consider that anything turns upon this matter owing to the high degree of similarity of the respective signs. In this case, owing to this degree of similarity, if I had found that the respective goods and services were similar it would have been an inevitable sequitur that confusion would arise; the public would have very little to allow them to differentiate between the respective signs and the goods and services that they encompass.

46) I can well understand why the opponent launched these opposition proceedings. However, an analysis of the goods and services leads, in my mind, to the inevitable failure of the action.

**47) Consequent upon the absence of similarity of goods and services the opposition must be dismissed.**

#### **Costs**

48) Mr Lutkin asked that any award of costs should take into account the effectively duplicated evidence of Ms Rawlence and the first affidavit of Raymond T Wagner Jnr. I do not see that the consideration of the evidence of Mr Wagner would have put the applicant to any great effort; it is effectively the same as that of Ms Rawlence. The evidence of Mr Wagner was put in quite sensibly by Ms Rawlence. It militates against attacking her evidence on the basis that it is hearsay. Ms Rawlence indicated that her evidence was put in in order to meet deadlines whilst awaiting the completion of the evidence by Mr Wagner. This approach appears to me to be eminently practical and sensible. I, therefore, do not consider it appropriate to award any additional costs in relation to the first affidavit of Mr Wagner.



**49) The applicant is entitled to a contribution towards his costs and I therefore order the opponent to pay him the sum of £835. 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 08 day of April 2002**

**D.W.Landau  
For the Registrar  
the Comptroller-General**