

O-156-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS NOS 3 139 628 AND 3 139
625 IN CLASSES 09 AND 42 BY CHINA NUCLEAR POWER TECHNOLOGY



INSTITUTE LTD TO REGISTER THE MARK

AND

IN THE MATTER OF OPPOSITION THERETO BY CATERPILLAR INC

Background and pleadings

1. China Nuclear Power Technology Institute Co. Ltd (the applicant) applied to register the following trade mark¹ under Nos 3 139 628 and 3 139 625 in the



UK on 8th December 2015: They were accepted and published in the Trade Marks Journal on 18th December 2015 in respect of the following goods and services:

3 139 625:

Class 09:

Electronic control systems; Radiation sensing apparatus; Nuclear resonance spectrometers [other than for medical use]; Particle accelerators; Detectors; Measuring apparatus; Heat regulating apparatus; Cameras for monitoring and inspecting equipment in a nuclear power station; Radiological apparatus for industrial purposes; X-rays producing apparatus and installations, not for medical purposes.

3 139 628:

Class 42:

Technical research; Project studies (Technical –); Engineering; Scientific research; Quality control; Quality testing; Chemical analysis; Chemical research; Computer programming; Computer software design.

¹ Each trade mark application is in respect of the same trade mark.

2. Caterpillar Inc (the opponent) opposes the trade marks on the basis of Section 5(2) (b), Section 5(3) and Section 5(4)(a) of the Trade Marks Act 1994 (the Act). Under Section 5(2)(b) and 5(3), this is on the basis of European Union (formerly Community) Trade Marks:

a) EUTM 5 540 844 for CAT in respect of which the following goods and services are relied upon:

Class 09:


Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking, (supervision), life saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, computer software, data processing equipment including computers; wireless sets (complete), television sets (complete), fire extinguishing apparatus; testing apparatus and instruments; electric cable and wire; conduits, switches, pressure switches, connectors, jump leads, fuses, circuit testers, voltage testers; fuse holders, transformers, battery testing apparatus for sale in kit form; thermostats, gauges, levelling apparatus and instruments; tape measures and rules; microscopes, tachometers; diagnostic apparatus and instruments; meters, thermometers; alarms, horns, flasher units, reflectors, mirrors, aerials, battery chargers; weighing apparatus and instruments; computer programs; computer software; couplings; petrol pumps; levels; locks; radios; batteries; starters; speed checking apparatus and instruments; battery cables; connectors for sale in kit form; electrical terminals; switches; electrical tape; water temperature regulators, probes; ammeters; battery testers, terminals, gas detectors; flow meters; cutting torches; ohmmeters; pressure measurement tools; electric welding apparatus; battery ground strap connectors; battery tie down connectors; conduit and

wire protectors; emergency jump start apparatus, emergency jump start receptacle assemblies; voltage converters; welding apparatus; parts and fittings for all the aforesaid goods; parts and fittings included in class 9 for land vehicles, agricultural machinery and earth moving machinery namely amplifiers for wireless communications, antennas, antennas for wireless communications apparatus, audio equipment for vehicles, namely, stereos, speakers, amplifiers, equalizers, crossovers and speaker housings, batteries for vehicles, computer software, computer software that provides real-time, integrated business management intelligence by combining information from various databases and presenting it in an easy-to-understand user interface, devices for wireless radio transmission, electric control panels, electric luminescent display panels, electric relays, electronic and optical communications instruments and components, namely optical transmitters, electronic and optical communications instruments and components, namely optical receivers, electronic and optical communications instruments and components, namely digital transmitters, electronic control systems for machines, global positioning systems, laser object detectors for use on vehicles, navigation apparatus for vehicles in the nature of on-board computers, radios for vehicles, voltage regulators, voltage stabilizers, voltmeters; all the foregoing excluding music recordings or video recordings of musicals.

Class 42:

Scientific and technological services and research and design relating thereto; industrial analysis and research services; computer programming; engineering research and drawing; rental and leasing of engineering, agricultural and farming machinery and equipment; design and development of products and design of computer programs, computer hardware and software; surveying; legal services including professional consultancy relating to engineering, agriculture, transport and construction.



- b) EUTM 1 339 2733 for  in respect of which the following goods and services are relied upon in this opposition:

Class 03:

Cleaning, polishing, scouring and abrasive preparations; polishing paper, polishing wax for footwear, shoe polish, shoe wax, cobblers' wax, shoemakers' wax, sachets for footwear, creams for footwear, shine for footwear, lacquers for footwear, polishing preparations, cleaning preparations for footwear; parquet floor wax, non-slipping wax for floors, polish for furniture and flooring, non-slipping liquids for floors, windshield cleaning liquids, volcanic ash for cleaning, tripoli stone for polishing, polishing creams, polishing rouge, cleaning chalk, floor wax removers [scouring preparations], preparations for cleaning and polishing floors, tile, tile floors and glass.

Class 04:

Greases, lubricants, oils, and fluid additives for engines, compressors, generators, pumps, and vehicles; greases, lubricants, oils, and fluid additives for machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management.

Class 07:

Air intake and exhaust assemblies for engines; engines, other than for land vehicles; engines, compressors, generators, and pumps, and parts therefor,

for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lawn care, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lawn care, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management.

Class 09:

Computer hardware; computer software for testing, monitoring, and operating vehicles, engines, equipment, machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; computer software for testing, monitoring, and operating vehicles, engines, equipment, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; computer software in the field of statistical analysis, data analysis, predictive analysis, and job site office management and planning; computer software for selecting delivery location and tracking delivery status of packages, freight, and job site materials; equipment and parts therefor for locating, positioning, and controlling machines, engines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; equipment and parts therefor for locating, positioning, and controlling machines, engines, machine tools, and parts therefor, for use in oil

and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; equipment for remote operation, control, and monitoring of engines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; equipment for remote operation, control, and monitoring of engines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management.

Class 12:

Vehicles for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; locomotives; railcars; engines and air intake and exhaust assemblies for land vehicles; and parts and fittings for all of the foregoing goods.

Class 35:

Business management and consultation; product distribution and operations management services; logistics consulting services, namely, order management and fulfillment services, business consultancy service relating to warehouse management, inventory management, records management services (document indexing for others), business consultancy services relating to manufacturing, business consultancy services relating to remanufacturing, supply chain design and management, business consultancy services relating to transportation management, business

consultancy services relating to the management of shipping and storage of goods; marketing services; compilation and systemization of information into computer databases; management and compilation of computerized databases; retail stores featuring vehicles, equipment, and machines for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; retail stores featuring vehicles, equipment, and machines for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; retail stores featuring power generation equipment, generators, and tools; online retail store services and retail store services featuring clothing and clothing accessories, footwear, headwear, toys, games, bags, glasses, cups, keychains, watches, computer software, eyewear, pictures, and books; providing searchable computer databases, websites, and online information services relating to purchasing of vehicles, equipment, machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; providing searchable computer databases, websites, and online information services relating to purchasing of vehicles, equipment, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring and vegetation management; providing searchable computer databases, websites, and online information services relating to purchasing of engines and power generation equipment.

Class 36:

Providing searchable computer databases, websites, and online information services relating to financing of vehicles, equipment, machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry,

landscaping, lifting, marine propulsion, material handling, mining, mulching; providing searchable computer databases, websites, and online information services relating to financing of vehicles, equipment, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring and vegetation management; providing searchable computer databases, websites, and online information services relating to financing of engines and power generation equipment.

Class 37:

Repair, servicing, and maintenance of vehicles, engines, equipment, machines, machine tools, and control units and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; repair, servicing, and maintenance of vehicles, engines, equipment, machines, machine tools, and control units and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring and vegetation management; machinery installation; rental of equipment, machines, and machine tools for use in compaction, construction, demolition, earth conditioning, earth contouring, earth moving, lifting, marine propulsion, material handling, mining, paving, pipelaying, and road building and repair, site preparation and remediation, and tunnel boring; remanufacturing of vehicles, engines, machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; remanufacturing of vehicles, engines, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; providing searchable computer

databases, websites, and online information services relating to renting of equipment, machines, machine tools and parts therefor for use in compaction, construction, demolition, earth conditioning, earth contouring, earth moving, lifting, mining; providing searchable computer databases, websites, and online information services relating to repair and maintenance of vehicles, equipment, machines, machine tools, and parts therefor, for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; providing searchable computer databases, websites, and online information services relating to renting of equipment, machines, machine tools, and parts therefor, for use in paving, pipelaying, road building and repair, site preparation and remediation, tunnel boring; providing searchable computer databases, websites, and online information services relating to repair and maintenance of engines and power generation equipment; providing searchable computer databases, websites, and online information services relating to repair and maintenance of vehicles, equipment, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring and vegetation management.

Class 39:

Freight brokerage; transport brokerage; freight forwarding; storage of goods; packaging of goods; provision of storage and transportation information; warehousing; vehicle rental services; rental of vehicles for use in agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; providing searchable computer databases, websites, and online information services relating to renting of vehicles and parts therefor for use in agriculture, compaction, construction, demolition, earth conditioning, earth

contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching.

Class 40:

Rental of generators; rental of equipment, machines, and machine tools for use in oil and gas distribution, oil and gas exploration, and oil and gas production; providing searchable computer databases, websites, and online information services relating to renting of equipment, machines, machine tools, and parts therefor, for use in material handling; providing searchable computer databases, websites, and online information services relating to renting of equipment, machines, machine tools, and parts therefor, for use in oil and gas distribution, oil and gas exploration, oil and gas production, power generation; providing searchable computer databases, websites, and online information services relating to renting of engines and power generation equipment.

Class 41:

Education services, namely, providing online safety training, workshops, and seminars in the fields of safety, health, and the environment in the agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching; education services, namely, providing online safety training, workshops, and seminars in the fields of safety, health, and the environment in the oil and gas distribution, oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management industries.

Class 42:

Engineering and technical consultation; providing online non-downloadable software; design of computerized information systems; testing and inspection

of engines and machinery; testing, control, diagnosis, calibration, and monitoring of vehicles, equipment, and machines used for agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution; testing, control, diagnosis, calibration, and monitoring of vehicles, equipment, and machines used for oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management; testing, control, diagnosis, calibration, and monitoring of engines, power generation equipment, jobsites, machine fleets, trucks, trucking fleets, and the operation of machines via computer networks and the internet; remote monitoring relating to the control and operation of vehicles, equipment, and machines used for agriculture, compaction, construction, demolition, earth conditioning, earth contouring, earth moving, forestry, landscaping, lifting, marine propulsion, material handling, mining, mulching, oil and gas distribution; remote monitoring relating to the control and operation of vehicles, equipment, and machines used for oil and gas exploration, oil and gas production, paving, pipelaying, power generation, road building and repair, site preparation and remediation, tunnel boring, and vegetation management via computer networks and the internet; remote monitoring relating to the control and operation of engines and power generation equipment via computer networks and the internet; data acquisition and analysis via computer networks and the internet; troubleshooting of computer hardware and software.

Class 44:

Rental of equipment, machines, and machine tools for use in agriculture, forestry, landscaping, mulching, and vegetation management; providing searchable computer databases, websites, and online information services relating to renting of equipment, machines, machine tools, and parts therefor, for use in agriculture, forestry, mulching, landscaping; providing searchable computer databases, websites, and online information services relating to

renting of equipment, machines, machine tools, and parts therefor, for use in vegetation management.

3. Under Section 5(2)(b), the opponent argues that the respective goods and services are identical or similar and that the marks are similar. Under Section 5(3), the opponent argues that its earlier trade marks enjoy a significant reputation and that use of the later trade marks will take unfair advantage of such a reputation. This is because they will feed on the fame of the earlier CAT trade marks; ride on the coat tails of the earlier trade marks and free ride on the substantial investment made by the opponent therefore benefitting from the power of attraction, the reputation and the prestige of the earlier trade marks and exploiting, without paying any financial compensation, the marketing effort expended by the opponent in order to create and maintain the image of the earlier trade marks. Under Section 5(4)(a), the opponent argues that its earlier signs relied upon (which correspond with those listed above) have acquired a goodwill in respect of the following goods and services:

Mining vehicles, machines, equipment and related products, construction vehicles, machines, equipment and related products, motors and engines and related products such as machine fluids including coolants, greases and oils; agricultural vehicles, machines and equipment, earth moving vehicles, machines and equipment; forestry machines and equipment, power generation products and related products and accessories; vehicles adapted for military use and equipment and related products and all terrain vehicles and equipment and related products, and a range of scientific and engineering research and development services including the design and programming of computer software and other technology related services.

4. The opponent claims that the use of the later trade marks will be a misrepresentation leading to damage.
5. The applicant filed a counterstatement denying the claims made.

6. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
7. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.
8. A Hearing took place on 10th January 2017, with the opponent represented by Ms Alaina Newnes of Counsel, instructed by Hogan Lovells International LLP. The applicant was not represented and did not attend the Hearing.

Evidence

The opponent's evidence

9. This is a witness statement, dated 28th August 2016, from Ms Lia Yasmin Young, an Attorney within the Legal Services Division of Caterpillar UK Limited, a subsidiary company of Caterpillar Inc, the opponent in these proceedings.
10. The following relevant information is contained therein:
 - According to Ms Young, the opponent is one of the world's leading manufacturers of construction and mining equipment, power systems, diesel and natural gas engines, industrial gas turbines and diesel-electric locomotives. It is also a major manufacturer of vehicles and machinery, including those with application to the military, oil and gas, marine and power sectors. It also builds and supplies software and technology solutions for use in connection with its goods and services.
 - The opponent established its first UK facility in 1950, when it first began using the CAT brand in the UK.
 - Ms Young described the products offered by the opponent in the UK. These are vehicles (construction, agricultural, military); engines and power systems (such as diesel and gas engines, marine applications etc); software.

- In respect of vehicles, the UK sales figures are provided and are significant: in 2013 - \$195 million; in 2014 - \$275 million and in 2015 - \$283 million.
- In respect of engines and power systems, sales are around \$80 million in 2012; \$65 million in 2013 and around \$95 million in 2014.
- In respect of software, it is noted that the opponent produces fleet management solutions, equipment management solutions (CAT Connect) and CAT Minestar for users of CAT Mining equipment.
- The opponent also produces a wide range of parts and fittings for its vehicle models and engines and power solutions under the CAT brand. Sales figures are provided and it is noted that these are around \$80 million in 2012; \$70 million in 2013 and \$75 million in 2014.
- In respect of research and development and engineering services, the opponent invests over \$2 billion each year worldwide and engineers most of its own products. It engages over 1,000 qualified engineers in product research and development; has developed relationships with several leading UK universities, including Cambridge universities and is also one of the six founding members of the UK Energy Technologies Institute (ETI). According to Ms Young, this puts the opponent at the forefront of the development, demonstration and commercial deployment of energy technologies.
- In respect of marketing and promotion, Ms Young explains that the opponent has been marketing and promoting its products under the CAT brand since the 1950s. Examples of recent activities are provided in the exhibits, which are comprehensive. The opponent regularly exhibits its products and services at trade shows in the UK, and Ms Young claims that this has resulted in the opponent being viewed as in a class of its own and one of the worlds top brands. It has also been involved in sponsorship deals, such as that in respect of the Leicester Tigers Rugby Union team in 2008.
- The opponent regularly appears in prominent positions in brand league tables, with several examples provided in the exhibits to the witness statement.
- The witness statement ends with Ms Young providing examples of decisions from other jurisdictions where the opponent has been found to have a reputation in respect of its earlier trade marks.

Conclusions on the evidence - Reputation

11. It is considered to be clear from the evidence filed that the opponent has used its earlier trade marks across a wide range of goods and services and enjoys a significant reputation. However, this reputation does not extend to the entire range of goods and services for which the earlier trade marks are registered. Rather, its reputation is considered to be shown in respect of the following:

Class 42:

Scientific and technological services and research and design relating thereto; engineering research and drawing; design and development of products;

Class 07:

Engines, for use in agriculture, construction, demolition; machines, machine tools, and parts therefor, for use in agriculture, construction, demolition,

Class 12:

Vehicles for use in agriculture, construction, demolition, locomotives; railcars; and parts and fittings for all of the foregoing goods.

Conclusions on the evidence – Goodwill

12. It is clear from the evidence that the opponent has acquired a substantial goodwill in CAT in the UK. This goodwill extends beyond the goods and services for which a reputation has been demonstrated (bearing in mind that the relevant tests and thresholds differ). The opponent enjoys a goodwill in respect of the following:

Mining vehicles, machines, equipment and related products, construction vehicles, machines, equipment and related products, motors and engines and related products such as machine fluids including coolants, greases and oils; agricultural vehicles, machines and equipment, earth moving vehicles, machines and equipment; forestry machines and equipment, power generation products and related products and accessories; vehicles adapted for military use and equipment and related products and all terrain vehicles and equipment and related products, and a range of scientific and engineering research and development services including the design and programming of computer software and other technology related services.

DECISION

Section 5(2)(b) – Likelihood of confusion

13. 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, 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

14. Some of the contested goods and services, i.e. engineering in Class 42 are identical to the goods and services on which the opposition is based (engineering research). For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods and services listed above. The examination of the opposition will proceed on the basis that the contested

goods and services are identical to those covered by the earlier trade marks. If the opposition fails, even where the goods and services are identical, it follows that the opposition will also fail where the goods and services are only similar.



Comparison of marks

15. It is clear from the guidance of the Court of Justice of the European Union (“the CJEU”) in *Sabel BV v. Puma AG* (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 Case C-591/12P, *Bimbo SA v OHIM*, 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.”

16. It would be wrong, therefore, to artificially dissect the trade 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.

The respective trade marks are shown below:

<p style="text-align: center;">CAT</p> 	
<p style="text-align: center;">Earlier trade marks</p>	<p style="text-align: center;">Contested trade marks</p>

17. On visual inspection of the respective trade marks, it is noted that the earlier trade marks are both dominated by the element CAT. In the earlier figurative trade mark, the triangular device is also noticed quickly, though this dovetails into the natural triangle shape at the bottom of the letter A which as a capital letter, naturally creates a triangular shape at the bottom of the letter. In respect of the later trade mark, its dominant component is its circular device with ornate triangular centre. This triangle is solid with pieces removed, creating other shapes within the triangle. It is clear that the entire graphic element is also distinctive. The verbal element CATFUEL is also distinctive, is visible and shares equal dominance with the device. It is also how the mark will be referred to.

18. Visually, the marks coincide in respect of CAT. Though one of the earlier trade marks contains a triangle in common with the later trade marks, the appearance of each respective triangle is significantly different and they are positioned differently within each of the respective trade marks. The marks

differ in all other respects. They only share any similarity due to CAT and as such the overall degree of similarity is considered to be very low.

19. Aurally, the device elements present in the respective trade marks play no part. The marks coincide in respect of CAT and differ in respect of the additional syllables FUEL in the later trade marks. There is a low to medium degree of aural similarity.
20. Conceptually, the earlier trade marks are most likely to be understood as meaning the feline animal. Though cat also appears in the later trade mark it is joined with fuel. It is considered that this creates a fanciful combination. Though the idea of CATFUEL is somewhat odd, it creates an idea which, overall, seems dissonant from the very specific meaning of the earlier trade marks.

Average consumer and the purchasing act

21. 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*.

22. 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.”

23. The goods and services in conflict are specialist in nature and are aimed at professionals, namely those in the scientific, engineering, construction and technology industries. The acquisition of the correct products and services for the specific purpose in hand is therefore paramount. It is considered that the purchasing process for such goods and services is likely to involve a period of research and consideration. As such, it is anticipated that a high degree of attention will be displayed.

Distinctive character of the earlier trade mark

24. 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).”

25. It is noted that the earlier trade marks have been found to enjoy a significant reputation in respect of certain of the goods and services for which they are registered. For such goods and services therefore, the earlier trade marks have acquired an enhanced degree of distinctiveness. That said, even in respect of the remaining goods and services and in consideration of the trade marks on a prima facie basis, it is noted that although CAT is a dictionary word meaning a feline animal, they have no meaning in respect of the goods and services. As such, they are considered, in any case, to have a good deal of distinctiveness, prima facie in respect of the goods and services for which an enhanced degree of distinctiveness has not been shown.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

26. 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.

The principles

(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.

27. The goods and services are all assumed identical. This is an important consideration as the identical nature of goods and services can offset differences between the trade marks (and vice versa) Further, in respect of the (identical) applied for services, namely engineering, the earlier trade marks have been shown to have acquired an enhanced degree of distinctiveness. This is considered to be the high point of the opponent's case under Section 5(2)(b) and so will form the focus of the assessment as to the likelihood of confusion. All of the goods and services in question will be availed of by a consumer displaying a high degree of attention. This is important because this negates against the respective trade marks being imperfectly recalled. In respect of the trade marks, there is only a very low degree of visual similarity and a low to medium degree of aural similarity. Notably, the marks have been found to have no concept in common. Rather, the later trade marks form a unit, different in meaning to earlier CAT trade marks, within which the meaning of CAT (alone) is lost. Bearing in mind all of the aforesaid and the way in which all factors interact, it is considered unlikely that the trade marks will be mistaken for each other. There is therefore no likelihood of direct confusion.

28. This is not the end of the matter and the following is taken into account:

In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on

the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

29. It is true that the earlier trade marks benefit from an enhanced level of distinctive character, at least in respect of some of the goods and services for which it is registered. However, it has already been found that CAT is not an element which will be picked out in the later trade marks. Rather, the later trade marks have their own, odd, fanciful meaning which differs from the specific meaning of the earlier trade marks. In such circumstances, category a) above cannot reasonably apply. The later trade marks do not merely add non-distinctive elements in the manner described in category b). To the

contrary, the additional verbal element entirely changes matters and the device element does not detract from this. Category c) above also clearly does not apply here. Though the list is non exhaustive, bearing in mind all of the aforesaid, it is difficult to see how the later trade marks will be viewed as being economically linked to the opponent. I conclude therefore, that there is also no likelihood of indirect confusion.

30. The ground of opposition under Section 5(2)(b) therefore fails in its entirety.

Section 5(4)(a) – Passing Off

31. It is noted that the basis of this claim is no broader than that claimed under Section 5(2)(b). Though the tests for confusion and misrepresentation differ², in these proceedings, with all other factors being equal, if there is no confusion, it is difficult to see how there will be a misrepresentation. It is considered that this ground of opposition does not advance the opponent's case. As such, it fails in its entirety.

Section 5(3) – Reputation

32. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

² Marks and Spencer PLC v Interflora [2012] EWCA Civ 1501, Lewinson L.J.

33. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

34. It has already been found that the earlier trade marks enjoy a significant reputation in respect of at least some of its earlier goods and services. I must therefore assess whether or not a link would be established between the opponent's trade mark and the later trade mark.

Link

35. In assessing whether the requisite link exists, the following has been taken into account:

In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

36. It is true that the earlier trade marks appear in the later trade marks. This automatically ensure that there is a degree of similarity between them.

However, as already found, the later trade marks are significantly different visually. Further, they evoke an odd, fanciful meaning which differs from the specific meaning of the earlier trade marks. It is considered therefore that no link will be formed in the minds of the relevant section of the public between the respective trade marks.

37. The ground of opposition based upon Section 5(3) of the Act also fails.

COSTS

38. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award costs as follows:

Preparing a statement of case and considering the other side's statement -
£500

39. I therefore order Caterpillar Inc. to pay China Nuclear Power Technology Institute Co. Ltd the sum of £500. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of March 2017

Louise White
For the Registrar,

