

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION No. 2471906
IN THE NAME OF RACEPARTS (UK) LIMITED**

**AND IN THE MATTER OF AN APPEAL BY THE APPLICANT
AGAINST A DECISION OF MR N. ABRAHAM DATED 30 JULY 2013**

DECISION

Background

1. On 2 November 2007, Raceparts (UK) Limited (“the Applicant”) applied under number 2471906 to register a series of 2 designations for use as trade marks in the UK in respect of the following services in Class 35:

“Retail services connected to parts and fittings for vehicles, parts and fittings for racing vehicles of all types”.

2. In Case C-418/02, *Praktiker Bau- und Heimwerkermärkte AG* [2005] I-5873 at paragraph 35, the Court of Justice of the EU explained what is covered by a retail services application:

“...all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor.”

3. Retail trade in goods (i.e., the purchase and sale transaction) is not included in such an application but instead must be the subject of an application for the goods.
4. Nevertheless, it is recognised that retail services are characterised by the goods or type of goods concerned so that to be valid, an application for retail services must specify the goods or type of goods to which those services relate (*Praktiker*, para. 50).

Series objection

5. The series of 2 trade marks applied for in Application number 2471906 was the words: RACEPARTS and RACEPARTS UK.
6. The Registry objected to the Application *inter alia* on the ground that the trade marks did not constitute a series within the meaning of Section 41(2) of the Trade Marks Act 1994.

7. In his decision, dated 30 July 2013, BL O/302/13, Mr. Abraham, the Hearing Officer acting for the Registrar, confirmed the examiner's view that the addition of the letters "UK" in trade mark 2 materially affected its identity, and distinguished it from trade mark 1. The Section 41(2) objection was therefore maintained.
8. On appeal, Mr. Brandreth of Counsel, who appeared on behalf of the Applicant, made clear that the Applicant did not challenge the decision in so far as it related to the Section 41(2) objection and that the Applicant was proceeding in this appeal *only* with the Application for RACEPARTS UK. I took this to mean (as indicated by paragraph 3 of the Grounds of Appeal) that the Applicant was requesting the Registrar to delete trade mark 1 in the series pursuant to Rule 28(5) and (6) of the Trade Marks Rules 2008, and my decision is given on this basis.

Inherent registrability

9. The Hearing Officer also confirmed the examiner's objections to the Application under Section 3(1)(c) and 3(1)(b) of the Act that the trade marks were inherently descriptive of, and consequently inherently non-distinctive for, the retail services in question.
10. Mr. Brandreth again confirmed that there was no appeal against that part of the decision, which included the following findings on the part of the Hearing Officer:

“22. It is clear from the aforementioned case law that I must determine whether, assuming notional and fair use, the marks in suit will be viewed by the average consumer as a means of directly designating essential characteristics of the goods. In identifying the average consumer, Mr Lynton stressed that the relevant consumer should not be assumed to be any and all purchasers/users of automotive parts, largely because the applicant was operating in a highly specialised area. However, it is clear from the Internet findings that general use of the term is not limited to the level of competitions at which the applicant operates. Those findings indicate that purchasers of race parts could be anyone – from those involved in amateur and semi-professional motorsport, through to enthusiasts and those simply looking to customise their machines in order to improve performance. The Internet research shows that the term 'race parts' is in common use by a wide range of UK-based suppliers of automotive parts, with terms such as 'Race Parts & Equipment', 'motorcycle road and race parts' and 'rally/race parts' all frequently being used in a manner which strongly suggests that the sign applied for is both generic and descriptive for high performance automotive parts. Examples showing this type of third party use were forwarded to the applicant with the ex parte hearing report dated 8 September 2011, and have been retained on the file.”

Acquired distinctiveness

11. Instead the appeal is against the Hearing Officer's findings under the proviso to the grounds of objection under Section 3(1)(c) and (b) of the Act to the effect that:

“... a trade mark shall not be refused registration ... if, before the date of the application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

12. The Hearing Officer’s conclusion under that proviso was that the Applicant’s evidence failed to demonstrate that either of the trade marks in suit – RACEPARTS or RACEPARTS UK – had acquired distinctiveness through use among the relevant public by the application date.

The Applicant’s evidence

13. During the course of the examination proceedings, the Applicant changed its representative several times. Each representative filed evidence, not always in the traditional form, in support of the Application at the IPO.
14. Dr. Trott, who appeared at the appeal hearing for the Registrar, supplied me with a useful table summarising the materials on file and the sequence in which they were submitted:

7 August & 25 October 2008	Witness Statement & Supplemental Witness Statement of Peter Bloore + Exhibits JB1 – 10
5 May 2009	Letter from Lynton Foster describing the history of the Applicant company
31 December 2009	Letter from Lynton Foster with further evidence
	Various testimonials: demon tweeks, Virgin, Lotus, Autosport
	Further evidence

15. As the Hearing Officer noted, there were few instances in the evidence showing either RACEPARTS or RACEPARTS UK in use.
16. Rather most of the evidence, comprising advertisements in motor car and motor sport magazines, catalogues, exhibition stands, stickers/letterheads/invoices and web pages displayed the signs RACE PARTS (UK) LTD or RACEPARTS (UK) LTD often accompanied by a distinctive “rp dot” logo as shown on the sample sticker below:



17. Dr. Trott took me to an early example of one of the Applicant’s magazine advertisements (Motorsport News, 1980, JB2) where under the titles RACE PARTS (UK) LTD, Peter Bloore Racing and address, the goods on offer were introduced by

the phrase: “RACE PARTS and RACEWEAR”. To be fair, however, most of the Applicant’s magazine advertisements omitted those introductory words, using instead under the title RACEPARTS (UK) LTD, if anything: “Motor racing parts, spares and equipment” (e.g., Autosport, 8 December 2005, JB2).

18. As for the few instances in the evidence showing uses of RACEPARTS or RACEPARTS UK before the application date (2 November 2007), the Applicant adduced first, 2 sample advertisements in motorsports now! magazines, autumn and winter 2007 (JB2). These both showed use of RACEPARTS UK, accompanied by the rp dot logo in the case of the autumn 2007 advertisement. The winter 2007 advertisement showed use of RACEPARTS UK over pictures of what appeared to be race parts.
19. The Applicant submitted copies of 4 further magazine advertisements appearing after the application date, in Motorsport News, 12 December 2007 and Autosport, 14 February 2008 (JB2) (the same as in motorsports now!, winter 2007), and Autosport, 24 January 2008 and 22 January 2009 (Lynton Foster). The latter 2 advertisements showed use of RACEPARTS, the first in the classified section under “Spares & Accessories”, the second also in the classified section under “Engineering”, followed by “Motor Sport Spares and Equipment” and the Applicant’s product trade mark RACETECH.
20. Second, the Applicant adduced a copy picture of racing car with “raceparts UK” on its bonnet. The picture had been taken in 1978 and was included in an editorial about the history of Reynard racing cars (JB1).
21. Third, the Applicant submitted its sample catalogues spanning the years 2000 – 2008 (JB4 and Further evidence). These catalogues all bore the cover title RACEPARTS (UK) LTD CATALOGUE or RACEPARTS (UK) LTD MOTORSPORT CATALOGUE usually with the rp dot logo. Pages 1 of the catalogues stated: “Raceparts has been supplying parts World-wide for over [25 - 35 years] from our Wallingford base”; the 2007/2008 catalogues added the sentence: “Raceparts prides itself on its friendly, personal, efficient and helpful service”.
22. Fourth, the Applicant exhibited copies of historical web pages from its website www.raceparts.co.uk for the years 1999 - 2007. These were headed with the banner rp dot logo RACEPARTS [U.K.] LTD. On the exhibited copy web pages, the sign rp dot logo RACEPARTS introduced the text: “The original motorsport supply company ...” whilst opposite that, the sign RACETECH led into the text: “Our Racetech range of products ...”
23. As I said, the overwhelming majority of uses shown in the Applicant’s evidence were of the sign RACEPARTS (UK) LTD often accompanied by the rp dot logo.
24. The Hearing Officer held that the evidenced uses of RACEPARTS (UK) LTD (whether or not that sign was distinctive) did not assist the Applicant in establishing acquired distinctiveness through use for RACEPARTS or RACEPARTS UK. In his view, the primary question was whether a significant proportion of the relevant public had been exposed to the signs RACEPARTS/RACEPARTS UK to the extent that those signs would be perceived as denoting trade origin rather than any characteristic

of the services applied for. The uses of RACEPARTS (UK) LTD did not enable that question to be determined by the Registrar because RACEPARTS (UK) LTD was a different sign to those applied for.

25. Further the trade testimonials filed by the Applicant in support of its claim for acquired distinctiveness of RACEPARTS and RACEPARTS UK were representative of only a small section of the relevant public (“the upper echelons of competitive motorsport”) for the retail services claimed. They did not establish therefore that either RACEPARTS or RACEPARTS UK had acquired distinctive character through use among a significant proportion of the public in question.

Grounds of appeal

26. The first ground of appeal was that the Hearing Officer erred in not finding that use of RACEPARTS (UK) LTD included also use of a component part of it, namely RACEPARTS UK.
27. The Applicant contended that the Hearing Officer’s alleged acknowledgement that the evidence showed: “the applicant has made longstanding use of the sign (around 30 years) and both the turnover figures and marketing spend are both [sic] fairly impressive” was inconsistent with his conclusion that the Applicant had failed to prove acquired distinctiveness in RACEPARTS UK.
28. I agree that at first blush these statements appear contradictory. However, not when judged in context because it is plain that the Hearing Officer was, in connection with the former, merely discussing the merits or otherwise of the Applicant’s evidence:

“33. On the issue of use, the evidence has clear shortcomings. In its favour, the first Witness Statement confirmed that the applicant has made longstanding use of the sign (around 30 years), and both the turnover figures and marketing spend are both fairly impressive. However, of all the exhibits submitted, I could find only three instances where the marks as filed (either or both) were being used ...”

29. Dr. Trott confirmed that the Registrar’s position was as follows: whilst the Registrar accepted that the Applicant enjoyed goodwill in the UK, the indications and extent of that goodwill were uncertain. Furthermore, since the Applicant had not provided evidence as to the size of the market for vehicle race parts and fittings, the Registrar did not necessarily adhere to the Hearing Officer’s impression that the turnover and marketing spend of the Applicant were impressive. To the contrary, Dr. Trott estimated that the overall retail market in parts and fittings for racing vehicles of all types would be lucrative and large.

Use as part of a mark

30. I accept for present purposes only that a sign can acquire distinctiveness from use as part of mark or in conjunction with a mark, whether that mark is registered or unregistered. The decisions relied on by the Applicant were rulings of the Court of Justice of the EU (“CJEU”) where the other mark was a registered trade mark, Case C-12/12, *Colloseum Holding AG v. Levi Strauss & Co.*, 18 April 2013, Case C-

353/03, *Société des produits Nestlé SA v. Mars UK Ltd* [2005] ECR I-6135 and Case C-252/12, *Specsavers International Healthcare Ltd v. Asda Stores Ltd*, 18 July 2013¹.

31. In *Specsavers*, the CJEU summarised the position thus:

“23. That distinctive character of a registered trade mark may be the result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking ...”

32. However, not all uses of a mark will result in an element or elements of it acquiring distinctive character. It all depends on the circumstances of the particular case. As the CJEU put it in *Colloseum* at paragraph 28:

“... the fundamental condition is that, as a consequence of that use, the sign for which registration as a trade mark is sought may serve to identify, in the minds of the relevant class of persons, the goods [or services] to which it relates as originating from a particular undertaking.”

33. Thus the correct question in this case was not whether RACEPARTS (UK) LTD had acquired distinctive character through use for retail services connected to parts and fittings for racing vehicles but whether, as a result of the use of RACEPARTS (UK) LTD, (on appeal) RACEPARTS UK had acquired distinctive character for those services. Essentially, I think that this was the question addressed by the Hearing Officer although not perhaps in those terms.

34. Mr. Brandreth likened this case to “McDonald’s”, “Mattel” or “John Lewis”. I disagree.

35. The words RACEPARTS UK are descriptive and generic for the goods which are the subject of the retail services applied for and the geographical origin of those goods and/or services respectively. They therefore characterise the retail services applied for, which is of course not true of either “McDonald’s”, “Mattel” or “John Lewis”.

36. I agree with the Applicant that generally speaking the word “Ltd” is a non-distinctive addition to a sign². However here, because of the descriptive and generic nature of the words RACEPARTS UK, in my view the word “Ltd” individualises the designation RACEPARTS (UK) LTD³ which is not true of the words RACEPARTS UK alone.

¹ I did not receive full argument on whether these rulings were also applicable to the situation where the other mark was unregistered (although Case C-553/11, *Bernhard Rintisch v. Klaus Eder*, 25 October 2012, suggests they would be). As far as I was aware, RACEPARTS (UK) LTD was not covered by any relevant trade mark registration.

² Mr. Brandreth relied on *Hotel Cipriani Srl v. Cipriani (Grosvenor Street) Limited* [2008] EWHC 3032 but again there is a clear difference between “Cipriani” and RACEPARTS UK in the present context.

³ Arguably giving it some degree of distinctive character.

37. In my judgment therefore, the Hearing Officer did not err in treating RACEPARTS (UK) LTD as a different mark. Like the Hearing Officer, I am not satisfied on the evidence of use before me (putting to one side for the moment the testimonials), that the Applicant has succeeded in establishing that RACEPARTS UK would be perceived by the relevant public as an indication of origin of the retail services concerned, rather than simply a generic or descriptive indication of the goods themselves (the subject of the retail services) and the territory of their provenance or availability.

Testimonial evidence

38. The second ground for appeal was that the Hearing Officer failed to give proper recognition to the testimonial evidence filed by the Applicant in the overall assessment of acquired distinctiveness.
39. The Applicant contended that the testimonials established that the relevant public perceived RACEPARTS UK as a designation of origin.
40. There were 2 sets of testimonials:
- (1) 4 letters addressed to the UK IPO from a former racing car driver and 3 race engineers respectively (Lynton Foster)
 - (2) 2 “to whom it may concern” letters from the Procurement Manager of Marussia Virgin Racing and the Senior Buyer of Lotus respectively, a “to whom it may concern” letter from the Production Director of demon tweeks Direct, a competitor of the Applicant and a letter addressed to the UK IPO from the Sales Manager of Autosport magazine (Further evidence).
41. As the Hearing Officer noted, all but the last 2 testimonials were from persons connected to the top end of motor car racing chiefly F1. Further, for the purposes of this appeal, all spoke to RACEPARTS, not RACEPARTS UK.
42. Dr. Trott confirmed that the Registrar’s objection to the value to be placed on these testimonials was that they derived from a small section of the industry in vehicle race parts and fittings, which was vast. The relevant consumers spanned not only professionals and amateurs involved in racing, but also enthusiasts wishing to customise their vehicles. Dr. Trott enumerated various different types of racing events. Further, the Applicant’s retail services specification covered parts and fittings for all types of racing vehicles.
43. Mr. Brandreth pointed to the testimonials of demon tweeks and Autosport as providing evidence of reach and recognition by a wider spread of relevant consumer.
44. I accept that demon tweeks and Autosport magazine both enjoy a wide consumer base.
45. However, in the context of the evidence as a whole, I do not consider that these testimonials from a competitor (who sells the Applicant’s own brand products) and a magazine (with whom the Applicant has advertised for many years) sufficed to

overcome the sizeable hurdle of proving acquired distinctiveness of what is acknowledged to be a sign consisting of descriptive and generic indications and inherently nothing else.

46. In an attempt to address these concerns, Mr. Brandreth indicated that the Applicant would be prepared to restrict the Application to: “Retail services connected to parts and fittings for motor racing vehicles of all types”. The possibility of limiting the specification had been canvassed below but was not pursued.
47. I do not consider that such a limitation would assist the Applicant. Although it would restrict the specification to the field of parts and fittings for *motor* propelled racing vehicles, that would still cover professionals, amateurs and enthusiasts, the different types of motor racing/motor race events enumerated by Dr. Trott, and all types of motor racing vehicles from cars and motorcycles to lawnmowers and hovercraft.

Conclusion

48. In my judgment, the Hearing Officer was entitled to decide that the Applicant had not succeeded on the evidence in establishing that RACEPARTS UK had acquired distinctive character through use for the services applied for by the relevant date.
49. The appeal fails and Application number 2471906 must be refused registration.
50. In accordance with usual practice, I make no order as to costs.

Professor Ruth Annand, 19 May 2014

Mr. Benet Brandreth of Counsel instructed by Jensen & Son appeared on behalf of the Applicant

Dr. W. J. Trott appeared on behalf of the Registrar