

O/0791/24

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK00003842954
BY HONDA MOTOR CO., LTD.
TO REGISTER THE TRADE MARK:**

PIONEER

IN CLASS 12

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 440054
BY DETHLEFFS GMBH & CO. KG**

Background and pleadings

1. On 26 October 2022, Honda Motor Co., Ltd. (“**the applicant**”) applied to register the plain word “**PIONEER**” as a UK trade mark, under number 3842954 (“**the applicant’s mark**”). The applicant’s mark was published in the Trade Marks Journal for opposition purposes on 13 January 2023. Registration is sought for *side by side off road vehicles* in class 12.
2. On 4 April 2023, **Dethleffs GmbH & Co. KG.** (“**the opponent**”) filed a notice of opposition. The opposition is brought under section 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon its International Registration designating the UK number WO0000001634807, “**PIONEER**” (“**the opponent’s mark**”) to support its claim. The earlier mark was registered on 21 October 2021. With effect from the same date, the opponent designated the UK as a territory in which it sought to protect the International Registration under the terms of the Madrid Agreement. The earlier mark claims a priority date of 23 April 2021 from the German Patent and Trademark Office.¹ Protection in the UK was granted on 26 May 2022 in respect of the following goods in class 12, all of which are relied upon for the purpose of the opposition:

Class 12: Touring homes; motor homes; caravans; recreational vehicles (RV); mobile offices; minibus and panel vans converted as housing; structural parts for mobile homes, motor homes, caravans and leisure vehicles, included in this class; vehicle accessories, namely roof racks, rear mounted carriers, motorcycle carriers, bicycle carriers, roof and underfloor storage boxes, moulded parts for motor homes, caravans and recreational vehicles, included in this class.

3. Given the respective priority/filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. As it had not been registered for five years or more at the filing date of the applicant’s mark, it is not subject to the use

¹ Priority claimed from Trademark No. 30 2021 107 211

requirements specified within section 6A of the Act; consequently the opponent can rely on all of its registered goods.

4. The opponent claims that the parties' marks are identical, and that their specified goods are either identical (sic) or similar, and that the effect of these factors taken together lead to a likelihood of consumer confusion including a likelihood of association with the opponent's earlier trade mark.
5. The applicant filed a notice of defence. In its counterstatement the applicant accepts that the marks are identical but denies that the goods are either identical or similar, and denies that there is a likelihood of confusion or association between the marks.
6. The opponent is professionally represented by Venner Shipley LLP; the applicant is professionally represented by Stevens Hewlett & Perkins.
7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has 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.

Evidence and submissions

8. Both the opponent and the applicant chose to file evidence.
9. The opponent's evidence comprises a witness statement of Victoria Jane Martin, a Chartered Trade Mark Attorney acting on behalf of the opponent, together with Exhibits VJM1 to VJM14. The purpose of the opponent's evidence is to show that the opponent is the owner of the earlier mark which has protection in the UK, and how the competing goods are sold within the marketplace.
10. The applicant's evidence consists of three witness statements; two of which are the statements of Hiroshi Kamitani, dated 28 September 2023 and 5 October 2023 respectively, together with Exhibits HP1 and HP2. Hiroshi Kamitani is a General

Manager in the Litigation and Dispute management Division of the applicant's company. The reason for this evidence is to demonstrate that the applicant's mark has been used on the marketplace since 2017. The third witness statement for the applicant is from Peter Williams Cornford, a Trade Mark Attorney acting on behalf of the applicant, dated 2 October 2023. Mr Cornford introduces Exhibits PWC1 – PWC5. The purpose of the applicant's evidence is to provide assistance in defining the competing terms and to show how the competing goods are sold within the marketplace, including pricing and targeted consumer. Mr Cornford also makes criticisms of aspects of the opponent's evidence.

11. Neither party requested a hearing and only the applicant elected to file written submissions in lieu. I have read and considered all the papers and will refer to relevant points from the parties' evidence and submissions as and where necessary in this decision.

Preliminary issue

12. Exhibit VJM10 in the opponent's evidence shows a Canadian start-up business discussing a new all-terrain off-road camper vehicle. As accepted within the witness statement of Victoria Jane Martin, this is not directed at the UK market at present, but Ms Martin asserts that it is indicative of the direction of travel for future vehicles to be used for both off-road travel and camping/campervanning/adventure travel.² I do not accept that exhibit as establishing the submitted direction of travel, and as it is not relevant to the UK market at the relevant date, i.e. the date of application, I will say no more about it.

13. From the applicant's evidence, I note that Mr Cornford provides a Wikipedia page, to assist with the definition of *side by side off road vehicles*.³ Wikipedia is a community-based encyclopaedia based on user contribution which I acknowledge may be criticised as not being authoritative or sufficiently methodical in its fact-checking. I am conscious that the opponent has not challenged the accuracy of the content of the exhibit in this instance. Nor is the content or subject matter of a type that may involve different policy perspectives or issues of editorial self-promotion,

² Witness statement of Victoria Jane Martin, paragraph 8

³ Exhibit JWC1, page 15 of 245.

nevertheless, this evidence contains a great number of hyperlinks. The registry is not in the habit of accessing hyperlinks since the content of what is linked is subject to change across time and is therefore not a stable point of evidential reference. Instead, my assessment of the applicant's goods is based on what may be gleaned from the face of the witness statement and the supporting exhibits, alongside the evidence provided by the opponent.

DECISION

Legislation and case law

14. Section 5(2)(a) of the Act reads as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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”.

15. It will be noted from the above extract that section 5(2)(a) refers to the marks being identical, and the goods being similar (only). If the goods were identical, as the opponent claims in the alternative to similarity, then the appropriate ground of objection would be section 5(1) of the Act, which is based on double identity, and which does not feature the additional step of establishing a likelihood of confusion. In the present case, this does not raise any material question, because, as will be seen, I do not consider the goods to be identical.

16. I am guided by the following principles which 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:

(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;

[...]

(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.

Identity of the marks

17. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

18. I note that the applicant has accepted that the competing marks are identical.⁴ I agree. The earlier mark and the contested mark are both word-only marks consisting of the word “PIONEER” with no additional elements. Therefore, they are self-evidently identical.

Comparison of the goods

19. The goods to be compared are those set out in paragraphs 1 and 2 of this decision.

20. All relevant factors relating to the goods should be taken into account, which include, inter alia:⁵

- the physical nature of the goods;
- their intended purpose;
- their method of use / uses;
- who the users of the goods are;
- the trade channels through which the goods reach the market;
- in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

⁴ Applicant’s counterstatement, paragraph 2

⁵ See Canon, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “Treat” case.

- whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors)

or

- whether they are complementary to each other. Complementary signifying that “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”.⁶ Noting that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.⁷

21. When interpreting the terms in a specification, I bear in mind that it is necessary to focus on the core of what is being described and that trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. Nevertheless, the principle should not be taken too far and where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.⁸

22. Furthermore, I bear in mind the approach in *Sky v Skykick*,⁹ where Lord Justice Arnold set out the correct approach to interpreting broad and/or vague terms.

“...the applicable principles of interpretation are as follows:

- (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

⁶ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82, see also *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13

⁷ *Kurt Hesse v OHIM*, Case C-50/15 P, see also *Sanco SA v OHIM*, Case T-249/11

⁸ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

⁹ [2020] EWHC 990, (Ch),

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

23. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Meric')*,¹⁰ the General Court (“GC”) held that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

24. Before I begin my analysis of the competing goods, I pause here to mention that Ms Martin refers to Exhibit VJM14, a decision of the European Union Intellectual Property Office (“EUIPO”) which involved a comparison between automobiles (cars) and motorcycles.¹¹ Ms Martin submitted that the comparison should apply similarly in respect of the goods in this case.¹² Decisions of the EUIPO are of course not binding on the UK trade mark tribunal, but in any event I find that the different goods at issue in the present case give rise to different considerations.

Side by side off road vehicles

25. For clarity, when interpreting the opponent’s term “*recreational vehicles (RV)*” the applicant’s evidence, which was unchallenged, shows this to be a US term equivalent to the UK term “*motor home*”, i.e. a motor vehicle in which you can sleep and often cook, used for traveling and camping.¹³ Therefore, I have interpreted this term as such, rather than as encompassing any vehicle intended

¹⁰ Case T-133/05, paragraph 29.

¹¹ Joint cases R2211/2021-4 and R1/2022-4, *Eli Zero/Zero Motorcycles et al* (specifically paragraphs 47 and 48).

¹² Witness statement of Victoria Jane Martin, paragraph 12

¹³ Applicant’s evidence, Exhibit PWC2, page 41 of 245

to be used in recreational activity, for enjoyment when one is not working, as a hobby. On that basis I do not consider any of the competing goods to be identical.

26. As for the similarity of the goods. I consider the opponent's best case lies in its following terms: *Touring homes; motor homes; recreational vehicles (RV); minibus and panel vans converted as housing*. I understand the opponent's goods to be various types of vehicles that have a combined purpose of enabling users to travel, whilst also possessing facilities which enable the vehicle to act as accommodation, particularly overnight accommodation. In contrast, the applied-for term as shown in the evidence, refers to "an off road vehicle recognised by its 4-6 wheel design, its unique side by side bucket seat set up (hence its name) and its steering wheel and foot pedal driving system. It often comes with similar features to a car like a roll bar or cage, and wind protection that creates an enclosed look."¹⁴ The applicant's evidence suggests that these vehicles are used for adventuring outdoors, as well as by professionals such as farmers to haul heavy equipment over land.¹⁵ The opponent's evidence provides a broader scope of how this vehicle is used, including in facilities management, golf clubs, hotels, events such as festivals, and film making.¹⁶ The following pictures were included within the evidence which I understand to be typical of *side-by-side off road vehicles*.¹⁷



¹⁴ Applicant's evidence, Exhibit PWC1, page 23 of 245

¹⁵ Ibid

¹⁶ Opponent's evidence, Exhibit VJM5, pages 3 and 14

¹⁷ Applicant's evidence, Exhibit PWC4, page 3; and Opponent's evidence, Exhibit VJM5, page 5.



5.

27. There is some very general overlap in nature, method of use and intended purpose. The nature is that they are all (or include) four-wheeled vehicles, with shared vehicular features such as an engine, steering wheel, pedals, chassis and seats. These common features reflect the broad method of use - using a steering wheel to control the direction of travel of the wheels below, pedals to accelerate and brake etc. A shared broad purpose of all the goods is to move the user (and things with the user) from point A to point B.

28. However, I accept that there are significant differences in the specific nature, method of use and intended purpose of the parties' goods, reflecting how those vehicles would be described and categorised. The opponent's vehicles are by nature necessarily quite large, providing protection from the weather, with sleeping and other basic amenities. They are used predominantly for 'on road' travel to different locations, potentially far afield, where the vehicle doubles up as accommodation once the user arrives at the intended destination. Contrastingly, the applicant's goods are typically smaller vehicles, open to the elements. They offer no accommodation. They are used specifically 'off road' on various terrains not suitable for most vehicles, whether for fun or for transporting cumbersome items relatively short distances, such as on a farm. However, they do not appear to be used for travelling significant distances.

29. In relation to trade channels, the opponent has provided printouts from websites www.fantasticcampervans.co.uk and www.atv.suzuki.co.uk¹⁸ which Ms Martin claims shows that Suzuki sell both campervans/compact motorhomes and UTVs/quadbikes.¹⁹ I understand “UTV” to stand for “utility task/terrain vehicle”. In response to this evidence, I note that Mr Cornford states:

“It is noted that the evidence produced at “VJM13” references a campervan advertised by Fantastic Campervans which is said to be “based on the Suzuki Every/Carry”. The remainder of the Exhibit contains excerpts from Suzuki’s ATV range. Nothing in the evidence shows the Suzuki Every or Carry available for sale. Further, there is no evidence that I have seen which shows the Suzuki Every or Carry Van as being presently available for purchase from Suzuki in the UK, or available for purchase at the date of filing of the subject Application. Produced and shown to me marked “Exhibit PWC5” is an extract from Suzuki’s UK website, showing a press kit of the Carry Product, which seems to suggest that it ended production around 2004/2005. (Pages 241-245).”²⁰

30. I acknowledge that the evidence relating to the Carry Product dates from 2004, but I am not satisfied to conclude, as Mr Cornford submits, that production of the model ended around 2004/2005.

31. However, having considered exhibit VJM13 and the witness statement of Ms Martin, neither am I satisfied that the evidence shows that the same company, in this case Suzuki, sells both campervans/compact motor homes and UTVs/quad bikes. Indeed, on closer inspection of the evidence it appears to show that a third company, Fantastic Campervans, convert the Suzuki Every/Carry vans into campervans themselves as is apparent from the disclaimer shown in the exhibit.²¹ This is further corroborated by Suzuki’s own ‘press kit’ of the Carry model at Exhibit PWC5. Here Suzuki discusses in detail the vehicle and benefits of the

¹⁸ Exhibit VJM13

¹⁹ Witness statement of Victoria Jane Martin, paragraph 11

²⁰ Witness statement of Peter William Cornford, paragraph 13

²¹ Exhibit VJM13, page 1 – which reads “*The introductions provided for the vehicles we convert give a flavour of what is provided. Please be aware that there will be features available that we will not have been able to summarise here and possibly options that may not be apparent to you – please contact us to discuss your own requirements.*”

vehicle as a commercial van, rather than a campervan. As such, from the evidence before me, it follows that the Suzuki Every/Carry is not offered by Suzuki as a converted campervan but rather a commercial van. It is a third company that then uses these vehicles as a base vehicle to convert into campervans. Suzuki does not offer these vehicles as converted campervans itself. Therefore, it cannot be said that the evidence shows that Suzuki offer both campervans and side by side off road vehicles. Moreover, I note the applicant has provided evidence in the form of screenshots from websites of companies offering campervans, motorhomes and caravans,²² and companies that offer side by side off road vehicles.²³ From this evidence, it does not appear that any of these companies overlap in producing or selling both the opponent's and the applicant's vehicles. Whilst I accept that this evidence is not definitive, it does appear to indicate in the absence of any evidence to the contrary that companies offering motorhomes, campervans and caravans do not typically offer the applicant's side by side off road vehicles, as such, I find that the trade channels are likely to differ.

32. The goods will not be in competition with each other as users cannot use a side by side off road vehicle as a replacement for a motor home as it would not be able to provide accommodation for its users; equally a motor home would be an unsuitable substitute for the applicant's vehicles being unsuitable for off-road use. Further, despite the fact that the goods could be used together, with some motor homes often having the ability to tow or attach a small vehicle, the goods are not complementary as they are not important or indispensable to the use of the other. Users may overlap only insofar as the goods may be bought by the general public. A business user, such as a farmer, would be no more likely to use a motor home. Taking all of the factors into consideration, including the differences in nature, method of use and intended purpose, and no evidence of shared channels of trade, I find the competing goods are similar to a low degree (at most). For clarity, the remaining goods within the earlier specification would not put the opponent in a more favourable position.

²² Exhibit PWC2, pages 44-49 and PWC3

²³ Exhibit PWC4

The average consumer and the nature of the purchasing act

33. As indicated in the case law cited above, it is necessary to decide who the average consumer is for the parties' goods and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."²⁴ The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.²⁵
34. Whilst I note that professionals such as farmers may use the applicant's *side by side off road vehicles*, it is not likely that they would purchase the opponent's *motor home vehicles* in a professional capacity. Therefore, I consider the average consumer of the competing goods to be a member of the general public. The price of the goods is likely to be at the higher end of the scale. The goods are not typically purchased frequently, and the purchasing of the goods is likely to follow a measured and thoughtful process; it will not be merely casual.
35. The general public will consider factors such as cost, product specifications, quality, practicality and reliability when selecting the goods. The average consumer may conduct research before purchasing the goods as they will wish to ensure that they are making an informed choice. In addition, they may also engage in conversations with sales advisors to make sure that they have the correct product. Overall, I find that the general public would pay a high degree of attention. The goods are typically sold by brick-and-mortar retail establishments, where the goods will be purchased after a visual inspection. Alternatively, the goods and their information can be viewed online prior to purchase. Overall, I am of the view that the purchasing process would be predominantly visual in nature. However, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of goods would involve discussions with sales representatives or word of mouth recommendations.

²⁴ *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).

²⁵ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

Distinctive character of the opponent's mark

36. The distinctive character of a trade mark can be measured only, first, by reference to the goods and/or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

37. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of

confusion, since the more distinctive the earlier mark, the greater the likelihood of confusion may be.

38. The opponent has not pleaded that its mark had obtained an enhanced level of distinctiveness. Further, I note that evidence submitted by the opponent at Exhibit VJM6 refers to the name of the opponent's company (**Dethleffs**) rather than the earlier mark. This evidence comprises of just two pages entitled "Dethleffs expands". It states "Dethleffs has been producing van conversions on behalf of other brands in Isny since 2004." However, there is no mention of the "PIONEER" brand. Furthermore, the evidence refers to the location of Isny im Allgäu, which is in Germany rather than the UK. Whilst the applicant has also submitted evidence of the opponent's company selling campervans and motorhomes within the UK,²⁶ the evidence does not appear to show use of the earlier "PIONEER" mark. Consequently, I have only the inherent position to consider.

39. The earlier mark is a word-only mark that consists of the word "PIONEER". I have no submissions before me commenting on the meaning of this word. However, the applicant has suggested that as the opponent has been unable to show that its mark possesses an enhanced level of distinctiveness, then the question of confusion should be assessed from the perspective of the opponent's mark having an "ordinary" or "unremarkable" distinctive character. The word "PIONEER" is not an invented word; it is a well-known, ordinary word in English, that will be understood by the UK average consumer in line with its dictionary definition, as synonymous with "trailblazer" or "explorer". I consider this to be loosely allusive of the goods that are vehicles for venturing on tour to explore parts of a country. When considered in relation to the opponent's goods - *Touring homes; motor homes; recreational vehicles (RV); minibus and panel vans converted as housing*,²⁷ – I agree that the earlier mark has an unremarkable degree of distinctive character – certainly no more (and possibly less) than a medium level of inherent distinctive character.

²⁶ Exhibit PWC2 pages 55-104

²⁷ These being the goods that I have found to be similar.

Honest concurrent use and no evidence of actual confusion.

40. The applicant's counterstatement made no pleading of a defence of honest concurrent use. I also note that the applicant's written submissions in lieu raised neither honest concurrent use nor a lack of evidence of actual confusion. However, I observe that in his witness statement, dated September 2023, Hiroshi Kamitani states:²⁸

1. Produced and shown to me marked "Exhibit HP1" is proof of the Applicant having sold products in the UK under the Pioneer trade mark during the last five years:
 - a) Extracts of the Applicant's website, offering its Pioneer range of side by side vehicle(s) obtained via the Wayback Machine (the digital archive of the World Wide Web), across 2017, 2018, 2020, 2021, and 2022, which in combination pre-dates the Opponent's registration of the Pioneer sign under its International Trade Mark Registration No. 1634807 (UK Designation).
 - b) Sales figures relating to the UK under the Applicant's Pioneer mark over the last 5 years, commencing in 2016. The excerpts demonstrate a sales volume of approximately 1000 side by side vehicles sold under the Pioneer mark throughout the UK. The Registrar is asked to note that the figures are impressive given that the years span the Covid pandemic, during which commercial activity was depressed generally. The Company's products under the Pioneer trade mark have been on continuous sale in the UK since 2016. The sales figures are shown below.

²⁸ The first witness statement of Hiroshi Kamitani, dated September 2023, paragraph 1(a)-(d).

	Pioneer700 No. of items sold	Pioneer520 No. of items sold
April 2016 – March 2017	132	
April 2017 – March 2018	102	
April 2018 – March 2019	100	
April 2019 – March 2020	100	
April 2020 – March 2021	136	3
April 2021 – March 2022	140	177
April 2022 – March 2023		116
<u>Totals</u>	710	296
<u>Grand total</u>		1006

c) A sample of the Applicant's available invoice which reflects sales of the Pioneer product in the UK. The invoice has been issued by HONDA (UK) Limited, a subsidiary company of the Applicant (HONDA MOTOR CO., LTD.) and which is under its control. Commercially sensitive information has been redacted.

d) I am not aware of any confusion with the products of Dethleffs GmbH & Co. KG having arisen in the UK as a result of the Applicant's sale of Pioneer side by side vehicles.

41. Determining whether or not a *likelihood* of confusion arises is an assessment based on all the relevant factors. It is not necessary for an opponent to provide evidence of actual confusion and it is clear from case law that an absence of confusion is unlikely to be a determinative factor since it may be as a result of differences extraneous to the earlier mark.²⁹ In the present case an absence of evidence of actual confusion is of no significance at all. The earlier mark had been registered for less than 5 years when the applicant applied for the contested trade mark. As such, there is no obligation for the opponent to have yet used the earlier mark, and having examined all the evidence before me, there is indeed nothing to

²⁹ *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283

indicate that the opponent is currently using the mark within the UK marketplace. There is therefore no basis on which the average consumer would be aware of the respective marks on the market.

42. Similarly, for an honest concurrent use defence to be successful, it would need not only to be clearly pleaded, but an applicant would need to show that the relevant public has shown itself able to distinguish between the goods, bearing the marks in question, without any confusion as to trade origin. In the present case, I have been provided with some evidence by the applicant of the existence of its “PIONEER” mark on the marketplace between 2017 and 2023, but there is no evidence to show the opponent has yet used its “PIONEER” mark. The consumer has not therefore been consistently exposed to them side by side in comparable market environments.³⁰

43. My final remark regarding this evidence and similar evidence presented within the second witness statement of Hiroshi Kamitani, dated 5 October 2023, is that if the applicant contends that it should be allowed to register the applied trade mark, based on unregistered rights acquired through use predating the opponent’s earlier trade mark, then the proper course of action is to challenge the validity of the opponent’s earlier mark.³¹ It has not done so.

Likelihood of confusion

44. Whether there is a likelihood of confusion must be assessed globally, taking into account all relevant factors. These interdependent considerations include the principle that a lesser degree of similarity between the respective goods may be offset by a great degree of similarity between the respective trade marks. In the present case, as is necessary for all section 5(2)(a) claims, the marks are identical. I have found the goods to be similar to no more than a low degree. It is my understanding that there being identical marks and similar goods does not

³⁰ *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41

³¹ See Tribunal Practice Notice (“TPN”) 4 of 2009 – citing Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O/211/09.

automatically lead to a likelihood of confusion, and therefore success under the ground pleaded.

45. Although the marks are identical, and the goods have some similarity it remains necessary to consider whether the effect of those two requisite elements of the section 5(2)(a) ground cause there to be a likelihood of confusion. Will the average consumer assume that the respective goods of the parties, all sold by reference to the identical mark "Pioneer", come from the same or associated businesses. I must keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. I also consider it appropriate to take into account the factors that led to my finding similarity between the goods.

46. Although I recognise that the average consumer of the applicant's goods include professionals such as farmers, the average consumer of both parties' goods will be a member of the general public (above driving age). Given the generality of that large group, this is not a significant factor in my determining whether customer confusion is likely. More important is the level of attention in purchasing the parties' vehicles; this I have found to be a high level, since the goods will be bought infrequently and will entail substantial cost. The purchase will be well considered and may even entail research. However, the significance of this factor is not so great because the marks are identical visually, aurally and conceptually. There is nothing on the face of the marks to distinguish the goods. I recognise that it may well be that a trade mark for a vehicle may be deployed as a sub-brand, designating perhaps a particular vehicle type or model under a different, often more distinctive, house-mark. However, this consideration is not to inform the determination of an opposed trade mark application. My analysis must proceed on the basis that the marks at issue will serve as the sole identifier of origin.

47. I also take into account the distinctive character of the earlier mark, which for the goods at issue I accept is "unremarkable", with certainly no more than, and perhaps less than, a medium level on an inherent basis. I also take into account that I have found that the evidence fails to establish that the channels of trade are shared. These factors are important considerations. However, given the identical marks

and the similarity of the goods based on their both being vehicles, indeed both types of vehicles for leisure and entertainment (in a general sense) I conclude that there is a likelihood that use of the trade marks may confuse a member of the public purchasing such goods that the same or an associated undertaking is responsible. Therefore, there is a likelihood of direct confusion between the trade marks.

Conclusion

48. The opposition under section 5(2)(a) of the Act has been successful in its entirety. Therefore, subject to any successful appeal against my decision, the application will be refused registration.

Costs

49. As the opponent has been entirely successful, it is therefore entitled to a contribution for its costs based upon the scale published in Annex A of the Tribunal Practice Notice 1 of 2023.³² Applying this guidance, I award the opponent the sum of **£950**, which has been calculated as follows:

Official fees	£100
Preparing the notice of opposition and considering the counterstatement:	£250
Preparing evidence:	£600
Total:	£950

50. Accordingly, I hereby order **Honda Motor Co., Ltd.** to pay **Dethleffs GmbH & Co. KG.** the sum of **£950**. This sum is to be paid within twenty-one days of the expiry

³² As the opposition proceedings were commenced after 1 February 2023.

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 19th day of August 2024

**Sarah Wallace
For the Registrar**