

O-267-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2353215
BY TAKATA KABUSHIKI KAISHA (ALSO T/A TAKATA CORPORATION)
TO REGISTER THE TRADE MARK**

 TAKATA

IN CLASS 12

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 93037
BY TATA MOTORS LIMITED**

BACKGROUND



1) On 13 January 2004, Takata Kabushiki Kaisha (also trading as Takata Corporation), of No 25 Mori Building, 4-30 Roppongi, 1-chome, Minato-ku, Tokyo 106, Japan applied under the Trade Marks Act 1994 for registration of the following trade mark:

The logo consists of a stylized black square on the left, followed by the word "TAKATA" in a bold, black, sans-serif font.

2) In respect of the following goods in Class 12: “Safety belts for aircraft, other aircraft and their parts and fittings; seat belts for automobiles; safety air bags for automobiles, detachable child seats for automobiles, other automobiles and their parts and fittings; safety air bags for two-wheeled motor vehicles, expansive seatbelts for two-wheeled motor vehicles, other seat belts for two-wheeled motor vehicles, other two-wheeled motor vehicles and their parts and fittings; vehicle occupant restraint devices.”.

3) On 28 September 2006, subsequently amended, Tata Engineering and Locomotive Company Limited of Bombay House, 24 Homi Modi St, Hutatma, Bombay 400001, India, filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Application date	Registered Date	Class	Specification
	1579689	27.07.94	22.03.96	12	Land vehicles; motor vehicles; parts and fittings for the aforesaid goods; all included in Class 12; but not including installations and appliances for cooling and ventilating, air-conditioning and cooling apparatus and fans.
	2044098	09.11.95	29.11.96	12	All kinds of land vehicles and parts and fittings therefore.
TATA INDICA	2183834	08.12.98	02.06.00	12	All kinds of land vehicles, motorised land vehicles; parts and fittings for the aforesaid goods.

TATA SAFARI	CTM 1318500	22.09.99	18.02.05	12	Land vehicles; motor vehicles; parts and fittings for all the aforesaid goods.
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b) The opponent claims that the goods are identical and/or similar and that the marks are confusingly similar. The mark therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent's claims and notes that the Registry has indicated that marks 1579689 and 2044098 cannot be relied upon as no proof of use has been filed.

5) Only the applicant filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard although the applicant filed written submissions which I shall refer to in my decision as they are relevant.

APPLICANT'S EVIDENCE

6) The applicant filed a witness statement, dated 18 January 2007, by Anne Wong their Trade Mark Attorney. She merely provides her views on the similarity of the marks which is not evidence but submissions.

7) That concludes my review of the evidence. I now turn to the decision.

DECISION

8) The sole ground of opposition is under section 5(2)(b) which reads:

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

(a)....

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK), Community trade mark or International Trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

10) The Registry decided that as the opponent had not filed any proof of use with regard to its marks 1579689 & 2044098 that these marks were excluded from the

opposition. The opponent is left relying upon UK trade mark No. 2183834 which has an effective date of 8 December 1998, and CTM 1318500 which has an effective date of 22 September 1999, both of which are clearly earlier trade marks.

11) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *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 and Adidas Benelux B.V.* [2000] E.T.M.R 723.

12) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion, I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

13) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

14) I also have to consider whether the marks that the opponent is relying upon have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. The marks as registered are inherently distinctive. The opponent has not provided any evidence of use and so the opponent cannot rely upon any enhanced protection on the basis of reputation.

15) I shall first consider the specifications of both parties. For ease of reference these are as follows:

Applicant's specification	Opponent's specification	
In Class 12: Safety belts for aircraft, other aircraft and their parts and fittings; seat belts for automobiles; safety air bags for automobiles, detachable child seats for automobiles, other automobiles and their parts and fittings; safety air bags for two-wheeled motor vehicles, expansive seatbelts for two-wheeled motor vehicles, other seat belts for two-wheeled motor vehicles, other two-wheeled motor vehicles and their parts and fittings; vehicle occupant restraint devices.	2183834	Class 12: All kinds of land vehicles, motorised land vehicles; parts and fittings for the aforesaid goods.
	CTM 1318500	Class 12: Land Vehicles; motor vehicles; parts and fittings for all the aforesaid goods.


16) In carrying out the comparison of the specifications of the two parties I take into account the factors referred to in the opinion of the Advocate General in *Canon* [1999] ETMR 1. In its judgement, the ECJ stated at page 6 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.”

17) Clearly, there is considerable overlap with most of the applicant's specification being identical to that of the opponent. Those aspects which are not identical, “safety belts for aircraft, other aircraft and their parts and fittings”, must be considered similar. As the identical goods provide the strongest possible case for the opponent I shall use this in the global assessment.

18) I must also consider the average consumer for the types of goods in Class 12. Vehicles and parts and fitting for vehicles are purchased by businesses and by the general public. The average consumer must be considered to be reasonably well informed and reasonably circumspect and observant. In my view, vehicles and parts and fittings for vehicles are not purchased without careful consideration. They tend to be expensive purchases and also have a health and safety aspect which makes consumers cautious. Although I must take into account the concept of imperfect recollection.

19) I now move onto consider the marks of the two parties which are as follows:

Applicant's mark	Opponent's marks	
	2183834	TATA INDICA
	CTM 1318500	TATA SAFARI

20) The opponent contends that the applicant's mark has the same first two letters "TA" and that it also ends in "TA" as the first word in its marks also end. However, I disagree with the simplicity of this argument. Whilst I accept that the marks share the same first two letters "TA" the opponent then repeats these letters in the first word of its marks, whereas the applicant's mark has the letters "KA" inserted in the middle. This moves the applicant's mark to a three syllable word "TA-KA-TA" as opposed to the two syllable first word of the opponent's marks "TA-TA". The opponent's marks also each have a second word element each of which is three syllables long. The applicant's mark also has a very sizable device element that is hard to ignore although the shape is not meaningful. Although sharing the same first two letters the marks, both visually and aurally, are quite different.

21) The only word in any of the marks which has a meaning is the word "SAFARI". Therefore, conceptual aspects do not really apply.

22) Taking account of all of the above when considering the marks globally, I have no hesitation in stating that, despite the identical goods, there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

COSTS

23) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1,000. This sum 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 13th day of September 2007

**George W Salthouse
For the Registrar,
the Comptroller-General**