

O/273/12

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 2572383
BY
EURO CAR PARTS LIMITED
TO REGISTER THE TRADE MARK



IN CLASSES 08, 09 AND 12
AND
IN THE MATTER OF OPPOSITION THERETO
UNDER NO 102051
BY
RENAULT S.A.S. SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE

BACKGROUND

1) Euro Car Parts Limited (“the applicant”) applied to register the following trade mark trade on 16 February 2011, for the list of goods shown below:



Class 08: workshop tools, including hand tools and hand-tool sets; tools for removing vehicle service valves.

Class 09: Jump leads; jumpstart booster pack; accumulators; accumulators for vehicles; aerials; alarms; batteries; batteries for vehicles; gasoline gauges; hands free kits for phones; distance recorders for vehicles; petrol gauges; radios; tape, cd and mp3 players; signalling equipment; steering apparatus for vehicles; electric accumulators; electric batteries and mountings therefor; electric condensers; electric circuit breakers; electric connections; electric cables; electric fuses and electric fuse boxes; electric control apparatus and instruments for motor vehicles and for engines; electrical sensors; gauges; instrument panels and clusters; electric lighters; printed electric circuits; electric relay; electric switches; speedometers; tachometers; thermostats; voltage regulators; voltmeters; testing and measuring apparatus and instruments; temperature switches, ignition lead sets; ignition amplifiers; ignition coils; lenses and glasses for lamps; highway emergency warning equipment; exhaust gas analysers; brake fluid tester; anti-theft devices; alarm apparatus and installations; parts and fittings for all the aforesaid goods.

Class 12: EGR valves; air mass sensors; parts and fittings included in class 12 for motor vehicles, vans and engines; engines; motors; transmissions and transmission shafts; hydraulic cylinders; couplings; bearings; manual and power steering apparatus; vehicle steering columns; vehicle wheels, vehicle wheel hubs; wheel trims; accessories for vehicle wheels; wheel trims; deflectors; vehicle bodies; vehicle doors; vehicle wings; vehicle panels; bumpers; bonnets; dampers; grilles; vehicle horns; vehicle mirrors; mud flaps; roof racks; shock absorbers; springs; suspensions and suspension systems; starter motors; steering wheels; steering linkages; torsion bars; tow bars; tow poles; vehicle towing equipment; windows and window winding mechanisms; windscreen wipers; brakes, brake pads and brake linings for vehicles; caps for vehicle fuel tanks; engine mountings; vehicle fuel tanks; anti-theft devices; alarm apparatus and installations; accelerator cables; cam shafts and cam shaft bearings; engine dampers, mountings, oil coolers, sumps and valves; gearboxes and gearbox mountings; gearbox filters; creepers; parts and fittings for all the aforesaid goods.

2) The application was published on 25 March 2011 in the *Trade Marks Journal*, and a notice of opposition was later filed by Renault s.a.s. société par actions simplifiée (“the opponent”). The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the applicant’s goods.

3) The opponent relies on one earlier International Registration designating the UK (IR (UK)), details of which are as follows:

Mark details	Goods relied upon
<p>IR (UK): 449974</p> <p>MASTER</p> <p>Date of International registration: 18 January 1980 Date of designating the UK: 27 November 2006</p>	<p>Class 12:</p> <p>Land motor vehicles, motor cars for transport on land, their spare parts and/or replacement parts included in class 12.</p>

4) The opponent claims that the applicant’s mark offends under Section 5(2)(b) as it is similar to the earlier mark and seeks to become registered for identical or similar goods such that there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the earlier mark.

5) The opponent’s earlier mark has completed its registration procedure and is therefore an earlier mark within the meaning of Section 6(1)(a) of the Act. Further, the registration procedure was completed less than five years before the publication of the applicant’s mark and, as such, the earlier mark is not subject to the proof of use provision (Section 6A of the Act refers).

6) The applicant subsequently filed a counterstatement denying the grounds of opposition.

7) The opponent did not file evidence in chief (instead filing written submissions which I will bear in mind and refer to, as necessary, in the decision which follows) however it did file evidence in reply to the evidence filed by the applicant. Neither party requested to be heard but both filed written submissions in lieu of a hearing. I therefore make this decision after conducting a thorough review of all the papers and giving full consideration to all submissions and evidence submitted by the parties.

Applicant's evidence

8) The applicant's evidence consists of two witness statements which are both in the name of Mr Mahesh Shah, Commercial Director of Euro Car Parts Limited. The first statement is dated 23 December 2011; the other is dated 19 January 2012 and attaches exhibit MS-1. In the second statement Mahesh Shah states that Euro Car Parts ("ECP") had a turnover of nearly £70 million in 2005, £118 million in 2007, £145 million in 2008 and over £185 million in 2009. It is not clear whether these figures relate to use of the mark applied for. It is also not clear whether the figures relate solely to the UK. Mahesh Shah refers to exhibit MS-1, being *„a print out from ECP's website showing a description of the ECP's history'.* The exhibit consists of a single page which appears to show the home page of a website. The words „euro CAR PARTS Any Part for Any Car' (stylised) are visible in the top left hand corner of the web page. The applicant's mark is not visible anywhere on the page.

9) The applicant also filed submissions which I will bear in mind but will not detail here.

Opponent's evidence in reply

10) The opponent's evidence in reply consists of a witness statement dated 19 March 2012 in the name of Mr Pierre Renucci, head of the Intellectual Property Department and the Deputy General Counsel for the opponent.

11) At paragraph 3 of the statement Mr Renucci states that the Opponent company dates back to 1898 and that the Opponent is now a well known manufacturer of vehicles and is present in 118 countries. Mr Renucci refers to exhibit PR1 as being pages taken from the Opponent's website, detailing the history of the Opponent and providing information about the Renault group.

-Exhibit PR1: The exhibit shows pages from the website www.renault.co.uk which are entitled „HISTORY OF RENAULT' and provide a history of Renault. None of the pages of this exhibit show the opponent's earlier mark.

12) At paragraph 4 of the statement Mr Renucci states that the MASTER trade mark was first used by the Opponent in the UK in 1980 in connection with vans designed for business and fleet use and that use has continued since this date such that the MASTER van is now very established in the van market. Mr Renucci refers to exhibit PR2 which he states are brochures dating back to 1998 featuring the MASTER van of the Opponent. It is not clear to what extent these brochures are distributed or to whom.

-Exhibit PR2: Pages 10-21 show a brochure detailing the specification of a „Renault Master' van. Page 10 shows the words „Renault Master' at the top of the page below which is the image of a van with the word „Master' on the registration plate. At the bottom of the page appears the word „Renault' together with a quadrilateral device element. Page 11 of the exhibit is entitled „MASTER VANS EQUIPMENT'. Page 15 of the exhibit is entitled „Renault Master Panel Vans Technical Information'. Page 21 of the exhibit shows the

words „RENAULT Master’ underneath „van of the year’. A publication date of June 1999 is visible at the bottom of the page.

- Pages 22-36 show a brochure entitled „RENAULT Van Price Guide November 2001, Manufacturers recommended Prices’. The word MASTER is visible on page 23 under the heading „The Van Range’ and on pages 24 and 28 on the registration plate of a van. Various „Master’ models are listed on pages 32, 33 and 34.

- Pages 37- 60 show a brochure entitled „Van Price Guide 5th August 2003, Manufacturers recommended prices’. The word „RENAULT’ is present on the left hand side of the front cover. Page 39 shows a contents page referring to „Master Van’ and an image of a van with its registration plate reading „MASTER’. Pages 49-54 show details of the „Master Van’ range and its core features. Page 55 lists various van accessories such as Front carpet mats, Front fog lights and Front Rubber Mats under the name „Master’.

- Pages 61-68 show a brochure (dated February 2001 which is visible on the bottom of page 68) entitled „CREATEUR D’AUTOMOBILES’ and „RENAULT Master’. Again, „Master’ is visible on the registration plate of two vans. There are various descriptions of the „Renault Master’ together with images of the exterior and interior of vans.

- Pages 69-74 show a brochure (dated September 2003 which is visible on page 71). The brochure is entitled „RENAULT Master’. Page 70 shows a van with „Master’ on the registration plate. The words „RENAULT Master’ are on the bottom of the page. Page 71 describes the „New Master’ range. Page 73 shows photographs of the interior and exterior of vans. The word „Master’ is visible on the bodywork and registration plate of a pick-up van.

- Pages 75- 80 show a brochure entitled „RENAULT Vans, WHAT THE PAPERS SAY’ (dated March 2002, visible on page 80). Page 76 refers to „the Master-International Van of the Year 1998-is still in a league of its own when it comes to big van ride and handling’. Page 78 shows the word „Master’ next to a van and provides extract quotes from „*What Van?*’ reviewing „Master’ such as *“the Master is well worth investigating”*.

13) At paragraph 5 of the statement Mr Renucci refers to exhibit PR3 which he states show a selection of press articles referring to the new model of the MASTER van.

-Exhibit PR3: Pages 82-84 show one newspaper article from the „Daily Mirror’ dated 29 January 2010 and a further two newspaper articles from the „Daily Star’ dated 12 February 2010 and 23 April 2010. All three articles detail information about Renault’s new Master range of vans. The „Daily Mirror’ article states *„The new Master is being launched on April 9 but you can order one from today’*.

-Pages 85-94 show various further articles from „Fleet Manager’(dated April 2010), „Fleet Van’ (dated 1 September 2010, 1 April 2010) and „Professional

Housebuilder & Property Developer' (dated 1 September 2011) detailing the launch of Renault's new Master range of vans and providing reviews thereof. Page 91 from „Fleet Van' dated 1 April 2010 shows a photograph of a van with 'MASTER' on the registration plate.

-Page 95 shows an article from „The People' newspaper dated 17 April 2011 which provides a review of the Master van entitled „Bow to the Master'. This falls after the filing date of the opposed application.

-Pages 97-105 show articles from „Van User' dated 1 March 2010 and 1 July 2010. The circulation of this publication is stated to be 10,000 monthly in the UK. The articles are reviews of the Renault Master. The article dated 1 July 2010 states, inter alia, „*the Master is a very pleasant motorway companion*' and „*The old Master, and its Vauxhall Movano cousin, was certainly getting pretty long in the tooth by the time it was replaced.*' The article dated 1 March 2010 is entitled „*Renault's master plan*' and states, inter alia, „*The Master line-up is growing above its traditional 3.5 tonne top weight, with models now going up to 4.5 tonnes.*' A photograph of a van with „Master' on the registration plate is also visible in the article.

-Pages 106-107 show an article from „Motor Transport' dated 11 June 2009. This publication is stated to have a circulation of 20, 376 weekly in the UK. It is entitled „Van Test: Renault Master 120.35- Master class'. It states, inter alia, „*Renault's Master is showing it's age...*' and „*...the strength of the Master lies in its handling*'.

-Pages 108-112 show an article from „Professional Electrician & Installer' dated 1 May 2010. The circulation of this publication is stated to be 67, 348 monthly in the UK. The article is entitled „Transport Update, Renault's new vans-designed with the tradesman in mind- I am the Master'. The body of the article states, inter alia, „*The Master is not a new name in the CV world, but the new model has been significantly redesigned and restyled*' and „*The Master is a fabulous cruiser*'. The article shows a photograph of a van with the word „MASTER' on the registration plate.

14) At paragraph 6 of the statement Mr Renucci states that the Opponent is the number one van seller across Europe and that the MASTER van is ranked highly in the United Kingdom in particular. He states that, in 2010, the MASTER van had a 4.12 % share of the fleet van market, ranking 7th in that class of vans.

15) At paragraph 7 of the statement Mr Renucci states that the success of vans produced and sold by the Opponent under the MASTER trade mark can be supported by the huge volume and value of sales. It is not clear if these figures relate solely to the UK, however the figures are provided in pounds sterling. He goes on to provide details of these figures which are:

Approximate annual volume and value sales under the MASTER trade mark

Year	Volume	£ million
2001	4600	£69

2002	4247	£63.7
2003	3884	£58.3
2004	5489	£82.3
2005	5597	£84
2006	5620	£84.3
2007	6207	£93.1
2008	5938	£89
2009	2954	£44.3
2010	4134	£62
2011	4736	£71

16) At paragraph 10 of the statement Mr Renucci provides what he states are approximate annual advertising and promotional expenditure on the MASTER trade mark over the last 5 years. Again, it is not clear whether these figures relate solely to the UK, although the figures have been provided in pounds sterling. The figures are as follows:

Year	£
2008	514, 000
2009	1, 268, 000
2010	2, 008, 000
2011	412, 000
2012	626, 000

17) At paragraph 11 Mr Renucci states that the MASTER trade mark is highly visible at the 180 dealerships located throughout the UK and that the trade mark is consequently very exposed to the public. Mr Renucci refers to exhibit PR4 as being a list of the dealerships in the UK.

- **Exhibit PR4:** The exhibit consists of five pages listing the names and addresses, phone numbers and fax numbers of dealers throughout the UK.

18) The opponent also filed submissions which I will bear in mind but will not detail here.

DECISION

Section 5(2)(b)

19) This section of the Act states:

- “5. (2) A trade mark shall not be registered if because –
- (a)
 - (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

20) The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. 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*,

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

(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*,

(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*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) 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*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the

distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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*.

Comparison of goods

21) In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the goods and services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of the Judgment:

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

22) Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

23) In *Gérard Meric v OHIM*, Case T-133/05, the General Court (GC) held that:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”

24) Furthermore, whether goods are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other (*Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06*) (“*Boston Scientific*”).

25) The goods to be compared are:

Opponent's goods	Applicant's goods
<p>Class 12: Land motor vehicles, motor cars for transport on land, their spare parts and/or replacement parts included in class 12.</p>	<p>Class 08: workshop tools, including hand tools and hand-tool sets; tools for removing vehicle service valves.</p> <p>Class 09: Jump leads; jumpstart booster pack; accumulators; accumulators for vehicles; aerials; alarms; batteries; batteries for vehicles; gasoline gauges; hands free kits for phones; distance recorders for vehicles; petrol gauges; radios; tape, cd and mp3 players; signalling equipment; steering apparatus for vehicles; electric accumulators; electric batteries and mountings therefor; electric condensers; electric circuit breakers; electric connections; electric cables; electric fuses and electric fuse boxes; electric control apparatus and instruments for motor vehicles and for engines; electrical sensors; gauges; instrument panels and clusters; electric lighters; printed electric circuits; electric relay; electric switches; speedometers; tachometers; thermostats; voltage regulators; voltmeters; testing and measuring apparatus and instruments; temperature switches, ignition lead sets; ignition amplifiers; ignition coils; lenses and glasses for lamps; highway emergency warning equipment; exhaust gas analysers; brake fluid tester; anti-theft devices; alarm apparatus and installations; parts and fittings for all the aforesaid goods.</p> <p>Class 12: EGR valves; air mass sensors; parts and fittings included in class 12 for motor vehicles, vans and engines; engines; motors; transmissions and transmission shafts; hydraulic cylinders; couplings; bearings; manual and power steering apparatus; vehicle steering columns; vehicle wheels, vehicle wheel hubs; wheel trims; accessories for vehicle wheels; wheel trims; deflectors; vehicle bodies; vehicle doors; vehicle wings; vehicle panels; bumpers; bonnets; dampers; grilles;</p>

	vehicle horns; vehicle mirrors; mud flaps; roof racks; shock absorbers; springs; suspensions and suspension systems; starter motors; steering wheels; steering linkages; torsion bars; tow bars; tow poles; vehicle towing equipment; windows and window winding mechanisms; windscreen wipers; brakes, brake pads and brake linings for vehicles; caps for vehicle fuel tanks; engine mountings; vehicle fuel tanks; anti-theft devices; alarm apparatus and installations; accelerator cables; cam shafts and cam shaft bearings; engine dampers, mountings, oil coolers, sumps and valves; gearboxes and gearbox mountings; gearbox filters; creepers; parts and fittings for all the aforesaid good
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26) I consider it convenient to make the comparison by addressing the goods in each class within the applicant's specification in turn, and, where appropriate and for the sake of expediency, grouping certain terms together (*Separode Trade Mark* BL O-399-10). I will compare those terms to those which I consider to be the most relevant within the opponent's specification:

Applicant's Class 08

27) I consider that the opponent's strongest case lies with its „*spare parts and/or replacement parts*’. The applicant's goods are tools which will include, inter alia, spanners, pliers, sockets and wrenches, all of which may be used by mechanics in the repair and maintenance of motor vehicles. The opponent's goods are those which include motor vehicles and parts therefore such as car bonnets, doors, cylinders, engines and valves. The purpose of the opponent's goods is to form components of vehicles which combine to enable the vehicles to function efficiently and effectively. The nature, purpose and method of use of the respective goods therefore differ and they cannot be said to be in competition with one another. However, the channels of trade may substantially converge since car parts and tools are often sold in the same retail establishments, whether on-line or traditional bricks and mortar. Also, certain tools are sometimes intended for use with a specific vehicle part in that a tool may be of a particular shape or configuration to enable easy manipulation of said part. To this end, certain of the respective goods covered by the respective broad terms may be complementary in the *Boston Scientific* sense. Taking all of the aforesaid into account, I find that there is a low to moderate degree of similarity between the respective goods.

Applicant's Class 09

Hands free kits for phones; Highway emergency warning equipment; Brake fluid tester; exhaust gas analysers; testing and measuring apparatus and instruments; Jump leads; jumpstart booster pack; parts and fittings for all the aforesaid goods.

28) These goods may be used in conjunction with vehicles but they do not form parts of vehicles. They may sometimes be sold as accessories to vehicles, however they differ in nature and purpose to actual vehicles/parts of vehicles and are not in competition with or complementary to vehicles/vehicle parts in the *Boston Scientific* sense. If there is any similarity between these goods and the opponent's class 12 goods it is only low.

Radios; tape, cd and mp3 players; signalling equipment; aerials; parts and fittings for all the aforesaid goods.

29) These are goods with a primary purpose of providing entertainment and include those which are specifically adapted to fit in vehicles such as car radios and car aerials. The opponent's class 12 goods will predominantly constitute essential components of the vehicle bodywork/essential mechanics of the vehicle and vehicles themselves. The exact nature and purpose of the respective goods differs however trade channels may sometimes converge and end users may be the same. Furthermore, the applicant's goods may be specifically adapted to fit into certain vehicles (or their parts) and accordingly the respective goods may be complementary. Taking into account all factors, I find the respective goods to be similar to a moderate degree.

Alarms; anti-theft devices; alarm apparatus and installations; Electric lighters; parts and fittings for all the aforesaid goods.

30) The opponent's '„*spare parts and/or replacement parts*' in class 12 may include '„*alarm apparatus for vehicles*'. The applicant's '„*alarm systems and anti theft devices*' in class 09 are not those intended for use in vehicles. Whilst their nature is similar in that both are used to deter thieves from acquiring someone else's property, alarms in class 12 will be purchased by drivers for use in a vehicle whereas '„*alarm systems and anti-theft devices*' in class 09 are those which will be purchased by the public/businesses for other uses such as in a commercial building/house. I do not consider the respective goods to be similar but if I am wrong it would only be very low.

31) The opponent's '„*spare parts*' may also include '„*electric lighters for vehicles*'. The applicant's '„*electric lighters*' in class 09 are not those which have been specially adapted to fit a vehicle. Lighters which have been adapted to fit vehicles are only proper to class 12. Accordingly, while the respective goods may both be used to light a cigarette they will nonetheless be sold through completely different trade channels and their methods of use and exact nature differ. I find there to be no similarity between the respective goods but if I am wrong it would only be very low.

32) In assessing the similarity between the remainder of the applicant's goods in Class 09 and the opponent's goods I bear in mind the comments of the court in *Editions Albert Rene v OHMI (MOBILIX)*-T-336/03:

“60 As to the goods in Classes 9 and 16 in respect of which registration is sought, such as ‚apparatus, instruments and installation for telecommunication‘, ‚cellular telephones‘, ‚coders and decoders‘, etc., the applicant essentially submits that they all contain essential components of the goods covered by the trade mark.

*61 The applicant’s arguments can only be rejected. It is true that computers in different forms are necessary for the proper operation of ‚instruments and installations for telecommunication‘ and ‚telephone-answering service (for temporarily absent subscribers)‘ may occasionally be supplied by the body which manufactures the necessary equipment, but that is not enough to conclude that those goods and services are similar, still less ‚very similar‘. **The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.**”*

electric circuit breakers; electric connections; electric cables; printed electric circuits; electric fuses and electric fuse boxes; electrical sensors; electric relay; electric switches; temperature switches; voltmeters; thermostats; voltage regulators; electric control apparatus and instruments for motor vehicles and for engines; lenses and glasses for lamps; parts and fittings for all the aforesaid goods.

33) To my mind, the applicant's goods listed above are all small electrical goods involved in the transmission, regulation and switching of electricity which may be used as intricate components to the opponent's class 12 goods such as 'starter motors' 'air mass sensors' and 'motors'. The functions of the opponent's class 12 goods range from those with a sensory function to those involved in enabling a motor to start. The applicant's goods may be essential to enabling the opponent's goods to perform their function. There is, therefore, a complementary relationship between the goods. However, as the court has stated, this fact alone does not suffice to reach a conclusion that the respective goods are similar. The nature and purpose of the opponent's goods and the applicant's component goods are different, however, if one considers the average consumer of the respective goods in the instant case, it is likely that trade channels of the finished goods and components of those goods are likely to converge and users may be the same. The goods at issue are those which may all be purchased and fitted by a mechanic/other specialist (and sometimes the general public) in the maintenance and repair of vehicles and on that basis, there is, in my opinion, a low to moderate degree of similarity between the respective goods.

ignition lead sets; ignition amplifiers; ignition coils; accumulators for vehicles; accumulators; electric accumulators; electric batteries and mountings therefor; electric condensers; batteries for vehicles; batteries; petrol gauges; gauges; speedometers; tachometers; gasoline gauges; distance recorders for vehicles;

instrument panels and clusters; steering apparatus for vehicles; parts and fittings for all the aforesaid goods.

34) If one extends the reasoning given in paragraph 33, it appears to me that these goods constitute more substantial component parts of the opponent's goods and are those which may be more traditionally recognised as forming component parts of vehicles. Accordingly, they may be sold through the same trade channels and used by the same consumers as the opponent's goods. I find there to be a moderate degree of similarity.

Applicant's Class 12

35) All of the applicant's goods are those which can be described as spare parts or replacement parts for motor vehicles. I therefore consider that all of the applicant's goods in class 12 are covered by the opponent's broader term *'their spare parts and/or replacement parts'* (of *'Land motor vehicles, motor cars for transport on land'*). The respective goods are identical (Meric).

Average consumer and the purchasing process

36) It is necessary to consider these matters from the perspective of the average consumer of the goods at issue (*Sabel BV v. Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods.

37) The average consumer for the opponent's *'Land motor vehicles, motor cars for transport on land'* will primarily be the general public. In the case of *'spare parts and/or replacement parts'* these are also likely to be purchased by the public, whether it be directly, or indirectly, through a garage. Where the goods are purchased indirectly, the general public may not necessarily see the goods before they are fitted however I would expect that the consumer would be informed as to the source of the products which are to be fitted. The same can be said for the applicant's goods in Classes 09 and 12. In respect of the applicant's goods in Class 08, these will be purchased by the general public and mechanics or other professionals involved in maintenance and repair work.

38) I would expect the level of attention for the opponent's *'Land motor vehicles'* and *'motor cars'* to be very high during the purchasing act since these are expensive infrequent purchases. The level of attention will be lower in relation to the opponent's *'spare parts/replacements parts'* which are likely to vary greatly in price but I would still expect, on the most part, the purchase to be a considered one affording a reasonably high level of attention to ensure that the goods have the required compatibility and functionality; the same can be said for all of the applicant's goods. I would expect the purchasing act to be primarily visual in respect of the opponent's *'Land motor vehicles'* and *'motor cars'* and for the applicant's Class 08 goods where the consumer will wish to view the aesthetics and functionality of the goods. Insofar as the opponent's *'spare parts and/or replacement parts'* and the applicant's Class 09 and 12 goods are concerned, the visual aspect may not always come into play as these goods may be selected from a catalogue by reference to a catalogue number

rather than through sight of the product itself. Finally, I also do not discount aural considerations that may play a part in respect of all of the respective goods.

Comparison of marks

39) For ease of reference, the respective marks are:

Opponent's mark	Applicant's mark
	

40) In making a comparison between the marks, I must take account of the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*). However, I must not engage in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

Distinctive and dominant components

41) The opponent's mark consists solely of the word **MASTER**. Accordingly it is this sole element which is the dominant and distinctive element of the mark.

42) The applicant's mark is a composite one consisting of the word „*master*’ followed by the word „**PRO**’. The word „*master*’ is presented in red lower case italic letters in a prominent position at the beginning of the mark and is closely followed by the word „**PRO**’. The hexagonal shape is clearly visible, and thereby not negligible, and it must therefore be taken account of in the global assessment of the likelihood of confusion. Although the „**PRO**’ element is positioned towards the end of the mark, it nonetheless strikes the eye, as a consequence of it being presented in bold upper case letters. Taking into account all of the aforesaid and, in considering the mark in its entirety, it is my conclusion that the dominant distinctive element of the applicant's mark is the combination of the two words „*master*’ and „**PRO**’ i.e. „*master* **PRO**’.

Visual Comparison

43) The opponent's mark consists exclusively of the word „**MASTER**’ in bold upper case letters. The applicant's mark also contains the same word at the beginning of its mark but it is presented in lower case italic letters in the colour red, however, colour is immaterial where the earlier mark is registered in black and white (*Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2011] FSR 1 (High Court)). The applicant's mark also contains the word „**PRO**’ in bold upper case letters which is framed by a line in the shape of a hexagon; these

elements are absent from the opponent's mark. When considering the marks as whole, I consider that the marks share a moderately high degree of visual similarity.

Aural Comparison

44) From an aural perspective the opponent's mark consists of two syllables and is likely to be pronounced as MAST-ER or MAST-AH. The applicant's mark consists of three syllables which are likely to be pronounced as MAST-ER PR-OH or MAST-AH PR-OH. The device element will not be vocalised. The applicant's mark therefore contains a third syllable which is alien to the opponent's mark however the first two syllables shared by the marks are identical. I consider there to be a moderately high degree of aural similarity between the marks.

Conceptual Comparison

45) „Master' is a very well-known English word and is defined by *Collins English Dictionary (Collins)*, inter alia, as:

“noun

1. *the man in authority, such as the head of a household, the employer of servants, or the owner of slaves or animals. Related adjective [magistral](#).*

2.

a) *a person with exceptional skill at a certain thing: a master of the violin.*

b) *(as modifier): a master thief.*

3. *(often cap) a great artist, especially an anonymous but influential artist.*

4.

a) *a person who has complete control of a situation.*

b) *an abstract thing regarded as having power or influence: they regarded fate as the master of their lives.*

5.

a) *a workman or craftsman fully qualified to practise his trade and to train others in it.*

b) *(as modifier): master carpenter.*

...

12. *a person presiding over a function, organization, or institution.*

...

16. *a machine or device that operates to control a similar one.*

...

19. *designating a device or mechanism that controls others: master switch.*

20. *main; principal: master bedroom.*

verb (transitive)

21. *to become thoroughly proficient in: to master the art of driving.”¹*

46) Clearly, there are a number of definitions of the word „master' depending on the exact context in which it is used however, I conclude that, from the perspective of the average consumer, the word is likely to suggest a person/thing who/that is skilled, controlling or superior. This word is present in both marks and is a point of

¹ [‘master’](#) 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 20 June 2012, <from <http://www.credoreference.com/entry/hcengdict/master>>

conceptual similarity. I do not consider that the device element of the hexagonal shape in the applicant's mark will immediately evoke any concept in the mind of the consumer and therefore it does not come into play in the conceptual comparison. The question then is whether the addition of the word „PRO' in the applicant's mark creates any conceptual dissonance between the respective marks.

47) *Collins* define „pro' as:

*“Informal short for professional”*²

48) *Collins* also provides other definitions for the word, including, inter alia, *„in favour of; supporting’*³. In the context of the applicant's mark I consider that it is likely to be the „professional' meaning that will be immediately evoked in the consumers mind. This is because the word „PRO' follows immediately on from the word „master'. I have already stated that „master' may evoke the concept of a person/thing who/that is skilled, controlling or superior. It is a natural instinct to read from left to right, and consequently, the idea of a skilled person will already have been placed in the consumers mind upon reading the word *‘master’* before they come to word „PRO'. As such it is likely that the perception of „PRO' may be influenced by the concept which is already at the forefront of the consumers mind and I therefore consider it likely that the consumer will perceive the word „PRO' as meaning „professional' i.e. a skilled person. The overall concept of a „master professional' appears to me to be somewhat of an unusual tautology which evokes a reasonably similar concept to that evoked by the word „master' alone. Accordingly, I do not consider that the addition of the „PRO' element in the applicant's mark creates any significant degree of conceptual dissonance between the respective marks. I therefore conclude that the marks share a moderately high degree of conceptual similarity.

49) Overall there is a moderately high degree of similarity between the marks.

Distinctive character of the earlier mark

50) I must consider the distinctive character of the opponent's mark. The more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00 [2002] ETMR 91*). I also bear in mind the comments of David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles

² [‘pro_2’](http://www.credoreference.com/entry/hcengdict/pro_2) 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 21 June 2012, <from http://www.credoreference.com/entry/hcengdict/pro_2>

³ [‘pro- 1’](http://www.credoreference.com/entry/hcengdict/pro_1/1) 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 21 June 2012, <from http://www.credoreference.com/entry/hcengdict/pro_1/1>

established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in DUONEBS should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in Reed Executive & Ors v. Reed Business Information Ltd & Ors, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

51) I have already concluded earlier in this decision that the word MASTER will suggest a person/thing who/that is skilled, controlling or superior. As such, the opponent's mark, consisting solely of the word **MASTER**, presented in a very standard font is, to my mind, allusive of goods of a high quality and furthermore, the opponent's „*spare parts and replacement parts*’ may include parts with a controlling function. Accordingly, I find that I am unable to attribute the earlier mark with anything more than a low degree of distinctive character. I must now consider whether the evidence of use filed by the opponent is sufficient to warrant a conclusion that the mark has acquired an enhanced distinctive character. The opponent states in its submissions:

“The MASTER trade mark of the Opponent is and has been well exposed throughout the United Kingdom for several years and such use has enhanced the distinctiveness of the trade mark.”

52) Upon a review of the evidence submitted by the opponent it does indicate that there has been significant use of the earlier trade mark (in slight variations of font) however the use appears to be solely in relation to vans and much of this use is in conjunction with the trade mark 'RENAULT'. That said, there are a number of references to the 'Master Van' and images of vans consisting solely of the word 'Master' on the registration plate or on the body of the van. The evidence also contains numerous press articles from UK newspapers including the 'Daily Mirror', 'Daily Star' and 'The People' and specialist publications relating to motor transport such as 'Fleet Van' which refer to the opponent's 'Master' van (again this is in conjunction with 'RENAULT'). I bear in mind that in respect of vans (and vehicles in general) the public is accustomed to the use of secondary trade marks more so than in relation to some other goods and accordingly may be more inclined to attribute trade mark origin to such marks. The opponent states that the MASTER trade mark was first used by the opponent in the United Kingdom in 1980 and is now “*very established in the van market*”. The Opponent has stated that the opponent is the number one seller of vans across Europe and that the MASTER van is ranked highly in the United Kingdom in particular. However, it is not made clear in the witness statement of Mr Renucci, whether the market share, annual volume, sales,

advertising and promotion figures provided relate solely to the UK or to the whole of Europe. I note that the opponent's submissions, which comment on the evidence already submitted by Mr Renucci, state that „*the Opponent has consistently sold an average of over 4,800 vehicles per year under the MASTER trade mark in the United Kingdom, bringing in sales of an average of £65 million per annum*’, however, as this statement is made as part of submissions, not evidence, I am unable to give it any weight. That said, as the figures provided in the evidence are in pounds sterling, I will accept that the figures do relate to the UK and, as such, they would indicate that there have been significant sales under the earlier mark in the UK under the MASTER name. Taking the evidence as a whole and making the best view of it that I can, I accept that the earlier mark has been used in the UK to the extent that it has acquired an enhanced level of distinctive character. However, this is solely in relation to vans. As a consequence, the earlier mark remains of a low degree of inherent distinctiveness for all of the goods protected by the earlier mark with the exception of vans where the distinctive character is elevated to moderate.

Likelihood of confusion

53) In determining the likelihood of confusion, I must take the global approach advocated by case law (*Sabel BV v. Puma AG*). I must also take account that the consumer rarely has opportunity to compare marks side by side but rather must rely on the imperfect picture of them that he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

54) In summary, I have found that the respective marks share a moderately high degree of visual, aural and conceptual similarity resulting in a moderately high degree of similarity overall. The degree of similarity of the applicant's class 09 goods to the goods of the opponent's varies from a very low degree of similarity through varying degrees up to a moderate degree of similarity depending on the exact goods in question. The applicant's class 08 goods share a low to moderate degree of similarity to the opponent's goods and the applicant's class 12 goods are identical to the opponent's goods. The average consumer will include the general public and specialists such as mechanics, who will, on the most part, pay a reasonably high level of attention to the purchase. In light of the unit cost of the goods, the level will be even higher in relation to the opponent's '*land motor vehicles and motor cars*'. The purchasing act will be primarily visual in respect of the opponent's '*land motor vehicles*' and '*motor cars*' and for the applicant's Class 08 goods. However, insofar as the opponent's '*spare parts and/or replacement parts*' and the applicant's Class 09 and 12 goods are concerned, the visual aspect may not always come into play as these goods may be selected from a catalogue by reference to a catalogue number rather than through sight of the product itself.

55) In its arguments against the likelihood of confusion, the applicant contends that the opponent's mark is non-distinctive. It is clear from the guidance provided by the GC in *Formula One Licensing BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-10/09* (paragraphs 45 – 47) that the validity of an earlier mark cannot be called into question. Furthermore, Section 72 of the Act states that a registration is *prima facie* evidence of validity and in the absence of any cancellation proceedings against the earlier mark it is not open to me to conclude that it is non-distinctive. Accordingly, in the absence of evidence to the

contrary, the earlier mark must be attributed with *at least* the minimum level of distinctiveness to satisfy the requirements for registration. In relation to this latter point I have noted the comments of the court in *L’Oreal SA v OHIM-C235/05 P* (CJEU) where it was held that:

“45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.

*46 In addition, it should be noted that the assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark, but that such a comparison must, on the contrary, be made by examining the marks in question, each considered as a whole (see order in Case C-3/03 P *Matratzen Concord v OHIM*, paragraph 32).”*

56) In the instant case, I have found that the opponent’s mark has a low degree of distinctive character in relation to all of the goods for which it is protected with the exception of vans where the level of distinctiveness is elevated to moderate as a consequence of the use made of it. I have also found that the dominant distinctive element of the applicant’s mark is the combination of the two words, *„master PRO’*. Whilst the respective marks share the same word *„master’*, it is my conclusion that, taking account of the additional elements within the applicant’s mark, namely the word *„PRO’* and the device element, the overall impressions created by the respective marks are sufficiently different such that the average consumer is not likely to confuse the two marks when used in relation to the goods at issue (direct confusion) or assume that the respective goods are provided under the same or linked undertaking (indirect confusion). This is so notwithstanding certain of the respective goods being identical and taking into account the factor of imperfect recollection. The opposition therefore fails in its entirety.

COSTS

57) The applicant having been successful, it is entitled to a contribution towards its costs. I take account that no hearing has taken place but that the applicant filed evidence and written submissions in lieu. I award costs on the following basis:

Preparing a statement and considering the other side’s statement	£500
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Preparing and filing evidence	£500
Written Submissions	£300
TOTAL	£1300

58) I order Renault s.a.s. société par actions simplifiée to pay Euro Car Parts Limited the sum of £1300. This sum to be paid within seven days of the expiry of the appeal period, or within seven days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 13th day of July 2012

**Beverley Jones
For the Registrar,
the Comptroller-General**