

O-593-15

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NO. 3065067
FOR THE TRADE MARK**

ASTON HILL

**IN CLASSES 35, 37 AND 41
BY ASTON HILL LIMITED**

AND

**THE OPPOSITION THERETO
UNDER NO. 403244
BY ASTON MARTIN LAGONDA LIMITED**

Background and pleadings

1. Aston Hill Limited (“the applicant”) applied for the trade mark ASTON HILL on 21 July 2014 for services in classes 35, 37 and 41:

Class 35: Retail services, on-line retail services and mail order retail services connected with the sale of motor vehicles and parts thereof.

Class 37: Repair, maintenance and cleaning of motor vehicles.

Class 41: Organising and hosting sporting activities relating to motor vehicles or the driving of motor vehicles; providing training in respect of the driving of motor vehicles.

2. The application was published on 15 August 2015 and was subsequently opposed by Aston Martin Lagonda Limited (“the opponent”). It bases its opposition under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) on the following services registered under its earlier Community trade mark 8367815 ASTON MARTIN:

Class 35: Advertising; marketing; publicity services; business management; business administration; office functions; retail services connected with the sale of land, water and air vehicles; apparatus for locomotion by land, air or water; engines; boats, yachts, beauty products, toiletries, machines for household use, hand tools, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, stationery, publications, leather goods, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks, tobacco products, sporting goods, kitchen utensils and equipment, household linens, artificial plants and trees, glassware, porcelain and earthenware, household paper products, laundry preparations, soaps and cleaning products, cosmetics, personal care products, pharmaceutical preparations, vitamins, nutritional supplements, gardening products and equipment, pet food and pet care products, power and hand tools, automotive goods and gasoline, household and outdoor furniture, office furniture and equipment, computers and computer peripherals, computer software and hardware, small and major appliances, compact discs and DVDs, consumer electronics, batteries, luggage, jewellery, watches, clocks, entertainment tickets, holiday ornaments and decorations, and parts and fittings for the aforesaid goods; the bringing together for the benefit of others of a variety of business, financial, real estate, insurance, telecommunication, travel, ticketing and reservation services; consultancy and information services relating to all the aforesaid.

Class 37: Building construction; repair; installation services; construction, repair and maintenance of land, water and air vehicles, engines and parts and fittings for the aforesaid goods; consultancy and information services relating to all the aforesaid.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; publishing services; Educational services, health club facilities, instruction

services, clubs, [provision of casino facilities, gaming], organization of competitions, provision of games, training and publishing services relating to automobile clubs and exhibitions; provision and operation of leisure centres, fitness centres, health clubs, spas and gymnasium facilities and services; health and aftercare advice services in connection with leisure centre, health club, fitness centre, spa and gymnasium facilities; production and distribution services in the field of sound and/or visual recordings and entertainment; music publishing services; artist management; recording studio services; information services relating to music, entertainment, games and events provided on-line from a computer database, from the Internet or any other communications network including wireless, cable or satellite; publication of data, sound, music and/or or images from the Internet; provision of data, sound, music and/or images from websites; production, preparation, presentation, distribution, and rental of television and radio programmes and films, animated films and sound and/or visual recordings; production of live entertainment features; organisation, production and presentation of quizzes, exhibitions, sporting events, shows, road shows, staged events, theatrical performances, concerts, live performances and audience participation events; provision of on-line electronic publications; electronic game services provided from a computer database, the Internet or any other communications network including wireless, cable, satellite; consultancy and information services relating to all the aforesaid.

Filing date: 16 June 2009; date registration procedure completed: 16 March 2010.

3. Under section 5(2)(b), the opponent claims that ASTON HILL is similar to ASTON MARTIN because it contains the dominant and distinctive word ASTON at the beginning of the mark. It claims the services are identical. The combination of identical services and high visual, phonetic and conceptual similarity between the marks will cause a likelihood of confusion.

4. Under section 5(3), the opponent claims:

“The Opponent’s company was founded over a hundred years ago and has a motoring and sporting heritage second to none. The name of the company was inspired by the racing exploits of one of the founders, Lionel Martin, at the Aston Hill Climb race in 1914. His success at this event helped create an automotive icon that has become synonymous with British motor manufacturing. The Aston Hill-Martin story is a fundamental part of our client’s heritage and is one that is known the world over.”

5. The opponent claims that the mark ASTON HILL will create a connection in the mind of the consumer, leading to an assumption that the services are either connected or emanate from the same or economically linked undertakings. The opponent claims that the confusion caused would allow the applicant to take unfair advantage of ASTON MARTIN and that its brand allure will be diluted and damaged. The opponent also claims that use of ASTON HILL would cause detriment to the distinctive character of ASTON MARTIN by diversion of trade, and that the attractive force of ASTON MARTIN would no longer serve to act as a guarantee of quality and good service. The opponent claims that anyone familiar with the opponent, whether as a purchaser, car enthusiast or a person with general knowledge of luxury vehicles

would be aware of the connection between Aston Martin and Aston Hill and would assume a link between the two companies because the applicant provides motoring services.

6. The opponent also opposes ASTON HILL under section 5(4)(a) of the Act, based upon its use of the sign ASTON MARTIN in the UK, from 1 January 1914, in relation to motor vehicles, car parts and accessories; retail of motor vehicles, car parts and accessories; repair, maintenance, cleaning and valeting vehicles; workshops in the field of vehicle repair and in the field of motor vehicles; training services in the field of vehicle repair and in the field of motor vehicles; organizing community sporting and cultural events; driver training. The opponent claims that ASTON MARTIN is synonymous with luxury and quality and that use of ASTON HILL will lead to misrepresentation and damage the opponent's sign and business.

7. The applicant denies that the marks are similar. It refers to Aston being an area of Birmingham and refers to the Aston Villa football team and Aston University. The applicant claims that this shows that the opponent has no exclusive rights in the word Aston.

8. Both sides filed evidence and the opponent filed written submissions. The matter came to be heard before me on 26 November 2015. Ms Iram Zaidi, of Lewis Silkin LLP, represented the opponent via video conference. Mr Michael Brown, of Alpha & Omega, represented the applicant, attending in Newport.

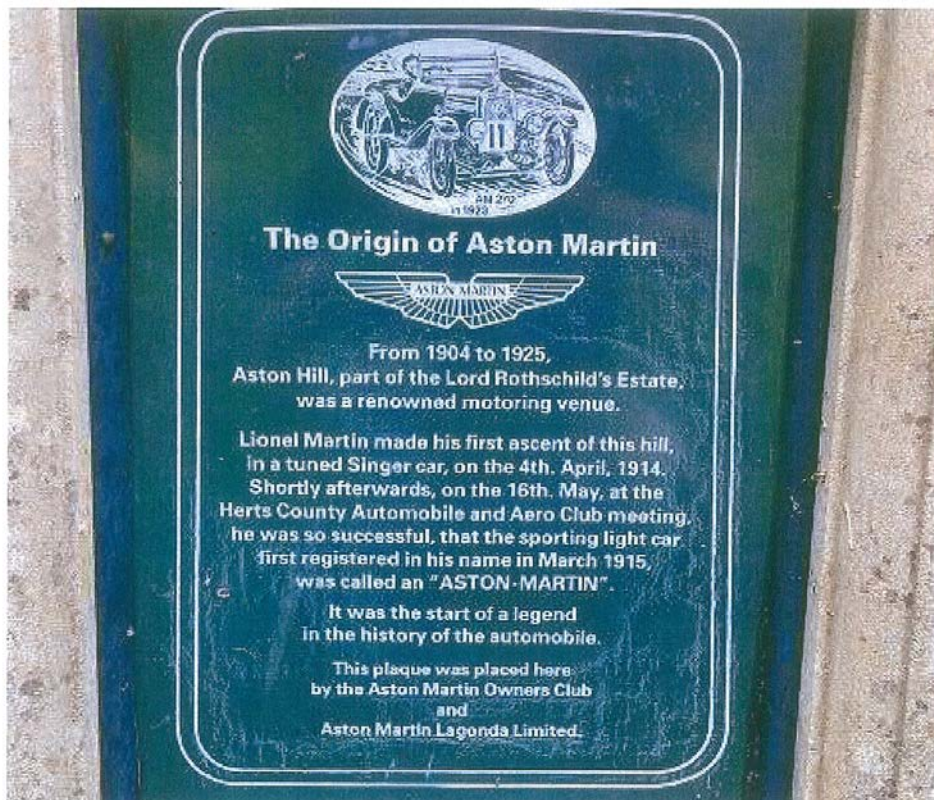
Opponent's evidence

9. Mr Duncan Hinnells has provided a witness statement, dated 23 April 2015, and supporting exhibits. Mr Hinnells is a solicitor at the opponent, responsible for all the opponent's intellectual property matters. I will not describe all of the evidence as it is a notorious fact that Aston Martin is a famous luxury car marque. The day prior to the hearing, the opponent made a request to submit a document (which was not in evidential format). The document is a print from the BBC's website about a programme available to watch on iPlayer. The programme is called 'Licence to Thrill', broadcasted recently on 7 November 2015. It is about Aston Martin cars and a particular presenter's passion for them. The document says no more than that. Ms Zaidi told me that the programme referred to Aston Hill and the connection with Lionel Martin/Aston Martin. I pointed out that the document does not mention Aston Hill. Ms Zaidi replied that the opponent would be happy to provide a copy of the programme. I refused to admit the document as a) it was not in evidential format and b) if the programme contains reference to the historical connection with Aston Hill, this is not new material. It should have been well within the opponent's capability to provide evidence over and above the evidence already provided regarding Aston Hill. Relying upon a recent television programme, broadcast after the relevant date and not even supplying the programme with the extremely late request, is unfair. It does not prove that, at the relevant date, the average consumer would have been aware of the significance of Aston Hill in the opponent's history.

10. Mr Hinnells states that¹:

- A company called Bamford & Martin was founded in 1913 by Robert Bamford and Lionel Martin.
- Messrs Bamford and Martin raced cars on the Aston Hill Climb, in Buckinghamshire.
- In 1914, Bamford & Martin was renamed Aston Martin, after one of Martin's successful runs at the Aston Hill Climb.
- Within a year, the first Aston Martin had been built.

11. Mr Hinnells states that the Aston Hill Climb is integral to the naming of the brand Aston Martin and to its history. He states that a monument has been placed at the roadside near to the top of the hill beside the Aston Hill mountain bike park car park. A picture of the monument is shown in Exhibit DH4, and its location is pictured and described in an article on a website called geograph.org.uk (Exhibit DH3). The article says that between 1904 and 1925 Aston Hill was the site of the summit of the Aston Hill Climb, "where cars were pitted against the steep slope of the Chiltern Escarpment. The hill gave the Aston Martin car the first half of its name". The monument is shown below:



¹ Supported in Exhibit DH1, from the opponent's website.

12. Mr Hinnells states that if the term 'Aston Hill' is searched in search engines, websites containing references to Aston Martin are retrieved. There are no examples of this in the evidence. Mr Hinnells states that Aston Martin enthusiasts and many members of the public with an interest in Aston Martin would be aware of this history.

13. Confidential advertising figures for the UK are given for 2009 to 2013. These are substantial. Confidential turnover figures are also provided, although these are not UK specific. These run into the many millions of pounds. A list of the 22 UK Aston Martin dealerships is provided, located throughout the UK. The dealerships sell vehicles and offer a unique personalisation service for customers.

14. Aston Martin operates specialist driver training events where learners can develop their driving skills with an Aston Martin trained instructor in an Aston Martin car. Exhibit DH6 gives details of the driving courses offered and Exhibit DH7 gives details of the performance driving course at Millbrook Proving Ground, in Bedford. These pages are printed from the opponent's website and are undated (save for the printing date of 20 April 2015). The dates of the courses in the UK (Millbrook) run from 1 March 2015 to 30 November 2015, after the relevant date in these proceedings. The cost of a course is £1,164.

15. Mr Hinnells refers to 'many independent' books about Aston Martin and says that they "may be about, among other things, the history of the company and its connection with Aston Hill...". At Exhibit DH8, a copy of the quarterly Aston Martin magazine is shown, which was launched in 2013 and is sent to current Aston Martin owners.

16. Mr Hinnells refers to the long and famous presence of Aston Martin cars in James Bond films. He states that the cars are often featured on the BBC programme *Top Gear*, and in automotive magazines such as *Autocar* and *Evo*. He refers to various celebrities who own or have publicly been connected to Aston Martin cars, such as David Beckham, the Duke and Duchess of Cambridge², and other members of the British royal family. There is also a considerable amount of social networking traffic for Aston Martin³, and inclusion in car-based computer games⁴. An Aston Martin car featured in a set of Royal Mail stamps in 2013, 'British Racing Legends'.

17. Mr Hinnells states that it is 'quite common' where a car manufacturer has a name comprised of two or more names for it to be shortened to just the first name, such as Alfa Romeo (Alfa), Mercedes Benz (Mercedes) and Rolls Royce (Rolls). He states that the opponent's name, Aston Martin Lagonda, the brand and the cars are known as Aston Martin(s). He states that "[c]onsequently, the mark Aston Martin is often referred to as Aston". Exhibit DH20 contains examples of reviews from the internet where this occurs:

An article in Classic Car magazine, 2013

² Exhibits DH10 and DH11.

³ Exhibits DH12 to DH17.

⁴ Exhibit DH18.

Articles in unidentified publications, 2011 and 2013
A car review in the *Mirror*, 2010
An article in *Evo*, 2011
An article on the *Speedhunters* website, 2013
An article on the RAC website, May 2014
An article in *The Telegraph*, June 2014

18. Mr Hinnells states that there are famous drivers with the surname Hill, for example, Graham Hill and Damon Hill, which would lead consumers to think that ASTON HILL is an Aston driven by a driver with the surname Hill. Exhibit DH22 is from the *Top Gear* website in 2002 referring to “Damon Hill and the Aston”.

19. Exhibit DH23 shows that for years, Aston Martin was the UK’s ‘coolest brand’, and is now second only to Apple. Mr Hinnells states that the opponent is extremely cautious when collaborating with other brands and partnering certain projects to maintain the aura of luxury and prestige. Partner brands include Jaeger LeCoultre, John Lobb, Louis Roederer and Bang & Olufsen.

20. The remainder of Mr Hinnells’ witness statement consists of submission, which it is not appropriate to summarise here, but which I bear in mind.

Applicant’s evidence

21. Mr Robert Salisbury, a director of the applicant, has filed a witness statement, dated 14 July 2015 and supporting exhibits. He conducted an internet search on 13 July 2015 for ASTON HILL, the first few pages of which are exhibited at RS1. The first page or so of results relates to the Aston Hill in Buckinghamshire referred to in the opponent’s evidence, but the hits are all in relation to it as a bike park location.

22. Mr Salisbury states that there are a large number of UK companies whose names begin with ASTON and exhibits some pages showing such companies⁵, printed from the register held on the Companies House website. Of course, the mere registration of a company does not mean that the public is aware of the company name. Nor does the list of trade mark registrations which begin with ASTON provided in Exhibit RS4 mean that a) that the marks are being used and b) that the public is used to distinguishing between them.

23. Mr Salisbury states that Aston is an area within Birmingham, which includes Villa Park, home of the premier league football club, Aston Villa. Exhibit RS3 comprises the Wikipedia entry for Aston.

24. Mr Salisbury provides details, in Exhibit RS5, of four garages which have names beginning with ASTON: Aston Garages (Farnborough), Aston Cross Garage (Tewkesbury), Aston Vauxhall (Melton Mowbray) and Aston Repair Depot (near Witney).

⁵ Exhibit RS2.

Decision

25. Section 5(2)(b) of the Act states that:

“(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.”

26. 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.

The principles

(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 services

27. The earlier mark is not subject to proof of its use, which means that it must be considered across the notional breadth of the services relied upon. The applicant has not commented upon whether the services are identical, similar or different.

28. The parties' respective services are shown in the table below:

Earlier mark	Application
<p><i>Class 35: Advertising; marketing; publicity services; business management; business administration; office functions; retail services connected with the sale of land, water and air vehicles; apparatus for locomotion by land, air or water; engines; boats, yachts, beauty products, toiletries, machines for household use, hand tools, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, stationery, publications, leather goods, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks, tobacco products, sporting goods, kitchen utensils</i></p>	<p><i>Class 35: Retail services, on-line retail services and mail order retail services connected with the sale of motor vehicles and parts thereof.</i></p> <p><i>Class 37: Repair, maintenance and cleaning of motor vehicles.</i></p> <p><i>Class 41: Organising and hosting sporting activities relating to motor vehicles or the driving of motor vehicles; providing training in respect of the driving of motor vehicles.</i></p>

and equipment, household linens, artificial plants and trees, glassware, porcelain and earthenware, household paper products, laundry preparations, soaps and cleaning products, cosmetics, personal care products, pharmaceutical preparations, vitamins, nutritional supplements, gardening products and equipment, pet food and pet care products, power and hand tools, automotive goods and gasoline, household and outdoor furniture, office furniture and equipment, computers and computer peripherals, computer software and hardware, small and major appliances, compact discs and DVDs, consumer electronics, batteries, luggage, jewellery, watches, clocks, entertainment tickets, holiday ornaments and decorations, and parts and fittings for the aforesaid goods; the bringing together for the benefit of others of a variety of business, financial, real estate, insurance, telecommunication, travel, ticketing and reservation services; consultancy and information services relating to all the aforesaid.

Class 37: Building construction; repair; installation services; construction, repair and maintenance of land, water and air vehicles, engines and parts and fittings for the aforesaid goods; consultancy and information services relating to all the aforesaid.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; publishing services; Educational services, health club facilities, instruction services, clubs, [provision of casino facilities, gaming], organization of competitions, provision of games, training and publishing services relating to automobile clubs and exhibitions; provision and operation of leisure centres, fitness centres, health clubs, spas and gymnasium facilities and services; health and aftercare advice

services in connection with leisure centre, health club, fitness centre, spa and gymnasium facilities; production and distribution services in the field of sound and/or visual recordings and entertainment; music publishing services; artist management; recording studio services; information services relating to music, entertainment, games and events provided on-line from a computer database, from the Internet or any other communications network including wireless, cable or satellite; publication of data, sound, music and/or or images from the Internet; provision of data, sound, music and/or images from websites; production, preparation, presentation, distribution, and rental of television and radio programmes and films, animated films and sound and/or visual recordings; production of live entertainment features; organisation, production and presentation of quizzes, exhibitions, sporting events, shows, road shows, staged events, theatrical performances, concerts, live performances and audience participation events; provision of on-line electronic publications; electronic game services provided from a computer database, the Internet or any other communications network including wireless, cable, satellite; consultancy and information services relating to all the aforesaid.

29. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the Court of Justice of the European Union (“CJEU”) stated, at paragraph 23 of its judgment:

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

30. 'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

"82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...".

31. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* ("Treat") [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

32. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"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."

33. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... 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) (IP TRANSLATOR)* [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."

34. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-33/05, the General Court ("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 trade mark application (Case T-388/00 *Institut für 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".

35. The class 35 specification of the earlier mark includes the following services:

retail services connected with the sale of land, water and air vehicles; apparatus for locomotion by land, air or water; engines.

Although some of this is separated by semi colons, the sense of the specification in class 35 is that the services are the retail of vehicles, apparatus for locomotion by land, air or water, and engines (which are parts of vehicles). These services are identical to the applicant's services in class 35.

36. The earlier mark covers *repair and maintenance of land, water and air vehicles* in Class 37. Repair and maintenance services are identical to the applicant's class 37 services. The opponent's vehicle repair and maintenance services share a moderate degree of similarity to the applicant's vehicle cleaning services, such as valeting by a dealership e.g. following a vehicle service.

37. The earlier mark covers, in class 41, *providing of training; organization of competitions; organisation, production and presentation of ...sporting events*. These are identical to the applicant's *providing training in respect of the driving of motor vehicles*, and the applicant's *organising and hosting sporting activities relating to motor vehicles or the driving of motor vehicles*.

Average consumer

38. 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*.

39. 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."

40. I will concentrate on the services which I have compared above. The average consumer for the retailing of vehicles is the general public (legally able to drive). Although the purchase of a car is an expensive, considered process, what is being considered is the selection of the retailer. The level of attention paid to the selection of a vehicle retailer will be one to which a good level of attention will be paid, to ensure a good deal, good after sales care, and a good level of safety and reliability in respect of the vehicles from which the choice to buy will be made. A good degree of attention will be paid in the case of repair and maintenance of vehicles (although less so for cleaning services) to ensure that the vehicle is safely repaired, without

damage etc. The purchase of driver training is a reasonably considered process; this includes not only the sort of driver training provided by the opponent, but the everyday driving lessons of someone who is a learner driver. The purchase of organisation and hosting of motor vehicle driving and motor sports is a niche activity which is likely to cause a relatively high degree of attention to be paid. The purchase of the services is visual, particularly in the case of researching and the examination of the retailer and the vehicles available, although I bear in mind that there will also be an aural aspect (e.g. during discussion with a dealer or vendor).

41. The opponent submits that the average consumer is someone who has an interest and knowledge of cars generally; this could be an Aston Martin owner, or someone who dreams of or aspires to ownership of an Aston Martin car. The opponent cites *Champagne Louis Roederer v J Garcia Carrion S.A. and others* [2015] EWHC 2760 (Ch) in support of this argument. However, the ‘aspirational’ consumer in that case was considered under the equivalent of section 5(3) of the Act, not 5(2). Under the latter section of the Act, it is the notional average consumer who must form part of the global assessment as to whether there is a likelihood of confusion.

Comparison of marks

42. 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 Court of Justice of the European Union 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.”

43. 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.

44. The respective marks are:

Earlier mark	Application
ASTON MARTIN	ASTON HILL

45. Each mark is comprised of two words which contribute roughly equal weight in the overall impression of the marks. Both marks begin with the word ASTON. However, the second component of each mark is completely different in looks and sound. There is no more than a medium degree of visual and aural similarity between the marks.

46. Although both marks begin with the identical component, conceptually they are dissimilar. The applicant's mark will be seen as a place name. The earlier mark will be seen either as a full name or as two surnames. This is because the immediate concept brought to mind by Martin is of a name not a place. Therefore, the consumer will make sense of its position, as the second element, as a surname and that what precedes it is a forename (Aston); or, the mark will be understood as comprising two separate surnames. In the case of Aston Hill, although Hill is a surname, the fact that Aston is uncommon as a name will cause the average consumer's immediate reaction to be that the combination of Aston Hill denotes a place, Aston qualifying Hill.

Distinctive character of the earlier marks

47. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁶ 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).”

48. Inherently, ASTON MARTIN has a good level of distinctive character for the services relied upon, which is a lengthy list. The evidence of use supports what I would, in any case, take to be a notorious fact: Aston Martin is a famous car marque. However, its evidence reveals a reputation in cars, rather than services. There is little about the driving courses (and what there is dates from after the relevant date) or evidence about repair and maintenance. Retail of cars is a service;

⁶ Case C-342/97.

what one expects to receive is the selection of goods to buy and the advice of the retailer.

49. The opponent's evidence is all focussed upon cars, but it has not relied upon its goods in Class 12 (i.e. cars)⁷. It is possible that the uniqueness and high level of fame of the mark ASTON MARTIN for cars spills over into the retail of the cars; depending on the facts of individual cases, the presence of identical branding on the goods the subject of the retail service may cause the average consumer to perceive a close connection between the origin of the goods and the identity of the undertaking selling the goods. I am willing to accept that Aston Martin branded dealerships selling Aston Martin cars are likely to benefit to an extent from the reputation of the car marque when providing retailing of Aston Martin cars.

Likelihood of confusion

50. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the parties' services are identical, or moderately similar, in the case of vehicle cleaning.

51. The parties' marks are visually and aurally similar to a medium level, but they are dissimilar conceptually. They each have a different, distinct concept. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

52. As I found earlier in this decision, the applicant's mark signifies a place. The earlier mark does not have locational significance. It signifies something different, a full name or two surnames. This is enough to militate against imperfect recollection, especially considering that there will be at least a reasonable level of attention paid to the purchasing process, even for identical services and despite the good, or possibly enhanced, level of distinctive character enjoyed by the mark ASTON MARTIN for the services relied upon.

53. It is also unlikely that the marks would be indirectly confused. This type of confusion was described in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 by Mr Iain Purvis, sitting as the Appointed Person:

⁷ It does rely upon goodwill and reputation in relation to cars for its section 5(4)(a) ground.

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

54. A move from surnominal significance to locational significance does not strike me as a natural or obvious brand extension. There is also no history of the opponent varying its mark. Ms Zaidi submitted that the historical significance of Aston Hill will mean that people assume that Aston Hill is connected to the opponent in some way, such as services relating to historic Aston Martin cars. Does the evidence support the opponent’s claim? In my view, it does not. The opponent states, without showing any evidence, that Aston Hill searches on Google result in references to Aston Martin. The applicant has actually adduced the results of a Google search for Aston Hill. The search results do not refer to Aston Martin, but instead refer to the location as a bike park. The opponent’s evidence refers to books which “may be about, among other things, the history of the company and its connection with Aston Hill...”. This is speculative, but assuming that the books do contain references to Aston Hill and the genesis of the opponent’s name (which would appear plausible in books about the opponent’s history), this does not mean that sufficient consumers will a) recall that fact from a book possibly read long ago and b) make a trading connection. Nor do I consider that people who are in the position of buying an Aston Martin car will research the history of the opponent to this extent. They are likely to focus on the car they are buying and the fact that they are buying into ownership of a brand

with cachet, but without being sufficiently aware as to the genesis of the opponent's name, some 100 years ago, that they will be confused.

55. The opponent claims that there will be confusion because car names are frequently abbreviated. This is not notional use; what must be considered are the registered and applied-for marks. The evidence shows that a few motoring journalists call the opponent, or the cars Aston(s). However, this does not mean the average consumer would confuse the earlier mark with later one, which must be considered as wholes, not dissected.

56. The ground under section 5(2)(b) fails.

57. Section 5(3) of the Act states:

“A trade mark which—

is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

58. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the

section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

59. The first requirement is for the opponent to prove that it has a reputation in the services relied upon, as per *General Motors*:

“23. Such a requirement is also indicated by the general scheme and purpose of the Directive. In so far as Article 5(2) of the Directive, unlike Article 5(1), protects trade marks registered for non-similar products or services, its first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on

the product of service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

60. The earlier mark is a CTM, so the judgment of the CJEU in *Pago International GmbH v Tirolmilch registrierte Genossenschaft mbH* C-301/07 is also relevant:

“29 As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

61. As discussed earlier, the opponent’s mark is a famous luxury car marque and this is what its evidence shows. However, the opponent has not relied upon its reputation in cars in these proceedings. It has relied upon the services which it considered to be identical to those of the application. I found, when considering the distinctiveness of ASTON MARTIN, that there is likely to be some degree of a spill-over reputation from the cars, as goods, to the retail of the cars. There is no evidence which, per se, establishes a *Chevy*-type of reputation for the other services relied upon. Since the opponent has not relied upon a reputation for cars in its pleadings, it is effectively asking me to make several steps: that its evidence of a reputation for cars will spill over into the selling of the same, which, in turn spills over into other ‘car-based’ services. Although I have allowed for the fact that in some circumstances the selling of the goods, under the same brand, will cause a link in the minds of the consumer between the selling and the goods themselves, it is too much of a jump to go from evidence for cars, which are goods not relied upon in the

pleadings, to sports and training services, albeit car-based, and car maintenance and repair. Taking a generous view, the opponent can only rely upon the spill-over reputation between cars and retail of cars under the ASTON MARTIN mark.

62. Similarity of signs under section 5(3) of the Act is assessed visually, aurally and conceptually, as per *Adidas-Salomon*:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

63. I found earlier that the marks are not similar enough, even where identical services are concerned, to cause a likelihood of confusion. However, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion⁸. The opponent’s case is weakened because its evidence relates to cars rather than upon its services but, even if it had relied upon cars in its pleadings, my view would be the same. The differences between the marks, in particular on a conceptual level, will mean that any calling to mind by consumers of ASTON MARTIN in relation to the purchase of ASTON HILL services would be, at the very most, fleeting.

64. The opposition has been pleaded in such a way that the three heads of damage claimed are based upon confusion. I have already found that there is no likelihood of confusion, which means that the claim that the relevant public will believe that the services are either connected or emanate from the same or economically connected undertakings is unsustainable. For the section 5(3) claim to have substance, the opponent’s case must be that, notwithstanding the lack of the belief that there is an economic connection, there must be other reasons why the earlier mark will be damaged in one of the three ways provided for by the section. It has not shown a serious likelihood that the use of ASTON HILL would mean that the attractiveness of the earlier mark will be diminished or why trade would be diverted to the applicant. Any link would be fleeting and it has not been established that, assuming a link was made, why the belief that the undertakings are unconnected would nevertheless still result in diversion of trade.

⁸ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P.

65. There is also a suggestion, though obliquely pleaded, that the expectation of the applicant's services will be that they are the same quality as the opponent's services and that if they do not meet that standard, the opponent's mark will suffer detriment to its reputation. This is the sort of damage claim met in passing off cases, but it is much less tenable as a claim under section 5(3). Damage in passing off cases only becomes relevant where it has been established that use of the later mark will constitute a misrepresentation to the public. The opponent's case that the use of the applicant's mark will cause the public to believe that the parties' marks are used by economically related undertakings has been rejected. If consumers are therefore aware that the parties are not economically connected, it is difficult to see why sub-standard service on the part of the applicant would damage the opponent's mark. Further, in *Champagne Louis Roederer v J Garcia Carrion S.A.*, Mrs Justice Rose observed that it would be "a step forward in the law to find that tarnishment is made out merely by using a sign on a product which is cheaper and more ordinary than the product to which the [earlier] mark is attached". This is crystal ball gazing; there is no evidence from the applicant that it is yet trading, so there is no evidence of sub-standard services which might raise the claim from the speculative to that of a serious likelihood of detriment to repute.

66. The claim to unfair advantage is thin and depends entirely upon confusion arising from similarity between the marks. As already said, any bringing to mind will be too weak to give the later mark any material advantage. The high point of the opponent's case under section 5(3) appears to be its reliance upon the historical connection between the genesis of the name Aston Martin and the Aston Hill climb. The opponent claims that the connection is known the world over, but this is not established in evidence. The evidence shows that this location ceased to be a motoring race in the 1920s and that it is now a mountain bike park. It cannot be inferred that those who are interested in buying an Aston Martin car are aware of the provenance of the name, so that encountering the applicant's mark will create a strong enough link that the applicant will derive an economic advantage from it. Ms Zaidi's submission that there may be an assumption that the applicant's mark relates to classic Aston Martin cars is no more than speculation. This is not enough for a claim under section 5(3).

67. Although there is an absence of explanation in the applicant's evidence as to its choice of mark, without a link and without one or more heads of damage, the claim under section 5(3) of the Act is not made out.

68. The ground of opposition under section 5(3) of the Act fails.

69. Section 5(4)(a) states:

"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, or

(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."

70. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury's Laws of England* 4th Ed. as being that:

i) the claimant's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant's goods or services are those of the claimant;

and iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant's misrepresentation.

71. The goods relied upon for this ground (cars) do at least reflect the evidence which has been shown. It is beyond dispute that the opponent enjoys a very considerable goodwill in ASTON MARTIN for cars in the UK. However, this ground does not take the opponent any further forward for the reasons identified earlier in this decision in relation to the similarity between the signs. In *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5, Court of Appeal, Jacob LJ said:

"16 The next point of passing off law to consider is misrepresentation. Sometimes a distinction is drawn between "mere confusion" which is not enough, and "deception," which is. I described the difference as "elusive" in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40. I said this, [111]:

"Once the position strays into misleading a substantial number of people (going from 'I wonder if there is a connection' to 'I assume there is a connection') there will be passing off, whether the use is as a business name or a trade mark on goods."

17 This of course is a question of degree—there will be some mere wonderers and some assumers—there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former.

18 The current (2005) edition of Kerly contains a discussion of the distinction at paras 15–043 to 15–045. It is suggested that:

"The real distinction between mere confusion and deception lies in their causative effects. Mere confusion has no causative effect (other than to confuse lawyers and their clients) whereas, if in answer to the question: 'what moves the public to buy?', the insignia complained of is identified, then it is a case of deception."

19 Although correct as far as it goes, I do not endorse that as a complete statement of the position. Clearly if the public are induced to buy by mistaking the insignia of B for that which they know to be that of A, there is deception. But there are other cases too—for instance those in the Buttercup case. A more complete test would be whether what is said to be deception rather than mere confusion is really likely to be damaging to the claimant's goodwill or divert trade from him. I emphasise the word "really."

72. No submissions were made in relation to this ground at the hearing. I do not think that the opponent's customers will even get as far as wondering if there is a connection between ASTON MARTIN and ASTON HILL for the services of the application. Even factoring in the historical genesis of the name Aston Martin as partly derived from Aston Hill, the evidence does not establish that this historical connection would be so known that it would cause a substantial number of the public to be misled into purchasing the applicant's services, believing that they are provided by the opponent. There will be no misrepresentation and, hence, no damage.

73. The section 5(4)(a) ground fails.

Outcome

74. The opposition fails under all grounds. The application may proceed to registration.

Costs

75. The applicant is entitled to a costs award as it has been the successful party. Both parties were content for the scale of costs to apply. Most of the applicant's evidence did not assist, so I will reduce the award accordingly. The award breakdown is as follows:

Considering the notice of opposition and preparing the counterstatement	£450
Considering the opponent's evidence and filing evidence	£600
Preparation for and attendance at the hearing	£500
Total	£1550

76. I order Aston Martin Lagonda Limited to pay Aston Hill Limited the sum of £1550 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 17th day of December 2015

**Judi Pike
For the Registrar,
the Comptroller-General**