

O-338-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2635625
BY SUPACAT GROUP LIMITED
TO REGISTER THE TRADE MARK
SUPACAT
IN CLASSES 7, 12, 37, 39 & 41**

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 400406 BY
CATERPILLAR INC.**

BACKGROUND

1) On 20 September 2012 Supacat Group Limited (hereinafter the applicant) applied to register the trade mark SUPACAT in respect of the following goods and services:

In Class 7: Mechanical handling equipment; robots [machines]; parts and fittings for the aforesaid goods.

In Class 12: Wheeled military vehicles; off-road vehicles; vehicles having more than two pairs of wheels; trailers; vehicles for use in transport and storage of boats; vehicles for launching lifeboats; vehicles designed for the transport of inflammable or explosive products; boats; catamarans; mobility vehicles; invalid vehicles; remotely controlled vehicles; parts and fittings for all the aforesaid goods.

In Class 37: Services for the repair and maintenance of land vehicles and of boats; advisory and consultancy services relating to the repair and maintenance of land vehicles and of boats.

In Class 39: Marine transport services; services for the transfer of goods and personnel to offshore wind farms; advisory and consultancy services in relation to the provision of the aforesaid services.

In Class 41: Training services relating to the driving of land vehicles; training services for the skippers and crews of marine vessels; training services relating to the repair and maintenance of land vehicles and marine vessels.


2) The application was examined and accepted, and subsequently published for opposition purposes on 15 March 2013 in Trade Marks Journal No. 6983.

3) On 14 June 2013, Caterpillar Inc. (hereinafter the opponent) filed a notice of opposition. The grounds of the oppositions are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Date of application / registration	Class	Specification relied upon
CAT Priority Date: 17 October 1968 Seniority country: UK	CTM 9344755	11.12.06 13.08.10	7	Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural instruments other than hand operated; incubators for eggs; valves; spark plugs; air filters (parts of machines or engines); water regulators; oil filters; couplings; machine tools; assembly presses; starters; pumps; diggers; excavators; bulldozers; loaders; fellers; bunchers; scrapers; pavers; agricultural machines; cutting machines; compactors; skidders; filters; belts; blades; earth moving machines; road marking machines; lifting machines; agricultural apparatus and instruments; steam

			<p>rollers; forestry machines; pipe laying machines; compacting machines; buckets for earth moving machines; hydraulic jacks; welding machines and apparatus; jet engines not for land vehicles; ground engaging machines; air cleaning filters (parts of machines or engines); pavement profilers; scarifiers to break up surfaces, in particular, topsoil and pavement; motor graders; fuel/air ratio controls; fuel nozzles; water separators; fuel heaters; cultivating and harvesting machines, threshing machines, heading machines, reaping machines, binding machines, mowing machines, harrows; ploughs and rakes; draining machines; diggers (machines); aeronautical engines; agitators; air condensers; alternators; antifriction bearings for machines; anti-friction pads for machines; anti-pollution devices for motors and engines; axles for machines; ball rings for bearings; bearing brackets for machines; bearings; belt conveyors; belts for machines; belts for motors and engines; blades (parts of machines); engines and motors for boats; brake linings other than for vehicles; brake segments other than for vehicles; brake shoes other than for vehicles; brushes (parts of machines); carburetors; compressed air machines; compressed air pumps; compressors (machines); condensing installations; connecting rods for machines, motors and engines; control cables for machines, engines or motors; control mechanisms for machines, engines or motors; current generators; cutters (machines); cutting machines; cylinder heads for engines; cylinders for machines; cylinders for motors and engines; drilling bits (parts of machines); drilling heads (parts of machines); drilling machines; drills; dynamo belts; dynamo brushes; dynamos; engines, other than for land vehicles; fan belts for motors and engines; fans for motors and engines; fuel conversion apparatus for internal combustion engines; fuel economisers for motors and engines; gear boxes other than for land vehicles; gears, other than for land vehicles; grinding machines; guards (parts of machines); hammers (parts of machines); pneumatic hammers; mechanically operated hand held tools; handling apparatus for loading and unloading; hoists; holding devices for machine tools; mechanical discharging hoppers; jacks (machines); lawnmowers (machines); lift belts; lifting apparatus; loading ramps; lubricating pumps; lubricators (parts of machines); machine fly wheels; machine wheels; apparatus for machining; metal working machines; spray guns for paints; painting machines; pistons; pneumatic transporters; presses; pulleys; pumps (machines); rammers (machines); reduction gears other than for land vehicles; mechanical shovels; shaft couplings; bearings for transmission shafts; speed governors for machines, engines and motors; spraying machines; superchargers; tarring machines; threading machines; threshing machines; transmission chains and shafts, other than for land vehicles; transmissions for machines; turbines other than for land vehicles; turbocompressors; valves (parts of machines); vehicle washing installations; vulcanisation apparatus; washing apparatus; waste disposers (machines); watering machines; parts and fittings for all the aforesaid goods; agricultural machinery and earth moving machinery, namely starting motors, alternators, pistons, cylinder heads, cooling systems parts, turbochargers, lubricating systems parts, air compressors and blocks not for land vehicles.</p>
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			<p>12 Vehicles; apparatus for locomotion by land, air or water; tractors and tractor engines; haulage trucks and trailer wagons; vehicle chassis; tires for vehicle wheels; wheels; tracks for vehicles; trucks; dump trucks; land vehicles incorporating loading, compacting, pipe laying and grading apparatus; tire valves; mufflers; exhaust caps; silencers; radiators and radiator caps; hydraulic circuits and hydraulic adapters; couplings; air pumps; horns; mirrors; mudguards, mud flaps, spray guards, spray flaps; seats and seat belts; windscreen wipers and windscreen wiper blades, anti-skid apparatus; anti-skid chains; brakes for vehicles; brake linings for vehicles; fuel economisers; exhausts; hydraulic apparatus for land vehicles; vehicle covers; parts and fittings for all the aforesaid goods; parts and fittings included in class 12 for land vehicles, agricultural machinery and earth moving machinery, namely cranks, camshafts, engines, bearings, rods, liners, transmissions for land vehicles and structural, repair and replacement parts therefore; mechanical engine parts for land vehicles; starting motors, alternators, pistons, cylinder heads, cooling systems parts, turbochargers, lubricating systems parts, air compressors and blocks.</p> <p>37 Repair; installation services; engineering construction; repair and maintenance of land vehicles, agricultural, earth moving and construction machines; rental and leasing of engineering and construction machinery and equipment; building construction.</p> <p>39 Transport; freight brokerage; transport brokerage; message delivery; delivery of goods; delivery of goods by mail order; distribution of energy; freight forwarding; delivery of goods; storage of goods; hauling; provision of storage and transportation information; message delivery, ? packaging of goods; parcel delivery; vehicle rental; warehousing; travel arrangement.</p> <p>41 Providing of training; education and training services; all related to transport, engineering, agriculture and construction; education in relation to the use and operation of land vehicles, agricultural machinery and earth moving machinery; entertainment; sporting and cultural activities; all the foregoing excluding the organisation, production and performance of musicals.</p>
 <p>Colours claimed: Yellow, black, white</p>	<p>CTM 5028147</p>	<p>19.04.06 08.07.10</p>	<p>7 Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural instruments other than hand operated; incubators for eggs; valves; spark plugs; air filters (parts of machines or engines); water regulators; oil filters; couplings; machine tools; assembly presses; starters; pumps; diggers; excavators; bulldozers; loaders; fellers; bunchers; scrapers; pavers; agricultural machines; cutting machines; compactors; skidders; filters; belts; blades; earth moving machines; road marking machines; lifting machines; agricultural apparatus and instruments; steam rollers; forestry machines; pipe laying machines; compacting machines; buckets for earth moving machines; hydraulic jacks; welding machines and apparatus; jet engines; ground engaging machines; air cleaning filters (parts of machines or engines); pavement profilers; scarifiers; motor graders; fuel/air ratio controls; fuel nozzles; water separators; fuel heaters; cultivating and harvesting machines, threshing machines, heading machines, reaping machines, binding machines, mowing machines, harrows; ploughs and rakes; draining machines; diggers (machines); aeronautical engines;</p>

			<p>agitators; air condensers; alternators; antifriction bearings for machines; anti-friction pads for machines; anti-pollution devices for motors and engines; axles for machines; ball rings for bearings; bearing brackets for machines; bearings; belt conveyors; belts for machines; belts for motors and engines; blades (parts of machines); engines and motors for boats; brake linings other than for vehicles; brake segments other than for vehicles; brake shoes other than for vehicles; brushes (parts of machines); carburetors; compressed air machines; compressed air pumps; compressors (machines); condensing installations; connecting rods for machines, motors and engines; control cables for machines, engines or motors; control mechanisms for machines, engines or motors; current generators; cutters (machines); cutting machines; cylinder heads for engines; cylinders for machines; cylinders for motors and engines; drilling bits (parts of machines); drilling heads (parts of machines); drilling machines; drills; dynamo belts; dynamo brushes; dynamos; engines, other than for land vehicles; fan belts for motors and engines; fans for motors and engines; fuel conversion apparatus for internal combustion engines; fuel economisers for motors and engines; gear boxes other than for land vehicles; gears, other than for land vehicles; grinding machines; guards (parts of machines); hammers (parts of machines); pneumatic hammers; mechanically operated hand held tools; handling apparatus for loading and unloading; hoists; holding devices for machine tools; mechanical discharging hoppers; jacks (machines); lawnmowers (machines); lift belts; lifting apparatus; loading ramps; lubricating pumps; lubricators (parts of machines); machine fly wheels; machine wheels; apparatus for machining; metal working machines; spray guns for paints; painting machines; pistons; pneumatic transporters; presses; pulleys; pumps (machines); rammers (machines); reduction gears other than for land vehicles; mechanical shovels; shaft couplings; bearings for transmission shafts; speed governors for machines, engines and motors; spraying machines; superchargers; tarring machines; threading machines; threshing machines; transmission chains and shafts, other than for land vehicles; transmissions for machines; turbines other than for land vehicles; turbocompressors; valves (parts of machines); vehicle washing installations; vulcanisation apparatus; washing apparatus; waste disposers (machines); watering machines; parts and fittings for all the aforesaid goods; mechanical engine parts for land vehicles, agricultural machinery and earth moving machinery, namely starting motors, alternators, pistons, cylinder heads, cooling systems parts, turbochargers, lubricating systems parts, air compressors and blocks.</p>
		9	<p>Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking, (supervision), life saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, computer software, data processing equipment including computers; wireless sets (complete), television sets (complete), fire extinguishing apparatus; testing apparatus and instruments; cable and wire; conduits,</p>

			<p>switches, pressure switches, connectors, jump leads, fuses, circuit testers, voltage testers; fuse holders, transformers, battery testing apparatus for sale in kit form; thermostats, gauges, levelling apparatus and instruments; tape measures and rules; microscopes, tachometers; diagnostic apparatus and instruments; meters, thermometers; alarms, horns, flasher units, reflectors, mirrors, aerials, battery chargers; weighing apparatus and instruments; computer programs; computer software; couplings; petrol pumps; levels; locks; radios; batteries; starters; speed checking apparatus and instruments; battery cables; connectors for sale in kit form; electrical terminals; switches; electrical tape; water temperature regulators, probes; ammeters; battery testers, terminals, gas detectors; flow meters; cutting torches; ohmmeters; pressure measurement tools; welding apparatus; battery ground strap connectors; battery tie down connectors; conduit and wire protectors; emergency jump start apparatus, emergency jump start receptacle assemblies; voltage converters; welding apparatus; parts and fittings for all the aforesaid goods; parts and fittings included in class 9 for land vehicles, agricultural machinery and earth moving machinery namely amplifiers for wireless communications, antennas, antennas for wireless communications apparatus, audio equipment for vehicles, namely, stereos, speakers, amplifiers, equalizers, crossovers and speaker housings, batteries for vehicles, computer software, computer software that provides real-time, integrated business management intelligence by combining information from various databases and presenting it in an easy-to-understand user interface, devices for wireless radio transmission, electric control panels, electric luminescent display panels, electric relays, electronic and optical communications instruments and components, namely optical transmitters, electronic and optical communications instruments and components, namely optical receivers, electronic and optical communications instruments and components, namely digital transmitters, electronic control systems for machines, global positioning systems, laser object detectors for use on vehicles, navigation apparatus for vehicles in the nature of on-board computers, radios for vehicles, voltage regulators, voltage stabilizers, voltmeters.</p>
			<p>37 Repair; installation services; engineering construction; repair and maintenance of land vehicles, agricultural, earth moving and construction machines; rental and leasing of engineering and construction machinery and equipment; building construction.</p>
			<p>39 Transport; freight brokerage; transport brokerage; message delivery; delivery of goods; delivery of goods by mail order; distribution of energy; freight forwarding; delivery of goods; storage of goods; hauling; provision of storage and transportation information; message delivery, 'packaging of goods; parcel delivery; vehicle rental; warehousing; travel arrangement.</p>
			<p>41 Providing of training; education and training services; all related to transport, engineering, agriculture and construction; education in relation to the use and operation of land vehicles, agricultural machinery and earth moving machinery; entertainment; sporting and cultural activities.</p>

b) The opponent relies upon the two marks above and contends that the mark in suit is confusingly similar to its trade marks as they all contain the distinctive and dominant element CAT, and that the goods and services are identical, similar or complementary. The opponent contends that it has a reputation and goodwill in the UK in its marks for machinery for mining, construction, agriculture, oil and gas, demolition and scrap, forestry, defence, landscaping, marine, pipeline, power generating quarry and aggregates and waste and services relating to same. They contend that use of the mark in suit will take unfair advantage of this reputation and will diminish, dilute and blur the distinctiveness of the opponent's marks. The mark in suit therefore offends against Section 5(2)(b), 5(3) and 5(4)(a) of the Act.

4) On 27 August 2013 the applicant filed a counterstatement denying all the grounds. It did not put the opponent to Proof of Use. The applicant contends that the term SUPACAT will not cause confusion or any link with the opponent's mark. It states that its associated company, Supacat Limited, has been using its UK Trade Mark No. 1432131 continuously and on an extensive scale since its registration on 14 July 1990 and has built up a considerable reputation in this mark. The applicant states that the average consumer is sophisticated and will view the mark in suit as an indication of a link to the associated company and not to the opponent.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 16 June 2014 when the applicant was represented by Mr Brown of Messrs Alpha & Omega; the opponent was represented by Ms Newnes of Counsel instructed by Messrs Hogan Lovells International LLP.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 28 November 2013, by Lia Yasmin Young an Attorney within the Legal Services Division of Caterpillar UK Ltd a subsidiary company of the opponent, a position she has held since January 2011. She states that she is authorised to make the statement and has access to the records of the company. She also sets out the names of individuals within the Caterpillar group and companies connected to the opponent such as its distributors, who have provided information to her to include in her statement. She states that the opponent is the world's leading manufacturer of construction and mining equipment, diesel and natural gas engines, industrial gas turbines and diesel electric locomotives. It is also a major manufacturer of vehicles and machinery including those with application to the military, oil and gas, marine and power sectors and related goods. She states that at the end of 2012 the opponent group of companies had 125,000 full time employees and a turnover of US\$65.88 billion. In the UK the opponent has 11,000 employees at sixteen facilities spread throughout the UK. These manufacture a wide range of goods including machinery used in all the industries mentioned earlier. She states that these facilities export a lot of their production, e.g. the facility in Dorset produces marine engines and marine power systems for all marine segments. Ms Young provides a list, and indeed images, of the numerous vehicles produced in the UK. These range from the vast trucks used in quarries, excavators, backhoe loaders, telehandlers and all manner of tracked

and wheeled vehicles used in a vast array of industries. In addition a wide range of tools and equipment accessories are also available, such as brush-cutters, brooms, grapples, blades, mulchers, rakes, saws, shears, stump grinders and tillers. She provides the following sales figures for the UK:

Year	Machine Sales US\$ million	Engine sales US\$ million	Parts sales US\$ million
2008	260	95	85
2009	90	35	60
2010	190	55	75
2011	250	75	90
2012	240	80	80

7) Ms Young states that the opponent also provides customers with the opportunity to modify their products for military use, which she refers to as the “CAT Defense [sic] Product Line”. She states that they offer a range of multi terrain military vehicles which can be remotely controlled. Ms Young also provides the following figures which are said to be in respect of defence products sold to UK based customers. It is unclear if these have been included in the sales provided above.

Year	US\$ Million
2007	22
2008	30
2009	24
2010	15
2011	27
2012	30

8) Ms Young states that the opponent offers a maintenance and support service throughout the UK. It offers advice on its website and even organises a CAT Operator Challenge which measures operator skills. She states that according to *International Construction Earthmoving Equipment* magazine, described as a leading publication in its field, in 2011 the global market share of the opponent’s products in construction and mining was 20%. She states that the opponent issues its own magazine approximately every quarter. The opponent sponsors sports teams and attends trade shows in the UK and globally. The brand is also mentioned frequently in the UK press. She claims that the opponent has established a significant reputation and goodwill in the UK in the Cat name by virtue of its long running use. She states that the opponent has been highly innovative and has led the market with new designs and technology. The CAT brand is well known and regularly features in International brand league tables with a value of approximately US\$ 9 billion. She mentions that in many worldwide decisions the reputation of the opponent has been acknowledged. She also filed the following exhibits:

- LYY1: This would appear to be copies of website pages which show US products and also information regarding other activities such as Oil and Gas, Marine etc.


They are all dated 15 October 2013. Most of the pictures of machines show use of the device mark 5028147, although in the wording in the brochure is use of the word CAT. The machines are referred to using CAT, with a letter “R” in a circle, then a number and a brief description; e.g. CAT® 416E Backhoe Loader.

- LYY2: A copy of the 2012 Annual review.
- LYY3: A copy of a UK brochure setting out the employment and facilities in the UK. This is dated 2012.
- LYY4: This consists of brochures on certain vehicles which provide detailed specifications. They are dated between 2011 and 2013. Most of the pictures of machines show use of the device mark 5028147, although in the wording in the brochure is use of the word CAT. The machines are referred to using CAT, with a letter “R” in a circle, then a number and a brief description; e.g. Cat®C11ACERT.
- LYY7 - 9: Copies of brochures relating to military versions of its vehicles. The first is headed “Cat® Defense [sic] Product Line”. From the spelling of the word “Defence” I assume that this was intended for the USA market. The vehicles are referenced by a number and a description e.g. CS433C Soil Compactor and engines are all referenced as “Cat C” and a number. However, armoured vehicles would appear to be referenced as “Cat” and a number.
- LYY10: Copies of two press articles referencing use of Caterpillar vehicles by the UK armed forces, dated May 2006 and November 2011.
- LYY11: A copy of website pages relating to parts for machines dated 2013. This use the term “Cat®” and a descriptor e.g. “Cat® Rakes”.
- LYY12: A copy of a brochure detailing the various marine engines and systems of offer. This is dated 2012. It is headed “Caterpillar Marine Power Systems”. It then refers to “Cat Marine Power”, and “cat engines” and “Cat reliability”. The engines tend to be referred to by use of a letter and number (C32), by number and letter (3516C) or by letter / number /letter (M 25 C).
- LYY13: A brochure issued by Finning with the Cat logo device regarding marine engine overhauls. This also mentions “Cat® Marine offerings”; invites customers to register at “Cat® Marine Customer support” or purchase a “Cat® Cruise kit”.
- LYY14: A copy of the Annual Report for Caterpillar Marine Power UK Ltd for the year ending 31 December 2012, which shows that it had a turnover of approximately £1.8 million.
- LYY24: A copy of *International Construction Earthmoving Equipment* magazine dated April 2012 which states that the global market share of the opponent’s in Mining and construction machinery was approximately 20%.

- LYY 25 – 32: Copies of *CAT MAGAZINE* dated 2011 - 2013. These show details of the equipment and servicing offered by the opponent.
- LYY 39 & 40: Copies of various UK newspaper articles which mention the opponent. These are dated between 21 July 1990 and 28 October 2013. The opponent is usually referred to as Caterpillar or Cat.

APPLICANT'S EVIDENCE

9) The applicant filed a witness statement, dated 31 January 2014, by Michael Stanley Brown the applicant's Trade Mark Attorney, a position he has held since 1990. He states that the information he provides is from the records of the applicant. He states that the applicant is the proprietor of the following trade mark:

Mark	Number	Date of application / registration	Class	Specification relied upon
<p>SUPACAT</p>  <p>A series of two</p>	1432131	14.07.90 24.07.92	12	Wheeled military vehicles; off-road vehicles; vehicles having more than two pairs of wheels; trailers; parts and fittings for all the aforesaid goods; all included in Class 12.

10) The mark was registered without opposition and is still in force. Mr Brown states that the applicant and its associated companies are developers and manufacturers of special purpose high mobility vehicles, other vehicles and trailers and providers of associated services. Although the main stay product has been a six wheeled light vehicle (6x6) the applicant has developed other vehicles for military and civilian use and entered into collaborations, some of which, he states, cannot be mentioned. One that can is the development of a trailer for lifting and transporting lifeboats from the boat house into the ocean, carried out on behalf of the RNLI. The company also manufactures items such as a glider launching winch. The basic 6x6 has been adapted and fitted with a vast range of equipment to suit the needs of the customer, from handling pallets to housing mortars, and supporting rocket launchers and land speed

record attempts. They now have companies within the group dedicated to marine, exploration and aviation.

11) Mr Brown states that prior to purchase or development of a vehicle there are significant negotiations with the customer and because of this there have been no instances of confusion between that two parties. He also includes the following exhibits:

- MSB4: A letter dated 22 January 2014 from the Director of Engineering and Supply for the RNLI which states that they have been dealing with the applicant since 1996 and the opponent since approximately 1974. His organisation has never believed the two parties to be linked in any way and they have never been confused into believing that such a connection existed.
- MSB5: A letter from Mr Gulli, the General Manager of Fred Olsen Ltd which states that they have been dealing with the applicant for over 3 years developing a wave energy device for developing electricity, currently being used in Falmouth Bay. His company have been involved in commercial contracts with the opponent but have never been confused into believing that there was a connection between the two parties.
- MSB6: A letter dated 29 January 2014, jointly from Mr Lawson the Head of Combat Mobility Programmes and Mr Robies Protected Mobility Team Senior Commercial Officer from the Defence Equipment and Support division of the MOD. They state that they have had dealings with both companies and have never been confused into thinking that there was a connection between them.

OPPONENT'S EVIDENCE IN REPLY

12) The opponent filed a second witness statement, dated 2 April 2014, by Ms Young. She begins by criticising the fact that the evidence was provided by the applicant's Trade Mark Attorney instead of an officer of the company. She also points out that the earlier trade mark has a narrower specification than that of the mark in suit. She states that the applicant is "evolving" its brand and placing more emphasis on the CAT element. She states that the manner in which the applicant's earlier mark is used has altered. She provides an example of the stylised version now use on the applicant's website which is as follows:



13) Ms Young states that this is much closer to its device mark and also notes that the applicant is using the black and yellow colours of its device mark. She also states that the applicant was, until recently, selling a vehicle called a “Wildcat” (exhibit LYY53 refers). She also points out that in the applicant’s brief history of events at the company included in its evidence, the applicant refers to the Supacat 6x6 as a “Cat” on a number of occasions. She also provides the following exhibit:

- LYY54: Consists of a copy of a witness statement by Michael Halloran the Managing Director of Supacat Pty Ltd in Australia. This company is part of the applicant group of companies. The witness statement was filed before the Australian Registry and is dated December 2013. In it Mr Halloran states:

“The word “CAT” has allusions in meaning to being “stealth-like” or to grip the ground or a support surface with cat-like traction. Athletes, such as tennis player Pete Sampras, have been likened to a cat in the way that they move around a court. Co-joining this concept with “SUPA” enhances the sense of superior cat-like qualities of mobility, traction and precision of movement.”

14) Ms Young suggests that the applicant is attempting to justify its use of “CAT” or “Cat” as being a point of comparison between a quality of its products and the characteristics of a cat. She claims that in using the proper noun “Cat” the applicant is merely using the opponent’s mark.

15) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

16) The first ground of opposition is under Section 5(2)(b) which reads:

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.”

17) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

18) The opponent is relying upon its two trade marks listed in paragraph 3 above which are clearly earlier trade marks. The applicant did not put the opponent to proof of use.

19) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *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 and *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)*. In the case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

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

(g) 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;

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Distinctive character of the opponent's earlier trade marks

20) The opponent has provided evidence of use of its marks in the UK. Clearly it has a significant reputation and must benefit from enhanced distinctiveness. The registered marks are essentially "CAT" marks and although this is an abbreviation of caterpillar, as in caterpillar-tracked vehicles, it has a moderate to high level of inherent distinctiveness for the goods and services for which they are registered.

The average consumer and the nature of the purchasing process

21) I must now determine the average consumer for the goods and services of the parties. The majority of the opponent's goods and services are, broadly speaking, all centred around the provision, maintenance and training of large scale mobile machinery for use in, inter alia, mining and construction. Machines such as excavators, dump trucks and bulldozers of the type made by the opponent, are very expensive items. As

such they are not purchased without considerable thought and research, not least because their price. Similarly, parts and fittings have to be of the correct type in order to fit the vehicle and so again are not purchased without considerable thought. Training for vehicles which can be very large is also something that will be given careful consideration, and will normally be tailored to an individual machine. These days training simulators are frequently used to provide training on a specified piece of plant. However, the opponent's specification also includes a number of items which are far more mundane such as pumps, incubators for eggs and mowing machines which can be relatively cheap, purchased by the average individual and whilst not bought without any care and attention, these would not be the subject of the kind of scrutiny reserved for the opponent's better known products. In respect of all the goods and services of the opponent, initially, selection will be predominantly by eye from advertisements, the internet etc., although word of mouth recommendations may also have a part to play. Broadly speaking these are not the types of goods available off the shelf in a high street shop and are usually only available from a specialist dealer. I would expect a face to face meeting to occur with the dealer selling the vehicle and possibly a demonstration being provided, followed by discussion and negotiation. The applicant's specification appears to cover much of the same goods and services as those of the opponent. The applicant has provided sparse detail of its business so I can but conclude that the same issues that apply to the opponent's goods and services also apply to the applicant's goods and services.

Comparison of goods and services

22) For ease of reference I reproduce the relevant specifications of both parties:

Applicant's specification	Opponent's specification re 9344755
Class 7: Mechanical handling equipment; robots [machines]; parts and fittings for the aforesaid goods.	Class 7: Diggers; excavators; bulldozers; loaders; fellers; bunchers; scrapers; pavers; agricultural machines; cutting machines; compactors; skidders; earth moving machines; road marking machines; lifting machines; agricultural apparatus and instruments; steam rollers; forestry machines; pipe laying machines; compacting machines; buckets for earth moving machines; hydraulic jacks; diggers (machines); parts and fittings for all the aforesaid goods;
Class 12: Wheeled military vehicles; off-road vehicles; vehicles having more than two pairs of wheels; trailers; vehicles for use in transport and storage of boats; vehicles for launching lifeboats; vehicles designed for the transport of inflammable or explosive products; boats; catamarans;	Class 12: Vehicles; apparatus for locomotion by land, air or water; tractors and tractor engines; haulage trucks and trailer wagons; parts and fittings for all the aforesaid goods.

mobility vehicles; invalid vehicles; remotely controlled vehicles; parts and fittings for all the aforesaid goods.	
Class 37: Services for the repair and maintenance of land vehicles and of boats; advisory and consultancy services relating to the repair and maintenance of land vehicles and of boats.	Class 37: Repair; installation services; engineering construction; repair and maintenance of land vehicles, agricultural, earth moving and construction machines.
Class 39: Marine transport services; services for the transfer of goods and personnel to offshore wind farms; advisory and consultancy services in relation to the provision of the aforesaid services.	Class 39: Transport; freight brokerage; transport brokerage; delivery of goods; distribution of energy; freight forwarding; storage of goods; hauling; provision of storage and transportation information.
Class 41: Training services relating to the driving of land vehicles; training services for the skippers and crews of marine vessels; training services relating to the repair and maintenance of land vehicles and marine vessels.	Class 41: Providing of training; education and training services; all related to transport, engineering, agriculture and construction.

23) The accepted test for comparing goods and services is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods and services;
- b) The respective users of the respective goods and services;
- c) The physical nature of the goods and services;
- d) The respective trade channels through which the goods and 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 and 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 in the same or different sectors.

24) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They

should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

25) I also take into account the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

26) Utilising the above guidance it is clear that the goods and services of the two parties are almost identical. For the avoidance of doubt I shall comment briefly on each class. In Class 7 the opponent has a range of machines which meet the description of “Mechanical handling equipment”, most of which can and frequently are robotised and it also has parts and fittings. Therefore, the class 7 goods are identical.

27) Moving onto Class 12 the term “vehicles” in the opponent’s specification encompasses “Wheeled military vehicles; off-road vehicles; vehicles having more than two pairs of wheels; trailers; vehicles for use in transport and storage of boats; vehicles for launching lifeboats; vehicles designed for the transport of inflammable or explosive products; mobility vehicles; invalid vehicles; remotely controlled vehicles”. The applicant raised whether “trailers” would fall within this category. To my mind it does, however even if I were wrong it must surely be covered by “trailer wagons”. Similarly, “boats; catamarans” are encompassed by “apparatus for locomotion by water”. Again parts and fittings are included in both specifications. Therefore, the Class 12 goods are identical.

28) The services in class 37 “Services for the repair and maintenance of land vehicles;” appears in both specifications. Whilst the term “advisory and consultancy services relating to the repair and maintenance of land vehicles” does not appear in the opponent’s specification it is clearly ancillary to the provision of the actual repairs and maintenance and so at the least the opponent’s services are very similar to those of the applicant. The only point of difference between the services of the two parties would appear to be in relation to those services relating to boats. The opponent does have “repair, installation services” which must encompass the repair of boats which only leaves “the maintenance of boats and advisory and consultancy services relating to the maintenance of boats” as being outside the opponent’s services. These services must be regarded as dissimilar to those of the opponent.

29) All of the applicant's services in Class 39 are encompassed by the opponent's services, as terms such as "transport" cover all transport by whatever method and for whatever reason. Similarly, in relation to class 41 the opponent has broad terms covering training for all forms of transport which encompasses the services of the applicant.

30) At the hearing the applicant sought permission to provide a fall back specification. I agreed to this, subject to the opponent having an opportunity to provide submissions on the proposal. The applicant's fall back position is as follows with additions in italics and underlined and deletions in bold:

- Class 7: Mechanical handling equipment, *namely loading and unloading machines and cranes*; robots [machines]; parts and fittings for the aforesaid goods.
- Class 12: Class 12: Wheeled military vehicles; off-road vehicles; vehicles having more than two pairs of wheels; **trailers**; vehicles for use in transport and storage of boats; vehicles for launching lifeboats; vehicles designed for the transport of inflammable or explosive products; boats; catamarans; mobility vehicles; invalid vehicles; remotely controlled vehicles; parts and fittings for all the aforesaid goods.
- Class 37: Services for the repair and maintenance of **land vehicles** *wheeled military vehicles, armoured vehicles, mobility vehicles, invalid vehicles, remotely controlled vehicles and vehicles for launching lifeboats* and of boats; advisory and consultancy services relating to the repair and maintenance of **land vehicles** *wheeled military vehicles, armoured vehicles, mobility vehicles, invalid vehicles, remotely controlled vehicles and vehicles for launching lifeboats* and of boats.
- Class 41: Training services relating to the driving of **land vehicles** *wheeled military vehicles, armoured vehicles, mobility vehicles, invalid vehicles, remotely controlled vehicles and vehicles for launching lifeboats*; training services for the skippers and crews of marine vessels; training services relating to the repair and maintenance of **land vehicles** *wheeled military vehicles, armoured vehicles, mobility vehicles, invalid vehicles, remotely controlled vehicles and vehicles for launching lifeboats* and marine vessels.

31) Unfortunately the revised schedule does not provide any clear blue water between the specifications of the parties and the fall back position is no better than the original in terms of overlap and identity of goods and services. I shall therefore ignore it.

Comparison of trade marks

32) The opponent contends:

“20. “CAT” is a word which has no natural relation to the goods and services in respect of which the Earlier Marks are registered. It is the short form of “Caterpillar”, the famous brand and accordingly would be recognised as an abbreviation of this brand name. The few consumers who do not know the mark and CAT brand might perceive the term “CAT” as a reference to a small carnivorous animal. Neither conceptual image is descriptive in any way of the goods and services in respect of which the Earlier Marks are registered. The Earlier Marks accordingly inherently have a highly distinctive character. The Earlier Marks also have an enhanced degree of distinctiveness as a result of their use (as to which, see above, at paragraphs 9 to 11 [of the submissions] and the 1st Young WS).

21. The Opponent’s Mark wholly reproduces the word “CAT” but adds to this the word “SUPA”. “SUPA” is a misspelled version of the word “SUPER”, a commonly used laudatory term. That SUPA is a common misspelling which would be equated to the word “SUPER” has previously been recognised by the Registry: Decision O-297-10 (SUPERBUNNY Mark) at [37]; Decision O-193-10 (KANDI KLUB Mark) at [68]. Even the managing director of the Applicant’s Australian group company has, in a sworn witness statement in Australian Trade Mark proceedings, said that the term “SUPA” in the mark “SUPACAT” operates to “enhance” the conceptual image associated with the term “CAT”. Indeed, in its own evidence the Applicant refers to its products as "Cats", omitting the preceding "SUPA" descriptor.

22. The relevant public would accordingly immediately perceive the term “SUPA” in the Mark Applied For to be no more than a term laudatory of the dominant and highly distinctive term “CAT” and would accord it no or very little importance. The Mark Applied For is therefore conceptually, phonetically and visually highly similar to the Earlier Marks.”

33) To my mind the opponent’s strongest case is under its CTM 9344755 mark, this was accepted by the opponent at the hearing. The applicant sought to rely upon its earlier registered trade mark shown in paragraph 9 above. Whilst I accept that this earlier mark, a series of two, contains an identical mark in capital letters the specification is significantly different. Although it is possible under section 5(2)(b) to take into account prior use of a mark as one of the factors in determining the likelihood of confusion, the evidence provided by the applicant fails to show the scale of use, what marketing has taken place or indeed anything that could be taken into account. The opponent has criticised the evidence on account that it was filed by the applicant’s trade mark attorney instead of an officer of the applicant company and therefore carries far less weight. To my mind, I do not find anything in the applicant’s evidence which can be taken into account to show concurrent use. The opponent also referred me to the comments of the Court of Justice in Case C-120/04 Medion [2005] ECR I-8551 where it was held that:

“30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be

dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.”

34) The two marks to be considered are “SUPACAT” and “CAT”. There are clear visual and aural differences as the mark in suit consists of three syllables whereas the opponent’s mark has only one syllable. The first four letters of the mark in suit are completely different to the opponent’s mark. Obviously the last three letters of the mark in suit are identical to the opponent’s mark. The applicant’s associated company in Australia accepted in a case before the Australian Registry that “SUPA enhances the sense of superior cat-like qualities of mobility, traction and precision of movement” (paragraph 13 above). The marks must be considered to have a moderate degree of similarity.

Likelihood of confusion

35) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. The opponent clearly has a reputation in its mark. I have found that the marks are moderately similar and that with one exception in Class 37 the goods and services of the two parties are identical. I have not attached much weight to the letters from customers of the applicant as these are letters not witness statements, and it is not clear what goods and services they have or have not purchased from either party. Despite the purchasing process I have mentioned earlier in this decision it is my opinion that there is a likelihood of consumers being confused into believing that the goods and services provided by the applicant are those of the opponent or provided by some undertaking linked to them, with the exception of the services listed below:

- “The maintenance of boats and advisory and consultancy services relating to the maintenance of boats”.

36) The opposition under Section 5(2)(b) succeeds in relation to:

- All goods in Classes 7 & 12, and all services in Classes 39 and 41 and the following services in Class 37: Services for the repair of land vehicles and of boats, and maintenance of land vehicles; advisory and consultancy services relating to the repair of land vehicles and of boats, and maintenance of land vehicles.

37) At the hearing the opponent accepted that the ground of opposition under section 5(4)(a) was no stronger than the 5(2)(b) ground and would be determined by the finding under the 5(2) ground. The applicant's 5(2)(b) case was severely weakened by the absence of evidence of concurrent use, and it could not play this card in the 5(4)(a) case either which would inevitably, in this case, have followed the 5(2)(b) ground. Given this, I do not need to consider the ground of opposition under Section 5(3).

CONCLUSION

38) The opponent has been almost entirely successful in its opposition under Section 5(2)(b).

COSTS

39) As the opponent has enjoyed a large degree of success it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Expenses	£200
Preparing evidence	£500
Attending hearing	£800
TOTAL	£1800

40) I order Supacat Group Limited to pay Caterpillar Inc. the sum of £1800. 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 31st day of July 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**