

O/666/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003590891
BY FOXTRON VEHICLE TECHNOLOGIES CO., LTD TO REGISTER THE
FOLLOWING TRADE MARK:**

F O X T R O N

IN CLASSES 9, 12, 35 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 426244 BY FOX FACTORY INC.**

Background and Pleadings

1. On 5 February 2021, Foxtron Vehicle Technologies Co., Ltd ('the Applicant') filed an application to register the word mark 'FOXTRON', number UK00003590891. The application was published for opposition purposes in the *Trade Marks Journal* on 18 June 2021. Registration is sought in respect of the following goods and services:

Class 9: *Computer software, recorded; Computer hardware; Computer programs, downloadable; Batteries; Lithium ion batteries; Solar batteries; Accumulators, electric; Battery boxes; Accumulators, electric, for vehicles; parts and fittings for the aforesaid goods; none of the aforesaid being intended for use in the real estate sector.*

Class 12: *Automobiles; Motorcycles; Electric cars; Chassis for electric cars; Chassis for electric buses; Transmission shafts for land vehicles; Driving motors for land vehicles; Transmission gears for land vehicles; Transmission chains for land vehicles; Self-driving cars; Buses; Land vehicles; Electric vehicles; for land vehicles; parts and fittings for the aforesaid goods.*

Class 35: *Import-export agency services; Systemization of information into computer databases; Retail services in relation to vehicles; Wholesale services in relation to vehicles; Retail services relating to automobile parts; Retail services relating to automobile accessories; Wholesale services relating to automobile parts; Wholesale services relating to automobile accessories; Retail services relating to batteries; Retail services in relation to computer software; Wholesale services in relation to computer software; Retail services in relation to computer hardware; Wholesale services in relation to computer hardware; none of the aforesaid being intended for use in the real estate sector.*

Class 42: *Computer programming; Computer software design; Cloud computing; Product research and development; Research and development of new products for others; Industrial design; none of the aforesaid being intended for use in the real estate sector.*

2. On 19 August 2021, the application was opposed by Fox Factory, Inc. ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against the following of the Applicant's goods and services only:

Class 12: *Automobiles; Motorcycles; Electric cars; Chassis for electric cars; Chassis for electric buses; Transmission shafts for land vehicles; Driving motors for land vehicles; Transmission gears for land vehicles; Transmission chains for land vehicles; Self-driving cars; Buses; Land vehicles; Electric vehicles; Transmissions for land vehicles; parts and fittings for the aforesaid goods.*

Class 35: *Retail services in relation to vehicles; Wholesale services in relation to vehicles; Retail services relating to automobile parts; Retail services relating to automobile accessories; Wholesale services relating to automobile parts; Wholesale services relating to automobile accessories*

3. The Opponent relies on the following earlier marks for its section 5(2)(b) ground:

i) UK00003682100

FOX

Filing date: 16 August 2021

Publication date: 3 December 2021

Priority date: 6 May 2020

Priority country: EUIPO

Registration is sought for the following goods:

Class 12: *Vehicles; apparatus for locomotion by land, air or water; suspension systems for vehicles, in particular, suspension systems for bicycles and motor vehicles; vehicle parts, in particular, shock absorbers (including for seats, in particular boat seats), suspension, and suspension parts consisting of lift kits comprising of spacers, linkages, cross members, shock absorbers, and mounting brackets; bicycle parts, in particular, shock absorbers, forks, sprockets, seat posts, handlebars, and wheels.*

The Opponent relies upon all of these goods.

ii) UK00902237568



Filing date: 30 May 2001

Date of entry on register: 26 June 2002

Registered for the following goods:

Class 12: *Vehicles parts, namely shock absorbers.*

The Opponent relies upon all of these goods.

iii) UK00908439499



Filing date: 21 July 2009

Date of entry in register: 22 February 2010

Priority date: 6 February 2009

Priority country: United States of America

Registered for the following goods:

Class 12: *Vehicles parts, namely shock absorbers; bicycle parts, namely, shock absorbers.*

The Opponent relies upon all of these goods.

iv) UK00917882581



Filing date: 3 April 2018

Date of entry in register: 4 October 2018

Priority date: 2 October 2017

Priority country: United States of America

Registered for the following goods and services:

Class 12: *Suspension systems for vehicles, suspension systems for bicycles and motor vehicles; Vehicle parts, shock absorbers; bicycle parts, shock absorbers; parts and accessories for all the foregoing.*

Class 18: *Gear bags, backpacks.*

Class 25: *Clothing, namely, shirts, T-shirts, tank shirts, jerseys, hoodies, hats, caps, head bands, sweat bands, wrist bands, footwear, socks, shorts, pants, jackets, gloves.*

Class 35: *Retail store services and computerized online retail store services featuring vehicle parts, bicycle parts, clothing and*

fashion accessories, bicycle bags, sports bags, decals, and printed materials.

The Opponent relies on the goods and services in classes 12 and 35 only.

4. The Opponent claims that the Applicant's goods and services are 'identical and highly similar' to the goods/services protected by the earlier marks and that the Applicant's mark is similar to each of the Opponent's earlier marks which will lead to a likelihood of confusion between the marks. The Opponent argues that its earlier marks have an enhanced level of distinctive character.
5. The Applicant filed a Defence and Counterstatement in which:
 - i) it denies the claim against it, save for conceding that the following of its goods are identical with the Opponent's goods:
Class 12: *Self-driving cars; Buses; Land vehicles; Electric vehicles;*
and
 - ii) the Opponent is put to proof of genuine use of its marks UK00902237568 and UK00908439499 in relation to all goods in respect of which they are registered.

Evidence and submissions

6. Evidence has been filed by the Opponent only. The Applicant has filed written submissions during the evidence round. A hearing was neither requested nor considered necessary. Written submissions in lieu of a hearing have been filed by the Opponent only.

Representation

7. The Opponent is represented by Hogan Lovells International LLP; the Applicant is represented by Trademarkit LLP.

Earlier marks

8. In accordance with section 6 of the Act:
 - the Opponent's unregistered mark, UK00003682100, is an earlier mark because the date from which it claims priority (6 May 2020) fell before the filing date of the applied-for mark (5 February 2021);

- the Opponent's earlier registration, UK00902237568, is an earlier mark because its filing date (30 May 2001) fell before the filing date of the applied-for mark;
and
- the Opponent's earlier registrations, UK00908439499 and UK00917882581, are earlier marks because the dates from which they claim priority (6 February 2009 and 2 October 2017, respectively) fell before the filing date of the applied-for mark.

Preliminary Issue

9. It is noted that the Opponent's earlier application no. UK00003682100, is subject to ongoing opposition proceedings (OP000431560). Should the instant opposition proceedings succeed, and should such success turn on the earlier pending application, then this Decision will stand only to the extent that the pending application achieves registered protection.

PROOF OF USE

Section 6A of the Act – Proof of Use

10. Section 6A of the Act provides that where the registration procedure of the earlier mark was completed more than 5 years prior to the application date of the applied-for mark, the Opponent may be required to prove use of the earlier mark.

11. In the instant case, section 6A is engaged in respect of the earlier marks UK00902237568 and UK00908439499 because registration procedures of both marks were completed more than 5 years prior to the application date of the applied-for mark. The Opponent claims that it has made genuine use of both marks for all of the goods in respect of which they are registered, and the Applicant has requested proof of such. The relevant time period for this purpose is the five years prior to and ending on the application date of the applied-for mark: 6 February 2016 – 5 February 2021. The goods for which the Opponent is required to prove genuine use are *Vehicles parts, namely shock absorbers* (under both UK00902237568 and UK00908439499) and; *bicycle parts, namely, shock absorbers* (under

UK00908439499).

12. The earlier marks to which section 6A of the Act applies are comparable marks. The Tribunal Practice Notice (2/2020) 'End of Transition Period – Impact on proceedings' states the following:

'Comparable marks – use and reputation

4. Where, to the extent set out above, comparable marks are relied on in opposition/invalidation proceedings, there will be circumstances when the use provisions apply, or where a reputation is claimed under section 5(3) of the Act. Comparable marks may also be the subject of revocation claims based on non-use. In such circumstances, it may still be possible to rely on evidence of use in the EU, as set out below:

- where all or part of the relevant five-year period for genuine use under sections 6A, 46(1)(a) or (b), or 47 falls before IP Completion Day, evidence of use of the corresponding EUTM in the EU in that part of the relevant period before IP Completion day will be taken into account in determining whether there has been genuine use of the comparable trade mark. For that part of the relevant period, for the purposes of the genuine use assessment, the UK will be taken to include the EU.'

13. Therefore, for the portion of the relevant five year period between 6 February 2016 and 31 December 2020, evidence of use of the mark in the EU may be taken into account.

Opponent's evidence

14. The Opponent's evidence comes from Senior Patent Engineer of the Opponent company. Mr Kendrick's Witness Statement is dated 10 February 2022. There are 14 Exhibits: PAK1 – PAK14. The evidence comes from a variety of sources and includes: sales revenue and marketing expenditure figures; Wayback prints¹ from

¹ Prints of web pages from the web archiving service 'the Wayback Machine'.

websites of the Opponent and third-party retailers; a selection of sales invoices; excerpts from the Opponent's social media accounts; and a selection of press articles and product reviews. I shall not discuss the evidence in detail but can confirm that I have considered it carefully and will refer to it where appropriate in my Decision.

Decision

15. Genuine use

Section 6A of the Act provides that:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows²: “114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: *Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV* [2003]

² Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to

secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor.

Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

17. The onus is on the Opponent, as the proprietor of the earlier mark, to show use because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³

19. Mr Kendrick states⁴ that the Opponent ‘has made intensive use of the FOX mark across the UK and EU for many years, including during the Relevant Period’ in respect of ‘all types of vehicle parts, including suspension parts of off-roads vehicles and bicycles’. Exhibit PAK4 shows that a new UK distributor, Silverfish, became the UK distributor for the Opponent’s goods from 1 November 2017. The overall figures for the Opponent’s sales and profits have been provided at Exhibit PAK2:⁵ However, the figures relating specifically to UK and EU sales, included at paragraph [33] of Mr Kendrick’s Witness Statement, are more relevant, and are set out as follows:

³ Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, GC.

⁴ Witness Statement of P. A. Kendrick

⁵ Reproduced at paragraph [16] of the Witness Statement of P. A. Kendrick, paragraphs [17] to [20] .

Year	UK Sales (USD)	EU Sales (USD)
2016	In excess of 4 million	In excess of 70 million
2017	In excess of 6 million	In excess of 80 million
2018	In excess of 5 million	In excess of 90 million
2019	In excess of 4 million	In excess of 110 million
2020	In excess of 5 million	In excess of 140 million
2021	In excess of 8 million	N/A




20. Exhibit PAK2 also includes the following figures relating to marketing and research and development expenditure:

(in thousands)	For the fiscal years ended				
	2020	2019	2018	2017	2016
Cost of sales	\$ 625	\$ 802	\$ 482	\$ 429	\$ 139
Sales and marketing	635	506	556	587	598
Research and development	788	721	640	442	357
General and administrative	6,570	4,835	5,644	7,269	5,129
Total	\$ 8,618	\$ 6,864	\$ 7,322	\$ 8,727	\$ 6,223

21. The figures above at [20] show that, for the years 2016 to 2021, significant sums have been generated through sales and demonstrate a steady general increase in turnover from one year to the next. However, I note that there is no breakdown of the figures to indicate the sums referable to the sale of the particular goods in respect of which the Opponent is seeking to demonstrate genuine use of its marks i.e. shock absorbers for vehicles and bicycles. I also note that it is not possible to discern what proportions of expenditure on marketing, research and development are: referable to each of the marks relied upon; or referable to the UK and EU markets.

22. The Opponent's evidence focuses, for the most part, on shock absorbers for bicycles. However, I note that the Opponent has included Wayback prints from the website of Spanish retailer www.em4x4.com, dated 9 August 2020, 22 February 2019 and 27 October 2018. Although the text is in Spanish, it is clear that the listings relate to shock absorbers for off-road/4x4 vehicles. Wayback prints dated 2 December 2018 and 2 November 2018 show, respectively, the Opponent's mark ii) UK00902237568 painted on the bodywork of a large 4x4 vehicle, and on the

website of UK 'off-road' retailer www.greggson-off-road.co.uk in relation to product listings for shock absorbers for motor vehicles. Text included at the bottom of an article from 'Cycling Industry News'⁶ states that the Opponent 'designs and manufactures performance-defining ride dynamics products primarily for bicycles, on-road and off-road vehicles and trucks, side-by-side vehicles, all-terrain vehicles, snowmobiles, specialty vehicles and applications, and motorcycles'. As far as I can discern, these pieces of evidence are the only items which indicate use of the mark UK00902237568 in respect of shock absorbers for vehicles other than bicycles within the relevant territory.

23. The selection of Wayback prints of the Opponent's product listings on its own website (Exhibit PAK3) shows that the Opponent's mark ii) UK00902237568  has featured frequently and prominently for the years 2018, 2019 and 2020 in relation to bicycle shocks. The Wayback print dated 15 January 2018 includes a list of distributors of the Opponent's goods in the following EU states/regions: Austria, the Benelux countries (2 listed), Finland (2 listed), France (2 listed), Germany (3 listed), Greece (2 listed), Hungary, Italy (3 listed), Poland (3 listed), Portugal (4 listed), Romania, Slovakia (2 listed), Bulgaria, Lithuania, Spain (3 listed), Sweden, Croatia, Cyprus, Czech Republic, Denmark (2 listed), Estonia, UK (3 listed). The above-mentioned evidence, together with the figures relating to marketing, and research and development expenditure, along with the selection of articles and reviews published between 7 April 2017 and 22 January 2021 in which the Opponent's mark ii) UK00902237568  regularly appears, demonstrate that the Opponent has made real efforts to market its shock absorbers for bicycles under the mark UK00902237568  in both the EU and the UK. The inclusion of Wayback prints for the Opponent's webpages and articles/reviews for 2016⁷ would have further strengthened the Opponent's evidence.

24. The Opponent has provided a selection of 29 invoices⁸ dated between 22 February 2016 and 8 January 2019. With exception of two invoices to the UK

⁶ Exhibit PAK4.

⁷ Dated from 22 February onwards i.e. the portion of February 2016 included within the relevant period.

⁸ At Exhibits PAK7 and PAK14.

distributor, Silverfish, information on the buyer has been redacted from all remaining invoices. It is therefore not possible to discern the geographical spread of sales within the countries/member states mentioned or whether retailers/buyers have been returning customers. This evidence demonstrates sales of mainly bicycle shocks, including, *inter alia*, suspension forks and seat posts, (and components therefor) to:

- Belgium – 7 invoices amounting to 172 units and a sum of \$20,404.92 US Dollars;
- United Kingdom – 4 invoices: 3 of which relate to the purchase of goods amounting to 52 units and a sum of \$2,916.68 US Dollars; the remaining invoice in respect of the setting up of a trade stand showcasing the Opponent's products at a bike festival 27-28 January 2018 in Whittle Bury Hall, UK in the sum of £13,253;⁹
- Spain – 8 invoices amounting to 1,615 units and a sum of \$282,740 US Dollars;
- Denmark – 4 invoices amounting to 1195 units and a sum of \$19,739.79 US dollars;
- Germany – 5 invoices amounting to 1,819 units and sums of \$132,638 US Dollars and 2,087 Euro¹⁰;
- France – 1 invoice amounting to 498 units and a sum of \$86,649 US Dollars.



25. The Opponent has not provided any invoices dated after 8 January 2019.

In my view, the evidence adduced by the Opponent is not overly impressive; but nor is it without probative value. The material adduced is such that where an individual piece of evidence, taken in isolation, has evidential shortcomings, other pieces of evidence are able to 'fill in the gaps'. For example: although no invoices have been provided for 2020 or 2021, and only a scant number of invoices have been provided for 2017, 2018 and 2019, the UK and EU sales figures, the inclusion of a number of articles and product reviews for those years, together with photographs of a trade stand showcasing the Opponent's shock absorbers for bicycles in 2018 and 2019 at the 'Core Bike trade show' in Northamptonshire,¹¹

⁹ This is the only invoice which expresses the amount in £Sterling.

¹⁰ Four invoices express the amounts in US Dollars, with the remaining invoice expressing the amounts in Euro.

¹¹ Exhibit PAK13.

UK00902237568  has continued to be used in relation to shock absorbers for bicycles. My global assessment has determined that the totality of the evidence presented succeeds in establishing that the Opponent has made genuine use of its mark ii) UK00902237568  in respect of class 12 *shock absorbers*, but only in respect of bicycles. In my view, there is insufficient evidence of use of the mark in respect of shock absorbers for other types of vehicle to support a finding that the Opponent has made genuine use of the mark for the broad term *Vehicles parts, namely shock absorbers*. It is, in my view, not possible to discern from the invoices provided whether any of them relate to the sale of shock absorbers for vehicles other than bicycles. I have noted Mr Kendrick's statement¹² that the Opponent has produced suspension components for 'automobiles, all-terrain vehicles, snowmobiles', and bear in mind the above-mentioned evidence at [22] in relation to vehicles other than bicycles. However, I do not consider this pieces of evidence sufficient to enable me to attribute a certain amount of the sales figures to *Vehicles parts, namely shock absorbers*. There is only scant evidence suggesting that shock absorbers for 4x4 vehicles have at some time been held out for sale. Although the Opponent cannot reasonably be expected to have used its mark in relation to shock absorbers for every conceivable type of vehicle, I find that the totality of the Opponent's evidence falls short of establishing genuine use in relation to shock absorbers beyond those for bicycles.

26. Framing a fair specification

In cases where genuine use has been demonstrated in respect of some goods, but not others, I bear in mind Mr Geoffrey Hobbs Q. C.'s summary of the law as the Appointed person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of

¹² Witness Statement of P. A. Kendrick, paragraphs [10] and [11].

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

27. I must therefore assess the range of goods exemplified by the term *Vehicles parts, namely shock absorbers* from the perspective of the average consumer of those goods. In my view, the average consumer would perceive this term to denote shock absorbers for several types of vehicles rather than just one type e.g. bicycles.

28. I remind myself of the following principles set out by Mr Justice Carr in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47]:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them;
Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”

29. The question that I must consider is whether genuine use of the marks in respect of shock absorbers for bicycles warrants protection for the mark in respect of vehicle shock absorbers at large. My view is that the average consumer would fairly describe the goods for which use has been shown as ‘shock absorbers for bicycles’. Although a bicycle is indeed a vehicle, I consider it unlikely that the average consumer would describe the goods for which genuine use has been shown in such broad terms as ‘shock absorbers for vehicles’.

30. Use of variant marks

The Opponent has submitted¹³ that the ‘Fox Tail’ and ‘Fox Circle’ marks are permitted variant marks and use of the former amounts use of the latter:



31. I bear in mind the decision in *Bernhard Rintisch v Klaus Eder* Case C-553/11 from which it can be derived that a registered trade mark A which differs in form from a

¹³ Opponent’s written submissions in lieu of a hearing, paragraph [15].

registered trade mark B, albeit in a form that does not alter its distinctive character, may constitute use of both trade marks A and B.¹⁴

32. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS

¹⁴ At paragraph [24].

registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

33. In *Hyphen GmbH v EU IPO*, Case T-146/15, the General Court held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.



35. In the light of the foregoing, I find that the Opponent has demonstrated genuine use of its marks UK00902237568 and UK00908439499 in respect of the class 12 term *bicycle parts, namely, shock absorbers*.

36. Opposition under section 5(2)(b) of the Act

Section 5(2)(b) of the Act states:

“5(2) A trade mark shall not be registered if because –

(a) ...

(b) It is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

There exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

37. The following principles are derived from the decisions of the Court of Justice of the European Union (“CJEU”) 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 C120/04; *Shake 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.

Comparison of goods and services

38. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

39. I must therefore be mindful of the fact that the appearance of respective services in the same class is not a sufficient condition for similarity between those services, and neither are they to be found dissimilar simply because some services may fall in a different class.

40. I must also bear in mind the decision of the General Court (‘GC’) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05:

“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 trade mark application (Case T-388/00 Institut für 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”.

41. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to a parties' goods and services must be taken into account:

“[23] “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”.

42. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281¹⁵, identified the following factors for assessing similarity of the respective goods and services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and, in particular, whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

¹⁵ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

43. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.¹⁶

44. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods [or services]. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

45. The Tribunal may group goods (or services) together for the purposes of assessment:

Separode Trade Mark BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

46. The goods to be compared are as follows:

Opponent's (earlier marks):	Applied-for mark:
i) UK00003682100	Class 12: <i>Automobiles; Motorcycles; Electric cars;</i>

¹⁶ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

Class 12:

Vehicles; apparatus for locomotion by land, air or water; suspension systems for vehicles, in particular, suspension systems for bicycles and motor vehicles; vehicle parts, in particular, shock absorbers (including for seats, in particular boat seats), suspension, and suspension parts consisting of lift kits comprising of spacers, linkages, cross members, shock absorbers, and mounting brackets; bicycle parts, in particular, shock absorbers, forks, sprockets, seat posts, handlebars, and wheels.

ii) **UK00902237568**

Class 12:

Vehicles parts, namely shock absorbers

iii) **UK00908439499**

Class 12:

Vehicles parts, namely shock absorbers; bicycle parts, namely, shock absorbers.

iv) **UK00917882581**

Class 12:

Suspension systems for vehicles, suspension systems for bicycles and motor vehicles; Vehicle parts, shock absorbers; bicycle parts, shock

Chassis for electric cars; Chassis for electric buses; Transmission shafts for land vehicles; Driving motors for land vehicles; Transmission gears for land vehicles; Transmission chains for land vehicles; Self-driving cars; Buses; Land vehicles; Electric vehicles; Transmissions for land vehicles; parts and fittings for the aforesaid goods.

Class 35:

Retail services in relation to vehicles; Wholesale services in relation to vehicles; Retail services relating to automobile parts; Retail services relating to automobile accessories; Wholesale services relating to automobile parts; Wholesale services relating to automobile accessories

absorbers; parts and accessories for all the foregoing.

Class 35:

Retail store services and computerized online retail store services featuring vehicle parts, bicycle parts, clothing and fashion accessories, bicycle bags, sports bags, decals, and printed materials.

Class 12

Contested goods: terms '*automobiles; motorcycles; electric cars*' and '*self-driving cars; buses; land vehicles; electric vehicles*'.

47. The Applicant has conceded that its class 12 terms '*automobiles; motorcycles; electric cars*' and '*self-driving cars; buses; land vehicles; electric vehicles*' are identical to the Opponent's *vehicles*. The term *vehicles* is included in the specification for the Opponent's earlier mark i) UK00003682100, only.

48. I now compare the Applicant's goods above against the Opponent's: *Suspension systems for vehicles, suspension systems for bicycles and motor vehicles* under earlier mark iv. UK00917882581. I find the Applicant's goods to have a medium level of similarity with these goods. There will be user overlap to the extent that owners of the Applicant's goods will also purchase parts for those vehicles. Trade channels will overlap; many manufacturers of vehicles also supply their parts. The respective goods are not in competitive relationship; neither is substitutable for the other. I consider the goods to be complementary; the Opponent's goods are necessary for the Applicant's goods and the average consumer may presume that both originate from the same undertaking.

49. I now compare the Applicant's goods above to the Opponent's *bicycle parts, namely shock absorbers* under registrations ii. UK00902237568 and iii UK00908439499. I do not consider the Opponent's goods to have any level of similarity between the Applicant's *automobiles; motorcycles; electric cars; self-driving cars; or buses*. However, I find a medium level of similarity to the extent that the Applicant's terms *land vehicles; and electric vehicles* include bicycles. The specific purposes of the respective goods will differ; the function of the Applicant's goods being to transport the rider or to enable to rider to exercise and/or compete, whereas the Opponent's shock absorbers are designed to lessen the impact when a vehicle's suspension encounters a 'bump'. Users will overlap; owners of the Applicant's goods will purchase replacement shock absorbers. Trade channels will sometimes overlap; a manufacturer of bicycles (which will include electric bicycles) may also supply their parts. The goods are not in a competitive relationship; neither is substitutable for the other. The goods will differ in terms of physical nature; a bicycle is a 'complete' product in that it is ready to use whereas shock absorbers are components that need to be installed on a bicycle in order to function. In my view, there is complementarity between the goods; shock absorbers are indispensable or at least important to many bicycles and the average consumer may presume both sets of goods to originate from the same undertaking.

Contested goods: *Chassis for electric cars; Chassis for electric buses*.

50. A chassis is the backbone of the vehicle which bears the load and is the framework upon which other components (including engine, transmission system, brakes, axles) are mounted. I first compare these goods against the Opponent's class 12 term *vehicle parts, in particular, shock absorbers (including for seats, in particular boat seats), suspension, and suspension parts consisting of lift kits comprising of spacers, linkages, cross members, shock absorbers, and mounting brackets* under the earlier mark i) UK00003682100. Both sets of goods share the broad purpose of being component parts of vehicles. Their specific purposes will, however, differ; the function of suspension parts and shock absorbers being to keep the vehicle's tyres on the ground and lessen the impact when the vehicle encounters a 'bump'. Users will overlap; repair garages buying in parts will be purchasers of both sets of goods, with the ultimate end-user of both being the owner/user of the vehicle for which they are intended. Trade channels will be shared. The goods will differ vastly

in nature in terms of size, appearance and function. There is no competition between the goods because they are not substitutable. In my view, the goods are complementary. Many of the Opponent's goods will be mounted on to the Applicant's chassis in order to make the vehicle operate (e.g. a suspension fork will be fixed to the bicycle chassis/frame) and the average consumer would presume both sets of goods to derive from the same undertaking. Consequently, I find the respective goods to have a low level of similarity. I also find the Applicant's goods to have a medium level of similarity with the Opponent's *Suspension systems for vehicles, suspension systems for bicycles and motor vehicles* under its earlier registration UK00917882581, for the reasons above.

51. I do not consider the Applicant's goods above to have any degree of similarity to the Opponent's: *bicycle parts, namely, shock absorbers* under earlier marks ii) UK00902237568 and iii) UK00908439499. However, I find the Applicant's goods to have a medium level of similarity with the Opponent's class 35 services '*Retail store services and computerized online retail store services featuring vehicle parts, bicycle parts [...]'* under its earlier mark iv) UK00917882581. There will be user and trade channel overlap. The respective goods and services will be complementary; the goods are necessary in order to deliver the retail services in respect of those goods, and the average consumer may presume both to originate from the same undertaking.

Contested goods: *Transmission shafts for land vehicles; Transmission gears for land vehicles; Transmission chains for land vehicles; Transmissions for land vehicles.*

52. I first compare these goods against the Opponent's class 12 *Vehicles* under its earlier mark i) UK00003682100. The Applicant's goods concern the gears/gearbox in a vehicle the function of which is to enable the engine power (or pedal power) to be adjusted in relation to speed. The Opponent's *vehicles* are 'complete' goods (as opposed to components) whose purpose is to transport persons, goods or animals, or to enable drivers to enjoy competitive or recreational driving/riding. The specific purposes of the respective goods are therefore different. Users will overlap; owners of the Opponent's goods will purchase replacement parts falling under the

Applicant's terms. Trade channels will sometimes overlap; a manufacturer of vehicles may also supply their parts. The goods are not in a competitive relationship; neither is substitutable for the other. The goods will differ in terms of physical nature; a vehicle is a 'complete' product in that it is ready to use whereas the Applicant's goods will need to be installed in the vehicle. In my view, there is complementarity between the goods; transmission components are indispensable to many vehicles and the average consumer may presume both sets of goods to originate from the same undertaking. I find these goods to have a medium level of similarity.

53. I now compare the Applicant's goods above against the term: *bicycle parts, namely shock absorbers* under the Opponent's two earlier marks ii) UK00902237568 and ii) UK00908439499. The respective sets of goods overlap to the broad extent that the terms cover/include component parts for bicycles. However, the specific purposes of the goods will differ because the respective components deal with different aspects of the vehicle in question; the Applicant's goods allow the user to adjust power in relation to speed, whereas the Opponent's goods lessen the impact upon encountering 'bumps'. Users and trade channels will overlap. Given their different roles within the vehicle, the goods are not in competition. I do not find complementarity, either; although the average consumer may presume both sets of goods to originate from the same undertaking, neither shock absorbers nor gears are necessary or important for the other.¹⁷ I find the respective goods to be similar to a low - medium level.

54. I now compare the Applicant's goods against the Opponent's *Vehicle parts, shock absorbers* under registration iv) UK00917882581. Both parties' terms cover goods for vehicles, which will encompass motor vehicles e.g. cars, vans, motorbikes etc. The respective goods overlap in purpose to the broad extent that both cover components for motor vehicles. The different roles of the respective sets of component parts have already been noted at [53]. Users and trade channels will overlap. Given their different roles within the vehicle, the goods are not in competition. I find the goods to be complementary; the goods will be important for

¹⁷ Not all bicycles have shock absorbers and not all bicycles have gears.

one another to the extent that a car could not function effectively if either a gearbox or system of shock absorption were missing from it, and the average consumer may presume that both sets of goods originate from the same undertaking. I therefore find the respective goods to have a medium level of similarity.

55. In addition, I find the Applicant's goods to have a medium level of similarity with the Opponent's class 35 services '*Retail store services and computerized online retail store services featuring vehicle parts, bicycle parts [...]'* under its earlier mark iv) UK00917882581. There will be user and trade channel overlap. The respective goods and services will be complementary; the goods are necessary in order to deliver the retail services in respect of those goods, and the average consumer may presume both to originate from the same undertaking.

Contested goods: *Driving motors for land vehicles*

56. I compare the Applicant's goods above against the Opponent's *Vehicles* under the earlier mark i) UK00003682100. I find the respective goods to have a medium level of similarity. Although the specific purposes of the respective goods will differ, users and trade channels will overlap. The goods are not in competition; neither is substitutable for the other. The goods will differ in terms of physical nature; a vehicle is a 'complete' product in that it is ready to use whereas the Applicant's goods will need to be installed in the vehicle. In my view, there is complementarity between the goods; *driving motors* are necessary for the Opponent's vehicles to operate and the average consumer may presume both sets of goods to derive from the same undertaking. I do not find the Applicant's goods to have any level of similarity with the Opponent's *bicycle parts, namely shock absorbers* under earlier registrations UK00902237568 and UK00908439499. I find the Applicant's goods to have a medium level of similarity with *Suspension systems for vehicles, suspension systems for bicycles and motor vehicles* under earlier mark vi) UK00917882581. Users and trade channels will overlap. Although the specific purposes of the goods differ, both comprise components of vehicles. I do not find the respective goods to be competitive. However, both motors and suspension systems are necessary for many vehicles to operate, and the average consumer may presume both to derive from the same undertaking. In addition, I find the

Applicant's goods to have a medium level of similarity with the Opponent's class 35 services '*Retail store services and computerized online retail store services featuring vehicle parts [...]*' under its earlier mark iv) UK00917882581. There will be user and trade channel overlap. The respective goods and services will be complementary; the goods are necessary in order to deliver the retail services in respect of those goods, and the average consumer may presume both to originate from the same undertaking.

Contested goods: *parts and fittings for the aforesaid goods*

57. The Applicant's term *parts and fittings for the aforesaid goods* will include parts and fittings for *Automobiles; Motorcycles; Electric cars; land vehicles; electric vehicles*, because these latter terms precede the broader term in the specification. The Applicant's broad term *parts and fittings for the aforesaid goods* will therefore encompass: the Opponent's term *vehicle parts, in particular, shock absorbers (including for seats, in particular boat seats), suspension, and suspension parts consisting of lift kits comprising of spacers, linkages, cross members, shock absorbers, and mounting brackets* under its earlier mark i) UK00003682100; as well as *bicycle parts, namely shock absorbers* under the two earlier marks ii) UK00902237568 and iii) UK00908439499; and *Vehicle parts, shock absorbers* under earlier mark iv) UK00917882581. These respective sets of goods are therefore 'Meric' identical.

Class 35

Contested services: *Retail services relating to automobile parts; Retail services relating to automobile accessories*

58. I find that the Applicant's term *Retail services relating to automobile parts*; will encompass the Opponent's class 35 term *Retail store services and computerized online retail store services featuring vehicle parts [...]* under its earlier mark iv) UK00917882581. These services are therefore 'Meric' identical.

59. I consider the Applicant's term, *Retail services relating to automobile accessories*, to be similar to the Opponent's services to a medium degree. The specific purposes of the respective services are very similar i.e. both involve retail of automobile-related goods. Users will coincide. Trade channels will be shared; automobile accessories are often sold alongside automobile parts in the same outlets. It is nevertheless acknowledged that many retailers offering automobile accessories (e.g. ice scrapers, car wax, tyre pumps, petrol cans) such as supermarkets and other shops do *not* also sell automobile parts. I do not find the services to be complementary because neither retail service is essential or important for the other retail service. In addition, I find the Applicant's *Retail services relating to automobile accessories* to have a medium degree of similarity with the Opponent's class 12 term *parts and accessories for all the foregoing*¹⁸ under its earlier registration iv) UK00917882581. Users and trade channels will overlap. The respective goods and services will be complementary; the goods are necessary in order to deliver the retail services in respect of those goods, and the average consumer may presume both to originate from the same undertaking.

60. I now compare the Applicant's services above against the Opponent's *vehicle parts, in particular, shock absorbers (including for seats, in particular boat seats), suspension, and suspension parts consisting of lift kits comprising of spacers, linkages, cross members, shock absorbers, and mounting brackets*, under earlier mark i) UK00003682100. I find that the Applicant's *Retail services relating to automobile parts* will have a medium level of similarity with these goods. There will be user and trade channel overlap. The respective goods and services will be complementary; the goods are necessary in order to deliver the retail services in respect of those goods, and the average consumer may presume both to originate from the same undertaking. I do not find any level of similarity between the Applicant's services and the Opponent's shock absorbers for bicycles under its earlier marks ii) UK00902237568 and iii) UK00908439499.

¹⁸ The 'all the foregoing' element of the term will encompass accessories for shock absorbers and suspension systems for vehicles and motor vehicles

Contested services: *Retail services in relation to vehicles*

61. I find the Applicant's services above to be similar to the Opponent's class 12 *vehicles* under earlier mark i) UK00003682100 to a medium degree. Trade channels and users will overlap. The respective goods and services will be complementary; *vehicles* are necessary in order to deliver the retail services in respect of those goods, and the average consumer may presume both to originate from the same undertaking. I do not find the Applicant's services to have any level of similarity with the Opponent's *bicycle parts, namely shock absorbers* under the earlier marks ii) UK00902237568 and iii) UK00908439499.

62. I now compare the Applicant's services to the Opponent's *Retail store services and computerized online retail store services featuring vehicle parts [...]* under its earlier mark iv) UK00917882581. The services share purposes to the broad extent that both comprise retail services connected to vehicles, albeit the Applicant's services concern retail of complete vehicles as opposed to parts therefor. Users will overlap; users of retail services for vehicles may also be users of retailers of parts for vehicles. Trade channels may overlap to the extent that a retailer of vehicles may also sell parts for those vehicles. There is no competition between the services. I do not find the respective services to be complementary; although the average consumer may presume both sets of services to be offered by the same undertaking, neither retail service is necessary or important for the other. I therefore find only a low level of similarity between the respective services.

Contested services: *Wholesale services in relation to vehicles*

63. I now compare the Applicant's services above against the Opponent's *vehicles* under the earlier mark i) UK00003682100. Users will necessarily overlap; retailers will engage the services of the vehicle wholesaler while purchasing the vehicles offered for sale. Trade channels will therefore also overlap. The respective services and goods will be complementary; the goods are necessary in order to deliver the wholesale services in respect of those goods, and the average consumer, i.e. retailers, may presume both to originate from the same undertaking. I therefore

find the Applicant's services to be similar to the Opponent's *vehicles* to a medium degree.

64. I do not consider there to be any similarity between the Applicant's services and the goods under the Opponent's earlier marks ii) UK00902237568 and iii) UK00908439499.

65. I find the Applicant's services to have a low level of similarity with the Opponent's class 35 *Retail store services and computerized online retail store services featuring vehicle parts [...]* under mark iv) UK00917882581. The respective sets of services have similar purposes to the broad extent that both bring together collections of goods for sale, however the Applicant's services are wholesale, i.e. goods sold in bulk to retailers who then sell them on to consumers (i.e. the 'ultimate' purchasers), whereas retail services offer goods to consumers. I do not consider wholesale services to be in competition with retail services; the difference in wholesale and retail pricing is too vast for either to be a realistic substitute for the other. I do not find complementarity, either; neither wholesale services related to vehicles nor the Opponent's retail services relating to vehicle parts are important or necessary for each other.

Contested services: *Wholesale services relating to automobile parts*

66. I now compare the Applicant's services above against the Opponent's *vehicle parts, in particular, shock absorbers (including for seats, in particular boat seats), suspension, and suspension parts consisting of lift kits comprising of spacers, linkages, cross members, shock absorbers, and mounting brackets* under its earlier mark i) UK00003682100. For the reasons provided above at [63] I find the respective goods and services to have a medium level of similarity.

67. I do not consider there to be any similarity between the Applicant's services and the goods under the Opponent's earlier marks ii) UK00902237568 and iii) UK00908439499.

68. I find the Applicant's services to have a medium degree of similarity with the Opponent's class 35 *Retail store services and computerized online retail store services featuring vehicle parts [...]* under mark iv) UK00917882581. The services will coincide in nature, purpose and methods of use. Users may also overlap in some instances e.g. a mechanic may choose to buy some goods from a retailer and others from a wholesaler, depending on the quantity of goods required.

Contested services: *Wholesale services relating to automobile accessories*

69. I now compare the Applicant's services above against the Opponent's class 12 term *parts and accessories for all the foregoing*¹⁹ under its earlier registration iv) UK00917882581. Users and trade channels will overlap. The respective goods and services will be complementary; the goods are necessary in order to deliver the wholesale services in respect of those goods, and the average consumer may presume both to originate from the same undertaking. I therefore find a medium level of similarity. I do not find the Applicant's services to have any level of similarity between the goods under the Opponent's earlier mark i) UK00003682100 or registrations ii) UK00902237568 and iii) UK00908439499.

Average consumer and the purchasing act

70. In *Hearst Holdings Inc*²⁰ Birss J. (as he then was) described the average consumer thus:

"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 word

¹⁹ The 'all the foregoing' element of the term will encompass accessories for shock absorbers and suspension systems for vehicles and motor vehicles.

²⁰ *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).

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

71. Class 12 goods

In my view, the average consumer of goods covered by the terms *Vehicles; Automobiles; Motorcycles; Electric cars; Self-driving cars; Land vehicles* and *Electric vehicles* will comprise both the general and professional public. Vehicles such as cars and motorcycles will, in my view, be purchased predominantly by the general public, with a smaller number of purchases made by professionals. To my mind, vehicles such as vans and pickup trucks, both of which will be encompassed by the broad terms *Vehicles; Automobiles; Land vehicles* and *Electric vehicles* are more likely to be purchased by professionals. *Buses* will almost always be purchased by professionals e.g. bus companies. These goods are expensive and infrequent purchases. The purchasing act will be primarily visual to the extent that the prospective purchaser will likely first encounter the goods in a showroom or as a listing online. The average consumer would almost always take the vehicle for a test drive before concluding a purchase. There will also be an aural aspect to the purchasing process by way of discussion with sales staff. I find that the average consumer would pay a high level of attention during the purchasing act.


72. The remainder of the class 12 goods pertinent to this opposition comprises, broadly speaking, parts and fittings for vehicles. The average consumer of these goods will include both the general and professional public. Although the owners of the particular vehicles for which the parts are required will be the end users, in many cases, particularly where cars and the like are concerned, the selection of the parts is typically made by a professional at the repair garage. It is appreciated, however, that for goods like bicycle shocks, the purchasing act will often be carried out by members of the general public e.g. mountain biking enthusiasts. I consider the purchasing act to be primarily visual; the purchaser having first encountered the products online, in physical shops, catalogues, or magazines in the field of automobiles and bicycles. Purchases of these goods are likely to be carefully considered. Factors influencing the purchase will likely include, *inter alia*: compatibility of the part with the vehicle; durability; and, particularly in the case of shock absorbers for bicycles, how the part might enhance the performance of the

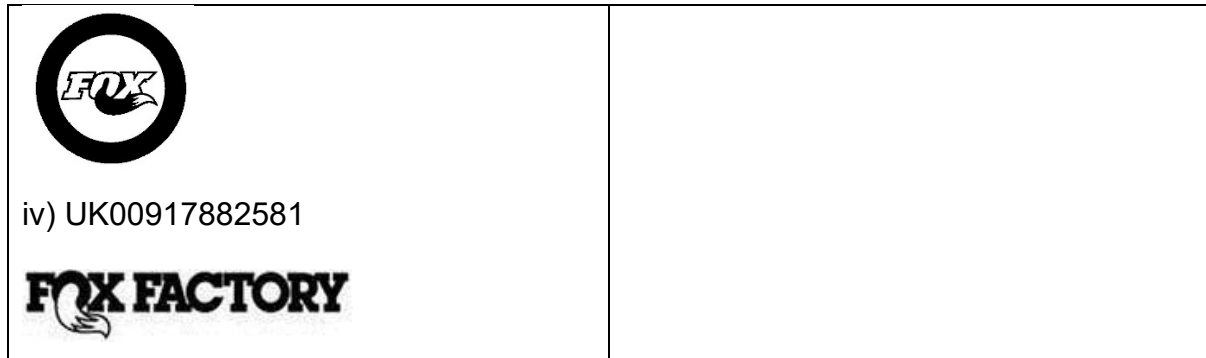
bicycle. I find that the average consumer will pay a level of attention in the medium - high range when purchasing these goods; the general public paying a medium-high level of attention.

73. Class 35 services

The relevant class 35 services comprise, broadly speaking, retail and wholesale services in relation to vehicles, and their parts and accessories. The average consumer of the retail services will be predominantly members of the public, but will also include members of the professional public. The average consumer of the wholesale services will almost always be professionals i.e. retailers of the goods concerned. I consider the purchasing act to be primarily visual in all cases. Purchaser will have likely encountered the retailer/wholesaler online, in catalogues, trade publications or in physical shops. To my mind, although the average consumer will pay a high level of attention when purchasing the particular goods to which the retail/wholesale service relate, the level of attention paid when deciding to which retail/wholesale service provider to direct one's custom will be no more than medium. Factors influencing which service-provider to choose will include, *inter alia*: the range of goods stocked; whether sufficient units are stocked for the purchaser's needs (e.g. in the case of retailers placing bulk orders with wholesalers).

Comparison of the marks

<p>Opponent's (earlier) marks</p> <p>i) UK00003682100 FOX</p> <p>ii) UK00902237568 </p> <p>iii) UK00908439499</p>	<p>Applicant's (contested) mark:</p> <p>F O X T R O N</p>
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74. 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.”

75. 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.

76. I will consider each of the Opponent’s earlier marks in turn.

i) UK00003682100

77. The Opponent's mark is a word mark²¹ consisting of the single element 'FOX' rendered in a plain sans serif font, all characters in upper case. The overall impression of the mark resides in the mark in its entirety.

78. The Applicant's mark comprises one word 'FOXTRON' rendered in a stylised font, all characters in upper case. The letters are widely spaced and appear slightly horizontally elongated as if 'flattened'; the letters 'o' appearing almost rectangular but with curved corners. The overall impression of the mark resides in the mark in its entirety.

79. The Opponent has submitted²² that the Applied-for mark is 'similar to a high degree' to the Opponent's mark. The Applicant argues²³ that the respective marks are visually dissimilar.

80. Visual comparison

The respective marks share the letters 'FOX'. Whilst the Applicant's mark is rendered in a slightly stylised font, as described above at [78], the Opponent's word mark may be used in a range of fonts. Therefore, the only real point of visual difference is the presence of the letters 'TRON' in the Applicant's mark, absent from the Opponent's mark. In my view, this amounts to a marked difference; the Applicant's mark is more than twice the length of the Opponent's mark and will be noticed by the average consumer. I therefore find that the marks are visually similar to a low to medium degree.

81. Aural comparison

²¹ In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

'[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).'

²² Opponent's written submissions in lieu of a hearing, paragraph [35].

²³ Counterstatement, paragraphs [14] – [15].

The Opponent has submitted²⁴ that the respective marks are aurally similar to a high degree. The Applicant has argued²⁵ that ‘the relevant consumer will note the aural differences between the marks and come to the conclusion that they can be adequately aurally distinguished’.

82. The Opponent’s mark will be articulated as ‘FOX’; the Applicant’s mark will be articulated as ‘FOX-TRON’. The first syllable of the Applicant’s mark is aurally identical to the Opponent’s mark. However, given that both are short marks, the difference of one syllable, making the Applicant’s mark twice as long as the Opponent’s mark, will be readily perceived by the average consumer. I find the marks to be aurally similar to no more than a medium degree.

83. Conceptual comparison

The Opponent had submitted²⁶ that the marks are conceptually identical ‘in that they all relate to the fox animal’, arguing that the ‘tron’ element ‘denotes a subatomic particle’ or that the word FOXTRON ‘could also be taken to be the robotic form of a fox’. The Applicant has argued²⁷ that ‘The Applicants [sic] mark has no meaning in the English language because it is not a recognised English word’ and that the marks are conceptually different.

84. The word ‘fox’ is a word in the English language with which the average consumer will be very familiar. It will be understood as denoting the wild canine animal with a reddish coat and bushy tail. I note that the word ‘tron’ appears in the English dictionary²⁸ and denotes ‘a public weighing machine’ or ‘the place where a tron is set up’. In my view, the average consumer will not be familiar with this dictionary meaning of ‘tron’. I consider that the average consumer would perceive the word ‘FOXTRON’ as an invented word. In my view, the respective marks are conceptually dissimilar.

²⁴ Opponent’s written submissions in lieu of a hearing, paragraph [36].

²⁵ Counterstatement, paragraph [16].

²⁶ Opponent’s written submissions in lieu of a hearing, paragraph [37].

²⁷ Counterstatement, paragraph [17].

²⁸ [Tron definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/english-english/dictionary/tron), accessed 21 July 2022 at 18:58.

85. ii) UK00902237568

I now consider the Opponent's earlier mark ii) UK00902237568.

The Opponent's mark comprises the word 'FOX' rendered in a heavily emboldened Times New Roman font, with a white infill, with an 'interplaying' device comprising a fox tail emerging from the aperture of the letter 'O'. The overall impression resides in the mark in its entirety.

86. Visual comparison

As with the above earlier mark, both marks include the word element 'FOX'. Points of difference are:

- the presence of 'TRON' in the Applicant's mark, absent from the Opponent's mark; and
- the presence of the fox tail device in the Opponent's mark, absent from the Applicant's mark.

I find the respective marks to be visually similar to a low degree.

87. Aural comparison

My finding on aural similarity at [81] also applies here. The respective marks are aurally similar to no more than a medium degree.

88. Conceptual comparison

My conceptual analysis of the Opponent's earlier mark i) UK00003682100 applies here also. I will add that the fox tail device simply reinforces the concept of the word 'fox' denoting the wild canine mammal with the reddish coat. I find the respective parties' marks to be conceptually dissimilar.

89. iii) UK00908439499

The Opponent's mark is identical to its earlier registration ii) UK00902237568, save that it has a thick black circular surround. The overall impression resides in the mark in its entirety.

90. Visual comparison

As with the above earlier marks, both marks include the word element 'FOX'. Points of difference are:

- the presence of 'TRON' in the Applicant's mark, absent from the Opponent's mark; and
- the presence of the fox tail device in the Opponent's mark, absent from the Applicant's mark; and
- the presence of the thick black circular surround in the Opponent's marks, absent from the Applicant's mark.

I find the respective marks to be visually similar to a low degree.

91. Aural comparison

My finding on aural similarity at [81] also applies here. The respective marks are aurally similar to no more than a medium degree.

92. Conceptual comparison

My conceptual analysis above at [83] also applies here. I find the respective parties' marks to be conceptually dissimilar.

93. iv) UK00908439499

The Opponent's mark comprises both text and a fox tail device. The two word elements 'FOX' and 'FACTORY' are rendered in heavily emboldened Times New Roman font in solid black. The device consists of a fox tail emerging from the aperture of the 'O' in a similar fashion to that of the earlier marks ii) UK00902237568, albeit the tail is curved at a slightly different angle. The overall impression resides in the mark in its entirety, with the 'FOX' element, with the interplaying fox tail device, having the visual edge due to being more distinctive than the 'FACTORY' element of the mark.

94. Visual comparison

As with the above earlier marks, both marks include the word element 'FOX'. Points of difference are:

- the presence of 'TRON' in the Applicant's mark, absent from the Opponent's mark;

- the presence of the fox tail device in the Opponent's mark, absent from the Applicant's mark; and
- the presence of the 'FACTORY' element in the Opponent's marks, absent from the Applicant's mark.

I find the respective marks to be visually similar to a low degree.

95. Aural comparison

The Opponent's mark will be articulated as 'FOX FACT-UR-EE', with the emphasis on the first syllable. The aural difference resides at the ends of the respective marks: TRON/FACT-UR-EE. The difference in the lengths of the marks will be discerned aurally by the average consumer. I find that the respective parties' marks will be aurally similar to a low-medium degree.

96. Conceptual comparison

The 'FOX' element will be understood in the way already set out in respect of the three earlier marks. The word 'FACTORY' will be understood by the average consumer as a premises within which goods are manufactured. Although the literal interpretation of 'FOX FACTORY' is of a factory that produces foxes, the average consumer would, in my view, perceive the mark as a manufacturer of goods with a brand name 'FOX'. I find the respective marks to be conceptually dissimilar.

Distinctive character of the earlier marks

97. *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).

98. The Opponent has submitted²⁹ that each of its earlier marks has a high level of inherent distinctive character and that, furthermore, they have enhanced distinctive character through use.

99. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

100. I first consider earlier marks i), ii) and iii). 'FOX' is a dictionary word with which the average consumer in the UK will be very familiar. It will be perceived by the average consumer as a reference to the wild canine mammal with a reddish coat and bushy tail. 'FOX' neither describes nor alludes to the goods and services under the marks. I find that the earlier mark i) has a medium level of inherent distinctive character. I note the stylisation of the fox tail protruding from the center of the 'o' in marks ii) and iii) and it is my view this raises the inherent distinctiveness of these marks to a slightly above medium level.

²⁹ Opponent's written submissions in lieu of a hearing, paragraphs [44] – [45].

101. I now turn to the earlier mark iv) 'FOX FACTORY'. 'Factory' is also a dictionary word with which the average consumer in the UK will be very familiar. The mark is neither descriptive of, nor does it allude to, the goods and services in respect of which it is registered. I find this mark to have a medium level of inherent distinctive character.

102. Enhanced distinctive character

Regarding the earlier marks i) UK00003682100 and iv) UK00917882581, the Opponent has not adduced any evidence from which the Tribunal may make a finding as to whether or not these earlier marks enjoy an enhanced level of inherent distinctive character.

103. I now consider marks ii) UK00902237568 and iii) UK00908439499. In my view, the totality of evidence available does not succeed in demonstrating that these earlier marks have an enhanced level of inherent distinctive character. The Opponent has not included, in its evidence of use, material to demonstrate the market share held by the mark or the geographical spread of sales. Whilst not prerequisites to establishing enhanced distinctiveness, sales of between 4 – 8 million USD per annum in the UK do not strike me as being overly significant in what must be a large market. Although information on expenditure on marketing and research and development has been provided, it is not possible to discern what proportions of the sums provided are referable to: goods and services under these two marks; or to the UK market. I find that the body of evidence before me is not sufficient to find that the level of distinctiveness of the mark can be raised above the finding that I have made for the mark's inherent distinctive character, that of a slightly above medium degree.

Likelihood of confusion

104. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v Back Beat*

*Inc*³⁰. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*³¹, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

105. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [37]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

106. In my view, considering all of the factors, despite the identity and levels of similarity found between the parties’ goods and services, the net effect of the visual, aural and conceptual differences is sufficient to overcome the similarities that I have identified. This is the case in relation to all of the earlier marks. Notwithstanding the principle of imperfect recollection, the average consumer will, in my view, notice that the Applicant’s mark is twice as long as the Opponent’s marks (in the case of earlier marks i) – iii)) and that the ‘FOX’ element, common to both parties’ marks, is incorporated into the one word element ‘FOXTRON’. In the case of earlier marks ii) to iv), the fox tail device will also be noticed by the average consumer. In the case of earlier mark iv) FOX FACTORY, the differences between the respective parties’ marks will be even more marked by virtue of the Opponent’s mark comprising two separate elements, aside from the fox tail device. I find that there is no likelihood of direct confusion.

³⁰ Case BL O/375/10 at [16].

³¹ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

107. I now consider whether there is a likelihood of indirect confusion. I note that in the recent case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

108. I have borne in mind *Whyte and Mackay*³² in which it was held that where an average consumer perceives that a composite mark consists of two or more elements, one of which has a distinctive significance independent of the mark as a whole, confusion may occur as a result of the similarity/identity of that element to the earlier mark. In my view, the ‘FOX’ element common to the respective parties’ marks does not result in the Applicant’s mark conveying the same concept that is conveyed by ‘FOX’ in each of the Opponent’s earlier marks. The ‘FOX’ element in the Applicant’s mark is part of one word ‘FOXTRON’ rather than being a standalone element and the average consumer will perceive ‘FOXTRON’ as an invented word. I can see no reason why the average consumer would presume that the same or economically linked undertaking is responsible for the relevant goods. The instant case does not fall within any of the categories identified in *L.A. Sugar Limited v By Back Beat Inc*³³ Mr Iain Purvis Q. C., as the Appointed Person, explained that [my words in parentheses]:

17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] 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

³² *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271.

³³ Case BL O/375/10

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)".

109. Whilst the categories set out above were not intended to be exhaustive, I can see no other mental process by which the average consumer would arrive at a conclusion indicative of indirect confusion.

Conclusion

110. The Opposition fails. Subject to any successful appeal against this Decision, the application may proceed to registration.

COSTS

111. I award the Applicant the sum of **£500** as a contribution towards its costs, calculated as follows³⁴:

Consideration of the Opposition and preparation of Defence and Counterstatement	£300
Preparation of written submissions	£200
Total:	£500

³⁴ Based upon the scale published in Tribunal Practice Notice 2/2016.

112. I therefore order Fox Factory, Inc. to pay to Foxtron Vehicle Technologies Co., Ltd the sum of £500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of August 2022

**Mx N. R. Morris
For the Registrar,
the Comptroller-General**