

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2160434
BY CUMMINS ENGINE COMPANY INC.
TO REGISTER A TRADE MARK
POWERCARE
IN CLASSES 7 & 12

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 49551
BY PERKINS HOLDINGS LIMITED

BACKGROUND

1) On 9 March 1998, Cummins Engine Company Inc. of 1000 Fifth Street, Columbus, Indiana, United States of America applied under the Trade Marks Act 1994 for registration of the mark POWERCARE in respect of the following goods:

In Class 7: "Internal combustion engines (not for land vehicles) in Class 7. "

And

In Class 12: "Internal combustion engines for land vehicles in Class 12."

2) On the 8 March 1999 Perkins Holdings Limited of Eastfield, Peterborough, PE1 5NA filed notice of opposition to the application, which are in summary:

a) The opponent is the proprietor of a number of UK Trade Marks and Community Trade Marks (detailed at annex A).

b) The mark applied for is similar to the earlier marks POWERPART, POWERPIC and PERKINS POWERPAK. The opponent has used the marks POWERPART and POWERPAK in the UK for many years and enjoys considerable reputation.

c) The mark applied for therefore offends against Sections 5(2), 5(3), & 5(4) of the Trade Marks Act 1994.

3) The opponent further requested that the Registrar refuse application number 2160434 in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects

4) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 31 August 2001 when the applicant was represented by Mr Farrington of Messrs Ladas & Parry, and the opponent by Mr Hume of Messrs Fitzpatrick's.

OPPONENT'S EVIDENCE

6) The opponent filed two declarations and a witness statement. Paul Stephen Edghill

provided a declaration dated 9 September 1999 and also a statement dated 12 September 2000. He does not state his profession or for whom he works. He merely states that “instructions were received from Fitzpatrick’s” the opponent’s Trade Mark Attorney. These instructions were to “undertake discrete enquiries concerning any possible use of the word “POWERCARE” in the UK and/or Europe generally” by the applicant company.

7) In his declaration of 9 September 1999, Mr Edghill states that his enquiries, in January 1999, via the internet and directly with the applicant company in the UK, USA, Italy and Germany elicited only one usage of the mark in suit. This was in a letter to shareholders in May 1997 where reference was made to a launch of a “Signature 600” diesel engine and the company’s commitment to providing its high performance fleet markets with “Powercare” customer support service. Mr Edghill also states that another US company uses the term Powercare in relation to support services but no connection could be found between this company and the applicant.

8) Mr Edghill then provides details of further enquiries carried out in September 1999 when he contacted the Powercare Account Manager in Northern Illinois, USA. This person stated that the term POWERCARE was used in the USA to describe a replacement parts service for automotive fleet customers. No use in the UK or Europe was found.

9) In his statement dated 12 September 2000 Mr Edghill describes further enquiries carried out in August 2000. He states that searches of the applicant’s internet sites and also phone calls to subsidiaries around the globe have failed to find any use of the mark in suit other than in the USA where it is used in relation to the provision of spares for engines.

10) The opponent also filed a declaration, dated 31 August 2000, by Nigel Ruffles, the Regional Marketing Manager (Aftermarket) for Perkins Engines Company a position he has held since April 1993.

11) Mr Ruffles states that the opponent and its predecessor in business have used the mark POWERPART continuously in the UK since 1 January 1980. He provides, at exhibit NR1, a declaration by Mr D B Jones dated 8 August 1991 in support of this claim. The declaration by Mr Jones states that the mark has been used mainly on goods within Classes 7 and 12 with a small proportion falling within Class 11. Sales figures for the years 1983 - 1987 inclusive are provided as are packaging materials, parts catalogues, training materials and general brochures and leaflets. All show use of the mark POWERPART.

12) Mr Ruffles states that the mark is used world wide and is not just a parts brand but is a “total product service providing technical information, logistics support and a comprehensive range of parts and kits for the repair and servicing of a wide range of internal combustion engines”. He claims that it is also used on a range of care products and accessories. He provides turnover and promotion figures for products supplied under the POWERPART brand as follows:

Year ending December	UK turnover £	UK advertising and promotion £
1994	9,300,000	n/a

1995	10,300,000	n/a
1996	9,500,000	n/a
1997	9,900,000	70,000
1998	9,000,000	85,000

13) At exhibit NR3 Mr Ruffles provides brochures and a poster which are headed by the name Perkins but also show use of the mark POWERPART. These are dated 1995 and 1999. The brochures cover the supply of engines, parts, other accessories and services.

14) At NR4 are other brochures which show the POWERPART mark used in conjunction with the Massey Ferguson brand on paints, lubricants, sealants, vehicle jacks and batteries. Another brochure for distributors shows use of the PERKINS POWER mark. Examples of packaging shows use of POWERPART as do examples of brochures for parts for engines.

15) Mr Ruffles concludes:

“Cummins Engine Company, Inc. is a major competitor of my company in the diesel engine market and its related parts and aftermarket operations. In my opinion any use by Cummins of the mark POWERCARE would be likely to lead to confusion as to the origin of the goods or services offered under the said mark. I do not believe that two diesel engine companies could use marks as closely similar as POWERPART and POWERCARE without this inevitably leading to confusion. This is especially likely because POWERPART is such a well known brand of Perkins and is specifically the brand for its care products and aftermarket and customer care services.”

APPLICANT’S EVIDENCE

16) The applicant filed a declaration, dated 13 December 2000, by Graham Farrington an employee of the applicant’s Trade Mark Attorneys. Mr Farrington provides the results of a search of marks on the UK and European Community Trade Marks Registers. In Classes 7,12 and 37 there are a number of marks registered which commence with the word POWER. However, this is of little or no relevance to the case because “state of the Register” evidence is, in principle, irrelevant: TREAT 1996 RPC 281.

17) Mr Farrington states that the prefix POWER is in common usage in the relevant field of business and the final elements of both marks (CARE and PART) have dictionary meanings. He supplies definitions of each word at exhibit GF2.

OPPONENT’S EVIDENCE IN REPLY

18) The opponent filed a statement, dated 9 March 2001, by Alasdair Hume an employee of the opponent’s Trade Mark Attorneys. Mr Hume questions the relevance of the Register evidence of the applicant. He also points out that mark should be compared in their entirety.

19) That concludes my review of the evidence. I now turn to the decision.

DECISION

20) At the hearing Mr Farrington raised a preliminary point. He contended that the opponent had not provided proof of their registrations and that the applicant was therefore uncertain as to the opposing trade marks and whether they were registered. He referred me to a Journal Notice from 1997 and a Registry decision ORADENT [unreported] which he contended showed that the onus was on the opponent to provide proof of claimed registrations. I note that the opponent has provided the registration numbers for the marks being relied upon within the original statement of grounds. I also note that in the applicant's own evidence a search of the UK Register revealed full details of the opponent's marks. The applicant could therefore not claim to be unaware of the marks being relied upon nor could there be doubt as to their validity. I therefore dismiss the point.

21) The first ground of opposition is under Section 5(2)(b) of the Act which states: -

*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 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.

22) An earlier right is defined in Section 6, the relevant parts of which state

6. - (1) In this Act an 'earlier trade mark' means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b)...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.

23) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv. v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel Bv* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

24) As is clear from the Annex to this decision the opponent is relying on a number of registrations. However, Mr Hume acknowledged that the various PERKINS POWERPAK marks were all subject to the same disclaimer of the word POWERPAK. He accepted that the opponent's strongest case was therefore under the POWERPART registrations 1175196, 1339156, 1175197 & 1339406. At the hearing Mr Farrington accepted that the opponent has the mark POWERPART registered for inter alia "parts and fittings for engines" in Classes 7 and 12. He therefore accepted that the goods were similar if not quite identical.

25) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

26) Visually the marks are both made up of two dictionary words. They share the first word POWER, but end differently (CARE and PART). They are of equal length. There is therefore

some visual similarity.

27) Phonetically the marks have common beginnings as they both start with the word POWER. The conjoined words have quite different sounds and so the two marks have different endings.

28) Mr Farrington contended that the conceptual nature of each mark was different as both consist of two dictionary words, the first of which, POWER, is “a purely descriptive term in relation to engines, because that is the whole essence of the thing.” He therefore invited me to consider and compare the last sections of the marks. Clearly I have to consider the whole of the marks.

There is a clear conceptual image in the case of the applicant’s mark. The application carries a specification for “Internal combustion engines”. The mark in suit implies caring for or looking after the output of an engine. It would clearly be descriptive if used on a lubricant, but not for the goods covered by the specification. The opponent’s mark is somewhat descriptive when it is used on “parts and fittings for engines”. The message is that these are the parts which increase or improve power or output. I do not consider there to be a conceptual similarity.

29) Internal combustion engines or parts therefore are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise considerable care in the selection. Even so allowance must be made for the notion of imperfect recollection.

30) Mr Hume contended that the opponent had a “family of marks”. In the case of *Infamous Nut Co Ltd v Percy Dalton (Holdings) Ltd*, SRIS 0-411-01, Professor Annand, acting as the Appointed Person, stated:

“Although the registrability of the applicant’s mark must be considered against each of the opponent’s marks separately, it may be possible for an opponent to argue that an element within each of his marks has acquired an enhanced distinctive character because of its use within a family of registered marks within his proprietorship.”

31) However, the various “Perkins Powerpak” marks all disclaim the word “Powerpak” and no evidence of use has been provide for these marks or the “POWERPIC” mark. All the evidence of use relates to the POWERPART marks. Also given the range of goods for which the POWERPART mark is registered the turnover figures are unexceptional given the totality of the various markets. The opponent’s reputation in its POWERPART marks can only be regarded as average and is not enhanced by the other registrations it holds. The mark is not an inherently strong mark and its penumbra of protection is limited.

32) With all of this in mind I come to the conclusion that when all factors are considered, the differences between the marks overcomes any similarities despite the similarity of the goods. In my view there was no realistic likelihood of confusion at 9 March 1998. Consequently, the opposition under Section 5(2)(b) fails.

33) I next turn to Section 5(4) which reads:

(4) *A trade mark shall not be registered if, or to the extent that, its use in the*

United Kingdom is liable to be prevented -

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

(b) *.....*

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

(5) *Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.*

34) I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

35) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions

of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been “acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed...”. The relevant date is therefore 9 March 1998, the date of the application.

36) It is clear from the opponent’s evidence that they do have goodwill in the UK. Earlier in this decision I found that the marks POWERCARE and POWERPART were not confusable and so there would not be any misrepresentation. I do not believe that members of the public would confuse the two trade marks, or believe that there was a trade connection between the users of the two marks. The opponent has filed no evidence that the trade or customers would expect POWERCARE to be economically linked to POWERPART and the onus under Section 5(4)(a) is on the opponent.

37) In my opinion use of the applicant’s trade mark would not amount to a misrepresentation resulting in the passing off of its products as those of the opponent. On this footing the opposition under Section 5(4)(a) of the Act must fail.

38) Finally, I turn to the ground of opposition under Section 5(3). Mr Hume contended that the opponent had shown significant use of the mark. I note that the turnover figures provided relate to all goods and services sold under the POWERPART mark. Given the scale of the collective markets I do not consider the opponent’s mark to have an above average reputation. I have already considered the marks when used on identical goods and found that there is no likelihood of confusion because of the dissimilarities between them. In the circumstances the opposition under Sections 5(3) fails.

39) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £635. 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 24 day of October 2001

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Mark	Number	Effective Date	Class	Specification
POWERPART	1180779	26.8.82	1	Chemical products for use in industry; chemical products included in Class 1 for use in agriculture, horticulture and forestry; fire extinguishing compositions; chemical substances for soldering; detergents for use in industrial and manufacturing processes; chemical fluids for dewatering; anti-freeze preparations; cleaning solvents, sealants and adhesive substances, all included in Class 1.
POWERPART	1339153	22.3.88	1	Chemical products for use in industry; chemical products for use in agriculture, horticulture and in forestry; fire extinguishing compositions; chemical substances for soldering; detergents for use in industrial or manufacturing processes; chemical fluids for de-watering; anti-freeze preparations; cleaning solvents; sealants and adhesive substances; all included in Class 1.
POWERPART	1180780	26.8.82	2	Paints; varnishes (other than insulating varnish); lacquers; preservatives against rust.
POWERPART	1339154	22.3.88	2	Paints; varnishes (other than insulating varnish); lacquers; preservatives against rust; all included in Class 2.
POWERPART	1180781	26.8.82	3	Cleaning preparations
POWERPART	1339155	22.3.88	3	Cleaning preparations included in Class 3.

POWERPART	1175196	19.5.82	7	Parts and fittings included in Class 7 for winches, hoists, cranes, engines, motors, compressors (superchargers) and for electric generators; but not including any of the aforesaid goods being power units or incorporating their own power source.
POWERPART	1339156	22.3.88	7	Parts and fittings included in Class 7 all for vehicles, hoists, cranes, engines, motors, compressors (superchargers) or for electric generators; but not including any of the aforesaid goods being power units or incorporating their own power source.
PERKINS POWERPAK Registration of this mark shall give no right to the exclusive use of the word "Powerpak".	1352772	23.7.88	7	Engines and transmissions, none for land vehicles; parts and fittings for all the aforesaid goods; all included in Class 7.
POWERPART	1180783	26.8.82	11	Lighting apparatus for vehicles and parts and fittings therefor included in Class 11.
POWERPART	1339405	23.3.88	11	Lighting apparatus for vehicles and parts and fittings therefor; all included in Class 11; but not including any of the aforesaid goods being power units or incorporating their own power source.
POWERPART	1175197	19.5.82	12	Parts and fittings included in Class 12 for land vehicles, pumps, engines, motors and for power transmission systems; but not including any of the aforesaid goods being power units or incorporating their own power source.

POWERPART	1339406	23.3.88	12	Parts and fittings all included in Class 12 for land vehicles; pumps, engines, motors or power transmission installations; but not including any of the aforesaid goods being power units or incorporating their own power source.
PERKINS POWERPAK Registration of this mark shall give no right to the exclusive use of the word "Powerpak".	1352773	23.7.88	12	Engines and transmissions, all for land vehicles; parts and fittings for all the aforesaid goods; all included in Class 12.
POWERPART	1180784	26.8.82	25	Articles of weatherproof clothing and articles of protective clothing (not for protection against accident or injury); coats, jackets, anoraks, trousers, T-shirts, overalls, hats, boots, shoes and slippers.
POWERPART	1339407	23.3.88	25	Articles of weatherproof clothing and articles of protective clothing (not for protection against accident or injury); coats, jackets, anoraks, trousers, T-shirts, overalls, hats, boots, shoes and slippers; all included in Class 25.
POWERPIC	1406724	29.11.89	37	Advisory services relating to the installation of power plants, engines, gearboxes, generators, pumps, motors and power plant accessories; all included in Class 37.
POWERPART	2153080	9.12.97	37	Repair, maintenance and servicing of vehicles, engines, generators and motors; repair, maintenance and servicing of parts, fittings or components for vehicles, engines, generators and motors.
PERKINS POWERPAK Registration of this mark shall give no right to the exclusive use of the word "Powerpak".	1352774	23.7.88	42	Design and development of engines and transmissions; all for land vehicles; all for others; all included in Class 42.

POWERPART	CTM 152157	1.4.96	7	Parts & fittings included in Class 7 for winches, hoists, cranes, engines, motors, compressors (superchargers) and for electric generators.
			12	Parts & fittings included in Class 12 for vehicles, pumps, engines, motors and for power transmission systems.
			37	Repair, maintenance and servicing of vehicles, engines, generators and motors; repair, maintenance and servicing of parts, fittings or components for vehicles, engines, generators and motors.