

O/1023/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3590072

BY

FLEETCLEAN-UK LTD AND AARON CHEMICALS LTD

TO REGISTER THE FOLLOWING TRADE MARK

IN CLASS 3

fleetclean

AND OPPOSITION THERETO UNDER NUMBER 425214

BY

FLEETCLEAN LIMITED

Background and Pleadings

1. On 4 February 2021, Fleetclean-UK Ltd and Aaron Chemicals Ltd (“the first and second Applicant”) applied to register in the UK the trade mark “fleetclean” for goods in class 3 namely **Cleaning sprays; Cleaning fluids; Hand cleaning preparations; Automobile cleaning preparations; Car polish; Car shampoos; Car wax; Cleaning foam; Carpet cleaning preparations; Caustic cleaning agents; Windscreen cleaning liquids; Windscreen cleaning fluids**. It was accepted and published in the Trade Marks Journal on 2 April 2021. For the purposes of this opposition only those goods highlighted in bold are opposed.

2. Fleetclean Limited (“the Opponent”) issued opposition proceedings on 28 June 2021 under section 5(3) of the Trade Marks Act 1994 (“the Act”). It relies on its earlier UK trade mark as set out below:

UKTM 3571720



Filed on 23 December 2020 and registered on 28 May 2021.

Class 1: Industrial chemicals; Chemical cleaning agents for use in industrial processes; Chemical grease removing agents for use in industrial manufacturing processes; Industrial detergents for use in manufacturing processes; Detergents for industrial use; Chemicals for use in the automotive industry.

Class 7: Electric high pressure cleaners; Steam cleaners; Steam cleaners [machines]; Steam cleaners for household purposes; Electric steam cleaners for household purposes; Multi-purpose steam cleaners; Vacuum cleaners; Vacuum cleaners for household purposes; Vacuum cleaners for industrial purposes; Commercial and industrial vacuum cleaners; Electric vacuum cleaners for industrial use; Industrial cleaning machines [vacuum cleaners]; Industrial floor cleaning machines [vacuum cleaners]; Suction cleaning machines [vacuum cleaners]; Wet and dry vacuum cleaners; Wet vacuum cleaners; Automatic floor scrubbers; Floor polishers; Floor polishers [electric]; Floor polishers, electric; Electric floor polishers; Electric sweepers;

Rechargeable sweepers; High pressure cleaners; High pressure cleaning machines; High pressure pumps; High pressure washers; Machines for cleaning surfaces using high pressure water; Rotary nozzles for use with high pressure water washing machines; Pressure washers; Multi-purpose high pressure washers.

Class 37: Cleaning equipment (Rental of -); Cleaning equipment hire; Rental of cleaning equipment; Rental of tools, plant and equipment for construction, demolition, cleaning and maintenance; Vehicle cleaning; Cleaning of vehicles; Industrial machinery repair; Machinery repair; Providing information relating to the repair or maintenance of power-driven floor cleaning machines; Repair of industrial machinery; Repair of machines; Repair or maintenance of power-driven floor cleaning machines; Maintenance and repair of pressure equipment; Vacuum cleaner repair; Repair of vacuum cleaners; Cleaning of storage containers; Machinery installation; Machinery installation services; Machinery installation, maintenance and repair; Installation of industrial machinery; Providing information relating to the installation of machinery; Cleaning of storage tanks; Cleaning of water tanks; Providing information relating to storage tank cleaning services; Storage tank cleaning; Maintenance and repair of industrial pressure vessels; Providing information relating to the repair or maintenance of vessels; Repair or maintenance of vessels.

3. The Opponent relies upon its earlier mark claiming a reputation for all the goods and services of its registration. It claims that use of the Applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the earlier mark. Furthermore as a result of the similarity between the respective marks, it is claimed that the relevant public will believe that the undertakings are the same or are economically connected, and that the Applicant will gain an unfair advantage, damaging the Opponent's reputation. In particular the Opponent claims:

"[The Applicants] are promoting and selling a range of cleaning products with an identical name and identical usage within the same marketplaces as our company.

As a company of 42 years with a well established reputation within all aspects of commercial and industrial cleaning the Applicant[s] will benefit from the use of our company name, trade mark and internet presence when promoting their products.

..there is a distinct probability that existing and prospective customers of Fleetclean Limited may be misled into purchasing the wrong product.”

4. The Applicants filed a defence and counterstatement, denying the ground of opposition. They state that they have been using the unregistered trade mark “Fleetclean” for a very long time and have built up a solid reputation themselves using this mark since their company Aaron Chemicals was launched in 1992. They deny that the Opponent has a reputation in the goods and services as claimed. They claim that the Opponent is a ‘commercial and industrial cleaner’ and has a reputation for carrying out cleaning, not manufacturing or selling chemicals. They deny that their class 3 goods conflict with the earlier mark’s goods and services in classes 1, 7 and 37.

5. The UK trade mark registration, as relied upon by the Opponent, qualifies as an earlier mark under section 6 of the Act. As it has been registered for no more than five years at the date the application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon the entirety of the goods and services of its registration without having to establish genuine use.

6. Neither party was represented in these proceedings. Both parties filed evidence and submissions during the evidence rounds. Neither party asked to be heard on the matter, however, the Opponent filed submissions in lieu of hearing. This decision is taken following a careful consideration of all the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

Opponent's Evidence in Chief

8. The Opponent's evidence in chief consists of the first witness statement of Alistair Shedden dated 25 March 2022, accompanied by thirty eight exhibits marked AS1-AS38. Mr Shedden is the Opponent's General Manager a position he has held for 25 years. He confirms that he has worked for the company in total for 40 years and provides the information contained within his statement from his own knowledge and from company records.

9. Mr Shedden states that the Opponent has used the name 'Fleetclean' as a recognisable product trade mark and as the company name since 1978. He produces a copy of the company's registration documents maintained by Company House confirming the date of incorporation of the Opponent.¹ The background of the business is produced. It is said that the Opponent originally provided "external livery and MOT cleaning services" to commercial vehicle fleets, later developing the business into "the sale, servicing and hire of industrial cleaning equipment for many of the world's most recognisable manufacturers". Mr Shedden contends that the name Fleetclean has become synonymous within the marketplace as being one of the "UK's leading distributors for these types of equipment and associated chemical products." In addition Mr Shedden states that the Opponent operates a "Road Tanker and IBC Cleaning" facility at their premises in West Yorkshire. This service it is said is provided to companies throughout the UK and Europe and has a high volume throughput.

Branded Goods

10. Mr Shedden accepts that the Opponent does not manufacture the chemicals/detergents that complement the ranges of equipment it sells, however, he states that the company has "a relationship" with a chemical manufacturer (Specialised Aerosols) and supplies it with Fleetclean branded "own-label" products which it has actively promoted and sold since 1985. He produces a letter headed 'to whom it may concern', dated 25 February 2022 from Specialised Aerosols' managing director namely Mr Stephen Lucas.² Mr Lucas confirms that they are manufacturers of a full range of industrial and automotive cleaning products and have supplied Fleetclean Ltd with branded 'own label' products since 1985. He provides an example

¹ Exhibit AS1

² Exhibit AS2

of one of the products described as “Fleetclean 4000 Traffic Film Remover”. It is said that the Opponent is supplied with “several other industrial cleaning products under the Fleetclean name....”.

11. Mr Shedden states that the Opponent provides branded ‘own label’ products to its customers and produces example labels of the 13 currently available products.³ All labels bear the earlier mark and are similarly presented as per the following example:



12. The label for “TFR 3000/4000 Traffic Film Remover” is said “for use in high pressure cleaning systems.” The other products produced are labelled as “Non Caustic Traffic Film Remover”, “Aluminium Cleaner”, “Enviro-Wash”, “Power Scrub”, “UltraScrub”, “De Foam”, “Rubber Dust Cleaner”, “Neuclean”, “Tanker Kleen”, “Screenwash Concentrate” and “Spray Wax Rinse”.

³ Exhibits AS3-AS15

Advertising

13. It is said that the Opponent invests heavily in the promotion and development of its company name and brand in all areas of its business. Mr Shedden states that pre the internet, the Opponent's name and associated products were consistently promoted via various means to include Yellow Pages, trade shows, mailshots, leaflet drops and vehicle livery. Mr Shedden states that its promotional/advertising spend amounted to in excess of £30,000 per annum. Mr Shedden produces a letter dated 24 March 2021, drafted by Tony Fry (the Opponent's Managing Director) which is headed 'to whom it may concern', confirming these details.⁴ Mr Fry states that the Opponent promotes the Fleetclean brand across its complete range of products and services throughout the UK and in the EU as a provider of tank and IBC cleaning services with companies such as Hoyer,⁵ Sitra,⁶ H&S Transport.⁷ As a result Mr Fry states that Fleetclean is now a truly recognised name throughout the UK and Europe.

14. Mr Shedden produces a 'confirmation order' invoice to Yell dated 23 September 2008, said to be a sample of the advertising commitment between the Opponent and Yellow Pages.⁸ No reference is made to the trade mark within the invoice. The column headed "product or service and proposed publication date advertisement details" is blank save that the order attracted a promotional offer. The invoice is for the sum of £12,487 payable by direct debit which indicates an ongoing commitment. The invoice is issued to T Fry of FLEETCLEAN LTD.

15. It is said that the company moved over to digital advertising in 'later years'. Extracts of the Opponent's company accounts are produced said to show the regular investment in promotion and marketing via its web developers. The "Digital Marketing Support and Reporting" monthly expenditure figures are listed dated between 14 October 2020 and 1 March 2022.⁹ These figures are recorded as either £720 or £1080 per month. An extract from the Opponent's company accounts is produced which is said to show the investment and promotion of the company via Google Advertising.¹⁰

⁴ Exhibit AS16.

⁵ A German International Logistics Company

⁶ Belgian International Logistics Company

⁷ Netherlands International Logistics Company

⁸ Exhibit AS17

⁹ Exhibit AS32

¹⁰ Exhibit AS33

The extract shows a list of Google advertising figures ranging from £18.36 to £500 per month, during the period 15 March 2019 and 25 February 2022.

Website

16. It is said that the Opponent's website www.fleetclean.co.uk was developed to build the Fleetclean name and brand within the industry and has been in existence since 2000.¹¹ Screen shots of the Opponent's website are produced dated 1 July 2012 and 12 April 2020, retrieved using the internet archive Wayback machine website. The screenshots are of the website's home page and display the earlier mark as registered, the company name, photographs of vehicle livery and a number of radio buttons where it is said consumers may select information as to the product range of chemicals via a drop down box.¹² The website includes the following information:

- Cleaning Equipment, Sales Service and Hire
- Suppliers of all makes of cleaning equipment including Karcher...etc.
- Hot and Cold Steam cleaners, Floor scrubbers and sweepers, Polishers, burnishers, Vacuum Cleaners, Carpet and Upholstery Cleaners,
- Operators of a state of the art Road Tanker Cleaning Station using High pressure Cleaning equipment.
- Suppliers and Installers of Piped factory cleaning systems.
- Service and Repair of all types of cleaning equipment and Tank Cleaning systems.

17. Mr Shedden produces a number of undated screen shots (two of which are reproduced below) taken from the current website, said to be post 2020.¹³ It is said that these screenshots clearly show the extensive range of services that 'Fleetclean' offers, including but not limited to the availability of chemicals and detergents.

¹¹ Exhibit AS18

¹² Exhibit AS18 and AS19

¹³ Exhibits AS20-AS22



Pressure Washers

Electric, diesel, mobile or static



Floor Sweepers

Available in both manual or powered models



Floor Scrubber Driers

Available in compact designs to large ride on models



Vacuums

Powerful industrial vacuum cleaners



Steam & Carpet Cleaners

Versatile, hygienic and safe cleaning



IBC Cleaning Equipment

Our range of IBC cleaning equipment systems/parts



Chemicals

The Fleetclean range of industrial detergents

<p>Fleetclean 3000</p> <p>Bulk Order Offer - Buy 4, Get One Free!</p> <p>View Product</p>		<p>Fleetclean 4000</p> <p>Bulk Order Offer - Buy 4, Get One Free!</p> <p>View Product</p>	
<p>Fleetclean Non-Caustic TFR</p> <p>Bulk Order Offer - Buy 4, Get One Free!</p> <p>View Product</p>		<p>Fleetclean Ultra Scrub</p> <p>High Quality Floor Care Detergent</p> <p>View Product</p>	

Domain names

18. Mr Shedden provides details of various web domain addresses owned by the Opponent, all of which include the word Fleetclean. Registration Certificates of the various domain names owned by the Opponent are produced dated between 28 April 1998 to 6 July 2019, taken from whois.com.¹⁴ An example of the Opponent's account with 1&1 IONOS (a web hosting service provider) is produced, showing the current

¹⁴ Exhibits AS23-AS30

domain name registrations which it is said are all directed to its main website address www.fleetclean.co.uk.¹⁵

Example of Confusion

18. Mr Shedden states that there have been a number of incidents of marketplace confusion as a result of the name Fleetclean being used on similar/identical products by the Applicant. He produces a letter from Ray Boyes (the Opponent's Service Manager), dated 24 March 2021, outlining the circumstances of one such incident.

Turnover

19. The annual turnover for the company "in the last 5 years",¹⁶ is said to average £2.25 million per annum, with all transactions carried out under the Fleetclean name and branding.

The Applicants' Evidence

20. The Applicants' evidence consists of the witness statements of Mrs J Cripps dated 22 April 2022, accompanied by five exhibits marked JC1-JC5; Mr Peter Harvey dated 25 April 2022 and Ms Jay Harvey dated 22 April 2022 accompanied by twelve exhibits marked JH1-JH12. The purpose of their statements is to challenge the Opponent's claim that it enjoys a reputation for all the goods/services relied upon and to set out the use that has been made of the contested mark and the reputation the Applicants hold. The salient points are outlined as follows:

Ms Cripps' statement

21. Ms Cripps is the director of the first Applicant a position she has held since August 2020. Ms Cripps states that a decision was made in 2020 to start the new company and she undertook research into any conflicts with their chosen name. Ms Cripps states that she "looked into Fleetclean Limited and checked their website" and formed the view that they were an "equipment hire and repair company" that did not promote any chemicals. Ms Cripps produces four undated screenshots (save for a print date of "Mon 28 Mar") of the Opponent's website, said to demonstrate the extensive research that she undertook into a potential conflict. Ms Cripps states that the Opponent's

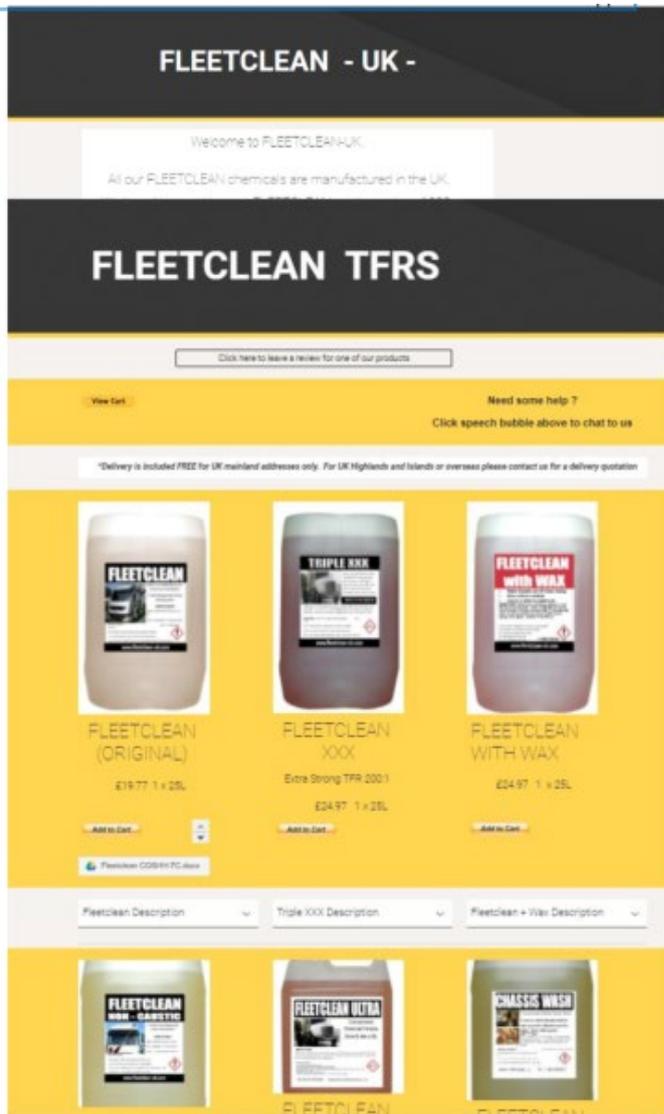
¹⁵ Exhibit AS31

¹⁶ which I understand to be from April 2017 to March 2022.

website does not demonstrate use or promotion of goods bearing the mark, only services. Furthermore, she confirms that the goods the Opponent's offer are proper to class 3 and are not covered by class 1.

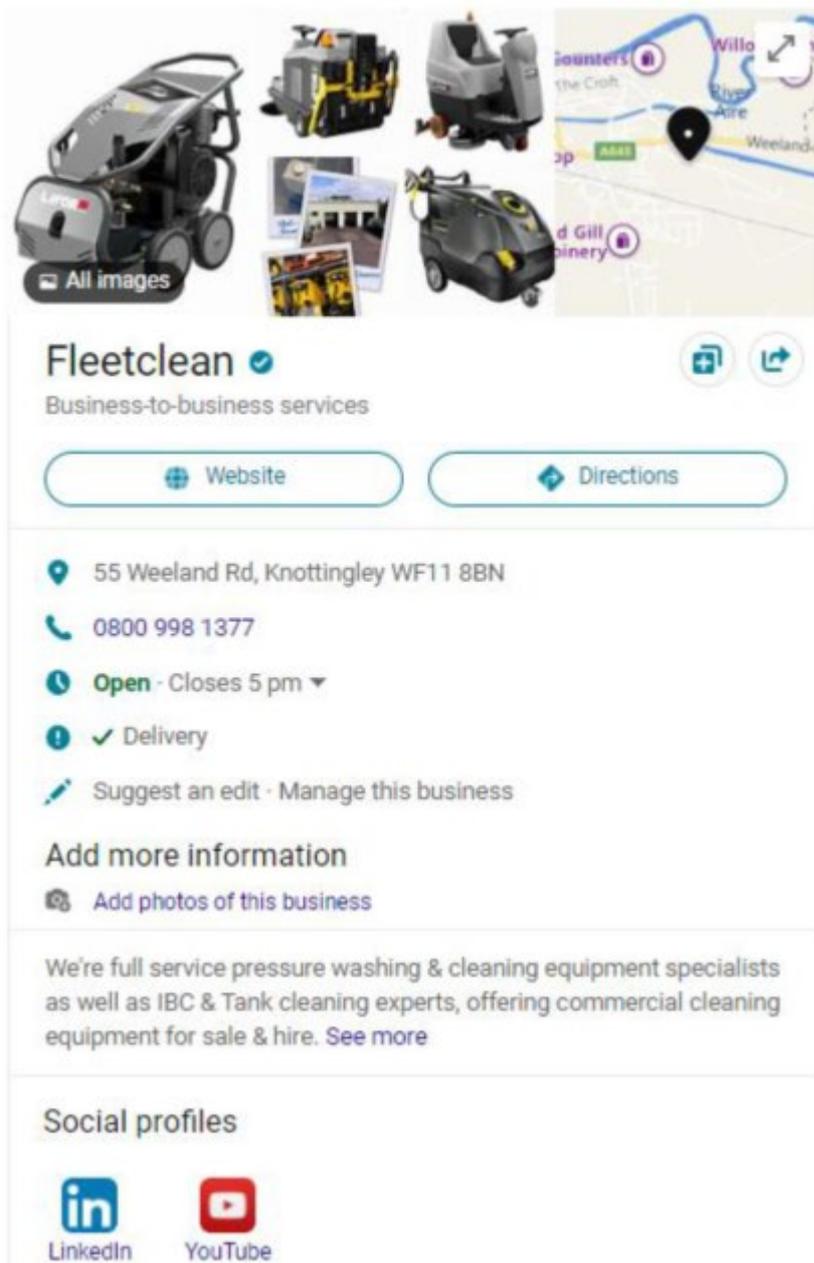
22. Ms Cripps states that the first Applicant was first registered under a different company name in 2015 under number 09592519, subsequently changing its name to Fleetclean-UK Ltd in August 2020 and changing its company number to 13116455 in 2021. Ms Cripps confirms that the application for the contested trade mark was submitted in both Applicants' names.

23. Ms Cripps states that the Applicants' range of Fleetclean products are promoted via their website. Exhibit JC3 is an undated screen shot (reproduced below), showing photographs of products said to be sold by the first Applicant on its website.



24. Ms Cripps refutes that the google adverts referred to by Mr Shedden, demonstrate the promotion of goods relied upon by the Opponent, and believes that they only relate to hire and cleaning services. To support this view, an undated screenshot (reproduced below) of an advert taken from google is produced.

See your ad here >



All images

Fleetclean ✓

Business-to-business services

[Website](#) [Directions](#)

55 Weeland Rd, Knottingley WF11 8BN

0800 998 1377

Open · Closes 5 pm ▾

✓ Delivery

[Suggest an edit](#) · [Manage this business](#)

Add more information

[Add photos of this business](#)

We're full service pressure washing & cleaning equipment specialists as well as IBC & Tank cleaning experts, offering commercial cleaning equipment for sale & hire. [See more](#)

Social profiles

[LinkedIn](#) [YouTube](#)

25. Ms Cripps believes that the Opponent only holds a reputation in hire and cleaning services and that it has not shown any evidence of promoting the mark in relation to the goods/services at issue.

Peter Harvey's statement

26. Peter Harvey is the second Applicant's company secretary, a position he has held since 1992. Mr Harvey states that 'Fleetclean' was an original line that the company sold in 1992 and have made significant sales of Fleetclean products to date, which it is said is a major part of the company's annual turnover amounting to approximately 50%. Mr Harvey states that although it has not officially had the trade mark registered, it has been used for the best part of 30 years and has a reputation as a product brand within the Aaron Chemicals range.

Jay Harvey's statement

27. Ms Harvey is the director of the second Applicant a position she has held since 1992. She states that her company has been using Fleetclean as a trade mark since January 1992 as the brand name for their degreasers, shampoos and automotive range of cleaning chemicals. She states that the company has been trading since 1992 and from its current premises since 2000. Ms Harvey produces the original lease agreement dated 1 April 2000 and the company's incorporation/registration certificate dated January 1992.¹⁷ The front page of the lease is produced showing the parties as Donovan Eastwood and Aaron Chemicals Ltd. The term of the lease is five years.

28. An undated screenshot is produced taken from the second Applicant's website.¹⁸ The page is headed 'vehicle washing chemicals' and includes photographs of four products bearing the mark FLEETCLEAN in 25L containers.

29. Ms Harvey produces the results of an undated google search undertaken as at "Mon 28 Mar",¹⁹ by inputting the name "fleetclean chemical products" into the search engine which it is said demonstrates both Applicants' reputation. Of the 17,700 results identified, three web addresses are disclosed; one for www.fleetclean-uk.com and two for www.aaronchemicals.co.uk.

¹⁷ Exhibits JH1 and JH2

¹⁸ Exhibit JH5

¹⁹ Exhibit JH6

30. Ms Harvey states that she has been involved in the sales of the second Applicant's products bearing the mark Fleetclean since 1992, but has not come across the Opponent as a competitor in the field, during this time.

31. Ms Harvey confirms that the second Applicant initially opposed the Opponent's registration, however, later withdrew its opposition under the belief that the goods/chemicals in class 1 and class 3 did not conflict. She produces the full alphabetical list of goods proper to class 1 and class 3 taken from the 11th edition of the niche classification guidance.²⁰

32. Ms Harvey believes that there is a clear difference between the class 1 chemicals and those outlined in class 3. It is argued that class 3 includes cleaning, polishing, scouring and abrasive preparations, whereas class 1 represents chemicals used in science and agriculture and making other products.

33. Ms Harvey confirms that their Fleetclean products are the company's best-selling range. To demonstrate proof of sales two letters from customers are produced dated 1 April 2022 and 4 April 2022.²¹ The first is from Alan Godden (the director of Thomas Transport Ltd) who confirms that he has been purchasing Fleetclean products from Aaron Chemicals for over 20 years and has been completely satisfied with their performance. The second letter is from LJ Parry (the Health and Safety Manager of Minera Roof Trusses Ltd). He states that he came cross the second Applicant over five years ago whilst searching the internet for a good vehicle wash, and has not bought any other vehicle wash since. He states that Fleetclean is a great product.

34. Ms Harvey produces an invoice dated 31 July 2008 addressed to Thomas Transport said to show the sale of Fleetclean products. The order refers to FLEETCLEAN NON CAUS in the product description column and the order quantity as 210 for a total price of £169.71.²²

35. A customer statement is produced from the second Applicant's records (reproduced below) said to show the continued sale of Fleetclean to customers since 2000.²³ The extract is undated and lists 20 entries between 2008 and 2021 with

²⁰ Exhibits JH7 and JH12

²¹ Exhibit JH3 and JH4

²² Exhibit JH9

²³ Exhibit JH10

reference to sales of three FLEETCLEAN non caustic and ultra non caustic products. A similar document dated between 2002 and 2005 is produced referring to two products within the range.²⁴ The entry for March 2021 shows 210 units sold totalling £409.50 plus Vat.

212 - Customer Account Enquiry:

PostNo	Inv Date	Inv No	Typ	UnitPr	Qty	DiscoAmt	Net Amt	VAT Amt	Tot Amt	Cost Amt	Margin
5.FCNC SP - FLEETCLEAN NON CAUSTIC											
116758	31/07/2008	12089	Inv	0.68	210.00	21.42	121.38	21.24			
Product Total for 5.FCNC SP:					210.00	4,498.20	121.38	21.24			
5.FCU 12 - FLEETCLEAN ULTRA NON CAUSTIC											
118986	14/05/2009	12794	Inv	1.11	210.00	81.59	151.51	22.73			
128057	01/05/2014	15088	Inv	1.79	210.00	131.57	244.33	48.87			
128269	23/01/2015	15210	Inv	1.87	210.00	137.45	255.25	51.05			
128548	03/08/2015	15311	Inv	1.95	210.00	143.33	266.17	53.23			
Product Total for 5.FCU 12:					840.00	103,727.40	917.26	175.88			
5.FCU K - FLEETCLEAN NON CAUSTIC											
120648	22/02/2010	13341	Inv	1.17	210.00	85.67	159.09	27.84			
121636	10/09/2010	13658	Inv	1.17	210.00	86.00	159.70	27.95			
123064	29/06/2011	14074	Inv	1.17	210.00	86.00	159.70	31.94			
123622	21/12/2011	14328	Inv	1.17	210.00	86.00	159.70	31.94			
124739	30/07/2012	14601	Inv	1.25	210.00	91.88	170.62	34.12			
125108	10/12/2012	14744	Inv	1.25	210.00	91.88	170.62	34.12			
125775	09/07/2013	14911	Inv	1.25	210.00	91.88	170.62	34.12			
126001	27/02/2014	15044	Inv	1.56	100.00	0.00	156.00	31.20			
126881	20/05/2016	15487	Inv	1.95	210.00	0.00	409.50	81.90			
127026	21/10/2016	15569	Inv	1.95	210.00	0.00	409.50	81.90			
127027	21/10/2016	15571	Inv	1.95	20.00	0.00	39.00	7.80			
127279	20/10/2017	15719	Inv	1.95	210.00	0.00	409.50	81.90			
127393	23/04/2018	15777	Inv	1.95	210.00	0.00	409.50	81.90			
127693	14/05/2019	15946	Inv	1.95	210.00	0.00	409.50	81.90			
128353	03/03/2021	16321	Inv	1.95	210.00	0.00	409.50	81.90			

Opponent's Evidence in Reply

36. The Opponent's evidence in reply consists of the second witness statement of Alistair Shedden dated 7 July 2022 accompanied by fourteen exhibits marked AS-SEC1 to AS-SEC14.

²⁴ Exhibit JH11

37. The purpose of Mr Shedden's statement is to comment on the Applicants' evidence denying various claims. In particular Mr Shedden refutes the following:

- that the products in class 1 are dissimilar to those contained within class 3. He states that the Applicants have omitted information which clearly show an overlap.
- In so far as the Applicant's google search not producing any reference to the Opponent it is said that their search was undertaken via the Bing search engine and not Google. A counter result list using Google is produced which includes the Opponent's details.
- that the first Applicant has traded for a number of years as claimed, given that it was only incorporated 18 months ago and prior to that under a completely different name with the company's activities listed as unlicensed restaurant and café services.
- It denies that the Opponent's website makes no reference to its goods under the mark. The screenshot produced by the Applicants only shows the landing page of its website and it is said that upon clicking the radio button/ drop down menu the goods are clearly displayed.

Submissions

38. Both parties filed submissions during the proceedings. Whilst I have read the contents of these documents in their entirety, I do not propose to summarise them here, but have taken them into account and will refer to them where appropriate later in my decision. It is noted that the Opponent filed five sets of submissions during the proceedings, responding to each statement made by the Applicants. A number of these responses duplicated previous submissions relied upon and did nothing more than refute the allegations. In addition some of the contents of the submissions purported to advance evidence of fact. For clarification only those facts contained within the Opponent's witness statement shall be taken as evidence of fact and considered in my assessment regarding the Opponent's claim to a reputation.

Case Management Conference

39. During the evidence rounds the Opponent initially filed submissions rather than evidence of fact albeit within the original timetable set. It was asked to refile the

evidence in the correct format which necessitated a request for an extension of time. A Case Management Conference (“CMC”) was held before me on 16 March 2022 to consider the request. I granted the extension of time after hearing submissions from both parties. I subsequently issued a letter to the parties dated 18 March 2022 setting out my reasons and I adopt those reasons.

40. During the CMC it became clear that both parties were raising issues which were not related to a ground of opposition under section 5(3) and appeared to be more suitable to other grounds not relied upon or pleaded. In my post CMC letter I advised both parties to seek legal advice as to their respective positions to ensure that they were bringing and defending the action under the correct section of the legislation. Neither party availed themselves of that opportunity. Since this decision is based solely on an opposition brought under section 5(3) I can only consider those matters that relate directly to this ground.

The Applicants’ defence

41. The Applicants appear to be defending the matter on the basis of their claim to an entitlement to a prior right and that they have built up their own reputation in their unregistered sign. This type of argument is one ordinarily raised as a due cause defence, which has to be specifically pleaded. Although the words ‘due cause’ have not been explicitly pleaded by the Applicants, the way in which the Applicants have drafted their defence is such that I shall consider the issue later in my decision.

Hearsay Evidence

42. Both parties have filed witness statements which contain letters drafted by third parties within exhibits, without those third parties having completed a witness statement themselves or those letters being verified by a statement of truth. Letters filed in this manner are known as hearsay evidence and whilst they are admissible, it brings into question the weight I attached to this evidence.

43. The relevant part of the Tribunal Work Manual relating to hearsay states:

“4.8.10 Hearsay

Hearsay evidence is oral or written statements made by someone who is not a witness in the case but which the Court or Tribunal is asked to accept as evidence for the truth of what is stated.

If a witness statement, affidavit or statutory declaration contains hearsay evidence, it should be filed in sufficient time and it should contain sufficient particulars to enable the other party or parties to deal with the matters arising out of its containing such evidence. If the provision of further particulars of or relating to the evidence is reasonable and practicable in the circumstances for that purpose, they should be given on request.

It is also to be borne in mind that in estimating the weight (if any) to be given to hearsay evidence in proceedings before the Tribunal, the Tribunal and those acting on its behalf shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence. In estimating the weight, if any, to be given to hearsay evidence attention is drawn to the provisions of section 4 of the Civil Evidence Act 1995, which states:-

“4(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following –

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.”

44. The authors of the letters appear to be UK based and either customers or employees of the respective parties. I see no reason, therefore, why they could not have filed the information under cover of a witness statement. Nevertheless, I do not believe, nor has it been argued, that either party has been motivated to conceal or misrepresent matters by filing evidence in this way, nor that it has been done to prevent the proper evaluation of the information contained within those letters or that they contain an edited account. It appears clear from the dates of these letters that they have been prepared for the purposes of these proceedings and are not a contemporaneous note of the events to which they refer, namely the supply and sale of goods. Despite this I note that the parties are unrepresented, which has a bearing on the way in which the evidence has been prepared and filed and neither party is in a more advantageous position than the other. Therefore, whilst I intend to take the letters into account, the letters themselves contain little information as to the number of products sold/supplied or the number of orders placed. They do no more than confirm that goods have been sold by both parties but not the volume or extent. The generality of the contents of the letters are such that they are of little assistance in the assessment I must make.

Decision

Section 5(3)

45. Section 5(3) of the Act reads as follows:

“5(3) A trade mark which-

(a) 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 European Union trade mark or international trade mark (EC), in the European Union) 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.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.

5A. [...] Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

46. The relevant case law can be found in the following judgments of the Court of Justice of the European Union (“CJEU”): Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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* and *Environmental Manufacturing, paragraph 34*.

(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 of 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).

47. The conditions of section 5(3) are cumulative. Firstly, whether the respective marks are similar. Secondly, the Opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed by the Opponent will be suffered. It is unnecessary for the purposes of section 5(3) for the goods and services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between them. For the purposes of this assessment the relevant date is the date of filing of the application, namely 4 February 2021.

Similarity of the marks

48. Both trade marks include the identical word 'fleetclean', which is the dominant element of the earlier mark and the only element of the contested mark. The differences arising from the casing and font used in the respective marks as well as the use of colour and some stylisation in the earlier mark does little to detract from the obvious similarities between them as a result of the common word 'fleetclean'. I consider that the marks are similar. The first condition is met. I shall address the degree of similarity later in my decision.

Reputation

49. In assessing whether the earlier mark has a reputation, I must assess the evidence in terms of the extent it demonstrates "the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it."²⁵ Whilst not regarded as a particularly onerous requirement,²⁶ nevertheless, a trade mark with a qualifying reputation must be known to more than a commercially non-negligible part of the relevant public, namely a significant number of relevant consumers concerned by the products or services

²⁵ *General Motors* para 28

²⁶ *Enterprise Holdings Inc. v Europcar Group UK Ltd* [2015] EWHC 17 (Ch)

covered by that trade mark. As Mr Phillip Johnson, sitting as the Appointed Person, stated in *Spirit Energy Limited v Spirit Solar Limited*,²⁷ context is everything. Therefore in assessing what constitutes a significant number, whilst the courts have not indicated what this number is, it is accepted that the threshold would be considerably higher, if the relevant public is the public at large, as opposed to a relevant public within a small market.

50. The Opponent's evidence is not the most focussed and lacks specificity. For example, whilst Mr Shedden provides turnover figures, no breakdown is provided as to how much relates to the provision of the services and what relates to the sale of goods, specifically the detergents and cleaners relied on in class 1. Similarly, Mr Shedden states that it operates a high volume throughput cleaning facility in West Yorkshire and has become synonymous within the marketplace as being one of the UK's leading distributors for industrial cleaning equipment and associated chemical products. However, these broad claims are not supported by specific details as to the extent of its customer base, how many actual customers use the facility, during any given period or the number of longstanding contracts it has with its customers.

51. The screenshots from its website said to have been in existence since 2000 clearly show the trade mark prominently displayed for the provision of both the goods and the services under the trade mark, but are of limited probative value since no information has been provided as to the volume of consumers who have viewed or accessed the website or the custom generated as a result. Similarly the existence of domain name registrations tell me nothing as to how many customers accessed these websites and were redirected to the Opponent's main site.

52. I place the greatest weight on the turnover figures produced, which amount to £2.25 million per annum and which whilst not extensive are not insignificant either. I am not told what the market share is for the provision of such goods/services and whether a turnover of £2.25 million can be regarded as representing a good proportion of that market. However, I consider that the Opponent operates in a fairly narrow, niche field which, therefore, would make an annual turnover of £2.25 million, a reasonable accomplishment within the industry. The Opponent has also provided evidence of its regular advertising and promotional spend, amounting to between £30,000 to £40,000

²⁷ BL O/034/20

per annum which pre 2010 was predominantly via Yellow Pages, later developing online. Google advertising and digital marketing monthly expenditure figures are produced which show a regular and consistent monthly outlay being expended in the months leading up to and after the relevant date. The Opponent is clearly not a multinational global company, with a business predominantly located in and around West Yorkshire.

53. It appears to me, that the services are not ones that are widely and readily available to members of the public, in the same way as a commonplace/conventional car wash or valeting service for example. In my view the provision of the services offered by the Opponent is much more niche with a specific commercial, business to business purpose. The same cannot be said for the goods predominantly referred to in the evidence, which appear to be for the most part detergents and cleaners of various strengths and would not necessarily be restricted to the same niche consumer as for the services and may have a wider market. Little evidence is provided that demonstrates that the Opponent sells cleaning equipment branded with the earlier mark (other than one reference by way of a photograph on its website to an IBC cleaner). Those referred to appear to be predominantly third party brands, such as for example Karcher.

54. It is clear from the evidence that the main focus of the Opponent's business is in the services it provides, which was originally the provision of external cleaning services to commercial fleet vehicles and at some point developed into the field of industrial cleaning equipment hire and IBC/tank cleaning services. The turnover supports the contention that the mark Fleetclean has become synonymous within the marketplace for these services.

55. Ms Cripps for the Applicant appears to accept that the Opponent holds a reputation in hire and cleaning services; it is the claimed reputation in the provision of detergents and cleaners that is disputed. In response to this claim, the Opponent disputes the contention that it only has a reputation for cleaning and contends that its reputation extends to selling chemicals also.²⁸ However, without any cogent evidence to demonstrate this by sales figures, units sold or the number of customers, I am unable to draw this conclusion. It appears to me that the provision of cleaners and detergents

²⁸ additional submissions (filed 7 July 2022)

by the Opponent forms part of an after care service, but this is not where predominantly its reputation lies. The fact that the Opponent does not manufacture its cleaners and detergents would not have been fatal to its case, however, given that no details are provided as to the actual number of units sold, the evidence from Mr Lucas is of little value in establishing the required reputation. I fully accept that the Opponent sells detergents and cleaners under the earlier mark and a proportion of the turnover will relate to these goods, but I am unable to determine with any degree of certainty how much, as no information is given in this regard. It is impossible, therefore, for me to assess the extent of the reputation the Opponent holds in its class 1 and 7 goods as the evidence has fallen far short for me to be able to do so.

56. Nevertheless, despite the shortcomings in the evidence filed, overall, taking the evidence as a whole and the position taken by the Applicants, it is sufficient to demonstrate that the Opponent has a customer base in the UK, that that customer base is not the public at large and that it has a sufficient reputation upon which to base its section 5(3) ground, but only in the following services:

Class 37: Cleaning equipment (Rental of -); Cleaning equipment hire; Rental of cleaning equipment; Rental of tools, plant and equipment for cleaning.....; Vehicle cleaning; Cleaning of vehicles; Cleaning of storage containers; Cleaning of storage tanks; Cleaning of water tanks; Storage tank cleaning.

Link

57. Having found a reputation I must now go on to consider whether this reputation would give rise to the necessary mental link being made between the respective trade marks. The relevant public for the services in which I found that the Opponent had a reputation, is the business user for the services under consideration, who are deemed to be reasonably informed and reasonably observant and circumspect. The factors to be taken into account to establish as to whether a link would be made, are those as set out in *Intel*²⁹ where the CJEU stated that if the later mark would call the earlier mark to mind, this is tantamount to the existence of a link. The other factors considered by the CJEU from the same judgment, are as follows:

²⁹ *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU).

“31. In the absence of such a link in the mind of the public, the use of the alter mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

[...]

41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.

[...]

44. As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.”

58. As regards the degree of similarity between the conflicting marks, since the Opponent has not sought to rely on any other ground I shall consider the assessment having regard to the established principles as set out by the caselaw.³⁰ I make the following findings:

³⁰ *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 overall impression of both marks resides in the word fleetclean/Fleetclean which is the totality of the Applicant's mark and the dominant element of the earlier mark. In both marks the word fleetclean, despite being presented as one word, will be seen as made up of two words, the word 'fleet' together with the word 'clean'.
- As a result of the common word 'fleetclean' the marks are visually similar to a high degree, regardless of the difference in casing/font and the use of colour and the scroll in the Opponent's mark. Aurally the marks are identical, given that no pronunciation will be given to the scroll in the earlier mark. Conceptually whilst the word fleetclean could give rise to a number of meanings, whichever meaning is attributed, it would apply equally to both marks. The most likely and immediate meaning attributed to the word fleet is a term to mean a group or a number of vehicles operating together or under the same ownership.³¹ The ordinary meaning will be attributed to the word clean namely something that is free from dirt, marks or stains. In combination the meaning would allude to a fleet of vehicles kept clean. Conceptually the marks are identical. Overall the marks are highly similar.
- The average consumer of the Opponent's services is predominantly a business user and the Applicant's goods will either be a business user or the general member of the public.
- I consider that due to the potential hazardous and caustic nature of the goods at least an average level of attention would be undertaken in the purchasing process. Considerations such as price, suitability, effectiveness and efficiency would be taken into account. In so far as the services, as they are likely to be supplied under contract I consider that an above average level of attention will be undertaken. Visual considerations will dominate the purchasing process, where purchases/selection of the services are made online or from equivalent retail premises. I do not discount aural considerations, however, following word of mouth recommendations or enquiries with sales assistants over the telephone.
- The distinctiveness of the earlier mark lies in the combination of the words and the stylisation. Due to the nature of the services on offer, namely those provided

³¹ Oxford online dictionary.

in an industrial setting to clean groups of vehicles, I consider that the earlier mark is allusive as to the nature or characteristic of the services on offer and therefore is inherently distinctive to a low degree. Despite the shortcomings in the evidence, overall, I find that the use the Opponent has made of its earlier mark for those services as set out in paragraph 56, will have built upon the low degree of inherent distinctive character its trade mark enjoys and enhanced the level of distinctiveness to a medium degree.

59. In so far as the similarity or otherwise of the respective goods and services I bear in mind section 60A of the Act which states:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

60. The arguments raised by the Applicant namely that the parties’ goods/services cannot be regarded as similar as they appear in different classes, is, therefore, flawed and wrong in law. Specifications appearing under different class headings do not preclude a conclusion of identity/similarity on this basis alone, as the classification system’s purpose is to determine the boundaries of infringement rights. A reference to a class heading may be appropriate, where the meaning of a term is not sufficiently clear and precise.³² This is not the position in the decision in suit. The assessment to be undertaken, takes into account the meaning and scope of the respective terms in

³² *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch),

their entirety and is not based solely on the specific class heading in which they appear.³³

61. In light of my findings regarding the Opponent’s reputation only residing in those services as set out in paragraph 56, the comparison of the parties’ goods and services are set out as follows:

Applicant’s goods	Opponent’s services
Class 3: Cleaning sprays; Cleaning fluids; Automobile cleaning preparations; Car shampoos; Cleaning foam; Caustic cleaning agents.	Class 37: Cleaning equipment (Rental of -); Cleaning equipment hire; Rental of cleaning equipment; Rental of tools, plant and equipment for cleaning; Vehicle cleaning; Cleaning of vehicles; Cleaning of storage containers; Cleaning of storage tanks; Cleaning of water tanks; Storage tank cleaning.

62. When conducting a good and services comparison all relevant factors should be considered such as, inter alia, their nature, their intended purpose, their method of use, trade channels and whether they are in competition with each other or are complementary.³⁴ Complementarity was defined in *Boston Scientific Ltd v OHIM*,³⁵ which stated:

“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...”.

63. The Applicant seeks registration for *Cleaning sprays; Cleaning fluids; Automobile cleaning preparations; Car shampoos; Cleaning foam; Caustic cleaning agents* which are all detergents or cleaning preparations for general cleaning purposes or specifically for automobiles. A detergent is defined as a cleaning agent made up of

³³ Article 33(7) EUTMR

³⁴ *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97(CJEU) and *Treat*, [1996] R.P.C. 281

³⁵ General Court- Case T-325/06

various chemicals in order to remove dirt, stains or marks. The Applicant's terms are drafted fairly broadly and there is nothing to preclude them being used in an industrial setting, despite the Applicant's submissions to the contrary. The Opponent's *Vehicle cleaning; Cleaning of vehicles; Cleaning of storage containers; Cleaning of storage tanks; Cleaning of water tanks; Storage tank cleaning* services are those specifically related to the provision of vehicle cleaning services and would be understood as part of the service to include the use of cleaning agents/preparations such as shampoos, liquids and foams as part of the process. Whilst the nature of the services and the goods differ they share a common purpose namely the removal of dirt. In addition, the respective goods and services may be provided through the same channels of trade and will also be regarded as complementary such that consumers will believe that the same undertaking is responsible for the provision of the respective goods and services. On this basis I consider that the Applicant's goods and the Opponent's services are similar to a low to medium degree.

64. Similarly an undertaking providing *cleaning equipment (Rental of -); Cleaning equipment hire; Rental of cleaning equipment; Rental of tools, plant and equipment for cleaning* is also likely and often does provide a recommended cleaning agent to complement the hire/rental of the equipment and therefore I also consider that for these services they would also share trade channels, be directed at the same end user and be complementary to the Applicant's goods in class 3. They are similar to a low to medium degree.

65. As stated earlier in my decision, the contested cleaning preparations in class 3 are directed towards the public at large but nothing would preclude them from being used by the professional public. This would apply equally to the Opponent's services in class 37 when considering the broad meaning of the terms on a notional basis.

Conclusions as to a link

66. Taking into account the factors in *Intel*, I found that based on the evidence filed, the Opponent has demonstrated a modest reputation in the services as identified and that the low level of inherent distinctive character of its mark has been enhanced to a medium degree, as a result of the use it has made of it. The Opponent's reputation is sufficiently strong, that combined with the similarities between the respective marks and the goods/services, it is sufficiently distinctive for the earlier mark to be brought to

mind upon seeing the later mark and for a connection to be made between the two undertakings. In my view there is sufficient nexus between the respective goods and services and the parties' field of business for a significant part of the relevant public to make the necessary link between them.

Damage

67. Having come to this conclusion, I must now assess whether one of the three types of damage will arise. In relation to the first head of damage, namely unfair advantage, I must consider whether the Applicant would gain an unfair advantage, because it will benefit from the advertising and investment already expended by the Opponent and enjoy increased sales, without having to outlay the equivalent expenditure and investment or time to promote its mark. The Opponent submits that the "Applicants' website is 'riding on the back' of all the work carried out by our company in promoting the brand name Fleetclean on the internet over many years" and that the fact that two companies are selling identical products under the same name is a clear conflict that will repeatedly cause marketplace confusion. This is denied by the Applicants.

Unfair Advantage

68. In *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods/services offered under the later trade mark was required to establish unfair advantage. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark.³⁶

69. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

"80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of

³⁶ *Claridges Hotel Limited v Claridge Candles Limited and Anor*, [2019] EWHC 2003 (IPEC).

the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

70. It is claimed that as a result of the Opponent’s reputation, it will be easier for the Applicant to market its goods such that consumers are more likely to select the goods under the application than they would otherwise, had they not been reminded of the earlier mark. I agree with this contention. I note that the Opponent has spent thousands of pounds each year in promoting its company and mark, in recent years via its website and Google. Its reputation has therefore been built up over a number of years and whilst not a large company, that reputation would not have been achieved overnight.

71. It is clear that the Applicants were aware of the Opponent’s business before they applied for the trade mark as Ms Cripps admitted that she undertook research into any conflicts with their chosen name, and “looked into Fleetclean Limited and checked their website”. They formed the view that the Opponent was operating in a different field of activity and therefore there would be no conflict. This however is a complete misunderstanding of trade mark law. In my view, there is an increased chance of consumers buying the later mark’s products because of their perceived link with the Opponent. I consider that there is a strong possibility that the Applicant would gain a commercial advantage and gain a foothold in the industry quickly without making the equivalent marketing effort themselves, taking unfair advantage of the Opponent’s well established reputation. The economic behaviour of customers would change leading to a commercial advantage being gained by the Applicant.

Due cause

72. The Applicants’ case, as far as I can tell, is that it has a prior entitlement to the name and that it has built up its own reputation in the mark prior to its application for registration. It submits that on the basis that “the two trade marks are registered under

two separate classes” and that Aaron Chemicals has been trading using this trade mark for so long and clearly have a reputation in this field ... both marks should be allowed to exist as they do not conflict with each other”. In assessing whether this gives rise to a due cause defence, I shall consider the comments in *Leidseplein Beheer BV v Red Bull*, Case C-65/12, where the CJEU held that:

“60. ...the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of ‘due cause’ within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith. In order to determine whether that is so, the national court must take account, in particular, of:

- how that sign has been accepted by, and what its reputation is with, the relevant public;
- the degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered; and
- the economic and commercial significance of the use for that product of the sign which is similar to that mark.

73. The Applicant’s evidence of its reputation is limited. Whilst Mr Harvey states that ‘their fleetclean products account for 50% of turnover’ no details are provided of the actual turnover achieved for me to be able to assess how much 50% represents. Whilst a customer statement is produced from the second Applicant’s records, said to show sales of Fleetclean products since 2000, the screenshot only appears to relate to one customer and appears to show sales amounting to at best no more than 210 units, totalling approximately £500 (inc vat), in any given year. A number of the screenshots taken from its websites are undated as are other extracts. The results of its internet searches are inconclusive and are of limited value. The letters from two of its customers are again of little assistance as neither provide details as to how many products were purchased despite a claim that they have done so for over 20 years.

74. I do not accept that the Applicants' use of the contested mark would be regarded as fair competition. Whilst the Applicants state that they have built up a strong reputation of their own, the evidence to support such a claim does not demonstrate this. I have insufficient evidence to determine the market share held by the Applicants. No evidence was produced as to its turnover figures or the geographical extent of its sales. The evidence filed by the Applicants is insufficient in order to establish that it has gained the necessary reputation amongst the general members of the public (to whom I believe their goods are directed).

75. I acknowledge that the Opponent did not file evidence of market share either, however, it did produce sufficient evidence overall, as to the geographical extent and promotion of its mark as well as its turnover figures, to enable me to distinguish its evidence from that of the Applicants in my assessment of the respective reputations claimed. Moreover, I take account of the fact that I considered the Opponent's services were directed towards a smaller consumer market, whereas, the Applicants goods were directed at the public at large, therefore, requiring a larger percentage of sales to cross the reputation threshold. The scale and extent of the Applicants evidence was such that it was insufficient for a defence of due cause to succeed (even if I accept that it has been pleaded).

76. Furthermore, it is my view that use by the Applicants of their mark would take unfair advantage of the Opponent's reputation and therefore this is sufficient to counter the Applicant's arguments in any event.

Conclusion

77. Since I have found damage resulting from an unfair advantage being gained by the Applicant, this is sufficient for the opposition based upon section 5(3) to succeed and I need not therefore consider whether any of the other heads of damage has arisen.

78. The opposition based upon section 5(3) of the Act succeeds. Subject to any successful appeal, the application shall be refused registration for the following goods:

Class 3: Cleaning sprays; Cleaning fluids; Automobile cleaning preparations; Car shampoos; Cleaning foam; Caustic cleaning agents.

79. The Opponent has not opposed the following goods in the Applicant's specification and therefore they shall proceed to registration unchallenged.

Class 3: Hand cleaning preparations; Car polish; Car wax; Carpet cleaning preparations; Windscreen cleaning liquids; Windscreen cleaning fluids.

Costs

80. As the Opponent has been successful it is entitled to a contribution toward its costs.

81. As an unrepresented party, any claim for costs is awarded in accordance with The Litigants in Person (Costs and Expenses) Act 1975 which sets payment at a rate of £19.00 per hour. The Opponent was invited by the tribunal to complete and file a pro forma, setting out the hours spent on a range of given activities and the costs incurred relating to the prosecution of the proceedings. In total Mr Shedden claims 30.5 hours of time for preparing the Opponent's case at an hourly rate of £77 per hour.

82. Firstly in assessing any costs award, as an unrepresented party and in accordance with Tribunal Practice Notice 2/2016, the hourly rate to be awarded is set at £19 per hour and not £77 per hour as claimed. Furthermore, in relation to the hours spent, I accept that as a 'lay person' the time taken by Mr Shedden to prepare the Opponent's case would take longer than a professional and that a claim under section 5(3) is not necessarily straightforward. I note, however, that Mr Shedden's claim includes 17.5 hours for "*detailed research of facts for primary evidence round, preparing of argument, collation of evidence, writing and presentation of statement of facts and additional submissions*" and 7 hours for "*detailed research of facts for secondary evidence round, preparing of rebuttal argument, collation of evidence, writing and presentation of statement of facts and additional submissions*" which in terms of the lack of specificity I have already identified earlier regarding the evidence, is excessive. Furthermore the Opponent filed five sets of submissions which were largely repetitive and included evidence of fact either already referred to in the witness statements or details that I have not been able to take into account.

83. Taking these matter into account, I consider that an appropriate award amounts to 16 hours; 11 hours for the time spent on its primary evidence rounds and submissions and a further 5 hours for its secondary evidence rounds. I do not challenge the

remaining hours spent for preparing and drafting the notice of opposition, submissions in lieu of hearing or considering the Applicants' documents. Furthermore in relation to any costs arising from the CMC, the CMC was as a result of a challenge by the Opponent to the Registry's refusal to allow an extension of time, which ultimately went in the Opponent's favour and not from a challenge by the Applicant. On this basis, I make no additional award for the costs arising from the CMC.

84. I therefore make an award of costs on the following basis at the rate of £19 per hour:

Preparing a Notice of opposition (2 hours):	£38
Considering TM8 and counterstatement filed by the Applicants (2 hours):	£38
Preparing primary evidence, research and writing witness statement/submissions (11 hours):	£209
Preparing secondary evidence, research and writing witness statement/submissions (5 hours):	£95
Preparing submissions in lieu of hearing (2 hours):	£38
Official Fee:	£200
Total:	£618

85. I order Fleetclean-UK Ltd and Aaron Chemicals Ltd, jointly and severally, to pay Fleetclean Limited the sum of £618. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of November 2022

Leisa Davies

For the Registrar