

O-485-16

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1286707
DESIGNATING THE UK FOR THE MARK:**

OPALS

**IN THE NAME OF DONGYING FANGXING RUBBER CO., LTD.
FOR GOODS IN CLASS 12**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000424 BY
FENDT-CARAVAN GmbH**

BACKGROUND

1) International Registration No. 1286707 was registered with a designation of the UK on 9 December 2015 by Dongying Fangxing Rubber Co., Ltd. (“the Applicant”) for the following mark (“the contested mark”) and goods:

OPALS

Class 12: *Vehicle wheel tires; tires for vehicle wheels; pneumatic tires; automobile tires; inner tubes for pneumatic tires; bicycle tires; casings for pneumatic tires; inner tubes for bicycles, cycles; tubeless tires for bicycles, cycles; airplane tires.*

2) The application is opposed by Fendt-Caravan GmbH (“the Opponent”) under the fast track opposition procedure. The opposition, which is directed against all the goods of the contested mark, is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon the earlier EU trade mark registration no. 10337574 (“the earlier mark”) for the following mark and goods:

Opal

Class 12: *Caravans, Caravans and spare parts and accessories therefor.*

The earlier mark was applied for on 29 September 2011 and its registration process was completed on 05 March 2012. The significance of these dates is that (1) the opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the Applicant’s mark.

3) The Opponent claims that because of identity or similarity between the Applicant’s marks and goods and those of the Opponent there exists a likelihood of

confusion. The Applicant filed a counterstatement, denying the grounds of opposition.

4) Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Neither side sought leave to file evidence. Rule 62(5) (as amended) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) (“the Rules”) states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. The Opponent is represented by White & Case LLP. The Applicant is not professionally represented. The Opponent filed written submissions basically reiterating the points raised in its grounds of opposition. A hearing was neither requested nor considered necessary. I therefore give this decision after a careful review of all the papers before me.

SECTION 5(2)(b)

5) Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because – [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

6) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 or 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;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also 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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(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;

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

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

7) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

8) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services

c) The respective trade channels through which the goods or services reach the market

d) 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;

e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

9) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”), the General Court (“the GC”) stated that:

“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 fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where 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)”.

10) When it comes to understanding what terms used in specifications mean and cover, the guidance in the case-law is to the effect that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical

matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

11) The Opponent’s *Caravans and spare parts and accessories therefor* covers caravan tyres, pneumatic tyres for caravans, and their casings and inner tubes. Since these caravan parts provide a more direct comparison with the Applicant’s goods, and a stronger case for the Opponent, I shall confine my comparison to these parts rather than making a comparison with caravans as whole vehicles. Caravan tyres fall within the ambit of the Applicant’s *vehicle wheel tires; tires for vehicle wheels*; pneumatic tyres for caravans are covered by the Applicant’s *pneumatic tires*; inner tubes and casings of pneumatic tyres for caravans are covered by the Applicant’s *inner tubes for pneumatic tires; casings for pneumatic tires*; under the guidance in *Meric* there is thus identity between these respective goods.

12) In addition to goods identical to those of the Opponent, the Applicant’s *vehicle wheel tires; tires for vehicle wheels; pneumatic tires; inner tubes for pneumatic tires*;

¹*British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281

²*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

casings for pneumatic tires also cover goods intended for a range of other types of vehicle. Such goods will, however, share the basic nature, function, purpose and method of use as the caravan tyres, casings and inner tubes covered by the Applicant's specification, partaking of the same basic materials, principles of construction and method of operation in enabling vehicles to move safely, comfortably and efficiently over ground. In addition, there can be overlap in channels of trade and perhaps some degree of competition (actual or perceived by the average consumer), between tyres used for different vehicles. The above factors can apply, for example, in the comparison between the Opponent's goods and the Applicant's *automobile tires*. There is a high degree of similarity between the Opponent's goods and all the goods of the Applicant discussed in this paragraph.

13) The Applicant's specification also includes goods designated by reference to two other specific types of vehicle: cycles and aeroplanes. Bicycles tyres and parts will regularly be sold through retailers specialising in selling bicycles. When sold by retailers also retailing parts for other vehicles, or when sold online, they will be displayed in a separate area of the premises or website. There is no element of competition, or perceived competition, between cycle tyres, casings and inner tubes and the goods of the Opponent. Aeroplanes may vary in size and cost, ranging from those used commercially to small, private aircraft, including microlight aircraft. Sources of aircraft tyres may range from online suppliers to specialist suppliers and fitters. Nevertheless, *bicycle tires; inner tubes for bicycles, cycles; tubeless tires for bicycles, cycles; airplane tires* all share the same basic nature, function, purpose and method of use as the caravan tyres, casings and inner tubes covered by the Applicant's *spare parts and accessories*, and partake of the same basic materials and principles of construction. There is a reasonably high degree of similarity between *bicycle tires; inner tubes for bicycles, cycles; tubeless tires for bicycles, cycles; airplane tires* and the Opponent's *spare parts and accessories* [for caravans].

The average consumer and the purchasing process

13) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention

is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

14) The average consumer for tyres, other than motor vehicle manufacturers, is the motor vehicle user at large who will purchase tyres to replace wearing or punctured tyres, or may replace summer tyres with winter tyres and vice versa. The purchaser will be faced with a choice of different tyres for different purposes and types of vehicle. The purchaser will normally make a choice as to the brand of tyre that he or she purchases. There may be some commercial use of caravans, but the average consumer of caravan tyres will consist overwhelmingly of that part of the general motoring public which uses caravans for private leisure purposes. Some commercial motor vehicle users may fit tyres in house. In my personal experience the fitting of tyres requires specialist expertise and equipment, so the goods are purchased and fitted in a commercial garage, service centre or workshop, or by firms offering tyre-fitting services. When tyres are bought in this way, their purchase will probably involve some discussion with the retailer or fitter, and the choice of tyre may be conveyed to the fitter orally. The purchase of tyres is an intermittent activity and one that will normally be made with a reasonable degree of care owing to the need to take into account the durability, reliability, suitability for purpose and technical compatibility of the tyre. Both visual and aural considerations may play a role in the selection process.

15) The Applicant's *airplane tires* may range from those used on airliners and other commercial aeroplanes to those suitable for small, private aircraft; consumers may range accordingly from airlines, through freight operators of varying sizes, to private owners of light aircraft, including microlight aircraft. The fitting of tyres requires specialist expertise and equipment, and considerations of safety and technical compatibility will mean that the process of purchasing aircraft tyres can be expected to be a careful and educated one, involving discussion with the purchaser. Both visual and aural considerations may play a role in the selection process

16) Bicycle accessories such as tyres will normally be purchased through outlets specialising in the retail of bicycles, or online. The selection process may involve considering brochures and inspecting tyres online or in the retailer's premises. Both visual and aural considerations may play a role in the selection process. The purchase of tyres will normally be made with a reasonable degree of care owing to the need to take into account the, durability, reliability and suitability for purpose of the tyre.

Comparison of the marks

17) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would be wrong, therefore, to dissect the trade marks artificially, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

18) The marks to be compared are shown below:

The contested mark	The earlier mark
OPALS	Opal

19) The contested mark appears on the register as the word “OPALS” in block capitals. The earlier mark appears on the register as the word “Opal” in a plain font and lower case, beginning with a capital. The typographical and orthographical treatment does not play a role in either case. It is the respective words themselves which form the dominant and distinctive components of the competing marks.

20) From a visual point of view, the word of four letters which forms the earlier mark is reproduced entirely in the contested mark, the difference between the two words consisting solely of the addition of a final “s” to give the five-letter word of the contested mark. Similarly, the pronunciation of both words will be identical, except for the addition of a final “s” to the contested mark. There is a high degree of visual and aural similarity between the marks

21) “Opal” is the name of a mineral, sometimes used as a gemstone, of which the plural is the word “opals”. Some consumers of the competing products may associate the competing marks with this meaning; even bearing in mind the difference between the singular and plural forms, this gives rise to a high degree of conceptual similarity overall. Other consumers may see the words as simply invented, or perhaps as unfamiliar names, in which case there is neither conceptual similarity nor difference between them.

The distinctiveness of the earlier mark

22) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

23) I have no evidence of acquired distinctiveness to consider. This leaves the question of inherent distinctive character. I have found that some consumers may see the mark as referring to the mineral/gemstone of that name, while others may see in it simply an invented word, or perhaps an unfamiliar name. However, the

word is not descriptive or allusive of the goods of the earlier mark. It has a normal degree of inherent distinctive character.

Likelihood of Confusion

24) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

25) I have found a high degree of visual and oral similarity between the competing marks, and that some consumers will find a high degree of conceptual similarity, while for others there may be neither conceptual similarity nor conceptual difference. I have found the earlier mark to have a normal degree of distinctive character, that the overall impression of the competing marks is created by the words of which they respectively consist, and that the sole difference between the words consists in the final “s” of the Applicant’s mark. I consider that the purchasing process and attention level of the average consumer for these goods of the Opponent will tend to reduce the scope for imperfect recollection.

26) On the other hand, the fact that the letter S is used to indicate plurals, and in popular usage is often tacked on possessively to brand names (Tesco/Tescos, Cadbury/Cadburys, etc.) also tends, in my judgment, to diminish its significance as a distinguishing factor in the perception of the average consumer in this case. I have found all the goods of the Applicant’s specification to have at least a reasonably high degree of similarity with those of the Opponent. Bearing in mind the interdependency principle and my findings on the average consumer and the purchasing process, and even taking into account a reduced scope for imperfect recollection, I think it likely that many consumers may simply not consciously register the difference between the marks, and will confuse them. Consequently, I find there is a likelihood of direct confusion. Where the final “s” of the Applicant’s mark is registered, however, I do not consider that it will be perceived as indicating a

different trade origin from that of the earlier mark, but simply as a variant of the earlier mark, identifying goods that come from the same, or an economically linked undertaking. There will therefore in any event be indirect confusion. Accordingly, **the opposition succeeds in its entirety.**

SECTIONS 5 (1) and 5(2)(a)

27) In view of my finding under section 5(2)(b) it is unnecessary for me to consider the Opponent's claims under sections 5(1) and 5(2)(a).

COSTS

28) Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Fendt-Caravan GmbH has been successful and is entitled to a contribution towards its costs. The pleadings of both parties, and the written submissions of the Opponent, were simple and brief. I hereby order Dongying Fangxing Rubber Co. Ltd. to pay Fendt-Caravan GmbH the sum of £500. This sum is calculated as follows:

Opposition fee	£100
Preparing a statement and considering the other side's statement	£200
Preparing written submissions	£200

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of October 2015

Martin Boyle

For the Registrar,

The Comptroller-General