

O/783/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3343260

BY

TERENCE PATRICK O'HALLORAN

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 12

Multibus

AND OPPOSITION THERETO (NO. 414492)

BY

VOLKSWAGEN AKTIENGESELLSCHAFT

Background and Pleadings

1. TERENCE PATRICK O'HALLORAN ("the Applicant") applied to register the word trade mark "Multibus", on the 4 October 2018 for goods in class 12 namely "*Vehicle bodies; Vehicles; Vehicles and conveyances; Vehicles (Electric -); Vehicles for locomotion by land*". It was accepted and published on the 12 October 2018.

2. VOLKSWAGEN AKTIENGESELLSCHAFT ("the Opponent") opposes the application under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). It relies on its International Registration ("IR") number 1136520, for the mark "MULTIVAN", which designated the EU for protection on the 18 June 2012 and on which protection was conferred in the EU on the 2 October 2013. The IR has a German priority date of 10 February 2012.

3. Whilst the Opponent's IR is registered for goods in classes 4, 9, 12 and 27, for the purposes of this opposition it is only relying on some of its goods in class 12 namely:

Class 12: Motorized land vehicles; vehicle bodies; motorbuses, trucks, caravans, tractors; motorcycles, mopeds, omnibuses; electric motors for land vehicles.

4. The Opponent claims under section 5(2)(b) of the Act that there is a likelihood of confusion because the trade marks are similar and are registered for goods identical with or similar to those for which the earlier mark is registered.

5. Mr O' Halloran filed a defence and counterstatement denying the claims made that there is any identity or similarity between the respective marks or the goods. Mr O' Halloran has put the Opponent to proof of use of its mark and submits that:

“There is nothing substantive submitted that would in any way create a substantive link between the Volkswagen’s ‘Multivan’ vehicle and the ‘Multibus’ trademark as applied for. This is made the more relevant particularly as Volkswagen choose to ignore Multitruck and MultiOne, existing trademarks”

“there can be no confusion between the opponent’s Multivan trademark and the applied for trademark Multibus; any more than between Multivan and ‘MultiOne’ or ‘Multitruck’”

6. In these proceedings Mr O’ Halloran is representing himself whereas the Opponent is represented by WP Thompson. Only the Opponent filed evidence by way of two witness statements; the joint statement of Dr Dieter Messnarz and Mr Martin Müller Korf dated the 20 March 2019 and the statement of Mrs Rigel Kate Moss McGrath dated the 18 March 2019.¹

7. By way of letter dated the 5 July 2019 Mr O’Halloran requested that the contents of his TM8 and counterstatement filed on 5 December 2018 stand as his evidence and submissions in lieu. Rule 64(1) of the Trade Marks Rules 2008 sets out the provisions as to what constitutes evidence in proceedings and the form they must take which would normally be by way of a witness statement, affidavit or statutory declaration. The witness statement must include a statement of truth and be signed and dated by the maker of that statement. Despite not being in the correct format the form TM8 has been signed by Mr O’Halloran and includes a declaration of truth and could therefore be taken as evidence.² In this instance, however, the contents of the TM8 only contain submissions in reply to the opposition rather than evidence of fact and therefore I will regard this document as the Applicant’s formal submissions for the purposes of these proceedings. Relying on the TM8 in this way has not been to the Applicant’s detriment as there was no requirement for him to file evidence.

¹ This was provided as an Annex to the Opponent’s written submissions dated 18 March 2019 filed within the timescales stipulated by the tribunal for filing evidence and submissions.

² *Soundunit Limited v Korval Inc.*, BL/0468/12

8. Neither party requested a hearing and only the Opponent filed submissions in lieu. Whilst I do not propose to summarise the entirety of the parties' submissions and evidence I have taken them into account in my deliberations and will refer to them where necessary in my decision. Both parties seek an award of costs.

Preliminary issue

9. Mr O' Halloran refers to other "MULTI**" marks which appear on the register namely "multitruck" and "multione" arguing that they are able to coexist without leading to a likelihood of confusion and that the Opponent has not sought to challenge these trade marks. The fact that others are including the prefix MULTI within their mark does not by itself reflect the actual position regarding whether average consumers would be aware of them on the market and even if they did it does not necessarily follow that the mark's inherent capacity to distinguish between the marks is altered. In any event Mr O'Halloran has not submitted evidence as to whether any consumers have been confused and even if he had this would not assist in determining whether there is a likelihood of confusion between the contested marks. The mere fact that a number of trade marks contain the prefix MULTI is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field.³

The Evidence

i. Dr Dietr Messnarz and Mr Martin Müller Korf joint statement

10. The Opponent's evidence consists of the joint witness statement of Dr Dietr Messnarz and Mr Martin Müller Korf accompanied by 12 exhibits. Dr Messnarz holds the position of head of trademarks, licences and central services for Volkswagen AG

³ *Zero Industry Srl v OHIM*, Case T-400/06

("the company") whereas Mr Korf is the company's business lawyer. Both have authority to provide the statement on behalf of the Opponent. The information provided in the witness statement is taken from the company's records and from both parties' personal knowledge.

11. Dr Messnarz and Mr Korf include production figures for goods sold, under the Opponent's mark, in Germany, Belgium, France, Italy and Spain reproduced below:

| Country | Year | Orders |
|----------------|-------------|---------------|
| Germany | 2014 | 108 |
| | 2015 | 7,211 |
| | 2016 | 15,410 |
| | 2017 | 15,547 |
| | 2018 | 17,691 |
| Belgium | 2015 | 396 |
| | 2016 | 464 |
| | 2017 | 482 |
| | 2018 | 502 |
| France | 2015 | 291 |
| | 2016 | 616 |
| | 2017 | 393 |
| | 2018 | 205 |
| Italy | 2015 | 98 |
| | 2016 | 338 |
| | 2017 | 291 |
| | 2018 | 294 |
| Spain | 2015 | 334 |
| | 2016 | 631 |
| | 2017 | 814 |
| | 2018 | 801 |

12. Dr Messnarz and Mr Korf state that the earlier mark has been consistently used on the company's websites, examples of which are attached to their exhibits marked ME/MK 1 to 4.

13. Exhibit ME/MK1 is described as printouts from the company's German website www.volkswagen-nutzfahrzeuge.de/de/modelle/multivan.html. Similarly, ME/MK 2, ME/MK3 and ME/MK4 are printouts from the company's equivalent French, Italian and Dutch websites. These printouts include pictures of what appear to be various models and specifications for vans/transporters marked as "Der Multivan" "Multivan Highline",

“Multivan Comfortline”, “Multivan Trendline” “Le Multivan” “Multivan Trendline”, Le Multivan Business”, “Le Multivan Edition 30” “Multivan” “Multivan Space” and “Multivan Prestige+”. The following figures in Euros appear underneath pictures of the Multivan Highline and Multivan Comfortline namely 61.172 EUR, 51.405 EUR, 46.475 EUR and 39.055 EUR respectively.⁴

14. The remainder of the statement consist of Exhibits marked ME/MK 5-12 described as company catalogues and price lists for products sold under the earlier mark between 2012 and 2018. These exhibits include catalogues in German, French, Italian and Spanish between 2017 and 2019 and German price lists dated 2012-2013 and 2015-2016.

ii. Rigel Kate Moss McGrath statement

15. The second statement was filed by Rigel Kate Moss McGrath dated 18 March 2019 accompanied by 7 exhibits.

16. Mrs McGrath is a chartered trade mark attorney with WP Thompson, the Opponent’s legal representatives.

17. It appears that the main purpose of her statement is to exhibit a number of documents described as catalogues and the company’s annual reports. Mrs McGrath states that the exhibits demonstrate that the mark Multivan has been used in a number of European countries over the last 2-3 years.

18. The five catalogues produced at Exhibits RMK1-5 are in German, French, Spanish and Italian and are described as dated June 2015, May 2017, June 2017, June 2017 and August 2018 respectively. Each copy has a handwritten date annotated in English

⁴ Page 6 Exhibit ME/MK1

on the front cover. These documents appear to be duplicates of those attached to Dr Messnarz and Mr Korf's statement.

19. Exhibit RMK6 is described as "the Wikipedia entry for the Volkswagen Transporter T5 which is also called the Volkswagen Multivan". She states that the MULTIVAN is described as "the range topping people mover based on the T5 platform". She continues that the entry does not provide information as to when the MULTIVAN was first launched but references MULTIVAN as one of the four main labels of the revamped and facelifted T5 range of Volkswagen Commercial Vehicles. The entry was last edited on 17 February 2019 and has a print date of "18/3/2019". The Wikipedia entry outlines the historical background of the Volkswagen T5 transporter van which is also called the Multivan. Reference is made to the Multivan range which is described as a people mover vehicle/transporter(T5) available in either a six or eleven seat configuration whose market includes Germany and France. The "Edition 25 Multivan (2011)" is described as the commemorative 25th anniversary model of the Multivan. The "Transporter" is described as a van(cargo/passenger), pick up, minibus, crew cab, chassis cab and campervan. Reference is made to various awards granted to the Multivan by the Auto Motor and Sports magazine regarded as "Best in Class". I note however that all these accolades were awarded outside the relevant period. Page 57 includes two pictures of a transporter/van referenced as "Multivan facelift (2010-2015)". It is clear within this Wikipedia entry that Multivan was launched as an updated model of the T5 transporter.

20. Exhibit RMK7 produces copies of the company's Annual Reports between 2013-2017. Mrs McGrath outlines that "These reports provide production figures for the vehicle known as Caravelle, Multivan or Kombi in various territories for the years 2012-2017 ranging from 112,492 vehicles to 115,553 in these particular years and the geographic breakdown of deliveries by Market."

Proof of use

21. In these proceedings, the Opponent is relying upon its IR as shown above, which qualifies as an earlier trade mark under section 6 of the Act. As its mark has been registered (or protection conferred) for more than five years ending on the date of publication of Mr O' Halloran's application it is subject to the proof of use provisions. In order for the Opponent to rely upon the goods listed within class 12 it must demonstrate that use has been made of the mark.

22. The relevant provisions regarding Proof of Use are set out as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

23. Section 100 of the Act is also relevant it states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

24. Accordingly under section 6A(3)(a) of the Act the relevant period in which genuine use must be established is the five year period ending on the date of publication of the applied for mark. Consequently, the relevant period is from the 13 October 2013 to 12 October 2018.

25. What constitutes genuine use has been subject to a number of judgements. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J. summarised the law relating to genuine use as follows:

“114.....The Court of Justice of the European Union (CJEU) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark:

Ansul at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

26. As the earlier mark is an international registration designating the EU, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

....

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

...

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine

whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

27. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

28. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and

national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or

services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

29. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of a EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union. On the basis of the above caselaw therefore, it is not a requirement to demonstrate use in the UK as it is sufficient to demonstrate use within the community area.

Form of the mark

30. Before I consider whether the opponent has demonstrated use of its marks I need to consider the variant forms produced in evidence. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

31. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

32. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

33. Where the mark has been used in the format in which it is registered this will clearly be use upon which the Opponent may rely. I note that the Opponent has produced catalogues, brochures, price lists and annual reports where the mark Multivan is referred to within the text, therefore this is use upon which the Opponent may rely. However as noted below the mark is displayed in a number of variations within the text of the catalogues, namely:

Der Multivan; Multivan Highline; Multivan Comfortline; Multivan Trendline; Le Multivan Business; Le Multivan Edition 30; Multivan Prestige+

detracting from the mark itself and therefore variants upon which the Opponent may rely.

Sufficient Use

35. Whether the use shown is sufficient, will depend on whether there has been real commercial exploitation of the IR, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant five-year period. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown
- b. The nature of the use shown
- c. The goods and services for which use has been shown
- d. The nature of those goods/services and the market(s) for them
- e. The geographical extent of the use shown

36. Use does not need to be quantitatively significant in order to be genuine, however, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark” is not genuine use.

37. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

38. I also note Mr Alexander's comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

"The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round- or lose it"" [original emphasis].

39. It is clear from the guidance that a number of factors must be considered when assessing whether genuine use of the mark has been demonstrated by the evidence filed. The responsibility is on the appropriate party, in this case the Opponent, to provide sufficiently solid evidence to counter the application, a task which should be relatively easy to attain.⁵ An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁶

40. From the outset I would point out that there are a number of deficiencies in the evidence filed by the Opponent. It is clear from the decisions in *Awareness Plymouth* and *Gucci* that the onus is on the Opponent to put forward its best evidence. The evidence consists of two brief statements exhibiting a number of catalogues and price lists in various European languages none of which are accompanied by translations.

⁵ *Awareness Limited v Plymouth City Council*, Case BL O/236/13

⁶ Case T-415/09, *New Yorker SHK Jeans GmbH & Co KG v OHIM*, GC

41. The printouts appear to show the various models, specifications and list prices for vehicles/vans under the mark Multivan taken from the company's German/French/Italian and Dutch websites.⁷ The websites are displayed ending with the format ".fr", ".de", ".sp" and ".nl" which indicates that they are websites from the respective European countries. They appear to be online catalogues of a kind viewed by potential customers wishing to purchase a new vehicle. The price where it is displayed is presented in Euros. No evidence however has been produced as to how many views the website has generated or the specific breakdown per territory of customers which have accessed the website. I also note that the printouts are undated and whilst the mark appears throughout the text it is unclear whether these documents are within the relevant period.

42. Exhibits ME/MK 5-10 are copies of catalogues dated between 2012 and 2018 produced in German, French, Italian and Spanish. The catalogues appear to be of the type produced and distributed to potential customers setting out the basic specifications and what is included as standard and those optional extras that can be purchased on request. However, I am unable to summarise these documents in any great detail as again, no translations have been provided or explanation as to what they show. I note however that within the text of all the catalogues irrespective of the language, reference is made throughout to the mark "Multivan". The catalogue exhibited at ME/MK 5 was printed in Germany in "Mai 2017". Similarly Exhibit ME/MK 7 was printed in France in "Juin 2017" and exhibit ME/MK9 is dated "Agosto 2018" and is described as an Italian catalogue. Produced within the Italian catalogue are photographs displaying the mark Multivan as a registration on the number plate of the vehicle(s). Exhibit ME/MK10 is described as a "2017 Spanish catalogue". Exhibit ME/MK8 is for the 2019 model and includes a price list dated from 14 June 2018 to 1 January 2019. The front cover sheet displays the mark as "Le Multivan". Exhibit ME/MK 6 is a German catalogue but is dated "Dezember 2018" and therefore is outside the relevant period. No information is provided as to the number of catalogues printed; a breakdown as to how many were produced in each territory; the number of catalogues distributed to the individual dealerships or the number of catalogues

⁷ Exhibits ME/MK1-4 taken from Dr Messnarz and Mr Korf's statement

requested by potential customers. There is no information or figures whatsoever regarding circulation or the cost of producing such materials.

43. Exhibits ME/MK11 and 12 are described as German price lists for the years 2012-13 and 2015-16 although again no translation is provided. One example of an entry however shows a “Multivan Comfortline 2.0-1-TDI” model listed for “36.070,00” euros.

44. Mrs McGrath produces at Exhibit RMK7 copies of the company’s Annual Reports between 2013-2017. She describes these reports as demonstrating “production figures for the vehicle known as Caravelle, Multivan or Kombi in various territories for the years 2012-2017 ranging from 112,492 vehicles to 115,553 in these particular years and the geographic breakdown of deliveries by Market.”

45. Throughout the five reports filed, reference is made to the mark Multivan. It is apparent from the documents that Multivan is a model of a vehicle within Volkswagen’s commercial vehicle range. An entry in the 2013 report outlines that collectively 153 thousand units of the “Caravelle/Multivan, Transporter and Amarok” models were produced at the main production facility in Hanover. No further breakdown is provided of the number of units produced per model, nor is there any evidence of actual sales of “multivan vehicles” or in which territory. What is produced is a global picture of the sales of commercial vehicles as a whole. The overall sales revenue for Volkswagen’s commercial vehicles recorded in 2013 was €9.4 billion. Similar details are contained in the other annual reports produced albeit that the figures differ for each year.

46. As outlined earlier there are deficiencies with the evidence filed. I am only able to assess the evidence on those documents that are attributed to a date within the relevant period. Only a small number of documents have dates attributed to them and in the main they are in the form of catalogues and price lists none of which have translations attached. Whilst I am unable to definitively read these documents I accept that the mark Multivan is displayed throughout. Also since no circulation or distribution

figures have been provided it would be open to me to conclude that only one catalogue has been produced for each country claimed. However, I accept that it is improbable for a global company of Volkswagen's size to only produce one catalogue in each language. The references to the company's various websites are undated and no evidence has been provided as to the number of views generated. Within the annual reports no breakdown is provided as to what proportion of the production figures relate specifically to Multivan in each individual territory. Collectively the annual reports include references to the mark MULTIVAN and demonstrate that in total, over 500,000 "Caravelle/Multivan, Kombi" units were produced over the relevant period. It follows therefore that at least a proportion of these figures relate solely to the Multivan model. The repeated nature of the production of the units each year would indicate that stock was being sold. In addition, Dr Messnarz and Mr Korf's statement includes a table of "production figures for goods sold" under the Opponent's mark, in Germany, Belgium, France, Italy and Spain during the relevant period.

47. The task of producing records would have been a relatively easy task to undertake and certainly something that I would have expected from a global company of this size. I would have expected the production of accounts, turnover figures, invoices and receipts to retailers and consumers as well as advertising costs as fairly standard pieces of evidence to satisfy the proof of use requirements.

48. Nevertheless, despite these deficiencies the caselaw suggests that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁸ Notwithstanding the lack of accounts, receipts or turnover figures it is clear that the MULTIVAN vehicle in combination with other models were being produced year on year within the relevant period. The company would not be continuing to produce vehicles under the mark MULTIVAN if they were not being sold. The catalogues, websites and price lists paint a global picture that the Opponent has commercially exploited the mark. I place particular weight on the table showing units

⁸ Case T-415/09, New Yorker SHK Jeans GmbH & Co KG v OHIM, GC

sold included in Dr Messnarz and Mr Korf's statement and the contents of the annual reports which are all within the relevant period. I am satisfied therefore looking at the evidence as a whole rather than each individual piece that the Opponent has proved sufficient use of its mark in the EU during the relevant five year period.

Fair specification

49. I must now consider whether or the extent to which the evidence shows use for all the goods relied upon.

50. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

51. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

52. I take note of the above case law and, in particular, that the Opponent should not be allowed to monopolise the use of a trade mark in relation to a general category of vehicles if it has only demonstrated use in relation to a particular type of vehicle. This must be balanced against not reducing the Opponent's specification too far so that its protection is only against a limited number of goods. It is clear that the term "Motorized land vehicles" is a wide ranging description covering a broad range of vehicles. The Opponent's evidence demonstrates that its mark MULTIVAN is clearly applied to vans and transporter vehicles, and would include multi occupancy and multi seater vehicles such as people and cargo carriers, minibuses and campervans. It would appear from the evidence that MULTIVAN is an edition/model of the transporter and is clearly used as a badge of origin for a specific type of van/vehicle. It would include the terms omnibuses and motorbuses since these types of vehicles are multi occupancy vehicles. I consider therefore that a fair specification for the purposes of this opposition to be "vans, transporters, people carriers, cargo carriers, minibuses, omnibuses, motorbuses and campervans".

53. Caravans would in my view be a subcategory of a camping vehicle but not necessarily a van, since a caravan is traditionally viewed as a free standing vehicle equipped for living and something usually towed by a car. Whilst I am aware that a transporter van can be adapted into a campervan and considered as a self reliant camping vehicle, I do not consider that the average consumer would consider that a caravan is a subcategory of a van as it will be categorised independently. The Opponent has not demonstrated use in relation to caravans and therefore it is not able to rely upon this specification.

54. I am able to infer from my own knowledge that a car catalogue includes such details such as the model's specification, engine size, interior configuration, colour scheme and what is included as standard and what are optional extras. However, whilst the Opponent's specification includes *vehicle bodies* and *electric motors for land vehicles*, without any translation or explanatory evidence I am unable to determine use of the mark MULTIVAN for these particular items in isolation. Whilst a finished vehicle includes electric motors and vehicle bodies I am unable to see any evidence produced

by the Opponent that categorically demonstrates use of the mark being attributed to these individual parts. If the Opponent wishes to rely on its registered specification it is for it to demonstrate use. No explanation has been provided within the witness statements that specifically points towards evidence for “electric motors for land vehicles” or “vehicle bodies”.

55. The Opponent has not provided any evidence to suggest that the mark has been used in relation to “trucks”, “tractors”, “motorcycles” and “mopeds”. I cannot find any reference to the mark for any of these goods within the statements filed. There is nothing that I can categorically point to that demonstrates, even at a base level, that the mark has been put to actual use in relation to these goods.

56. On this basis for the purposes of the opposition a fair specification that the Opponent is able to rely on would be:

Class 12: vans, transporters, people carriers, cargo carriers, minibuses, omnibuses, motorbuses and campervans.

Decision section 5(2)(b)

57. The opposition is based upon 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 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”.

58. 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 greater 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 to mind the earlier mark, 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 the goods and services

59. The Opponent submits that the goods are identical or highly similar submitting that “the goods have the same use, users, physical nature and are sold through the same trade channels. In some cases, the vehicles claimed in the earlier registration may be electric thus identical to the goods claimed in the Application; in other cases the goods are competitive. In either case there is a close proximity of these goods in the market.”

60. The Applicant denies any similarity exists between the respective goods submitting that:

“Goods and services states that no similarity identity because “Roget’s Thesaurus refuses to link a ‘bus’ and a ‘van’ as similar generic vehicles. They are dissimilar in the extreme.

Multibus referred to a retrofitted mechanism which fundamentally alters the capacity of an existing or new public service vehicle [PSV] (or heavy goods vehicle) to operate from mains electricity from overhead cables to allow for the recharging of on-board batteries and the propulsion of the vehicle to which it is fitted.

The application is made on the basis of class 12 because the fitting of the Multibus unit creates an entity that then applies to the whole vehicle and is an intrinsic part of the vehicle body.

Roget’s Thesaurus refuses to link a ‘bus’ and a ‘van’ as similar generic vehicles. They are dissimilar in the extreme.”

61. When conducting a goods and services comparison, I am mindful of the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc Case C-39/97*, where the court stated at paragraph 23 of its judgment that:

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

62. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

63. In addition, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J stated that:

"... 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."

64. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05, the General Court (GC) stated that even if goods or services are not identically worded they can still be considered identical if one term is encompassed within another broader term and vice versa:

"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".

65. Also in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

"...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".

66. In order to determine whether there is a likelihood of confusion the competing specifications must either be identical or share similarity. As a result of my earlier assessment as to what goods the Opponent is able to rely upon, the respective parties' goods are as follows:

| Opponent's goods | Applicant's goods |
|---|---|
| Vans, transporters, people carriers, cargo carriers, minibuses, omnibuses, motorbuses and campervans. | Vehicle bodies; Vehicles; Vehicles and conveyances; Vehicles (Electric -); Vehicles for locomotion by land. |

67. “Vans, transporters, people carriers, cargo carriers, minibuses, omnibuses, motorbuses and campervans” in the Opponent’s specification falls within the broader category of “Vehicles; Vehicles and conveyances; Vehicles (Electric -); Vehicles for locomotion by land” in the Applicant’s specification. These goods can therefore be considered identical on the principle outlined in *Meric*.

68. In so far as the Applicant’s “vehicle bodies” is concerned they are similar to a medium degree to the Opponent’s goods because they share the same producers, distribution channels and target the same end user. In addition, they are complementary. A vehicle would not be manufactured without its “body” as it is accepted practice for a manufacturer to assemble the whole vehicle to include the body work.

Average Consumer

69. When considering the opposing marks, I must determine, first of all, who the average consumer is for the goods and the purchasing process. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer’s level of attention is likely to vary according to the category of goods and services in question.⁹

⁹ Lloyd Schuhfabrik Meyer, case c- 342/97.

70. 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.”

71. Mr O’ Halloran submits that:

“The average consumer does not constitute the target market for the acquisition of a Multibus. Bus operator companies will certainly be specialized and recognise the difference between a bus and a van. However even if the ‘average consumer’ was to require public transport from A to B there would be little if any confusion whether to board a bus or a van to travel.”

72. Whist the Opponent submits that:

“based upon the analysis of the goods claimed, the consumer cannot be said to be linked to bus operator companies; it is submitted that the relevant public must be considered to be the general public as it would include any party involved in the purchase of the vehicles and the users of the vehicles and the general public involved in the purchase of the vehicles and the users of the vehicles and it is the general public that will travel on buses.”

73. Taking into account the general nature of the parties' specifications I do not consider that the average consumer is only linked to bus company operators. To my mind the average consumer for the goods at issue is a person or commercial undertaking looking for a new vehicle and are therefore both professional buyers and general members of the public. The goods are directed towards those individuals who wish to purchase a vehicle for their own use or a business customer such as those who own a dealership and sell vehicles or a professional driver who transports goods or people for a living.

74. For goods such as motor vehicles account has to be taken of the fact that, in view of the nature of the goods and in particular their price and their highly technological character, the average consumer will display a particularly high level of attention at the time of purchase of such goods.¹⁰ It is to be expected therefore that even general members of the public will purchase cars in a different way to how they would purchase every day goods. The consideration will be an informed one taking such things as price, quality, reliability and suitability into account. Most consumers purchasing a vehicle will have undertaken a degree of research before purchase often test driving the vehicle or checking reviews. Most purchases are undertaken with the expectation of longevity and reliability therefore they are not usually purchased with any degree of regularity. This position may be different however for a professional consumer within the trade who would purchase the vehicle relatively frequently. Value for money and safety implications are nevertheless important key factors for both individuals and professional drivers and on this basis a close level of attention will be paid in the purchasing process.

75. The purchasing process will be predominantly a visual one where purchasers view and test drive the car from an actual car dealership or from being exposed to the mark through magazine or television advertisements or their online equivalent. Aural considerations cannot be discounted however following discussions with sales representatives.

¹⁰ *Ruiz Picasso V OHIM, DiablerChrysler AG C-361/04 P*

Comparison of the marks

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

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

77. It would be wrong to artificially dissect the trade marks, although, it is necessary to consider 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.

78. The respective trade marks are shown below:

| Applicant's mark | Opponent's mark |
|------------------|-----------------|
| Multibus | MULTIVAN |

79. The Applicant's mark consists of the eight letter word Multibus presented in title case. Notwithstanding that the mark will be perceived by the average consumer as being devised from two common words Multi and bus the overall impression of the mark resides in the presentation of the conjoined word.

80. Similarly, the Opponent's mark also consists of an eight letter word; in this case MULTIVAN presented in capitals. The mark will also be understood to consist of two recognisable words multi and van and again as there are no other elements to contribute to the mark the overall impression lies in the conjoined word as a whole.

Visual comparison

81. Both marks present visually as word marks coinciding with the identical word MULTI and differing in only the casing and the last three letters van as opposed to bus. Since a word trade mark registration protects the word itself irrespective of font, capitalisation or otherwise, a trade mark in capitals covers use in lower case and vice versa.¹¹ Although both parties' marks are conjoined the average consumer is likely to separate them into two distinct words MULTI-VAN and MULTI-BUS and therefore the shared presence of the word "MULTI" at the beginning of the mark will result in the marks sharing between a medium to high degree of visual similarity.

Aural comparison

82. I consider that the Applicant's mark will be pronounced MUL-TI-BUS whereas the Opponent's mark will be pronounced MUL-TI-VAN. In both cases the first and second syllable will be pronounced identically, the only difference being in the third syllable which share no aural similarity. Since as a general rule, beginnings of marks have a

¹¹ *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

greater impact than their ends, the marks share between a medium and high degree of aural similarity due to the common element multi.

Conceptual comparison

83. I agree with the Opponent's interpretation of the word multi as being perceived as "more than one, many" and in my view the element multi in both marks will be construed as an abbreviation for multiple meaning numerous, more than one. I consider that the ordinary meaning will be given to both the words van and bus; bus being perceived as a mode of transport, a vehicle to transport passengers or numerous people; van will be perceived as a vehicle to transport goods or people. Conceptually both marks will be perceived as a reference to a multipurpose vehicle/mode of transport or a multiple fleet of vehicles. Since the elements bus and van will be descriptive of the type of vehicle provided by the undertaking conceptually the marks will be highly similar.

Distinctiveness of the earlier mark

84. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case 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).”

85. Despite filing evidence showing sales revenue of €11.9 billion in 2017, this figure represents the global sales revenue figure for all its commercial vehicle fleet rather than those goods under the mark. In addition, even if it had provided a breakdown, the position can only be assessed in relation to sales within the UK because it is the perception of the UK average consumer which is relevant in assessing whether there is a likelihood of confusion. Since no specific evidence has been provided in relation to use of the mark within the UK market I am only able to consider the distinctiveness of the mark based on inherent characteristics.

86. Bearing in mind my assessment of the overall impression, the mark MULTIVAN will be seen as the two conjoined words MULTI and VAN. I have already found that the word MULTI will be recognised as a shortening of the word multiple whilst the VAN element will be seen as descriptive and alluding to the nature of the Opponent’s goods. Whilst the VAN element is more descriptive of the type of vehicles sold, it nevertheless contributes to the distinctive character of the composite word mark MULTIVAN. The inherent distinctive character of the mark as a whole, resides with the two words in combination, albeit weighted in favour of the MULTI element as opposed to the VAN element and which I place at no higher than an average degree.

Likelihood of confusion

87. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

88. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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 recognised 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, I conclude that it is another brand of the owner of the earlier mark.”

89. In determining whether there is a likelihood of confusion there are a number of factors to bear in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent’s trade mark, the average consumer for the goods and the nature of the

purchasing process. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

90. I have found that the marks are visually and aurally similar to between a medium and high degree. I have found the conceptual similarity between the marks to be high. I have found that the earlier mark has an average degree of inherent distinctive character. I have identified the average consumer to be a member of the general public or business consumer who would primarily select the goods via visual means but with aural considerations not being discounted. I have concluded that a high degree of attention will be paid in the purchasing process.

91. In terms of direct confusion, I do not consider that the average consumer will mistake one mark for the other even in relation to identical goods. There is sufficient difference in the element van and bus for the average consumer paying a high level of attention to distinguish between the respective marks especially since the goods are chosen primarily through visual means. There would be no direct confusion.

92. However I must consider the possibility of indirect confusion and whether the relevant public believes that there is an economic connection between them or that they are variant marks from the same undertaking as a result of the shared common element MULTI. Whilst a shared common element alone does not necessarily lead to a likelihood of confusion¹² it is important for me to note the aspects of the other element within the respective marks and the part they play. I bear in mind not only the level of distinctiveness of the earlier mark as a whole but also the distinctiveness of the common element.

¹² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

93. Both marks include a combination of the word Multi with a descriptive element alluding to the type of vehicle provided by the respective undertakings. The distinctiveness of the earlier mark resides in the conjoining of the word multi with a type of vehicle. The distinctiveness of the mark is not provided by the vehicle type, but lies in the combination of the mark as a whole comprising of the “multi + vehicle” format.

94. Bearing in mind my assessment of the overall impression, when coming across the respective marks the average consumer is likely to recognise the difference between the second element bus as opposed to van, but still consider them to be descriptive of the type of transport and of sufficient similarity to be provided by the same undertaking. The shared presence of the Multi element at the beginning of the mark in combination with the second descriptive element is such to create a perception in the mind of the average consumer that the vehicles sold under the marks are part of the same undertaking’s range of vehicles. In my view the average consumer even paying a high degree of attention will perceive the application to be a sub brand of the earlier mark and that the respective goods which are identical or highly similar originate from the same or economically linked undertaking. On this basis I consider there would be a likelihood of indirect confusion.

Outcome

95. The opposition under section 5(2)(b) of the Act succeeds; subject to any appeal the application is refused.

Costs

96. As the Opponent has been successful it is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note 2 of 2016. However, I note that the Opponent’s evidence consisted primarily of copy catalogues and brochures duplicated across both statements with no

translations being provided. Attaching the material in this way has not involved an extensive degree of diligence. I reduce the costs awarded in relation to the preparation of evidence, accordingly. Applying the guidance, I award costs to the Opponent on the following basis:

| | |
|---|-------------|
| Preparing a notice of opposition and reviewing the counterstatement: | £200 |
| Preparing and filing evidence | £200 |
| Preparing submissions in lieu of a hearing: | £300 |
| Official fee: | £100 |
| Total: | £800 |

97. I order Terence Patrick O'Halloran to pay Volkswagen Aktiengesellschaft the sum of £800 as a contribution towards costs. This sum is to be paid within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated 20th December 2019

Leisa Davies
For the Registrar