O/0694/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3684350

BY KIRKBY (TYRES) LIMITED

TO REGISTER:

AS A TRADE MARK IN CLASS 35

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 432291 BY

CONSTANT PRICE MONITOR LIMITED

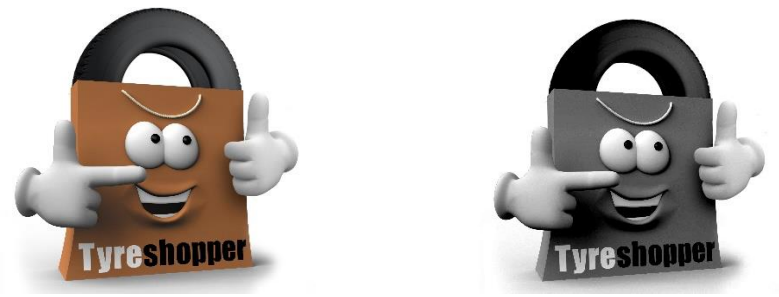
BACKGROUND AND PLEADINGS

1. On 20 August 2021, Kirkby (Tyres) Limited ("the applicant") applied to register the mark shown on the front cover of this decision in the United Kingdom in respect of the following services:

> *Class 35*
> *Retail services, including online retail services, in relation to wheels, tyres and tubes and inner tubes.*

2. On 24 March 2022, the application was opposed by Constant Price Monitor Limited ("the opponent"). The opposition is based on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and concerns all the services in the application.

3. Under section 5(2)(b), the opponent is relying on UK Trade Mark ("UKTM") No. 3065581, which is a series of two marks, as shown below:



4. The application for the series of marks was filed on 24 July 2014 and they were registered on 14 November 2014 for the following services, all of which are relied upon under this ground:

> *Class 35*
> *The bringing together, for the benefit of others of a variety of vehicle parts and tyres, enabling customers to conveniently view and purchase those goods in a retail vehicle parts and tyres outlet, garage and/or car servicing/maintenance centres; the bringing together, for the benefit of others of a variety of vehicle parts and tyres, enabling customers to conveniently view and purchase those goods from a catalogue of vehicle parts and tyres, by mail order or by means of telecommunications; the bringing together for the benefit of others of a variety of vehicle parts and tyres, enabling customers to conveniently view and purchase*

those goods from an Internet website specialising in vehicle parts and tyres; fleet management services; operation of discount schemes; operation of benefit/incentive schemes; accounting services relating to fleet management and maintenance.

5. These marks qualify as earlier marks under section 6(1) of the Act. As they were registered more than five years before the application date of the contested mark, the opponent has stated that it has used the series of marks for all the services relied upon.

6. The opponent claims that the marks are highly similar as the distinctive and dominant elements of both marks are “TyreShop” and “Tyreshopper” and that the services are identical or, in the alternative, highly similar. As a result, it claims that there is a likelihood of confusion, and that registration of the contested mark should be refused under section 5(2)(b) of the Act.

7. Under section 5(4)(a), the opponent claims to have used the sign **TYRE SHOPPER** throughout the UK since 1994 for the same services for which UKTM No. 3065581 stands registered. It also claims that, since 2014, it has used the signs shown in paragraph 3 throughout the UK for the same services. It contends that it has built up considerable goodwill through such use. Given the level of goodwill and the identity and similarity of the marks and services, the opponent claims that a substantial number of the relevant consumers in the UK would be deceived into thinking that the applicant’s services are those of the opponent or are commercially linked to the opponent. Damage would occur through loss of sales or through damage to the opponent’s reputation, should the services supplied by the applicant be of an inferior quality. Consequently, the opponent contends that registration of the contested mark should be refused under section 5(4)(a) of the Act.

8. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the earlier series of marks relied upon. It does not, however, deny that the services are similar.

9. The matter came to be heard by me on 23 October 2023. The opponent was represented at the hearing by Lee Curtis of HGF Limited. The applicant did not attend the hearing but has been represented in these proceedings by WP Thompson.

EVIDENCE AND SUBMISSIONS

10. The opponent's evidence in chief comes from Michael Bourne, Group Marketing & eCommerce Director of Constant Price Monitor Limited. At the date of the witness statement (19 August 2022), he had held this position for 16 years. His evidence goes to the use of the earlier series of marks and signs, and is accompanied by 14 exhibits.

11. The applicant's evidence comes from Francesco Simone, a trade mark attorney at WP Thompson, the applicant's representative. His witness statement is dated 20 October 2022 and presents the results of internet searches for tyre retailers using the phrase "tyre shop" and information about the size of the UK market for tyres. It is accompanied by 2 exhibits.

12. The opponent filed evidence in reply in the form of a witness statement from Melissa Buamah, a trainee trade mark attorney at HGF Limited, the opponent's representative. Her witness statement is dated 22 December 2022 and presents screenshots from the Quidco, Vouchercloud and DealsDaddy websites, showing use of the word mark "Tyre Shopper".

13. On 27 January 2023, the applicant notified the Registry that it wished to file further evidence in reply to the evidence of Ms Buamah. A further witness statement of Mr Simone was filed on 30 January 2023. This is a vehicle for presenting three screenshots from the same websites adduced by the opponent, showing use of the words "Tyre Shopper" with a logo. The Registry wrote to both parties on 24 February 2023 giving its preliminary view to admit the evidence. As the opponent did not request to be heard, the evidence was admitted.

14. The applicant also filed written submissions on 21 October 2022.

DECISION

Section 5(2)(b)

15. Section 5(2)(b) of the Act is as follows:

> "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."

16. The applicant had put the opponent to proof of use of the earlier series of marks. However, in its written submissions, it said that *"Genuine use of the Opponent's logo trade mark, registered under no. UK00003065581, is not denied"*.[1] Given this admission, the opponent may rely on all the services for which the earlier marks stand registered.

17. In considering the opposition under this section, I am guided by the following principles, gleaned 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):[2]

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their

[1] Page 3.

[2] The provisions of the Act relied on in these proceedings are assimilated law, as they are derived from EU law. Although the UK was left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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 services

18. Where goods (or services) in the specification of one party are included in a broader term from the other party's specification, those goods (or services) are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05 at [29]. The contested services are *Retail services, including online retail services, in relation to wheels, tyres and tubes and inner tubes.* These services are all included in the following broader terms taken from the opponent's specification:

> *The bringing together, for the benefit of others of a variety of vehicle parts and tyres, enabling customers to conveniently view and purchase those goods in a retail vehicle parts and tyres outlet, garage and/or car servicing/maintenance centres; the bringing together, for the benefit of others of a variety of vehicle parts and tyres, enabling customers to conveniently view and purchase those goods from a catalogue of vehicle parts and tyres, by mail order or by means of telecommunications; the bringing together for the benefit of others of a variety of vehicle parts and tyres, enabling customers to conveniently view and purchase those goods from an Internet website specialising in vehicle parts and tyres.*

19. Consequently, I find that the services are identical.

Average consumer and the purchasing process

20. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: see *Lloyd Schuhfabrik Meyer* at [26].

21. The opponent submits that the average consumer is a member of the general public who will pay an average attention to detail when choosing retailers of tyres and related parts. I agree with the identification of the average consumer, although I note that the average consumer may also be an individual, such as a taxi driver, who earns their living through driving a vehicle. They will bear in mind the range of tyres and parts offered by a retailer, the prices charged, whether fitting is included, and the

convenience of location. When buying tyres, the average consumer would in my view pay a higher than average degree of attention, given the importance of the goods for safe and legal driving. However, I do not consider that the average consumer would pay this same level of attention to choosing a retailer of those tyres. In my view, the average consumer would pay a medium level of attention.

22. The average consumer would make their choice after browsing the internet, viewing printed advertisements or other promotional material, seeing advertisements on television or signage on premises. While they may also hear radio advertisements or receive word-of-mouth recommendations, it is my view that this will be a largely visual purchasing process. Nevertheless, I shall not ignore the aural aspects of the marks.

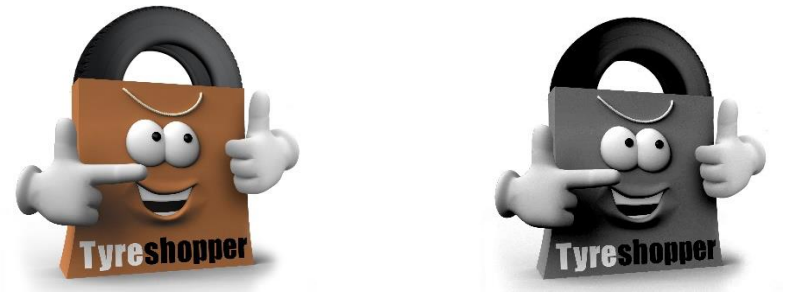
Distinctive character of the earlier mark

23. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "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)."

24. 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. The distinctiveness of the mark can be enhanced by the use that has been made of it.

25. The earlier series of marks is shown below for ease of reference. They are composite marks consisting of figurative and verbal elements.



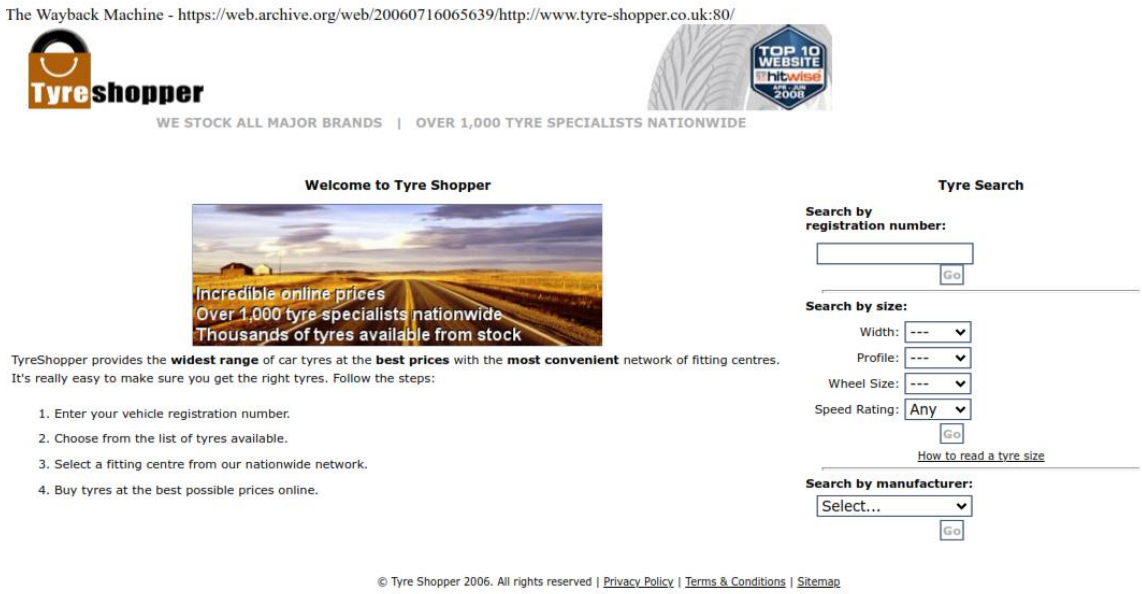
26. The figurative element is a bag containing a tyre, the top half of which can be seen emerging from the opening at the top of the bag. In the first earlier mark, this bag is a light brown, with a lighter string-type handle. On the surface of the bag there can be seen two cartoon-like eyes touching each other and a smiling mouth. On either side of the bag are two white hands. Again, these appear cartoon-like as they have a thumb and only three fingers. Both thumbs are raised and the index finger on the hand to the viewer's left points to the centre of the bag. The words "TYRE" and "SHOPPER" are seen juxtaposed at the bottom of the bag, with the former in white and the latter in black. Only the letter "T" is in upper case. It is my view that, because of this difference in presentation, the verbal element will be seen as two separate words. The second mark in the series is identical, except it is in greyscale, meaning that it could be used in any colour: see *Specsavers International Healthcare & Ors v Asda Stores Ltd & Anor* [2014] EWCA Civ 1294 at [5] and *J.W. Spear & Sons Ltd & Ors v Zynga Inc.* [2015] EWCA Civ 290 at [47].

27. The opponent submits that the most distinctive element of this mark is "Tyre shopper". The courts have held on a number of occasions, including in *Migros-Genossenschafts-Bund v European Union Intellectual Property Office (EUIPO)*, Case T-68/17 at [52], that verbal elements are generally regarded as more distinctive than figurative elements. However, this cannot be treated as a hard-and-fast rule. The words themselves are, at best, highly allusive of the services supplied under the mark. They also appear at the bottom of a large figurative element which will, in my view, be seen by the average consumer as a humanoid shopping bag. All other things being equal, I would find that the figurative element makes the greater contribution to the distinctive character of the mark and that its inherent distinctiveness was medium.

28. At the hearing, Mr Curtis submitted that the words "TYRE SHOPPER" had acquired an enhanced degree of distinctive character through the use that had been made of them. In *China Construction Bank Corp v EUIPO*, Case T-665-17, the General Court ("GC") held at [52] that evidence showing that part of an earlier mark has acquired an enhanced degree of distinctive character through use may be relevant to the assessment of the distinctiveness of that element within the earlier mark.

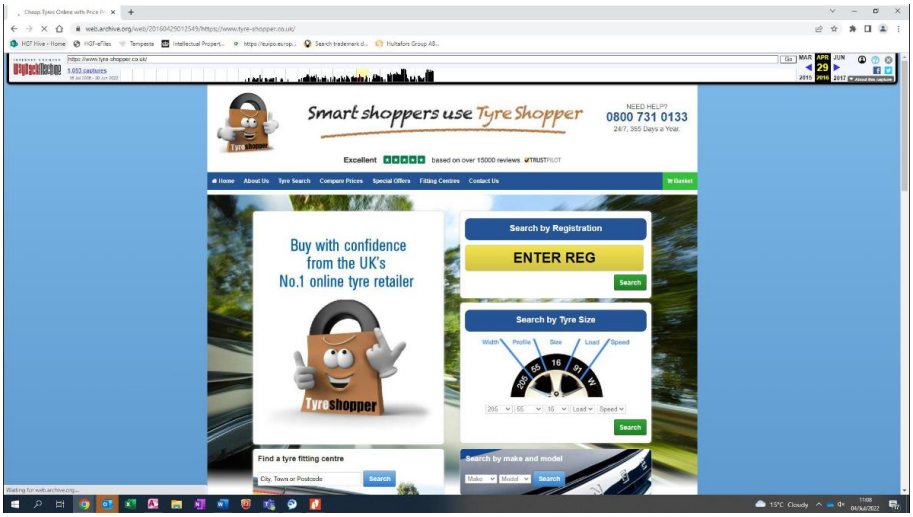
What does the evidence show?

29. Mr Bourne states that the opponent has been using the words "TYRESHOPPER" and "TYRE SHOPPER" and the domain name "tyre-shopper.co.uk" in the UK since 2006. The screenshot below is dated 16 July 2006:[3]



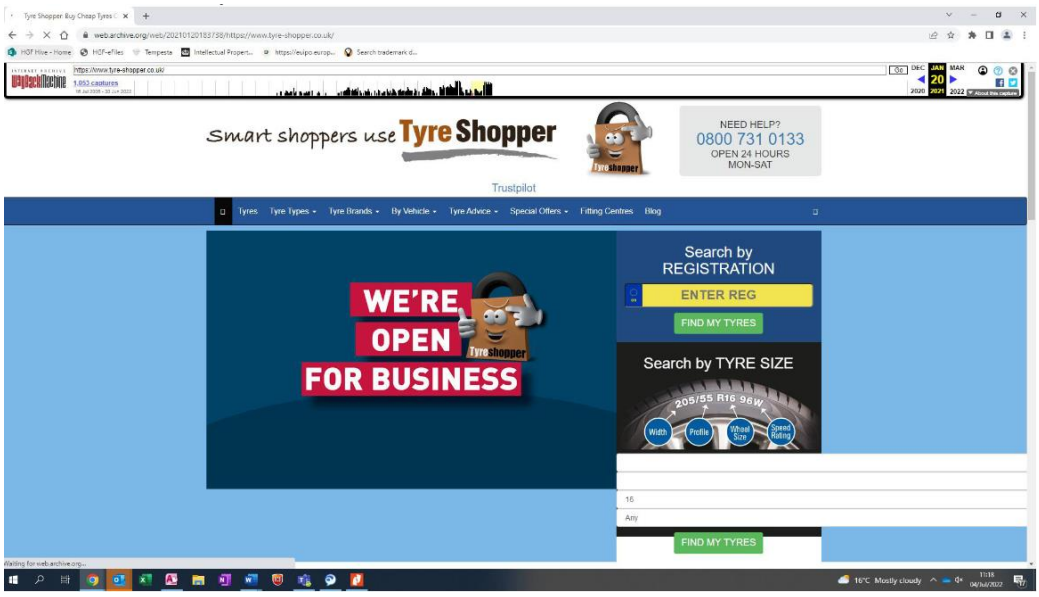
30. He says that the registered mark was first used in 2014 and it can be seen on the following screenshot, dated 29 April 2016:[4]

[3] Exhibit MB2.
[4] Exhibit MB4, page 27.



31. This screenshot also shows the words “TYRE SHOPPER” in title case in a typeface that resembles handwriting.

32. On 20 January 2021, the website appeared as follows:[5]



33. Total sales of services under the mark are shown in the following table.[6] Mr Bourne states that the majority of these sales would have been for the retail of tyres. This statement has not been challenged and I cannot see evidence of retail services related to any other products. I therefore accept it.

[5] Exhibit MB4, page 32.
[6] Witness statement of Mr Bourne, paragraph 4.

Year	Approximate Total Sales for Financial Year (£ sterling including VAT)
2021	£8,566,559
2020	£7,499,352
2019	£7,836,559
2018	£7,122,594
2017	£7,658,190

34. The applicant's evidence suggests that these figures represent a very small share of the market. Exhibit FS2 contains a printout from the website totallossgap.co.uk that states that over 40 million tyres are fitted to UK cars every year.[7] The date, and ultimate source, of this figure are not given. More helpful to the applicant is an article from techsciresearch.com summarising the findings from its February 2016 report *United Kingdom Tire Market Forecast & Opportunities 2021*.[8] According to the article, UK tyre sales were forecast to exceed £4.2 billion by 2021 and the proportion of the market accounted for by passenger car tyres was 80% in 2015. The £4.2 billion figure is, of course, only a forecast and a great deal may happen in the space of five years. Nevertheless, I am prepared to accept that the market for car tyres is very large, running into billions of pounds.

35. Mr Bourne states that advertising and marketing expenditure was £169,630 in 2017, £141,419 in 2018, £143,044 in 2019, £211,442 in 2020 and £246,309 in 2021. He says that the opponent is *"active in all digital marketing channels with substantial investment in PPC, affiliate marketing and display marketing"* and that this activity has resulted in 2.4 million visitors to the website per year.[9] A later table shows that the number of visitor sessions was 2,803,854 in 2017, 2,217,563 in 2018, 2,318,024 in 2019, 2,360,848 in 2020 and 2,303,799 in 2021.[10] He provides examples of an email sent to the opponent's database of around 100,000 subscribers in Exhibit MB8, but

[7] Pages 1-6.
[8] Pages 7-10.
[9] Witness statement of Michael Bourne, paragraph 5.
[10] Witness statement of Michael Bourne, paragraph 6.

the date of this is 28 May 2022, i.e. after the relevant date. Exhibit MB9 contains the opponent's first physical mailshot but this also post-dates the relevant date.[11]

36. Exhibits MB10, MB11 and MB12 contain screenshots from Twitter, Instagram and Facebook respectively. The two tweets are dated 28 May 2020 and 8 August 2021; the Instagram post is dated 31 January 2020; and the Facebook post is dated 28 May 2020. The Instagram post is shown below as an example:

37. Mr Bourne provides some information on the number of followers of each of these social media channels, but these are undated. However, he does say that the opponent made 290 posts on Facebook, 288 on Instagram and 298 on Twitter in 2021. As the relevant date is 20 August 2021, some of these posts can be inferred to have been made before this date, but I am unable to draw any conclusions on the percentage. Mr Bourne also refers to impressions and engagements with these posts, but the evidence is not clear about the date to which those figures refer.

38. Exhibit MB13 contains a collection of eight newspaper and website articles. Of these, two are undated and one (a post from moneysavingexpert.com) was updated on 24 May 2022. This leaves the following five:

i. "Best online tyre retailers 2020", autoexpress.co.uk, dated 4 June 2020. 8 retailers are given brief reviews, and Tyre Shopper appears after these in a list of three retailers also tested;

ii. "Best car tyre companies & makes 2019", HonestJohn.co.uk. This article features different brands of tyres, with the following text below each one:

[11] It is dated 24 June 2022.

"Prices sourced from Blackcircles.com, include VAT, but not fitting. Prices may vary from the above, so make sure that you check a number of retailers for current pricing and to shop around, including Tyre-shopper.co.uk and Tyresonthedrive.com.";

iii. "Tyre Shopper study reveals: 30% of UK travellers to shun EU holidays post-Brexit", markets.businessinsider.com, 1 October 2019. This article says nothing about the opponent apart from the fact that it has produced the study;

iv. "Four in five motorists have been victims of road rage", inews.co.uk, 1 June 2017, updated 16 July 2020; and

v. "Do people want to buy electric cars?", wales247.co.uk, 17 June 2021. Both (iv) and (v) are based on surveys carried out by the opponent and say nothing about its business.

39. The earlier mark does not appear in any of these articles.

40. The final exhibit to Mr Bourne's witness statement consists of over 100 pages of reviews from Trustpilot. He states that these show that *"the public refers to us and the services we sell simply as TYRE SHOPPER"*.[12] He claims that over 40,500 reviews have been given since 2014 and also states that the earlier marks and the words "TYRE SHOPPER" have gained reputation through the following:

i. An "Excellent" rating and a position of 17 among 41 tyre companies. I can see from Exhibit MB14 that the opponent had, at the date of printing, an excellent rating on Trustpilot, but I have not been able to find evidence of its relative position and Mr Bourne does not tell me the source of this information;

ii. Its status as a founding member of the charity Tyre Safe, established in 2006. No further information is given about this charity;

iii. The fact that it was awarded a bi-annual Experian Hitwise Top 10 Award 10 times during the first five years following its launch (which was in 2006). No

[12] Witness statement of Michael Bourne, paragraph 8.

information is given about this award, or whether the opponent has received it more recently.[13]

41. The evidence of Melissa Buamah shows that the opponent's services have been featured on cashback, voucher and discount websites Quidco, Voucher Cloud and Deals Daddy. The words "TYRE SHOPPER" can be seen on the print outs from (respectively) 11 September 2016, 13 May 2020 and 12 August 2021. However, the applicant has also filed screenshots from these dates showing that the first earlier mark in the series was used alongside the words.[14]

Findings

42. I accept that the words "TYRE SHOPPER" have been used since 2006 and it is reasonable to infer from the evidence of websites that they have been used throughout the UK. Indeed, the screenshot from 2006 reproduced in paragraph 29 above refers to a *"nationwide network"* of fitting centres. I do not find it surprising that a reviewer would refer to the company as "TYRE SHOPPER". It is the only part of the mark that can easily be typed or spoken.

43. However, the opponent has not addressed the evidence adduced by the applicant to show that this is a huge market and that consequently, in the applicant's view, the sales figures *"appear unremarkable"*.[15] I find that the sales have been consistent, but do not represent a particularly sizeable market share. The advertising and promotional expenditure seem to be modest in the context of the size of the market and I understand that inews.co.uk is a website associated with a particular newspaper (*the i*) but I do not have any figures on the reach of this website, or any of the others listed in paragraph 38 above. I have limited dated evidence before me that a significant proportion of the relevant public (which would be car owners) had by the relevant date been educated to understand that the words "TYRE SHOPPER" or the earlier series of marks denoted trade origin. I find that the inherent distinctiveness of neither "TYRE SHOPPER" nor the mark as a whole has been enhanced through use. I therefore find that the distinctive character of the earlier mark is medium.

[13] Witness statement of Michael Bourne, paragraph 7.
[14] Exhibits FS3-FS5.
[15] Applicant's written submissions, paragraph 14.

Comparison of marks

44. It is clear from *SABEL* (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. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo*, paragraph 34.

45. The respective marks are shown below:

Contested mark	**Earlier marks**
eTyreShop	 

46. I have already considered the distinctive character of the earlier marks. The dominant element of this mark is, to my mind, the humanoid bag character, on account of its size in relation to the words (which are placed at the bottom of the mark). The gaze of the viewer is drawn to the centre of the bag because of the pointing finger. The figurative element makes the greatest contribution to the overall impression of the mark, with a smaller contribution made by the words.

47. The contested mark is also a composite mark. It contains the words “TYRE” and “SHOP” juxtaposed in title case and in a standard typeface. To the right of these words

is the letter e, in white, on a red circular background, superimposed on an outline of a shopping trolley shown at a slight angle. The word “e” will be understood as an indicator that the services are provided online, and “TYRE SHOP” describes the services. I find that the verbal element is dominant, yet it is descriptive. The shopping trolley is also allusive of the services. The distinctiveness of the mark lies in this figurative element with the letter e on top, combined with the descriptive “TYRE SHOP”.

Visual comparison

48. Although I have found that the words “TYRE SHOP” in the contested mark are descriptive, this does not mean that I can ignore them in my comparison of the marks: see *The Stockroom (Kent) Ltd v Purity Wellness Group Ltd (PURITY HEMP COMPANY IMPROVING LIFE AS NATURE INTENDED)*, BL O-115-22, paragraph 31. The visual similarity between the marks lies in the words “TYRE SHOP” and “TYRE SHOPPER”, with the figurative elements being points of noticeable difference. Given the weight of the words in the overall impressions of each mark, I find that the marks are visually similar to a very low degree.

Aural comparison

49. The earlier mark will be pronounced as three or four syllables: “TIRE-SHOP-PER” or “TIE-UR-SHOP-PER”. No other elements of the mark can be articulated. I consider that the average consumer will articulate the initial “E” in the contested mark and so this mark will be spoken as “EE-TIRE-SHOP” or “EE-TIE-UR-SHOP”. The marks therefore share all but one syllable. The beginnings of the mark are therefore different. I find that the marks are aurally similar to a medium to high degree.

Conceptual comparison

50. On encountering the contested mark, the average consumer would immediately think of an online retailer of tyres. This mark has no other conceptual content. The earlier mark, on the other hand, show a humanoid shopping bag, which has no counterpart in the other mark, and which may be seen as the individual shopping for tyres. I find that the marks are conceptually similar to a medium degree.

Conclusions on likelihood of confusion

51. The likelihood of confusion must be assessed globally, taking into account all relevant factors. It is not simply a case of applying a formula and seeing what comes out at the end. I am required to make my assessment from the perspective of the average consumer and should also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services or vice versa. I keep in mind 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 they have in their mind.

52. There are two types of confusion that may occur. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.'"

53. I also recall another decision by Mr Purvis, namely *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which he pointed out that the level of distinctive character of a mark is only likely to increase the likelihood of confusion to the extent that it resides in the element or elements of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or

by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

54. I remind myself that I have found the services to be identical. Nevertheless, I find that there are sufficient differences between the marks for them not to be mistaken for each other in what I have found to be a largely visual purchasing process. I have asked myself whether the greater aural similarity between the marks should lead me to find that they would be mistaken for each other, on the basis of imperfect recollection. In *The Royal Academy of Arts v Errea Sport S.p.A.*, BL O/010/16, Mr Iain Purvis QC, sitting as the Appointed Person, rejected the appellant's submission that there was bound to be a likelihood of confusion where one mark consisted of letters and the other consisted of the same letters in a heavily stylised form. He said:

"15. … In essence [the appellant's attorney's] argument was that there was bound to be a likelihood of confusion in this case because of the aural 'identity' between the marks (if one tried to ask for goods using an aural version of the earlier mark, one would ask for 'RA' goods, just as one would ask for the applicant's goods). This argument seems to me to fly in the face of the necessary 'global' assessment, bearing in mind the visual, conceptual and aural similarities, which the tribunal must carry out. Particularly in the case of an earlier mark which is a heavily stylised device mark, taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark and is likely to lead to an erroneous result."

55. In my view, the same considerations apply in this case. To focus on the aural similarities between the words would be to ignore what it is about the earlier mark in particular that makes the greatest contribution to the distinctive character of that mark. I find that there is no likelihood of direct confusion.

56. This brings me on to the likelihood of indirect confusion. In paragraph 17 of his decision in *L.A. Sugar*, Mr Purvis gave the following examples of when indirect confusion could occur:

> "(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI', etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

57. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

> "12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.
>
> 13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

58. Mr Curtis referred me to the decision of another hearing officer, *WeFix v Revive A Phone Limited*, BL O/655/21, in which she found a likelihood of indirect confusion between the following marks:

59. This decision was upheld on appeal.[16] The hearing officer found that the common element in the marks had a low degree of distinctiveness but that the differences between them were sufficient for there to be no likelihood of direct confusion. She found there would be indirect confusion because consumers would think that one of the marks was an updated variant of the other.

60. This case is not entirely on all fours with the present case. The hearing officer found that the words "WE FIX" were the dominant elements of the marks, with the other elements playing lesser roles. In these proceedings, I have found that the dominant and more distinctive element of the contested mark is the humanoid bag character. There is also a difference between the verbal elements "TYRE SHOPPER" and "E TYRE SHOP". The common element, "TYRE SHOP", is not, in my view, so distinctive that the average consumer would assume that no one else would use it in a trade mark. In principle, the prefix "E" might well be the kind of non-distinctive element one would see in a sub-brand, but the absence of the dominant and more distinctive element of the contested mark points away from such a finding. The differences between the marks do not point to an obvious brand extension or variant.

61. I find that there is no likelihood of indirect confusion.

Section 5(4)(a)

62. Section 5(4)(a) of the Act states that:

> "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented–

[16] [2022] EWHC 2195 (Ch).

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

…"

63. Subsection 4(A) is as follows:

"The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

64. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off at [406]:

"First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

Relevant date

65. In *Starbucks (HK) Limited & Anor v British Sky Broadcasting Group PLC & Ors* [2015] UKSC 31, Lord Neuberger said:

> "16. It is common ground that, in order to succeed, a claimant in a passing off action has to establish its claim as at the inception of the use complained of. Although there is no decision of the House of Lords specifically to that effect, it is supported by a number of Court of Appeal decisions, perhaps most clearly from *Anheuser-Busch Inc v Budejovicky Budvar NP* [1984] FSR 413, 462, and it appears to me that it must be right."

66. There is no evidence that the applicant has been using the contested mark before the date of application. That is therefore the relevant date for this ground.

Goodwill

67. The opponent must show that it had goodwill in a business at 20 August 2021 and that the one or more of the following signs is associated with, or distinctive of, that business:

TYRE SHOPPER

68. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new

> business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

69. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After doing so, he concluded that:

> "34. ... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

70. I have already summarised what the evidence shows about use of these signs and I note that the applicant has admitted under section 5(2)(b) that the opponent has shown genuine use of the figurative signs for the services relied on under that ground. These are the same services for which the opponent claims goodwill under section 5(4)(a). Mr Curtis submitted that it was logical that the applicant should admit that the opponent has goodwill associated with all the above signs, because the second and third signs include the words of the first sign.

71. Mr Curtis also referred me to the decision in *Frank Reddaway & Anor v George Banham & Anor* [1896] AC 199. In his skeleton argument, he submitted that:

> "21. … it is an accepted principle that goodwill can be established in descriptive terms used in relation to a business based on sufficient use and the use of such terms can be prevented by the tort of passing off, although here Constant Price would contend that TYRE SHOPPER is not wholly descriptive."

72. In the cited judgment, Lord Herschell said at [210] that:

> "The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such a manner as to put off his goods as the goods of the plaintiff."

73. Although I found that the use of the earlier mark was insufficient to support a claim of enhanced distinctiveness, I am prepared to accept that the opponent has goodwill associated with internet-based retailing of tyres. There is a pattern of consistent sales over several years, together with third-party recommendations and Trustpilot reviews. I am satisfied that the earlier signs relied on are distinctive of that goodwill, including the plain word sign.

Misrepresentation

74. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:
>
> > 'is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product].

> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101."

75. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it is unlikely, in the light of the Court of Appeal's decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here as far as the earlier figurative signs are concerned and shall now turn to the opponent's case based on the word sign.

76. In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated that:

> "Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered."

77. The words "TYRE SHOPPER" are in common use and I found under section 5(2)(b) that they were, at best, highly allusive of the services supplied by the opponent. The words used by the applicant are descriptive. The differences between the contested mark and the earlier word sign are small, consisting, first, of the prefix "e" in a figurative element and, secondly, of the use of the word "SHOP" rather than "SHOPPER". In my view, these differences are sufficient to avoid the public being deceived into thinking that the applicant's services are those of the opponent.

78. As I have found no misrepresentation, the section 5(4)(a) ground fails.

OUTCOME

79. The opposition has failed and, subject to a successful appeal, Application No. 3684350 may proceed to registration.

COSTS

80. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 2/2016. I assess these costs as follows:

£350 for considering the Notice of Opposition and preparing a counterstatement;

£700 for filing evidence and considering the opponent's evidence.

81. The applicant did not attend the hearing or file written submissions in lieu and so I make no award for this part of the proceedings.

82. I therefore order Constant Price Monitor Limited to pay Kirkby (Tyres) Limited the sum of £1050. The sum should 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 or withdrawn.

Dated this 23rd day of July 2024

Clare Boucher
For the Registrar,
Comptroller-General