

O-948-22

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3625491
BY P1 MATCH MY CAR LTD
TO REGISTER**



**AS A TRADE MARK
IN CLASSES 12, 35, 36 & 37
AND OPPOSITION THERETO (UNDER NO. 425822)
BY
PIRELLI TYRE S.P.A**

Background & pleadings

1. P1 Match My Car Ltd (“the applicant”) applied to register the trade mark set out on the title page of this decision on 13 April 2021. The application was examined and published in the Trade Marks Journal on 11 June 2021 in classes 12, 35, 36 and 37. This opposition concerns only class 12. During the course of these proceedings the applicant sought to restrict its class 12 specification by means of a form TM21B dated 28 June 2022. The class 12 specification currently stands as: *vehicles; wheeled vehicles.*

2. Pirelli Tyre S.p.A (“the opponent”) opposed class 12 of the application, on 27 July 2021, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) on the basis of some class 12 goods in its UK trade mark no. 909938994. Details of the earlier registration are set out below.

UK TM No. 909938994	Goods relied on in Class 12
P1 Filing date: 4 May 2011 Registration date: 11 October 2011	<i>Vehicles; apparatus for locomotion by land, air or water, in particular tyres; solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds.</i>

3. The opponent’s trade mark has a filing date that is earlier than the filing date of the application and, therefore, it is an earlier mark, in accordance with section 6 of the Act. As the registration procedure was completed more than 5 years prior to the filing date of the contested application, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of the goods it relies on, namely *vehicles; tyres.*

4. The applicant filed a counterstatement in which it denied the ground of opposition but did not put the opponent to proof of use of its earlier registration. As a result the opponent can rely on all goods stated in its notice of opposition.

5. During these proceedings the applicant has represented itself whilst the opponent has been represented by Armstrong Teasdale Limited. Both parties filed evidence and written submissions in lieu of a hearing.

6. 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

7. I make this decision following consideration of all the material before me.

Applicant's evidence

8. The applicant submitted a witness statement in the name of Howard Forland, the sole director and majority shareholder of the applicant company. Mr Forland appended nine exhibits. His witness statement is a mix of evidence and submissions. With regard to the exhibits filed, exhibits 1-4 contain screenshots of online definitions for P1. Exhibits 5 and 6 consists of screenshots of the opponent's website and tyre catalogue. Exhibit 7 consists of a vehicle appraisal. Exhibit 8 consists of two MP4 videos clips demonstrating how the applicant's business works and finally exhibit 9 is evidence of registration for another of the applicant's trade marks which does not form part of these proceedings.

9. Having considered the applicant's evidence, I do not find it to be relevant to the decision I must make. Even if I accept that the applicant and the opponent currently operate in different areas of the motor trade, this would not in any case be relevant to the issue of confusion which I must decide in these proceedings. It is settled law that in assessing whether there is a likelihood of confusion I must make my comparison of "notional and fair use" based on the class 12 goods covered by the application and since the earlier mark is not subject to proof of use, the opponent's class 12 goods. It is the *inherent* nature of the specifications which I have to consider. Current use and business activities are not relevant to this notional comparison. My task, therefore, is to conduct the comparison simply on the basis of the goods as they are set out in the

respective specifications. The concept of “notional and fair use” is outlined in the *Roger Maier*¹ decision, particularly paragraph 78,

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

10. The applicant also provided detail of other trade marks on the UK register containing P1. Such “state of the register” evidence is also irrelevant to my decision. In *Zero Industry Srl v OHIM*,² the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM –

¹ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

² Case T-400/06

Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

Opponent’s evidence

11. The opponent filed a witness statement in the name of Giacomo Maria Marsaglia, a proxy holder in the IP Department of the opponent company. Ms Marsaglia appended six exhibits. Her witness statement and exhibits are largely rebuttals of the applicant’s evidence which for the reasons given above I do not need to consider further.

Section 5(2)(b)

12. Section 5(2)(b) of the Act is as follows:

“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”.

13. The following principles are gleaned from the judgments 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 C3/03, *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 the 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 goods

14. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*,³ 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”.

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case,⁴ for assessing similarity were:

- (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;

³ Case C-39/97

⁴ [1996] R.P.C. 281

(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.

14. The following case law is also applicable in relation to the contested goods in these proceedings when in *Gérard Meric v Office for Harmonisation in the Internal Market*⁵, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15. The goods to be compared are

Opponent's goods	Applicant's goods
<i>Vehicles; apparatus for locomotion by land, air or water, in particular tyres; solid, semi-pneumatic and pneumatic tyres for vehicle wheels of all kinds.</i>	<i>Vehicles; wheeled vehicles.</i>

16. I find the opponent's term *vehicles* to be identical to *vehicles* in the applicant's specification. Furthermore the opponent's term *vehicles* at large is sufficiently broad to cover the applicant's term *wheeled vehicles* so it is considered identical under the principle outlined in the *Meric* extract given above.

⁵ Case T- 133/05

Average Consumer

17. I next consider who the average consumer is for the contested goods and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.⁶ For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.⁷

18. The average consumers for the contested goods are the general public and businesses. These goods are likely to be relatively expensive and, in my view, perhaps less frequently purchased by the general public than by businesses. However, all consumers will be taking factors like price, condition, service history and suitability for purpose into consideration. As such I find consumers would be paying a high level of attention. The purchasing process will be primarily visual as consumers are likely to browse either the physical goods or review online material, websites etc, although I do not rule out an aural aspect to purchase through word-of-mouth recommendations.

Mark comparisons

19. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*⁸, 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

⁶ *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)

⁷ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

⁸ Case C-591/12P

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.”

20. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

21. The respective trade marks to be compared are:

Opponent's earlier mark	Applicant's mark
<p style="font-size: 2em; font-weight: bold;">P1</p>	

22. The opponent's mark consists of the letter and numeral combination **P1**. It has no other aspect to it and as such its overall impression derives solely from this presentation.

23. The applicant's mark is a composite arrangement of words and figurative elements. The mark consists of a three sectioned rectangular background with a red section at the front and at the end with a black section in the middle. Within the black section is a device of a red circle within which are pieces of paper with a £ sign and an outline of half of a car facing forward. The device is positioned before the words **P1 Match My Car** depicted in white lettering above the strapline **Driven to perfection** which is much smaller in scale and depicted in grey lettering. Given that the goods and services all relate to vehicles in some way then the words **Match My Car** and **Driven to perfection** are not especially distinctive. The figurative and word elements **P1 Match My Car** both make a contribution of the overall impression of the mark. The strapline, given its subordinate positioning and size of font compared to the other word element makes much less of a contribution.

24. In a visual comparison the respective marks share the letter and numeral combination **P1**. This is the entirety of the opponent's mark and one of the word elements of the applicant's mark. In terms of the differences, the applicant's mark has an additional number of word and figurative elements which are visually impactful and which have no counterpart in the opponent's mark. Essentially the marks look quite different. Taking this into account I find there is a low degree of visually similarity.

25. In an aural comparison the figurative elements of the applicant's mark will play no part. In terms of the shared word element, namely **P1**, this will be pronounced identically in both cases as PEE-ONE. If only this element is verbalised, which seems the most likely option for a significant proportion of consumers, then the aural similarity is identical. If the words **P1 Match My Car** are verbalised then the similarity is lessened to a medium degree. It seems very unlikely, not to mention unwieldy, for the additional words **Driven to perfection** to be verbalised as well but if they are then the similarity is further decreased.

26. Finally in relation to the conceptual comparison, I note that the applicant sought to provide definitions for the potential meanings of the letter and numeral combination **P1**. However I would point out that whatever meaning consumers attribute to **P1**, if any, it will be same in both cases. If no meaning is attributed then consumers will simply understand the marks to consist of the same letter and numeral combination. Other features of the applicant's mark namely the device of the half car, as well as the words **Match My Car** and **Driven to perfection** are likely to bring to mind that the mark has something to do with vehicles. I find that there is conceptual identity for the **P1** element and a low degree of conceptual similarity with regard to the remainder of the applicant's mark.

Distinctive character of the earlier mark

27. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or

because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*⁹ 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).”

28. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent distinctive character, such as invented words.

29. The opponent did not file any relevant evidence showing use of the earlier mark for the goods relied on, so I can only consider the inherent distinctiveness of the earlier mark.

⁹ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

30. Although the letter and numeral **P1** do not describe or allude to the relevant goods, there is nothing particularly striking or inventive about a letter and numeral combination. On that basis, I find that there is a medium level of inherent distinctiveness.

Likelihood of confusion

31. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.¹⁰ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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 and vice versa.

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

33. In *L.A. Sugar Limited*,¹¹ Mr Iain Purvis K.C. (formerly Q.C.), sitting 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 recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal

¹⁰ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

¹¹ *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark

34. In *Kurt Geiger v A-List Corporate Limited*,¹² Mr Iain Purvis K.C. (formerly Q.C.), again sitting as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

35. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

36. So far in this decision I have found that,

- the goods are identical
- The average consumer will pay a high level of attention during the primarily visual purchasing process
- there is a low degree of visual similarity between the respective marks

¹² BL O-075-13

- there is aural identity between the marks for the shared P1 element for a significant proportion of consumers
- the level of overall aural similarity is lower if the applicant's additional word elements are verbalised
- there is conceptual identity between the shared letter and numeral combination element P1 but it is lower for the conceptual similarity of the marks overall
- the earlier mark is inherently distinctive to a medium degree

37. Based on the marks and the goods before me and taking into account the assessments set out above, I find the identical nature of the **P1** element is the most pertinent factors to consider as per *Kurt Geiger*. As set out above a consumer rarely has the chance to make direct comparisons between marks but instead relies on an imperfect recollection. The distinctive letter and numeral **P1** will have an impact on consumers but given the other differences between the marks which are noticeable, I do not find that consumers will directly confuse the two marks.

38. As I did not find direct confusion, I will go on to assess the likelihood of indirect confusion. I remind myself of the guidance given in *L.A. Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to the same or an economically connected undertaking, taking the later mark to be a possible brand extension or sub brand of the earlier mark. In this case consumers will note that the additional word elements **Match My Car** and **Driven to perfection** and the device of the half car are present in the mark but given that the goods and services all allude to vehicles in some way, these elements have much less distinctive force and consumers may assume that the application is simply a brand extension or sub-brand of the **P1** mark being for other vehicle related goods and services. As such I find there is a likelihood of indirect confusion.

Conclusion

39. The opposition has been successful. Subject to any appeal against this decision, the application will be refused for class 12 only but can proceed to registration for the

remaining classes namely 35, 36 and 37 which did not form any part of these proceedings.

Costs

40. The opponent has been successful and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs to the opponent as follows but I have reduced the costs for the provision of evidence as it did not assist me in coming to my decision:

£100 Official fee for opposition

£300 Preparing Notice of Opposition and considering the counterstatement

£300 Preparing written submissions

£300 Provision of evidence and considering the other side's evidence

£1000 Total

41. I order P1 Match My Car Ltd to pay Pirelli Tyre S.p.A. the sum of £1000. 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 1st day of November 2022

June Ralph

For the Registrar

The Comptroller-General