

O-074-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3052125
BY CLEAN AIR TECHNOLOGY LIMITED TO REGISTER THE TRADE MARK**



IN CLASSES 7 AND 11

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 402817
BY CATERPILLAR INC.**

Background and pleadings

1) Clean Air Technology Limited (“the applicant”) applied to register the mark 3052125 in the UK on 18 April 2014. It was accepted and published in the Trade Marks Journal on 6 June 2014 and following a voluntary amendment to the specifications it currently stand in respect of the following goods:

Class 7: *Catalytic arrangements, assemblies and devices for pollutant emissions; Blowing machines for exhaustion of industrial and/or manufacturing process dust, gases etc. using catalytic processes and conversion; Cartridges for filtering machines using catalytic processes and/or for industrial and/or manufacturing process dust, gases, etc.; Dust exhausting installations for cleaning purposes using catalytic processes and conversion; Dust removing installations for cleaning purposes using catalytic processes and conversion; Filtering machines using catalytic processes and conversion; Filters (parts of machines or engines) all using catalytic processes and conversion.*


Class 11: *Air filters; Air conditioning filters; Filters for cleaning air; Air cleaning filters (parts of cleaning machines or installations); Air filters for use as dust extractors in industrial processes; air filters for use as dust arrestants in industrial processes; Air filtering installations; Air driers; Filters for air conditioning; Filters (parts of household, retail, storage or industrial installations) Gas Scrubbing apparatus; Pollution control filters; all for stationary industrial plant using catalytic processes and conversion.*

2) The applicant has also added the following disclaimer:

Registration of this mark shall give no right to the exclusive use of CAT or cat alone as descriptive of catalytic converters and the like.

3) Caterpillar Inc. (“the opponent”) oppose the mark on the basis of Section 5(2)(b), Section 5(3) and Section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The first two grounds are based upon conflict with the following two earlier Community Trade Marks (CTMs) no. 9344755 and 5028147. The relevant details of these are shown below:

Marks and relevant dates	Goods relied upon
CTM 9344755 CAT Filing date: 11 December 2006 Date of entry in register: 13 August 2010 Seniority dates claimed	Both marks are in respect of virtually identical lists of goods. The opponent relies only on its Class 7 and 11 specifications that differ in only minor detail. The specifications below are reproduced from CTM 9344755: Class 7: <i>Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural instruments other than hand operated; incubators for eggs; valves; spark plugs; air filters (parts of machines or engines); water regulators; oil filters; couplings; machine tools; assembly presses; starters; pumps; diggers; excavators; bulldozers; loaders; fellers; bunchers; scrapers; pavers; agricultural machines; cutting machines;</i>

<p>range between 1968 and 1983</p>	<p>compactors; skidders; filters; belts; blades; earth moving machines; road marking machines; lifting machines; agricultural apparatus and instruments; steam rollers; forestry machines; pipe laying machines; compacting machines; buckets for earth moving machines; hydraulic jacks; welding machines and apparatus; jet engines not for land vehicles; ground engaging machines; air cleaning filters (parts of machines or engines); pavement profilers; scarifiers to break up surfaces, in particular, topsoil and pavement; motor graders; fuel/air ratio controls; fuel nozzles; water separators; fuel heaters; cultivating and harvesting machines, threshing machines, heading machines, reaping machines, binding machines, mowing machines, harrows; ploughs and rakes; draining machines; diggers (machines); aeronautical engines; agitators; air condensers; alternators; antifriction bearings for machines; anti-friction pads for machines; anti-pollution devices for motors and engines; axles for machines; ball rings for bearings; bearing brackets for machines; bearings; belt conveyors; belts for machines; belts for motors and engines; blades (parts of machines); engines and motors for boats; brake linings other than for vehicles; brake segments other than for vehicles; brake shoes other than for vehicles; brushes (parts of machines); carburettors; compressed air machines; compressed air pumps; compressors (machines); condensing installations; connecting rods for machines, motors and engines; control cables for machines, engines or motors; control mechanisms for machines, engines or motors; current generators; cutters (machines); cutting machines; cylinder heads for engines; cylinders for machines; cylinders for motors and engines; drilling bits (parts of machines); drilling heads (parts of machines); drilling machines; drills; dynamo belts; dynamo brushes; dynamos; engines, other than for land vehicles; fan belts for motors and engines; fans for motors and engines; fuel conversion apparatus for internal combustion engines; fuel economisers for motors and engines; gear boxes other than for land vehicles; gears, other than for land vehicles; grinding machines; guards (parts of machines); hammers (parts of machines); pneumatic hammers; mechanically operated hand held tools; handling apparatus for loading and unloading; hoists; holding devices for machine tools; mechanical discharging hoppers; jacks (machines); lawnmowers (machines); lift belts; lifting apparatus; loading ramps; lubricating pumps; lubricators (parts of machines); machine fly wheels; machine wheels; apparatus for machining; metal working machines; spray guns for paints; painting machines; pistons; pneumatic transporters; presses; pulleys; pumps (machines); rammers (machines); reduction gears other than for land vehicles; mechanical shovels; shaft couplings; bearings for transmission shafts; speed governors for machines, engines and motors; spraying machines; superchargers; tarring machines; threading machines; threshing machines; transmission chains and shafts, other than for land vehicles; transmissions for machines; turbines other than for land vehicles; turbocompressors; valves (parts of machines); vehicle washing installations; vulcanisation apparatus; washing apparatus; waste disposers (machines); watering machines; parts and fittings for all the aforesaid goods; agricultural machinery and earth moving machinery, namely starting motors, alternators, pistons, cylinder heads, cooling systems parts, turbochargers, lubricating systems parts, air compressors and blocks not for land vehicles.</p>
<p>CTM 5028147</p>  <p>Filing date: 19 April 2006</p> <p>Date of entry in register: 8 July 2010</p>	<p>Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; installations for lighting, lighting and heating instruments; light bulbs, head lamp bulbs, tail lamp bulbs, direction indicator bulbs, dashboard lamp bulbs; torches; lights, lamps; reflectors; air conditioning apparatus; air condition filters; defrosters; fuel economisers; parts and fittings for all the aforesaid goods; parts and fittings included in class 11 for land vehicles, agricultural machinery and earth moving machinery, namely backup lights for land vehicles, coolant recovery systems, comprising reservoirs, pumps, filters, cleaners, electric light bulbs, LED light bulbs, rear lights for vehicles, valves as part of radiators.</p>

4) The opponent submits that:

- the stylisation present in the applicant's mark is inconsequential and the opponent's CAT mark is wholly contained within it;
- the "CLEAN AIR TECHNOLOGY" component of the applicant's mark is readily understood and common place;
- the "CAT" word component of the applicant's mark is more distinctive than the device component and the consumer is likely to give most attention to the word component;
- The consumer will perceive the applicant's mark as a spin off or derivative of the opponent's mark;
- The respective goods are identical or highly similar;
- There is a likelihood of confusion and the application should not be allowed on the grounds of Section 5(2)(b) of the Act.

5) The opponent also claims that the application offends under Section 5(3) of the Act because its CAT brand has a "vast reputation" in the UK extending back over 50 years and because of the similarities between the respective marks the average consumer would establish the requisite link between the marks. It pleads that the use of the applicant's mark will take unfair advantage of its marks' distinctive character and repute by "feeding on the fame" of its marks

6) The opponent also claims that the application offends under Section 5(4)(a) of the Act because its substantial goodwill identified by its CAT brand, the similarity between the respective marks will result in deception and confusion causing damage to the opponent's business.

7) The applicant filed a counterstatement denying the claims made and, in particular, states that:

- Its mark is neither graphically, nor phonetically as a whole similar to CAT with the font and styling being "radically different";
- CAT is descriptive in respect of catalytic apparatus and so can be ignored for the purposes of comparing the level of similarity between the marks;
- There are a large number of marks on the register and/or used in the UK that include the word CAT and in respect of Class 7 and Class 11 goods;
- The applicant has commenced cancellation proceedings at the OHIM in respect of the opponent's CTM 9344755.
- It claims that the opponent's goodwill in the UK is restricted to the industrial clothing sector.

8) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

9) A Hearing took place on 15 October 2015, with the opponent represented by Ms Alaina Newnes of Counsel, instructed by Hogan Lovells International LLP. The applicant was not represented at the hearing, but filed written submissions in lieu of attendance. It is represented in the proceedings by Parnham IP Services.

Opponent's Evidence

10) This takes the form of a witness statement by Lia Yasmin Young, an attorney within the Legal Services Division of the opponent. Ms Young states that the opponent is the world's leading manufacturer of construction and mining equipment, diesel and natural gas engines, industrial gas turbines and diesel-electric locomotives. Its vehicles have application to the military, oil and gas, marine and power sectors.

11) Ms Young states that the opponent opened its first European facility in the UK in 1950 and now has twenty facilities in the UK and includes an articulated trucks facility, a building construction products facility, a global mining facility, a marine power facility and a defence products facility.

12) Ms Young states that the opponent produces a range of CAT-branded industrial vehicles, engines and power systems with many applications and marine power systems. Ms Young provides UK turnover figures in the region of \$200 million in respect of its "machines" and generally in the region of \$65 million to \$95 million in respect of its "engines manufactured in the UK".

13) Ms Young provides evidence in respect of the opponent's ACERT® Technology "emissions solutions". She states that the opponent has invested over \$500 million to date in emissions reduction technology. Ms Young states that the opponent offers a variety of emission reduction products including a diesel oxidation catalyst, a diesel particulate filter and other catalytic systems.

14) Ms Young also provides evidence of the opponent providing filters such air filters, engine oil filters and hydraulic, transmission filters, fuel filters and water separators. Its annual UK sales in respect of parts has been in the region of \$75 million.

15) As a result of this use, Ms Young states that the opponent has established a significant reputation and goodwill in the UK and supports this with a number of third party quotes referring to the opponent in terms such as "construction machinery goliath", "...Cat, the world's biggest single plant manufacturer" and "Caterpillar...dominates its industry globally" and has been cited as one of the top 200 global brands since 2007 according to *brandirectory* (see Exhibit LYY45).

Applicant's Evidence

16) This takes the form of a witness statement by Gary K. Elliot, Sales and Marketing Director of the applicant. Mr Elliot provides evidence regarding the nature of the applicant's products and the difference between catalytic filters and non-catalytic filters. Mr Elliot characterises the differences as follows:

"A normal (non-catalytic filter) tends to remove particulates but some particulates and gases (NOx) are either dangerous or may have recoverable value so catalysis is used to convert these to more manageable or acceptable outputs."

17) At Exhibit A, Mr Elliot provides an extract from acronymfinder.com that includes references to "CAT" being an abbreviation for both "Caterpillar, Inc" and "Catalyst". The exhibit also includes evidence of "CAT" being used as parts of marks relating to the field of catalysts, such as "Catofin", "Catadiene", "CataMax" and "UltraCat". Exhibit B consists of Google search results for "cat catalysis exhaust filter installations UK" with numerous hits showing "cat" used in the context of "catalytic converters".

18) Exhibit E consists of a copy of the application for partial invalidation filed at the OHIM by the applicant against the opponent's CTM 9344755. It lists the following Class 7 and Class 11 goods as being challenged:

Class 7

Air filters (parts of machines or engines) (using catalysts and/or catalytic compositions)

Air cleaning filters (parts of machines or engines) (using catalysts and catalytic compositions)

Anti-pollution devices for motors and engines (using catalysts and/or catalytic compositions)

Class 11

Air conditioning apparatus (using catalysts and/or catalytic compositions)

Air conditioning filters (using catalysts and/or catalytic compositions)

Filters as part of coolant recovery systems (using catalysts and/or catalytic compositions)

Air conditioning apparatus (for deterring cat mammal allergies)

Air conditioning filters (for deterring cat mammal allergies)

19) The opponent's Class 7 specification also contains the unrestricted term *filters* and I note that this term is not challenged in the invalidation proceeding before the OHIM.

Opponent's evidence in reply

20) This takes the form of a second witness statement by Ms Young. She provides evidence in an effort to address Mr Elliot's criticism that the opponent has failed to

show that its reputation extends to goods such as catalytic converters and air filters. Most of these exhibits appear to show that it provides such goods as parts replacements for its own branded machines (see, for example Exhibit LYY55, headed “Cat® UHE Air Filters” where, on page 2, it states “Caterpillar offers the best selection of UHE Air filters to cover your entire fleet of Cat equipment”. Other exhibits are silent on the issue of whether they are fitted to non-Caterpillar equipment or engines. The one exception is Exhibit LYY61 that consists of an undated photograph of a CAT branded air filtration device that appears to be a stand-alone machine rather than a part of a larger machine.

DECISION

Section 5(2)(b)

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

Comparison of goods and services

22) In the absence of any detailed submissions regarding how the respective parties’ specialist goods are similar, at the hearing, I directed that the opponent provide written submissions to this effect. These were received on 22 October 2015. The applicant provided its submissions in response on 28 October 2015. I will refer to these submissions as appropriate.

23) The parties have both referred to an invalidation action lodged at OHIM, by the applicant in these proceedings, against the opponent’s earlier word CTM 9344755. The goods under challenge in the OHIM proceedings are:

Class 7: *Air filters (parts of machines or engines); air cleaning filters (parts of machines or engines); anti-pollution devices for motors and engines.*

Class 11: *Air conditioning apparatus; air condition filters; coolant recovery systems, comprising reservoirs, pumps, filters, cleaners, electric light bulbs, LED light bulbs, rear lights for vehicles, valves as part of radiators.*

24) The opponent submits that the term *filters* in Class 7 is not subject of the invalidation action. It suggested that, as a result, regardless of the outcome of the invalidation action, the term *filters* will remain unaffected. In its submissions, the applicant identifies what it describes as the opponent’s “all or nothing approach” whereby the opponent considers specific goods to be sub-sets of more generic terms. For example *air filters (parts of machines or engines)* would be covered by the term *filters*. It suggests that, by taking this approach, the opponent has backed itself into a corner. I make no comment on whether that is the case, but I agree with the

opponent's submission that the natural meaning of the term *filters* in its CTM 9344755 includes filters of all types proper to that class. The term *filters* is a broad term and covers all sub-categories of filters and, contrary to the applicant's submission, the term includes filters that operate by catalytic function. The applicant draws a distinction between filters that operate by trapping pollutants and filters that operate by converting pollutants by catalytic action. The broad term *filters* covers both of these types. Further, despite the applicant considering it to be otherwise, because the term has not been challenged in the invalidation action at OHIM, the opponent can rely upon this term regardless of the outcome of that invalidation. Further, it appears to me that reliance upon the term *filters* provides the opponent with its best case in most of the comparisons of goods that I am required to undertake. Therefore, I will conduct my comparison of goods from this perspective, namely, where appropriate, I will firstly consider the similarity between the applicant's goods and the opponent's *filters* (in Class 7).

25) The benefit of this approach is that I do not need to consider similarity of goods based upon terms being challenged in the invalidation proceedings and if I find that the opposition is successful, or partially successful, based upon the opponent's *filters*, it will not be necessary (or only necessary insofar as the opposition does not succeed based on the opponent's *filters*) to issue a provisional decision that would only be confirmed when the outcome of the invalidation action at OHIM is known.

26) I keep in mind the judgment of the Court of Justice of the European Union ("the CJEU") in *Canon*, Case C-39/97, where 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".

27) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity also included the respective trade channels through which the goods or services reach the market.

28) I keep in mind the following guidance of the General Court ("the GC") in *Gérard Meric v OHIM*, T-133/05 (citations omitted):

"29 ..., the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

29) In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the*

Internal Market (Trade Marks and Designs) (OHIM), Case T-325/06, the GC stated that “complementary” means:

“...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”.

30) In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

Class 7

29) With the above guidance in mind, it is clear that the applicant’s *Filters (parts of machines or engines) all using catalytic processes and conversion* are covered by the opponent’s *filters* and they are, therefore, identical.

30) The opponent makes submissions that a number of its goods are highly similar to the applicant’s *Catalytic arrangements, assemblies and devices for pollutant emissions*. Included in this submission is that these goods are highly similar to its *filters* because they “have the common purpose of removing undesirable elements from gas or liquid”. They also share similarity in terms of methods of use and nature because both may be in the form of a device situated between the polluted air/liquid and where the cleansed air/liquid is expelled. They may well be in competition with each other. I agree with the opponent that this results in a high level of similarity.

31) In respect of *Cartridges for filtering machines using catalytic processes and/or for industrial and/or manufacturing process dust, gases, etc.*, the opponent submits that because the applicant’s goods are parts of filtering machines and such filtering machines are similar to the opponent’s *filters*. I must consider the similarity between the cartridges themselves, to the opponent’s *filters*. I have no information before me as to how these cartridges operate but applying my knowledge as an ordinary member of the public (and not as a specialist), I consider it likely that these cartridges are the removable/replaceable part of the machine that capture the

pollutants and therefore they have the same purpose as *filters* themselves. Further, their respective nature may be the same, being constructed out of a material that captures the pollutant. The opponent's filtering machines may perform the same function as *filters*. Taking all of this into account, I conclude that these goods share a high level of similarity.

32) In respect of the applicant's *Dust exhausting installations for cleaning purposes using catalytic processes and conversion; Dust removing installations for cleaning purposes using catalytic processes and conversion; Filtering machines using catalytic processes and conversion*, they all appear to perform a cleaning function that utilises catalytic processes. Therefore, they all perform the same function as the goods covered by the opponent's broad term *filters*. Their nature may be similar because the installations and machines may consist essentially of a filter. As a result of these similarities they may also be in competition. I therefore find a high level of similarity.

33) In respect of the applicant's *Blowing machines for exhaustion of industrial and/or manufacturing process dust, gases etc. using catalytic processes and conversion*, the opponent submits that the use of the word "blowing" "implies the use of a fan or a pump in such a machine". It therefore contends that its *motors and engines (except for land vehicles), fans for motors and engines and pumps* and other terms in its Class 7 are highly similar on the basis that the applicant's goods may incorporate the opponent's goods. In considering these submissions, I am mindful of the guidance of the GC in *Les Éditions Albert René v OHIM*, Case T-336/03, where it found that:

"61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

34) With this guidance in mind, and bearing in mind the parts relied upon by the opponent are all integral parts of machines rather than disposable/replaceable in the sense that the user of the applicant's goods will, on occasion, have a need to purchase a part that is not expected or designed to last the life of the product. Therefore, the consumer of blowing machines will not normally have occasion to purchase such parts. Consequently, I dismiss the submission. The opponent also submits that the applicant's goods fall within the opponent's broader terms *Apparatus for [...] ventilating, water supply and sanitary purposes* or, if not, provide an alternative to achieve a comparable technical effect. The applicant has not provided any explanation of its goods, but the reference to "blowing" suggests that they relate to a process of propelling gasses (but not liquid because it is not normal to "blow" liquids) and, therefore, I dismiss the submission that such *blowing machines* are similar to goods related to water supply or for sanitary purposes. *Apparatus for ventilating* appears to be related to improvement of air quality and the applicant's *blowing machines* may have application in the removal of industrial or manufacturing pollution (in the form of dust or gasses) in the air. Therefore, there is a similarity of purpose and the opponent's broad term '*apparatus for ventilating*' covers ventilation apparatus similar to blowing machines. Therefore the nature and methods

of use may be the same. In light of these similarities the respective goods may also be in competition. I find that they share a reasonably high level of similarity.

Class 11

35) All of the following of the applicant's goods are filters and I will consider all of these together:

Air filters; Air conditioning filters; Filters for cleaning air; Air cleaning filters (parts of cleaning machines or installations); Air filters for use as dust extractors in industrial processes; air filters for use as dust arrestants in industrial processes [...] Filters for air conditioning; Filters (parts of household, retail, storage or industrial installations) [...]; Pollution control filters; [...] all for stationary industrial plant using catalytic processes and conversion.

36) All being filters, these goods all share a good deal of similarity with the opponent's *filters* in Class 7. However, by virtue of being in different classes, the respective goods are not identical. It is permissible to take into account the class number specified by the applicant when assessing the meaning of the descriptions of goods/services included in the application (see *Altecnic Ltd's Trade Mark Application [2002] RPC 34 (COA)*). The Class heading for Class 7 illustrates that the class covers mainly machines and machine tools and by extension, their parts and fittings. On the other hand, Class 11 includes apparatus for drying and ventilating etc. There is a close relationship between the two classes particularly where the machines, proper to Class 7 are for the purpose of drying or ventilating etc.. As the opponent submits, the respective goods share the same purpose of removing undesirable elements from air or other materials. However, I am less persuaded by their other submissions, namely that apparatus for heating or cooking covers a wide range of goods including industrial heat treatment and such a process produces exhaust fumes and therefore must be used with filters and filtering installations. If this is true, it does not bring the goods closer in terms of methods of use, nature, purpose or even trade channels. That said, the points highlighted earlier in this paragraph lead me to conclude that the respective goods share a reasonably high level of similarity.

37) The applicant's *Air filtering installations; [...]; all for stationary industrial plant using catalytic processes and conversion* share the same purpose as the opponent's *filters*, namely to remove pollutants from whatever is being filtered. An air filtering installation may consist of nothing more than a filter positioned in the most suitable place to perform its required function. Therefore, the respective goods also share the same nature and methods of use. Taking all of this into account, I conclude that there is a high level of similarity.

38) Next, I consider the applicant's *Gas Scrubbing apparatus [...] all for stationary industrial plant using catalytic processes and conversion*. The opponent submits that these goods are apparatus for the removal of undesirable elements from a gas by the action of a liquid, by means of a chemical reaction using a catalyst. This explanation is not disputed by the applicant. The purpose of removal of undesirable elements from gas appears to be the same as some *filters*. However, the use of the term "gas scrubbing apparatus" suggests large plant, whereas the term *filters* suggests a relatively small item. Of course, *filters* may be a part of gas scrubbing

apparatus, but as I have already discussed earlier, this does not necessarily result in similarity. The opponent submits that because the purpose is the same, then the consumer may consider each to be an alternative for the other, but in light of my comments above, I do not consider this to be likely.

39) The opponent also submits that there is similarity between *Gas scrubbing apparatus* and the opponent's *Apparatus for [...] ventilating, water supply and sanitary purposes* because the applicant's goods fall within this broad category, or if not provide an alternative to achieve the same or comparable technical effect. It is not clear to me how gas scrubbing apparatus is utilised in ventilation, water supply or for sanitary purposes and, consequently, I am not persuaded by this submission. The opponent refers to decision B1076431 of the Opposition department of the OHIM where similarity was found between these terms. I have analysed this decision, but the opposition division of OHIM provides no reasoning why such goods are similar other than to note that the party's specification, that includes *Apparatus for [...] ventilating, water supply and sanitary purposes*, is very broad in nature and, therefore, where the goods have industrial application, they are similar. As I have said above, it is not clear to me how the two sets of goods are linked. In the circumstances, I am unable to follow the OHIM's opposition division.

40) The opponent's Class 7 specification also contains the very broad term *machines*. The decision of the CJEU in the *IP Translator, C-307/10* case called for clarity in specifications, and whilst the term *machines* can be said to lack clarity on the basis of its breadth, in circumstances where it is simply a question of whether goods are similar to goods covered by the term, then I consider it appropriate to give the earlier mark the protection for which it is registered. With this in mind, the term *machines* covers industrial machines and plant. The applicant's *Gas Scrubbing apparatus* are for use with *stationary industrial plant*. Consequently, they are likely to share trade channels. Further, as the applicant's goods are limited to being specifically for use with *stationary industrial plant*, and it follows that such goods are complementary to such *stationary industrial plant*, in the sense that the opponent's goods are important, or in this case essential for the applicant's goods. The average consumer will therefore expect that the same entity is responsible for both goods.

41) Therefore, despite the respective goods differing in terms of nature, purpose and methods of use, when considering all the factors, I conclude that the applicant's *Gas Scrubbing apparatus [...] all for stationary industrial plant using catalytic processes and conversion* shares a medium level of similarity with the opponent's *machines* in Class 7.

42) Finally, I consider the applicant's *Air driers [...] all for stationary industrial plant using catalytic processes and conversion*. I do not consider the opponent's best cases to reside with its *filters* but, rather, its specification contains the broad term *Apparatus for [...] drying* that, when considering the guidance in *Meric*, includes *air driers*. The respective terms therefore include identical goods.

Comparison of marks


43) It is clear from the CJEU's guidance in *Sabel BV v Puma AG, Case C-251/95* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, 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 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.”

44) It would be wrong, therefore, to artificially dissect the 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.

45) The opponent’s best case lies with its word CTM 9344755 and I will restrict my considerations to the similarity of the applicant’s mark to this mark. The respective marks are shown below:

Opponent’s mark	Applicant’s mark
CAT	

46) The opponent’s mark consists of the three letter word “CAT” and self-evidently, it is the dominant and distinctive components of the mark.

47) The applicant’s mark consists of three elements, a red coloured “dots” device at the front of the mark, the word “cat” appearing alongside the device and, in small letters underneath the word “cat”, the words “CLEAN AIR TECHNOLOGY”. None of these elements can be considered as negligible and, therefore, they all play a part in giving the mark, as a whole, its distinctive character. The device and the word “cat” share prominent positions and size within the mark and these are more dominant than the words “CLEAN AIR TECHNOLOGY”. That said, the word “cat”, by virtue of its size, taking up nearly three quarters of the mark, is the dominant distinctive element. It has a greater relative weight within the mark compared to the other two elements. The device is also a distinctive element, but the words “CLEAN AIR TECHNOLOGY” is a descriptive term that is low, or has no distinctive character.

48) Visually, the marks share similarity in that they both include the word element "CAT" or "cat". In all other respects, the marks are different. The applicant's mark also includes the 'dots' device and the words "CLEAN AIR TECHNOLOGY". However, with the dominance of the word "cat" in the applicant's mark, I find that there is still a medium level of visual similarity.

49) Aurally, the applicant's mark will be referred to as "cat" because the device element does not aurally contribute to the mark. Further, it is not normal for secondary word matter to be referred to aurally, therefore, the words "CLEAN AIR TECHNOLOGY" is unlikely to be referred to. Consequently, the respective marks are aurally identical.

50) Conceptually, the "cat" element of the applicant's mark is likely to be understood as being a reference to "clean air technology" because the words that appear below the word "cat" in the mark provide this information. However, the presentation of the word "cat" in lower case and without full stops after each letter may also lead some consumers to perceive the ordinary dictionary meaning of the word, namely a feline animal. The "dots" device is abstract in nature and does not contribute to any meaning created or suggested by the mark. The opponent's mark merely consists of the word "CAT" being an ordinary dictionary word that will be readily understood as a reference to a feline animal. In the absence of any other indication, it is this meaning that is likely to immediately present itself to the consumer. It has been submitted by the opponent that because of its reputation, the mark will be readily understood as an abbreviation for "Caterpillar". It is well established that reputation should play no part when comparing marks (see *Ravensburger AG v OHIM*, Case T-243/08). However, even if this were not the case, it would not be helpful to the opponent because, as I have already observed, the word "cat" in the applicant's mark is likely to be perceived as meaning "clean air technology" and such a concept is different to the concept of a caterpillar. Taking all of the above into account, I find that the respective marks share no conceptual similarity where the applicant's mark is perceived as a reference to "clean air technology". If it is perceived as a reference to the feline animal, then the respective marks are conceptually identical.

Average consumer and the purchasing act

51) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

52) In *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), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The

words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

53) The majority of the parties’ goods are specialist goods for use in industry, agriculture or construction or are parts for such goods. Consequently, the average consumer of such goods is likely to have at least some specialist knowledge. These goods are not everyday purchases, but at least in respect of the smaller goods and parts of larger goods, the costs may not be high, but neither are they likely to be low cost. Therefore, the level of care and attention during the purchasing process is likely to be variable but above average and, in respect of the larger machines it will be high.

54) Such goods will be selected following discussions with sales personnel (where aural considerations will play a part) or from catalogues (where visual considerations will predominate) or from specialist retail or wholesale suppliers.

Distinctive character of the earlier trade mark

55) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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).”

56) The opponent's mark consists of the ordinary dictionary word CAT and, consequently it is not of the highest level of inherent distinctive character. The applicant claims that it is descriptive of goods that act via catalytic action, however, even for these goods, a registration is taken as prima facie evidence of validity of the mark in respect of all the goods and/or services listed in its specifications (*Formula One Licensing BV v OHIM*, Case C-196/11P, paragraphs 41 to 44). Even if the applicant is successful in its invalidation action against the opponent's earlier CTM, the term *filters* remains unchallenged and this term includes filters that operate by

catalytic action. Therefore the presumption of validity remains for such goods regardless of the outcome in the invalidation action.

57) In summary, the inherent distinctive character of the earlier mark is medium for many of the goods relied upon and is at least of the minimum distinctive character in respect of *filters* (that includes filters utilising catalytic processes).

58) The opponent has claimed that its marks benefit from enhanced distinctive character because of the use made. Clearly, the opponent has a large presence in its sector and, in its written submissions, the applicant concedes that the opponent has a reputation in respect of “engines, motors, machinery and heavy industrial and construction vehicles [and] rental and leasing of these goods”. Whether this is the most apt description of the scope of the opponent’s reputation may be an issue for debate, but I note that the opponent’s earlier marks do not include any rental services. Further, taking account that the opponent’s earlier marks do not include Class 12, but that its evidence does illustrate use in respect of goods such as *bulldozers*, I interpret the applicant’s concession insofar as it refers to “heavy industrial and construction vehicles” as relating to *bulldozers* and the like covered by the opponent’s Class 7 specifications. I conclude that the opponent benefits from enhanced distinctive character in respect of all of these goods. Ms Young, in her witness statement, claims that the opponent’s reputation extends to the parts and fittings that it supplies in respect of the goods identified above. On the other hand, Mr Elliot, in his witness statement, submits that the opponent has no separate reputation for filters, citing the fact that the evidence fails to establish whether the opponent provides such goods for use in third party machinery or whether it merely provides replacement parts for its own machinery. I agree with the applicant that the evidence only supports the latter position and as such, fails to show that the mark CAT enjoys an enhanced reputation in respect of these parts and fittings, including filters. The reputation relates to the machines themselves. However, for reasons that will become obvious, such a finding does not impact upon the outcome of these proceedings.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

59) The following principles are gleaned from the decisions 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 C-3/03, *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:

(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 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 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

60) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

61) The opponent submits that, because of the reputation that its CATERPILLAR and CAT brands enjoy, the applicant's CAT mark will be perceived as a reference to CATERPILLAR brand and that confusion will inevitably follow. I disagree. The applicant's mark includes the phrase CLEAN AIR TECHNOLOGY. This phrase invites the consumer to see the "cat" element of the applicant's mark as an

abbreviation for this phrase. Even if this is not perceived, the reference to a feline animal will be. Consequently, I do not accept the opponent's reasoning. Conversely, and not withstanding my findings at paragraph 50 above, the opponent's CAT mark may be perceived, by the consumers and potential consumers of the applicant's goods, as being an abbreviation for "Clean Air Technology". There is no other element present in the mark that may have the effect of dispelling this. As the GC stated in *Omega v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-90/05, paragraph 43, when considering a likelihood of confusion, it is irrelevant whose goods are confused with whose. Therefore, I must find a likelihood of confusion if the later mark is confused with the earlier mark or vice versa.

62) The applicant's primary case is that the opponent's mark is descriptive for goods incorporating or utilising a catalytic process and therefore it has no rights in its mark in respect of these goods and therefore it cannot prevent the applicant from registering its mark in respect of goods that utilise a catalytic process. However, as I noted in paragraph 24 above, even if the applicant is wholly successful in its invalidation action against the opponent's earlier CTM for the word mark CAT, it will remain registered in respect of the terms *filters* and *apparatus for ventilating*. The term *filters* includes those filters that operate by way of a catalytic process. Even if I am wrong about that, the terms *filters* and *apparatus for ventilating* include goods that share the same purpose and method of use as the applicant's goods. Consequently there would still be a good deal of similarity between the respective goods.

63) I have found that there is at least an above average level of care paid during the purchasing process and that the opponent's mark has at least the minimum level of distinctive character for registration. I have also found that the respective marks share a medium level of visual similarity, that they are aurally identical and, where the consumer perceives the applicant's mark as being a reference to "clean air technology", there is no conceptual similarity. This finding of no conceptual similarity arises because there is no indication in the opponent's mark that CAT means anything other than its ordinary dictionary meaning of a feline animal, however, as I discussed at paragraph 61, above, when considering likelihood of confusion, I keep in mind that consumers and potential consumers of the applicant's goods may attach a meaning of "clean air technology" to the opponent's mark.

64) Taking all of the above into account, there are some findings that point to no likelihood of confusion, but these are outweighed by the pointers towards likelihood of confusion. This confusion is indirect in that the consumer will notice the visual differences between the marks and therefore not confuse one mark with the other, but will, nonetheless, believe that goods provided under the respective marks originate from the same or linked undertaking. This finding of likelihood of confusion applies to all of the applicant's goods. The same finding applies in the case where some consumers perceive the applicant's mark as a reference to a feline animal. I concluded in paragraph 50 that, in such circumstances, the respective marks are conceptually identical. When this is factored into the global appreciation test, these circumstances also lead to a likelihood of confusion.

65) I reach this finding without factoring in the enhanced distinctive character of the opponent's mark (as identified in paragraph 58, above).

66) My finding is not disturbed by the applicant's disclaimer that states:

Registration of this mark shall give no right to the exclusive use of CAT or cat alone as descriptive of catalytic converters and the like.

67) As Ms Young referred to in her second witness statement, disclaimers are not in the public domain and therefore do not influence the average consumer in respect of how the mark is perceived. A disclaimer merely assists in clarifying legal rights. The applicant's disclaimer cannot limit the opponent's legal rights.

Section 5(3) and Section 5(4)(a)

68) The opponent has been wholly successful in its opposition based on Section 5(2)(b) of the Act and therefore, it is not necessary for me to consider its grounds based upon Section 5(3) or Section 5(4)(a).

COSTS

69) The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that both sides filed evidence and that a hearing took place. I award costs as follows:

Preparing a statement and considering the counterstatement	£300
Application fee	£200
Evidence	£1000
Preparing and attending hearing	£800
Total:	£2300

70) I order Clean Air Technology Limited to pay Caterpillar Inc. the sum of £2300 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 11th day of February 2016

**Mark Bryant
For the Registrar,**