

O/019/12

IN THE MATTER OF INTERNATIONAL REGISTRATION NO 1037590
IN THE NAME OF CHERY AUTOMOBILE CO LTD

AND

OPPOSITION THERETO UNDER NO 72252
BY RENAULT SAS

Background

1. On 13 April 2010 Chery Automobile Co Ltd (“Chery”) requested protection in the United Kingdom of the International Registration of the word TIGGO.

2. The UK Trade Marks Registry considered the request satisfied the requirements for protection and particulars were published on 17 December 2010 for the following goods in Class 12: Sports cars.

3. A notice of opposition was subsequently filed by Renault sas (“Renault”) based on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Renault’s opposition is based on the following trade mark:

Mark no	Mark	Application date	Registration date	Specification
1467503	TWINGO	14 June 1991	10 July 1992	Land locomotive vehicles; land automobile vehicles; all included in Class 12

4. The mark relied upon by Renault is an earlier mark under the provisions of section 6 of the Act and would be subject to the proof of use requirements of the Trade Marks (Proof of Use, etc) Regulations 2004, however, Chery filed a counter-statement in which it accepts that Renault has put its mark to use within the relevant period. It also does not deny that Renault has a reputation in the UK for motor vehicles. It otherwise denies the grounds of opposition.

5. Both parties filed evidence and written submissions but neither requested to be heard. I give this decision after a careful review of all the material before me.

The evidence

6. Evidence in the form of witness statements were filed by:

Pierre Renucci, Deputy General Counsel of Renault since July 2009. This evidence contains no evidence of fact but instead is in the form of submissions;

Gillian Deas, Trade Mark Attorney acting on behalf of Renault. Ms Deas’ witness statement serves merely to introduce an extract taken from the Wikipedia website about the SEAT company. They are not a party to these proceedings;

Roman Cholij, Trade Mark Attorney acting on behalf of Chery. This witness statement also serves to introduce material taken from the Internet, in this case the results of various searches of .e.g trade marks registers and Wikipedia.

I do not intend to summarise this evidence but will refer to it as necessary and have considered it in reaching my decision.

Decision

7. I deal first with the opposition based on grounds under section 5(2)(b) of the Act which states:

“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.”

8. An “earlier trade mark” is defined in section 6 of the Act. It states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

The mark relied on by Renault is an earlier mark within the meaning of the above provisions.

9. 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 v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 the earlier mark to mind, 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 causes the public to 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

10. The respective goods to be compared are as follows:

Chery's application	Renault's earlier mark
Sports cars	Land locomotive vehicles; land automobile vehicles; all included in Class 12

11. As *sports cars* is included within the specification of Renault's earlier mark, identical goods are involved.

The average consumer and the nature of the purchasing process

12. As the above case law states, it is necessary for me to determine who the average consumer is for the relevant goods and then determine the manner in which these goods are likely to be selected by him in the course of trade.

13. The respective goods are vehicles. Vehicles are bought by the general public. Whilst used by huge numbers of people on a daily basis, they are goods which are likely to be a major expense for most individuals and are purchased relatively infrequently. Vehicles come in a wide range, in terms of e.g. size, type and capacity of engine, body shape, load capacity, fuel economy etc. and are sold through specialist suppliers and garages. This was a matter dealt with in *Lancer Trade Mark* [1987] RPC 303. Although that case was brought under the 1938 Act, I do not consider that the considerations have changed and I adopt the position of the hearing office at first instance in that case. He stated:

“Mr. Hamer for the opponents suggested that a verbal recommendation of one of the opposed marks might lead to the mistaken purchase of a car under the other mark. With respect, I find that suggestion too extravagant. Taking a business-like view of the matter, I consider that, even with due regard to the considerable user built up of the mark LANCIA for specialist cares, registration of LANCER for the applicants' particular model of care will not involve a real tangible danger of confusion such as to disqualify LANCER under section 11.

The position is not materially different if considered under section 12(1). In that regard, I have to consider the opponents' normal and fair user of Fiat not only on vehicles but also on parts and fittings. But, even here, the specialist nature of the goods has to be borne in mind. Relying on my own experience

as a motorist, I know that parts and fittings are mostly sold from depots of particular car manufacturers and are called up by reference to model name, chassis numbers of vehicles and catalogue numbers of parts. This process must, it seems to me, make it hard to conceive of a purchaser, even if confused or simply careless, being sold a LANCIA part when he really wanted a LANCER part, or vice versa”

14. Many people will undertake test drives of vehicles before deciding whether, and if so which particular vehicle and available options, to purchase. Because of the cost involved, some will purchase a new vehicle with the assistance of some sort of finance deal, a deal which may also involve part-exchanging another, older vehicle. Vehicles are also bought by businesses, perhaps as part of a fleet of vehicles, where similar considerations will apply. Taking all matters into account, it is considered these are purchases over which a great deal of care will be taken.

Comparison of trade marks

15. The trade marks to be compared are as follows:

Chery's application	Renault's earlier mark
TIGGO	TWINGO

16. It is well established that the average consumer is reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks but must, instead, rely on the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective marks and, with that conclusion in mind, I must then go on to compare them from the visual aural and conceptual perspectives.

17. Chery's application is for the word TIGGO presented in upper case, plain block letters. The trade mark has no distinctive or dominant components. The word has no meaning, as far as I am aware. Its distinctiveness lies in the totality.

18. Renault's earlier mark consists of the word TWINGO, also presented in upper case, plain block letters. Both parties filed multiple submissions as to whether or not the earlier mark is a single, unknown word or a word made up of the two known words TWIN and GO. The public do not undertake philological analyses of trade marks. There is no obvious meaning in the word and no reason that the public would divide it. The earlier trade mark will be perceived by the average consumer as an invented word and its distinctiveness lies in its totality.

19. Both marks consist of a single word made up of two syllables. Both begin with the letter T and end in the letters GO. The letter 'I' is also common to both marks. The marks consist of 5 and 6 letters respectively and are, therefore, relatively short words where differences are more likely to be noticed. Chery's mark contains the double letters GG which are, visually, quite striking. Renault's earlier mark contains the letters W and N which are not present in the mark for which registration is applied. The end result of this is that whilst there are some similarities between the

respective marks from the visual perspective, there are also significant visual differences between them.

20. From an aural perspective, as both marks begin with the hard letter T and end in the same syllable GO there is some similarity between them. The presence and positioning of the other letters within each mark are such that they are not sounds that will be lost in pronunciation. In my view, the respective marks have significant aural differences.

21. Both words are, as far as I am aware, invented words with no particular meaning and thus, from the conceptual perspective, the position is neutral.

Distinctive character of the earlier mark

22. The distinctive character of the earlier mark can be appraised first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. Renault has not filed any evidence of its use of its earlier mark, as I indicated earlier in this decision, in its counter-statement Chery accepted the mark had been put to genuine use. It also did not deny that Renault has a reputation for motor vehicles, however, this is not the same as saying that TWINGO has a reputation. Whilst I accept this was a sensible concession to have made, the absence of evidence of use does not enable me to make a finding as to the degree to which the distinctive character of the earlier mark itself will have been enhanced. That said, I consider the earlier mark to be possessed of a fairly high degree of inherent distinctive character.

Likelihood of confusion

23. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. First, there is the interdependency principle whereby a lesser degree of similarity between the trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to keep in mind the distinctive character of Renault's earlier mark, as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer of the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparison between trade marks but must, instead rely on the imperfect picture of them he has kept in his mind. As both trade marks are invented words, there are no conceptual hooks upon which the average consumer can hang his memory which may increase the effects of imperfect recollection.

24. The parties have also referred to proceedings which have taken place in other jurisdictions. Whilst acknowledging the existence of these proceedings, they cannot form part of my consideration, as I have to take into account the position of the average consumer in the UK. Taking all relevant matters into account, I find that whilst there are some similarities between the respective marks, there are also significant differences between them. The differences, in my view, outweigh the similarities such that there is no likelihood of either direct confusion (where one mark is mistaken for another) or of indirect confusion (where the average consumer may

believe that the goods at issue come, at the very least, from companies which are economically linked) particularly so taking into account the nature of the goods. The opposition based on grounds under section 5(2)(b) of the Act therefore fails.

The objections under Section 5(3) and 5(4)(a) of the Act

25. Opposition has also been brought under grounds based on sections 5(3) and 5(4)(a) of the Act based on the same earlier mark. In view of my finding as regards the similarity or otherwise of the respective marks, Renault cannot be in any better position under these grounds. I would point out that as Renault has not filed any evidence to substantiate its claim to have a reputation or goodwill in the earlier mark it cannot hope to have succeeded under these grounds in any event and the objections are dismissed.

Costs

26. The opposition has failed and Chery is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using this TPN as a guide, I award costs to Chery on the following basis:

Preparing a statement and considering Renault's statement	£400
Preparing evidence/submissions and commenting on Renault's evidence/submissions	£600
Total	£1000

27. I order Renault sas to pay Chery Automobile Co Ltd the sum of £1000. 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 23rd day of January 2012

**Ann Corbett
For the registrar
The Comptroller-General**