

O-081-18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3199325
BY BBCLASSICS LTD & ACCUSPARK IGNITION SYSTEMS LTD
TO REGISTER THE FOLLOWING TRADE MARK
IN CLASS 12:**


Volante
Luxury Steering Wheels

AND

**OPPOSITION THERETO UNDER NO. 408738
BY ASTON MARTIN LAGONDA LIMITED**

Background and pleadings

1. The trade mark shown on the cover page of this decision was filed in the joint names of BBclassics Ltd and Accuspark Ignition Systems Ltd in the UK on 29 November 2016. It was published for opposition purposes on 09 December 2016. Registration of the mark is opposed by Aston Martin Lagonda Limited (“the opponent”) under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)¹. The opponent relies upon its earlier UK trade mark, registration no. 1196678, which was filed on 26 May 1983. In view of all this, the case boils down to an alleged conflict between the following marks and goods:

Applied for mark	Earlier mark
 <p>Class 12: Steering Wheels For Vehicles.</p>	<p>VOLANTE</p> <p>Class 12: Motor vehicles and parts and fittings therefor included in Class 12; but not including wheels</p>

2. Given its date of filing, the opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act. The earlier mark was registered more than 5 years before the date on which the applicant’s mark was published. This means that the earlier mark is subject to the proof of use provisions contained in section 6A of the Act and would, potentially, mean that the opponent is required to prove that it has made genuine use of the mark. In its statement of case, the opponent made a statement of use claiming that it has made genuine use of the mark in relation to all the goods for which it is registered.

¹ Claims under section 5(3) and 5(4)(a) were also initially pleaded, but these were struck out during the proceedings due to the opponent filing no evidence.

3. A counterstatement was filed denying the grounds of opposition. Only BBclassics Ltd (who I refer to from this point on as “the applicant”) were identified in the notice of defence, so it is the only party who has joined issue with the opponent in these proceedings. It states that it was aware (from conducting a search) of the opponent’s mark registered as a European Union Trade Mark (“EUTM”) (no. 2405314), but highlights that the EUTM had an exclusion in class 12 in respect of steering wheels. The applicant states that it only seeks to use the mark in respect of steering wheels. Whilst this is noted, the EUTM is not the earlier mark relied on in these proceedings. As can be seen in the above table, the earlier mark in these proceedings is a UK registration, the specification of which excludes “wheels” not “steering wheels”. I return to the significance of this later. The applicant also states that the word VOLANTE means steering wheel in Spanish and Italian, thus fitting its image of “continental luxury”. It concludes by stating that there would be no association between the marks unless Volante was preceded by the words Aston Martin and, further, that it has been using the mark for 5 or 6 years without confusion. Despite the earlier mark being subject to the proof of use requirements, the applicant did not ask the opponent to provide proof of use, so the opponent is entitled to rely on the earlier mark for all of the goods for which it is registered.

4. The applicant is self-represented. The opponent is represented by Lewis Silkin LLP. Neither side filed evidence. The opponent did request additional time to file evidence, but this request was refused at a case-management conference that took place on 21 August 2017. At the case-management conference, the applicant indicated that it did not wish to file evidence. Neither side requested a hearing. The opponent filed written submissions in lieu, which will not be summarised but will be referred to as and where appropriate in this decision. The applicant did not file submissions in lieu, despite the direction following the case-management conference that submissions could be filed so as to provide an opportunity to say what significance should be given to the exclusion of “wheels” from the UK earlier mark.

Section 5(2)(b)

5. Section 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”.

6. The following principles are gleaned from the judgments 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 greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

7. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the

purposes of the trade”² and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning³. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

8. If goods are not worded identically, they can still be considered identical if one term falls within the ambit of another (or vice versa), as per the judgment in *Gérard Meric v OHIM*, Case T-133/05, where the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

² See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

³ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

9. The applicant seeks registration for “steering wheels for vehicles”. As observed earlier, the applicant states that it was aware of the opponent’s EUTM registration, but had noted that “steering wheels” had been excluded from its scope. However, as the opponent states, the earlier mark in these proceedings (UK registration 1196678) is registered in respect of:

“Motor vehicles and parts and fittings therefor included in Class 12; but not including wheels”

10. The opponent submits that words in specifications are deemed to take their ordinary meaning, and that wheels would not be construed (for example, by someone in a spare parts shop) as including steering wheels. Reference is also made to the Nice Classification which separately lists steering wheels and vehicle wheels/wheel hubs. In other words, it submits that the UK registration covers steering wheels (as a subset of parts and fittings), with the exclusion not impacting upon this.

11. Steering wheels clearly fall within the ambit of parts and fittings for motor vehicles. Thus, ordinarily, the goods would be identical. However, the matter that falls to be determined relates to the scope of the term “wheels” within the exclusion and whether this has the effect of excluding steering wheels. The crux of the question relates to the scope of the term “wheels”. The comments in the preceding paragraph give the opponent’s view of matters. Despite being invited to comment on the scope of the exclusion, the applicant said nothing.

12. Although the term “steering wheels” includes the word “wheels”, I come to the view, in agreement with the opponent, that “wheels”, according to natural and ordinary language, have a clearly understood meaning that would not cover steering wheels. It would be a strain of the language to find otherwise. Therefore, the exclusion excludes only wheels (the items on the bottom of a vehicle that drive it forward); it does not exclude steering wheels. In view of this, “steering wheels” are included in the opponent’s “parts and fittings” and are not excluded by the limitation. The goods are, therefore, identical on the principle outlined in *Meric*.

Average consumer and the purchasing act

13. 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*. 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.”


14. The conflicting goods are steering wheels. Whilst these are not everyday consumer items, they could still be purchased by members of the general public for undertaking projects, hobbies and restorations at home. Alternatively, they could be purchased by specialist tradespeople. Either way, the goods are unlikely to be frequent purchases and, given the specialist nature of the goods, attention will be paid to their precise requirements to ensure compatibility with the vehicle concerned. This means that there is likely to be an above average level of care, albeit, not of the very highest level. The goods may be selected from the shelves of specialist stores, from websites, perused in brochures etc. It may also be that the average consumer requests the goods aurally at a trade counter, via a store assistant or over the telephone. Whilst there may be a slight skew towards the purchase being more visual than aural, the aural impact of the marks is still important to consider in the overall assessment.

Comparison of marks

15. It is clear from *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:

	VOLANTE
Applicant's mark	Opponent's mark

17. The applied for mark is made up of the word “Volante” in a font that is bold and has some stylisation, albeit of a fairly unremarkable nature. Underneath are the underlined words “Luxury Steering Wheels” in a similar font, but which are much smaller and which are in line with the bottom of the “V”, forming the impression of those words being subscript. I consider the word “Volante” to have by far the

greatest relative weight in the overall impression. The words “Luxury Steering Wheels” have much less relative weight, given their size and descriptive meaning in relation to the goods. The stylisation contributes to the overall impression, but only to a small degree. The opponent’s mark is the word “VOLANTE” alone, so this is the only thing that contributes to its overall impression.

18. Visually, that the marks both contain the words ‘Volante/VOLANTE’ provides a clear point of similarity. That the casing differs is immaterial because the earlier mark could notionally be used in upper and lower case. Whilst there are a number of visual differences (the stylisation of the lettering in the applicant’s mark, the additional words and the underlining), I still consider, bearing in mind the overall impressions of the marks, that there is high degree of visual similarity.

19. Aurally, the opponent’s mark would be articulated as VOL-LAN-TAY, or alternatively as VOL-LAN-TEA, or close variations thereof. Either way, most average consumers will articulate the applied for mark in an identical way as s/he may drop the “Luxury steering wheels” element. The mark are aurally identical. Even if the rest of the applied for mark were to be articulated, there is still a high degree of similarity, particularly bearing in mind that Volante is the dominant part of the mark.

20. In its counterstatement, the applicant states that “Volante” means “steering wheel” in both Spanish and Italian, but provides no proof of this assertion. In contrast, the opponent provides a definition from the “onelook” English dictionary for “Volante” as being “a horse drawn carriage of Spanish origin”, furthermore, its states that had the meaning been “steering wheel” when the earlier mark was registered in the 1980s, it would not have been subject to a translation and would not have been accepted.

21. I am not persuaded that the average consumer would see either meaning put forward, even in respect of the opponent’s suggestion for which a dictionary definition is provided. In my experience, it is not a commonly understood word and there is no evidence to suggest otherwise. My view is that the average consumer would see the word Volante/VOLANTE in both marks as an invented word; given

this, there is neither conceptual similarity nor dissimilarity with the position being neutral.

Distinctive character of the earlier trade mark

22. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v., Puma AG*, paragraph 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).”

23. The opponent has filed no evidence so I have only the inherent characteristics of the mark to consider. I have already found that the earlier mark is likely to be

perceived as an invented word. As such, I consider it to enjoy an above average level of distinctiveness, although, not of the highest degree.

Likelihood of confusion

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

25. There are two types of relevant confusion to consider. Direct confusion (where one mark is mistaken for the other) and indirect confusion (where the similarities between the marks leads the average consumer to believe that the respective goods come from the same, or related, economic undertaking). The differences between direct and indirect confusion were summed up by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he 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.”

26. The goods involved are identical. The marks are highly similar visually, and are aurally identical (or if not highly similar). The conceptual position is neutral. The concept of imperfect recollection must also be borne in mind. Consumers rarely have the chance to see the competing marks side by side and must, instead, rely on the imperfect picture of them kept in mind. Even taking into account the higher than normal level of care and attention which may be used when selecting the goods, the differences between the marks could easily be forgotten through the effects of imperfect recollection, so meaning that the marks could be confused directly for one another. Even if the average consumer did recall the differences between the marks, the common presence of the dominant element “Volante” will lead the average consumer to assume that the responsible undertakings are the same or economically linked.

27. Therefore, I find that there is a likelihood of confusion.

28. In reaching the above finding, I have not ignored two points referred to by the applicant in its counterstatement. First, it says that an association would not exist save for when the word is used in conjunction with “Aston Martin”. Second, the applicant claims to have been using the trade mark for 5 to 6 years without confusion. Whilst the points are noted, the opponent is entitled to rely on the notional use of its mark as registered, without ASTON MARTIN, for the goods for which it is registered. Further, as no evidence has been provided of any concurrent use, the claimed absence of confusion is not telling.

29. I also wish to add one final point. Even if I am wrong on my interpretation of the scope of the earlier mark’s exclusion, and that steering wheels are excluded, my overall finding would be the same. This is because the terms “parts and fittings” would still encompass parts such as steering columns that are linked to steering wheels and, also, gear knobs, which are similar after-market accessories for vehicles. Such goods have at least a medium and low (respectively) degree of similarity to steering wheels and the high visual and aural similarity that exists between the marks would lead the average consumer to believe that such goods, sold under the respective marks, are the responsibility of the same or related economic undertaking.

Costs

30. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of £800 as a contribution towards the cost of the proceedings, assessed from the published scale. The sum is calculated as follows:

Official fee - £100⁴

Preparing the statement and considering the other side's statement - £300

Written submissions - £400

31. I therefore order BBclassics Ltd to pay Aston Martin Lagonda Limited the sum of £800. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of February 2018

Oliver Morris

For the Registrar,

The Comptroller General

⁴ Although a fee of £200 was paid, the opponent is not entitled to this full fee as such a fee is only required for oppositions based on grounds other than 5(1)/5(2) – although other grounds were initially pleaded, they were struck out as no evidence was filed on time.