

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2242871  
BY TMC CONSULTANCY LTD  
TO REGISTER THE TRADE MARK SUSIE-TRACK IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 52313  
BY PARTCO GROUP LIMITED**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2242871  
by TMC Consultancy Ltd  
to register the trade mark SUSIE-TRACK in Class 9**

**AND**

**IN THE MATTER OF Opposition thereto under No. 52313  
By Partco Group Limited**

### **DECISION**

1. On 17 August 2000 TMC Consultancy Ltd applied to register the mark SUSIE-TRACK for a specification of goods in Class 9 which reads “electrical connectors for use on vehicles and vehicle trailers and semi-trailers”. The application is numbered 2242871.

2. On 23 March 2001 Partco Group Limited filed notice of opposition to this application. They are the proprietors of the following registrations which they say are earlier trade marks within the meaning of the Act:

<b>No.</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
1044419	SUSIE	09	Electrical cables and parts and fittings therefor included in Class 9.
1044420	SUSIE	17	Coil hose and parts and fittings therefor, all included in Class 17.

3. They say the mark applied for is similar to their earlier trade marks and that there exists a likelihood of confusion. Objection is, therefore, raised under Section 5(2)(b). In the alternative if, or to the extent, that the respective goods are held not to be similar they say registration would be contrary to Section 5(3).

4. They further say that the opponents have used their mark in the course of trade since 1962 and that the application is open to objection under the provisions of Section 5(4)(a) (reference is made to the law of passing off).

5. The opponents also say that the applicants have no bona fide intention to use the mark applied for in relation to all the goods for which registration is sought and the application has, therefore been made in bad faith contrary to Section 3(6) of the Act.

6. Finally they say that registration and use would prejudice the lawful conduct of the opponents' business. As I am not aware that this constitutes a ground of objection save as might be contained within the other grounds I do not propose to say any more about it.

7. The applicants filed a counterstatement denying the above grounds. They make the further important allegation "that the word SUSIE (and its phonetic equivalent SUZZI) is a word that has become generic for particular electrical connectors used on vehicle trailers". They also claim that there are at least five other registered marks owned by other proprietors containing the word SUSIE.

8. Both sides ask for an award of costs in their favour.

9. Both sides filed evidence. The matter came to be heard on 26 November 2002 when the applicants were represented by Mr M Stanley of Michael Stanley & Co and the opponents by Mr J Lumber of Harrison Goddard Foote.

### **Opponents' evidence**

10. The opponents filed a witness statement by Darren Miller, the Commercial Manager for Truck & Trailer Components (TTC), a division of the Partco Group Ltd.

11. Mr Miller describes the corporate background in the following terms:

"The Opponent was founded on 19 December 1985 and is the holding company for a number of companies in particular Partco Limited and is also part of the European after-sales market Division of Unipart Group of companies. Partco Limited trading as Serck Intertruck and a fellow Unipart Group company Edmunds Walker Limited trading as Truck and Trailer Components (TTC) are the leading providers of parts to amongst other areas the commercial vehicle after-sales market and associated service groups such as commercial vehicle maintenance, service and repair businesses. Now produced and shown to me marked Exhibit DM1 are extracts from the Serck Intertruck and Edmunds Walker web sites.

On 18 March 1997 the Opponent purchased the company Dana Distribution Europe Limited and its assets and has operated the business since that date. Of the assets acquired in the transaction, the various registrations for the trade mark SUSIE, BLUE SUSIE, BLACK SUSIE, YELLOW SUSIE and RED SUSIE were purchased by the Opponent together with the common law rights and goodwill and reputation attached thereto. Now produced and shown to me marked Exhibit DM2 is a copy of the 30 June 1997 Interim Report for Partco Group Plc, which on page 2, fourth paragraph refers to the acquisition of Dana Distribution Europe Limited."

12. Mr Miller says that since the acquisition of Dana Distribution the opponents have continued to use the various SUSIE trade marks in connection with the sale of electrical and air hose cables and coils. The coils in question are used to connect the air brakes and electrical items between

truck cabs and their trailers or containers. Exhibited at DM3 is a photograph of a specimen airline hose showing use of the mark. Also exhibited (DM4) are various examples of promotional materials and brochures showing use of the mark. I understand that all this material emanates from Group Companies.

13. Approximate annual sales turnover of goods in volume terms since 1996 is said to have been as follows:

<b>Year</b>	<b>Volume</b>
1995	14,405 units
1996	11,490 units
1997	9,958 units
1998	12,354 units
1999	9,176 units
2000	14,941 units
2001	15,353 units

(Information from the opponents' predecessors in title for the period prior to 1995 has been lost).

The approximate value of each unit sold to distributors is put at £5.90. Sales have been made throughout the UK. Serck Intertruck for instance, are said to have a national network of over 90 branches. The opponents also attend, and are major exhibitors at, leading trade shows.

14. Mr Miller says that it is the applicants' intention to use the mark applied for in relation to a satellite tracking system for commercial trucks and vans (this is confirmed by the applicants' own evidence). As a consequence he suggests that the applicants do not have a bona fide intention to use the mark in relation to the goods applied for.

15. As regards other SUSIE marks on the UK Trade Marks register, Mr Miller says that these relate to unconnected goods and are of no relevance in these proceedings.

16. In relation to the applicants' claim that the word SUSIE has become generic Mr Miller comments as follows:

“It is also denied that the trade mark SUSIE has become a generic term in the trade and I confirm that the Opponent continues to take vigorous steps to defend the integrity of the trade mark as a badge of origin.”

### **Applicants' evidence**

17. The applicants filed a witness statement by Rudolf Arthur Buré, the Managing Director of both TMC Consultancy Ltd and TMC Innovations Ltd who are authorised users of the trade mark SUSIE-TRACK.

18. Mr Buré says that:

“The Trade Mark “Susie-Track” has been used in the United Kingdom in advertisements, articles and brochures by TMC Innovations Ltd since August 2000 in relation [to] trailer tracking systems. These systems include an electrical connector which is the subject of Patent Application PCT/GB01/03482 and which is also known as “Susie-Track” coupling sensor.

The present application was filed on 17<sup>th</sup> August 2000 and TMC Innovations has since the first quarter of 2001 begun to market the tracking system and connectors, and has since 11<sup>th</sup> April 2001 sold connectors under the Mark “Susie-Track”.”

19. Exhibit A is a copy of a label incorporating the mark as applied to packaging for SUSIE-TRACK connectors.

20. Mr Buré goes on to say that SUSIE and its phonetic equivalents, when used in relation to electrical connectors and electrical cables for tractor/trailer interconnections has become generic in the trade.

21. In support of this claim he provides the following Exhibits:

- B - an extract from the 2001 catalogue issued by Gordon Equipments Ltd which lists on page ii of its index ‘Suzie cables’. The products themselves are shown on pages 5.18 and 5.19;
- C - a brochure issued by CS Electronics Ltd in 1998 relating to vehicle management systems and which on its overview page refers to “.... each time the suzzi is coupled”;
- D - an article entitled “Connections in all the right places” from the 1999 Index of the Jan 2000 issue of Transport Engineer, pages 6 to 11, and which on page 8 refers to “electrical susies ISO 1185 and ISO3731”. These are shown as electrical connectors on page 11. Mr Buré suggests that, as the authors of the article are members of the IRTE (Institute of Road Transport Engineers) technical committee and they are referring to ISO connectors as “susies”, the term has become a generic noun for such connectors.

22. Mr Buré goes on to say that, although the mark “Susie” is registered in Class 9 under 1044419 for electrical cables, he could find no evidence of its use within the United Kingdom in relation to electrical connectors before TMC Consultancy filed its present application.

23. In support of this he exhibits (E) The Truck and Trailer Components Catalogue edition 10 dated 2000 and issued by one of the opponents’ sister companies. The catalogue lists air coils under the mark “Susie” on pages 4 : 1 & 4 : 2, but the cables on pages 5 : 1 & 5 : 2 and connectors on pages 5 : 4 & 5 : 5 are not listed under any trade name.

24. The remainder of Mr Buré's evidence is largely a detailed commentary on the opponents' evidence. The main points are that this evidence is either undated; fails to show use of SUSIE as a trade mark in relation to the goods; shows use of SUSIE in a generic sense with other words such as Intertruck serving as the trade mark; and shows use of the mark EURO-SUSIE in relation to air coils. Further criticisms are made about the opponents' failure to provide disaggregated turnover information. It is suggested that the turnover may all relate to air coils rather than electrical goods.

25. That completes my review of the evidence.

26. The Section 3(6) objection, based on no bona fide intention to use, was not pursued at the hearing so I need say no more about it.

27. Submissions at the hearing were largely focussed on the ground based on Section 5(2)(b). I will deal with that ground first. The Section reads:

“5.-(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

28. In determining the question under section 5(2), I was referred to and take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

### **Similarity of goods**

29. Guidance on the approach to be adopted in comparing goods can be found in two main authorities. The first is *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) [1996] RPC 281 at page 296. The test proposed by Mr Justice Jacob involved consideration of the following;

- (a) the uses of the respective goods;
- (b) the users of the respective goods;
- (c) the physical nature of the goods;
- (d) the trade channels through which the goods reach the market;
- (e) (not relevant)

- (f) the extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify the goods, for instance whether market research companies put the goods in the same or different sectors.

30. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45 -48. In its judgment, the ECJ stated at paragraph 23:

“23. 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 end users and their method of use and whether they are in competition with each other or are complementary.”

The goods applied for are:

“Electrical connectors for use on vehicles and vehicle trailers and semi-trailers.”  
(Class 9).

The opponents’ goods are:

“Electrical cables and parts and fittings therefor” (Class 9)

and

“Coil hose and parts and fittings therefor” (Class 17).

31. In the *TREAT* case referred to above Jacob J said:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

32. Parts and fittings for electrical cables must on any reasonable construction of the terms cover and include ‘electrical connectors’. They are adjuncts to the electrical cables themselves. They meet on all the *TREAT/CANON* criteria save that the physical nature of a cable is different to a connector. I conclude that the applied for goods are identical to parts and fittings for electrical cables and similar to the cables themselves.

33. I do not understand the applicants to dispute that the respective Class 9 specifications contain overlapping goods. What they do say is that their actual goods which relate to a vehicle/trailer tracking system, are different in character to those of the opponents and reach the market through different trade channels being sold to telematics companies or transport operators. That may be the case at present but it may not always remain so. There seems no obvious obstacle to the applicants’ product being offered through the commercial vehicle fitting



or after-sales market in the same way as the opponents' goods (I note from the promotional material at DM5 that the system is said to be easy to install and is suitable for retrofit as well as newly built trailers). However, the key point is that the respective specifications are not limited to particular channels of trade and the applicants' specification is not limited in terms of the nature of the electrical connectors save that they are for use on vehicles etc., an application area that brings them into direct conflict with the opponents.

34. In the light of the above it is not necessary for me to undertake a full comparison of the applicants' goods and the opponents' Class 17 goods. Clearly they cannot be identical being in different Classes. Suffice to say that coil hoses in Class 17 are not for carrying electrical cables. The opponents' goods appear to be in the nature of air lines but they could equally be for other purposes. They do not have obvious points of similarity with electrical connectors.

### **The character of the opponents' mark**

35. As will be apparent from my summary of the evidence it is a main plank of the opponents' case that the opponents' mark, SUSIE, has become generic (this is not a case where it is said that the opponents' mark, though validly registered, is simply of low distinctive character). From Mr Stanley's submissions at the hearing I understand that this claim is levelled against particular goods, namely electrical connectors and cables of the kind sold by the opponents for vehicle and trailer interconnection.

36. A claim that a word has become generic is a serious one. It arises here in the context of an opposition. As Mr Lumber pointed out no application has been made to have the opponents' trade marks revoked or invalidated under Sections 46 or 47 of the Act. Section 72 is, however, relevant. It reads:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

37. The registrations relied on by the opponents are, therefore, prima facie valid. Furthermore, as the registrations are in respect of the word SUSIE solus, there can be no question but that the distinctive character of the mark resides in that word, no other matter being present.

38. In short an opposition action is not the place to resolve a charge of genericism against an earlier trade mark. I, therefore, decline to consider this aspect of the applicants' case in the absence of an action designed specifically to test such a claim. In any case, even accepting that the material before me suggests there may be an issue to consider, the evidence would be unlikely to be sufficient in itself to resolve the matter.

### **Similarity of marks**

39. I am required to consider the visual, aural and conceptual similarities between the marks. Given my starting point that SUSIE must be taken to be validly registered and is the only element in the mark, the process of comparison can be dealt with fairly shortly. Self evidently the applied for mark contains the whole of the earlier trade mark as its first element. Given that the applicants' goods are for use with a vehicle tracking system the second element of their mark is descriptive in nature. Bearing in mind the distinctive and dominant components of the respective marks it follows that there is a high degree of visual, aural and conceptual similarity. In short the essential character of the earlier trade mark is captured in the applied for mark and is employed as the first and dominant element in that mark. The similarity is not displaced by the presence of the additional word in the applicants' mark.

### **Likelihood of confusion**

40. The likelihood of confusion must be appreciated globally taking all relevant factors into account. In *Raleigh International Trade Mark* [2002] RPC 202 Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.”

41. I have found that the marks are closely similar and that, on a notional consideration of the respective Class 9 specifications, identical and/or closely similar goods are involved. In the circumstances of this case I find that there is a likelihood of confusion in the sense that the relevant public would wrongly believe that the respective goods came from the same or economically linked undertakings. The opposition therefore, succeeds under Section 5(2)(b).

### **The other objections on relative grounds**

42. It is unnecessary for me to consider the ground based on Section 5(3) of the Act which was essentially pleaded as an alternative basis of opposition were I to reach a different view on the goods themselves. Brief submissions were made at the hearing in relation to Section 5(4)(a) and the opponents' claim based on the law of passing off. I do not believe the opponents could be in a materially different or better position in this respect. Furthermore, although the opponents (or their predecessors in business) claim almost 40 years' use, there are unanswered questions as to the precise goods on which the mark has been used (whether on air coils, electrical coils and/or electrical connectors) and the nature of the use as discussed above. I do not propose to give further consideration to these grounds.

## **Costs**

43. The opponents have succeeded and are entitled to a contribution towards their costs. I note that the applicants' counterstatement suggests that no costs should be awarded against the applicants as the opposition was filed without notice. There may be some justification for such a claim if an applicant takes prompt action to withdraw his application in the face of an opposition. That is not the case here as the opposition has been contested throughout. I, therefore, order the applicants to pay the opponents the sum of £1500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 10<sup>th</sup> day of December 2002**

**M REYNOLDS  
For the Registrar  
the Comptroller-General**