

O-187-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3050058 BY
WINRUN TYRE CO., LTD**

TO REGISTER:



**AS A TRADE MARK
IN CLASS 12**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 402622 BY
RENAULT S.A.S.**

BACKGROUND & PLEADINGS

1. On 4 April 2014, Winrun Tyre Co., Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods shown below in class 12:

Tyres for vehicle wheels; inner tubes for pneumatic tires [tyres]; automobile tires [tyres]; spikes for tires [tyres]; vehicle wheel tires [tyres]; repair outfits for inner tubes; motor cars; mopeds; two-wheeled trolleys; non-skid devices for vehicle tires [tyres].

The application was published for opposition purposes on 9 May 2014.

2. The application is opposed by Renault s.a.s. (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against the following goods in the application:

Motor cars.

The opponent relies upon all the goods shown below in the following Community Trade Mark registration (“CTM”). CTM no. 11425287 for the trade mark: **TWIN'RUN** applied for on 14 December 2012 and for which the registration procedure was completed on 25 April 2013:

Class 12 - Vehicles; Apparatus for locomotion by land, in particular automobiles, cycles, bicycles, motor scooters, motorcycles, tricycles, spare parts and accessories for all the aforesaid goods.

3. The applicant filed a counterstatement in which the basis of the opposition is denied. It states:

“The applicant’s mark WINRUN in design is not similar or identical with the opponent’s mark in appearance meaning or phoneme...”

4. Neither party filed evidence. Whilst neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing. I will keep these written submissions in mind and refer to them, as necessary, below.

DECISION

5. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

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

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

An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

6. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As the CTM upon which the opponent relies had not been registered for five years or more before the date the application was published for opposition purposes, it is not subject to proof of use as per section 6A of the Act. The consequence of which, is that the opponent is entitled to rely upon all the goods for which its earlier trade mark is registered.

Section 5(2)(b) – case law

7. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

8. The opponent's specification includes "automobiles" (which is an alternative way of describing motor cars). As a consequence, the competing goods are identical.

The average consumer and the nature of the purchasing process

9. As the case law above indicates, it is necessary for me to determine who the average consumer is for motor cars. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

10. The average consumer for motor cars is the general public. My own experience tells me that when selecting a motor car, a wide range of factors will come into play including: price, size of the motor car, engine capacity, fuel efficiency, safety features, standard/optional features, colour, warranty, cost of servicing/repair etc. Once again, in my experience, the selection process is likely to typically involve considering brochures and reviews (in both hard copy and on-line), inspecting a range of motor cars both on line and at retailer’s premises and, in most cases, test driving a number of motors cars before making a final selection. In view of the above, visual considerations will dominate the selection process. Although aural considerations may feature to some extent in the selection process (perhaps in the form of radio advertisements or personal recommendations), the selection of a motor car on this basis alone is, in my experience, likely to be a very rare occurrence indeed. Given the type of considerations I have outlined above, the average consumer will, in my experience, pay a very high degree of attention to the selection of a motor car.

Comparison of trade marks

11. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

12. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks. The competing trade marks are as follows:

opponent’s trade mark	applicant’s trade mark
TWIN’RUN	

13. The opponent’s trade mark consists of the well known English language words TWIN and RUN presented in upper case separated by an apostrophe symbol. Both

elements make a roughly equal contribution to the overall impression the trade mark conveys, the distinctiveness of which lies in the totality it creates, rather than in its individual elements.

14. The applicant's trade mark consists of a number of elements i.e. a device of a chequered flag, the letters W-I-N-R-U-N and a number of horizontal lines which begin on the letter R, extend across and beyond the letters UN, and which are, in my view, intended to give the impression of speed. Although all of the letters are presented in upper case in the same font (in which the top of each letter is slightly darker than the bottom), the letter W is somewhat larger than the other letters which accompany it. The overall impression the trade mark creates will, given its relative size, be dominated by what, in my view, will be construed as the distinctive word WINRUN (i.e. a combination of the well known English language words WIN and RUN). However, as the distinctive device of a chequered flag which appears at the beginning of the trade mark is far from negligible, it too will contribute to the overall impression, albeit to a lesser extent. As to the shading of the individual letters and the horizontal lines, these are negligible and are likely to go largely unnoticed.

15. Insofar as the similarity between the competing trade marks is concerned, in its submissions the opponent states:

“4. It is submitted that the marks are closely visually similar owing to the fact that the marks share six identical letters in the same order. The marks are visually similar overall owing to the fact that the only difference is one minor element at the front of the marks; this difference is outweighed by the six following identical letters.

5. The marks are aurally extremely similar. As stated above, the marks share six identical letters. The marks are made up of two syllables which will basically be pronounced in an almost identical way. The earlier mark of the opponent includes an initial letter T that is not present within the mark of the applicant. However, the initial letter T is lost in pronunciation as when the prefix TW is pronounced emphasis falls upon the W. Consequently, when spoken, the marks are almost identical.

6. It is submitted that neither sign has an established meaning. However, the marks are likely to be confused from a conceptual point of view because they both include the English dictionary words “win” and “run” combined in the same order and taking on the same structure. The illusion to being successful and moving at speed is present within both marks.”

16. It is true that the competing trade marks contain the same six letters presented in the same order. However, the presentation of the opponent's trade mark as two well known words, whereas the applicant's trade mark will be construed as the combination of two different well known words, combined with the presence in the applicant's trade mark of the chequered flag device, results, in my view, in only a medium degree of visual similarity between them. As to the degree of aural similarity, it is well established that when a trade mark consists of a mixture of words and figurative elements it is most likely to be referred to by the word elements. The pronunciation of the competing trade marks, consisting as they do of two single

syllable words, is, given the well known meaning of those words, entirely predictable i.e. TWIN-RUN and WIN-RUN respectively. There is a high degree of aural similarity between them.

17. Finally, in relation to conceptual similarity, I agree with the opponent that neither trade mark has an established meaning. Whilst the word RUN may send the same conceptual message in relation to the goods at issue, and while I am prepared to accept that the presence of the word WIN as part of the word WINRUN combined with the presence of the chequered flag device in the applicant's trade mark may evoke an allusion to success, the presence of the letters WIN as part of the word TWIN in the opponent's trade mark (which has its own well known and different meaning) will create no such concept. Considered overall, as the totality of the competing trade marks will not create any concrete conceptual picture in the mind of the average consumer, the conceptual position is, in my view, neutral.

Distinctive character of the opponent's earlier trade mark

18. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As the opponent has not filed any evidence, I have only the inherent characteristics of its trade mark to consider. In its submissions the opponent states:

“8...The distinctiveness of the earlier mark must also be considered. The trade mark TWIN'RUN is highly distinctive in connection with the goods for which the opponent has achieved registration...”

19. In relation to the goods I identified earlier in these proceedings i.e. automobiles, I agree the opponent's trade mark is distinctive. However, as it consists of two well known words separated by an apostrophe symbol, it is in my view, possessed of an above average degree of inherent distinctive character rather than being highly distinctive as the opponent suggests.

Likelihood of confusion

20. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents' trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer

rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

21. Earlier in this decision I concluded that:

- the competing goods are identical;
- the average consumer is a member of the general public who will overwhelmingly select the goods by visual means and who will pay a very high degree of attention when doing so;
- both elements of the opponent's trade mark make a roughly equal contribution to the overall impression it creates; the distinctiveness lying in the totality;
- the overall impression of the applicant's trade mark will be dominated by the distinctive word WINRUN, although the device of a chequered flag will also make a contribution;
- the competing trade marks are visually similar to a medium degree, aurally similar to a high degree and conceptually neutral;
- the opponent's earlier trade mark is possessed of an above degree of inherent distinctive character.

22. Having concluded that the goods at issue are identical, the competing trade marks are visually similar to a medium degree, aurally highly similar and the opponent's earlier trade mark possesses an above average degree of inherent distinctive character, one might conclude that a likelihood of confusion was inevitable.

23. However, having concluded earlier in this decision that the average consumer will pay a very high degree of attention when selecting a motor car, I am satisfied that the differences in the competing trade marks are more than sufficient to avoid them being confused visually. Whilst I have accepted that there is a high degree of aural similarity between them, the average consumer is, in my view, most unlikely to select a motor car by purely oral means (a similar conclusion was reached by the Court of Appeal in *Lancer Trade Mark* - [1987] RPC 303, which although decided some time ago, considered many of the same factors which, in my experience, are still relevant today). In short, even if the degree of visual and/or aural similarity was sufficient to cause the average consumer to wonder whether a shared trade connection existed between the competing trade marks (which in my view it will not), any doubts would, given the nature of the purchasing process, be quickly dispelled. As a consequence, the opposition fails.

24. In reaching the above conclusion, I have not overlooked the opponent's submissions in relation to an ex parte decision of the Trade Marks Registry in BL-O/023/98 i.e. ANUCCI and device versus, inter alia, Yannuci. However, that decision was reached in the context of fragrances, perfumery, cosmetics and soaps, for which the nature of the purchasing act is quite different.

Overall conclusion

25. Subject to any successful appeal, the application may proceed to registration in respect of all the goods for which registration has been sought.

Costs

26. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent's statement: £200

27. I order Renault s.a.s to pay to Winrun Tyre Co., Ltd the sum of **£200**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of April 2015

C J BOWEN
For the Registrar
The Comptroller-General