

O-412-12

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2577356
BY MARK EWINGTON
FOR THE TRADE MARK:**



**AND OPPOSITION THERETO (NUMBER 102301)
BY BRIDGESTONE LICENSING SERVICES, INC.**

The background and the pleadings

1) Application 2577356 was filed by Mr. Mark Ewington on 31 March 2011 for the following mark:




The mark was published in the Trade Marks Journal on 20 May 2011. Goods were sought to be registered in Class 12, as follows:

Class 12: LIGHT ALLOY WHEELS FOR MOTOR VEHICLES

2) Bridgestone Licensing Services, Inc. (“the Opponent”) opposes the registration of the above application. Its opposition was filed on 19 August 2011 on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). By a notification of 1 May 2012 it withdrew its opposition under sections 5(3) and 5(4)(a), so that these proceedings fall to be decided on the basis of the ground under section 5(2)(b) alone. Seven earlier UK trade marks (“UK TM”) and five earlier Community Trade Marks (“CTM”) are relied on. They are shown below, together with their filing dates and the goods for which they are respectively registered:

Mark	Number, filing dates, goods covered
FIREHAWK	UK TM No 1271903 Filing date: 23 July 1986 <i>Class 12: Parts and fittings included in Class 12, for vehicles.</i>

	<p>UK TM No 1289721 Filing date: 31 October 1986</p> <p><i>Class 12: Tyres and tubes, all for vehicles; parts and fittings for all the aforesaid goods; all included in Class 12.</i></p>
<p>FIREHAWK 680 FUEL SAVER</p>	<p>UK TM No 1576570 Filing date: 27 June 1994</p> <p><i>Class 12: Vehicle tyres; all included in Class 12.</i></p>
<p>FIREHAWK 690 FUEL SAVER</p>	<p>UK TM No 1576571 Filing date: 27 June 1994</p> <p><i>Class 12: Vehicle tyres; all included in Class 12.</i></p>
<p>FIREHAWK 700</p>	<p>UK TM No 2070053 Filing date: 29 April 1996</p> <p><i>Class 12: Vehicle tyres.</i></p>
<p>FIREHAWK SZ40</p>	<p>UK TM No 2113730 Filing date: 24 October 1996</p> <p><i>Class 12: Vehicle tyres.</i></p>
	<p>UK TM No 2145420 Filing date: 18 September 1997</p> <p><i>Class 12: Vehicle tyres.</i></p>
<p>FIREHAWK</p>	<p>CTM No 314062 Filing date: 01 July 1996</p> <p><i>Class 12: Vehicle tyres.</i></p>

FIREHAWK 700 FUEL SAVER	CTM No 314021 Filing date: 01 July 1996 <i>Class 12: Vehicle tyres.</i>
VANHAWK	CTM No 2784437 Filing date: 22 July 2002 <i>Class 12: Vehicle tyres.</i>
MULTIHAWK	CTM No 3764743 Filing date: 07 April 2004 <i>Class 12: Vehicle tyres and tubes.</i>
WINTERHAWK	CTM No 9497645 Filing date: 04 November 2010 <i>Class 12: Vehicle tyres</i>

3) All the Opponent's above registrations ("the earlier marks") were filed before the date on which Mr. Ewington filed his application. They all, therefore, constitute earlier marks in accordance with section 6 of the Act. CTM No 9497645 completed its registration procedure less than five years before the publication of Mr Ewington's mark. All the other earlier marks completed their respective registration procedures five years or more before publication of Mr. Ewington's mark. The Opponent states that it has used all these marks in respect of all the goods for which they are respectively registered. Mr Ewington did not ask the Opponent to provide proof of use in respect of any of them under section 6A of the Act. As a result, all of the earlier marks may be taken into account in these proceedings for their specifications as registered.

4) Mr Ewington filed a counterstatement denying that the marks are similar or would give the public any cause to link the products supplied under them.

5) Neither party filed evidence. The Opponent filed submissions. Neither party requested a hearing. I therefore give this decision after a careful review of all the papers before me.

Lack of evidence – consequences

6) Whilst evidence is not a necessity in a section 5(2) case, I should note two issues where the lack of evidence is significant. Firstly, in its written submissions,

the Opponent states that it “effectively owns a family of ‘... HAWK’ marks”. Whilst the existence of a family of marks may be taken into account when determining whether there exists a likelihood of confusion, the Court of Justice of the European Union (CJEU) has made clear¹ that, to be relevant, proof of their actual use must be furnished. Since no evidence has been submitted in these proceedings, the claim to a family of marks must be dismissed. Secondly, although the Opponent submits that it is “one of, if not the most famous and prominent manufacturer, distributor and retailer of vehicle tyres throughout the world” no enhanced distinctiveness through use can be established in the absence of evidence. My assessment of the distinctiveness of the earlier marks will therefore be based on their inherent characteristics.

Section 5(2)(b)

7) Section 5(2)(b) of the Act 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.”

8) In reaching my decision I have taken into account the guidance provided by the CJEU in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [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 + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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

¹ See *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-234/06 P at paragraphs 63-64

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 great 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."

9) I consider that the Opponent's best case resides with its UK TM No 1271903 for the word mark FIREHAWK and CTM No 2784437 for the word mark VANHAWK. These two marks provide the closest goods and the closest mark

respectively. I do not consider the Opponent to be in any better position from the perspective of its other marks, although they have all been borne in mind. I will my make analysis and determinations accordingly.

Comparison of the goods

10) In making an assessment of the similarity of the goods, all relevant factors relating to the goods in the respective specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro- Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

11) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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;
- (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.”

12) Whether goods are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

13) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product/service is, as a practical matter, regarded for the purposes of the trade” (see *British Sugar plc v James Robertson & Sons Limited* [1996] RPC 281) and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning (see *Beautimatic International Limited v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267). Finally, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play (see *Gérard Meric v OHIM (“Meric”)* Case T-133/05) even if there may be other goods within the broader term that are not identical.

14) The goods for which registration is sought by Mr Ewington are:

Class 12: light alloy wheels for motor vehicles

The goods for which the earlier mark UK TM No 1271903 is registered are:

Class 12: Parts and fittings included in Class 12, for vehicles

15) Parts of fittings for vehicles cover a broad range of goods. Wheels are a part/fitting of a vehicle. In view of this, the goods for which Mr Ewington seeks registration, *light alloy wheels for motor vehicles*, clearly fall within the ambit of the term *parts and fittings included in Class 12, for vehicles*. The rule in *Meric* applies, and the goods are considered to be identical.

The goods for which CTM No 2784437 is registered are:

Class 12: Vehicle tyres

16) *Vehicle tyres* are obviously, in practice, indispensable to the use of *light alloy wheels for motor vehicles*, and vice versa. A wheel cannot function without a tyre and vice versa. In the absence of evidence to the contrary, I consider it

reasonable to conclude that they are so indispensable that customers may think that the responsibility for those goods lies with the same undertaking. Moreover, it seems likely that the goods will be sold through the same trade channels. The goods are therefore similar to at least a reasonable degree.

The average consumer and the purchasing process

17) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the General Court in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

18) In his counterstatement Mr Ewington contends that “*The Hawke product is aimed at a specific market group as a luxury item and although are in [sic] the automotive industry are targeted at a completely different sector ...*”. However, that is not the correct approach to identifying the average consumer, since Mr Ewington’s argument reflects a current marketing strategy rather than the inherent nature of the goods in question (see *Devinlec Développement Innovation Leclerc SA v OHIM* Case T- 147/03). That said, in relation to wheels, be they alloy or otherwise, their selection will involve a fair degree of consideration, calling for a reasonably high level of attention to ensure that the goods have the required technical compatibility, functionality and aesthetic appeal. Similar considerations, albeit to perhaps a slightly lower level, will apply to tyres – although, safety and performance considerations will be paramount, still lending a higher than normal level of care and attention.

19) The average consumer for both wheels and tyres will consist of the general motoring public. There is no evidence as to how the goods are selected. Whilst they can be purchased and fitted at home, the most likely method will be that the goods are purchased and fitted in a garage or other vehicle based retail establishment. When purchased in this way, the average consumer may not necessarily see the goods before they are fitted, especially in the case of tyres; however, s/he will normally wish to specify what goods are to be used, including brand. Aesthetic considerations will usually play a role (particularly in the case of alloy wheels), so it is likely that the purchaser will have had some visual impression of the goods before purchase, whether through inspection of the goods or through brochures and catalogues. Purchases will probably also involve some discussion with the retailer or garage. I consider visual and aural considerations to play a fairly equal role.

Distinctiveness of the earlier marks.

20) The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks (either on the basis of inherent


qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

21) No evidence of use of the earlier marks has been filed, so I have only inherent distinctiveness to consider. UK TM No 1271903 consists of the single word FIREHAWK, which is not descriptive or allusive in any way of the vehicle parts and fittings covered by the mark. It therefore enjoys a reasonably high (although not the very highest) degree of inherent distinctiveness in respect of those goods.

22) CTM No 2784437 consists of the single word VANHAWK, which, in the context of vehicle tyres, the average consumer will perceive as the conjoining of the two words VAN and HAWK. VAN can be seen as clearly descriptive, in that it describes a particular type of vehicle. HAWK is not descriptive or allusive in any way of the vehicle tyres covered by the earlier mark. The combination VANHAWK therefore enjoys a reasonably high degree of inherent distinctiveness in respect of those goods

Comparison of the marks

23) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. For ease of reference, I shall compare the Opponent's marks UK TM No 1271903 and CTM No 2784437 separately against Mr Ewington's mark. The marks to be compared are:

Mr Ewington's mark	The Opponent's earlier UK TM No 1271903
	FIREHAWK

24) Mr Ewington's mark consists of a device, below which the word HAWKE is written in stylised but easily readable lettering. This word, despite its additional E, will inform the average consumer that the device is intended to represent a highly stylised representation of a hawk's head in profile. The device and word are presented against a dark, textured background suggestive of a badge. Viewing the mark as a whole, there are two distinctive and dominant components: the device and the word. The device is striking and takes up more


space; but the word will attract as least as much attention, and gives the cue to view the device as a hawk's head.

25) I think the consumer perception of the Opponent's mark will be that two words, FIRE and HAWK, have been combined to evoke the composite idea of a (I believe, imaginary) type of hawk. Neither the word FIRE nor HAWK dominates the other – the dominant element of the Opponent's mark consists of the whole word FIREHAWK.

26) Visually, HAWK is common to both marks, but in Mr Ewington's mark an E is added to the end of the word, and in the Opponent's mark it is preceded by FIRE, forming a new and longer word. The device in Mr Ewington's mark also provides a significant visual difference. The dark, badge-like background of his mark is borne in mind but I do not consider that this creates a significant difference. Overall, there is a moderate degree of visual similarity between the marks.

27) From an aural perspective, the HAWK(E) elements in the marks will be pronounced identically – as in the name of the type of bird. FIRE adds a distinguishing first element to the Opponent's mark. Overall, there is a reasonable (but not high) degree of aural similarity between the marks.

28) Conceptually, the element FIRE is missing from Mr Ewington's mark, giving rise to a difference. However, the combination of FIRE with HAWK in the Opponent's mark means that the creature conjured up in the consumer's mind will still clearly be a hawk (if an imaginary one). Although an E has been added to HAWK in Mr Ewington's mark, the word will still tend to evoke the bird of prey for the average consumer, and this message will be reinforced by the associated device of the hawk's head. There is a reasonable degree of conceptual similarity between the marks.

Mr Ewington's mark	The Opponent's earlier CTM No 2784437
	VANHAWK

29) I have already assessed the elements of Mr Ewington's mark for their dominant and distinctive characteristics in paragraph 23. Although VANHAWK is presented as one word, I think the average consumer will perceive it as a conjoining of the two words: VAN and HAWK. Within VANHAWK, HAWK has the greater degree of distinctiveness (compared to VAN, which, in the context of vehicle tyres, can be seen as descriptive of a type of vehicle). I think the rule of thumb, whereby the consumer normally attaches more importance to the first part

of words, is, therefore, not an appropriate guide in this case. HAWK is the dominant and distinctive component of the mark.

30) My remarks in paragraph 25 apply here *mutatis mutandis*. Overall, there is a moderate degree of visual similarity between the marks.

31) My remarks in paragraph 26 apply here *mutatis mutandis*. Overall, there is a reasonable degree of aural similarity between the marks.

32) Conceptually the average consumer will tend to split VANHAWK into the component concepts VAN and HAWK. The VAN element is missing from Mr Ewington's mark, giving rise to a difference. However, in the context of vehicle tyres, VAN will be seen as descriptive of a type of vehicle. The memorable conceptual element will be that of the bird of prey: a hawk. Although an E has been added to HAWK in Mr Ewington's mark, the word will still tend to evoke the bird of prey for the average consumer, and this message will be reinforced by the associated device of the hawk's head. There is a reasonably high degree of conceptual similarity between the marks.

Likelihood of confusion

33) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

34) I shall firstly assess Mr Ewington's mark against the Opponent's UK TM No 1271903: FIREHAWK. I must allow for imperfect recollection and the fact that the average consumer will not usually compare the marks side by side. I think it likely, for example, that the E in the HAWKE of Mr Ewington's mark may not be perfectly remembered. Nevertheless, even allowing for imperfect recollection, and the fact that the goods are identical, I think there is sufficient difference between HAWKE and FIREHAWK, also bearing in mind the additional visual differences, to render direct confusion (whereby the marks are directly mistaken for one another) unlikely. However, in view of the fact that the distinctive concept of a hawk, or a kind of hawk, dominates both marks, together with the resulting visual and aural similarities, and that the goods in question are to be considered identical, I do consider it likely that the average consumer will regard the identical goods sold under the marks as coming from the same stable. In other words, the consumer will regard the HAWK element in the marks as indicating that the undertakings responsible for them are the same or related. There is a likelihood of confusion.

35) In assessing the Opponent's earlier mark CTM No 2784437, VANHAWK, taking the visual difference between HAWKE and VANHAWK and the device element of Mr Ewington's mark into account, I think there is probably still sufficient difference between the marks to render direct confusion unlikely. I think this is probably so even allowing for imperfect recollection, and the fact that the goods are similar to at least a reasonable degree. However, in view of the fact that the dominance of the HAWK element of the marks is even more pronounced in this case, and that the goods are similar to at least a reasonable degree, I consider it likely that the average consumer will regard the HAWK element in the marks as indicating that the undertakings responsible for them are the same or related. There is a likelihood of confusion.

36) I have found that there is a likelihood of confusion in respect of the goods for which Mr Ewington seeks protection. Accordingly, on the basis of section 5(2)(b) of the Act **the opposition succeeds in its entirety**. Having found that the opposition succeeds on the basis of the marks I have already assessed, it is not necessary to assess the Opponent's other earlier marks.

Costs

37) Bridgestone Licensing Services, Inc. has been successful and is entitled to a contribution towards its costs. I hereby order Mr Mark Ewington to pay Bridgestone Licensing Services, Inc. the sum of £700. This sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	£200
<i>Opposition fee</i>	£200
<i>Preparing written submissions</i>	£300

38) The above sum should 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 22nd day of October 2012

Martin Boyle
For the Registrar,
The Comptroller-General