

O-064-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO 960519**

**OF THE TRADE MARK:**

**GREENWHEEL**

**IN THE NAME OF**

**SHENZHEN GREENWHEEL ELECTRIC VEHICLE CO LTD**

**IN CLASS 12**

**AND THE APPLICATION FOR THE GRANTING OF PROTECTION THEREOF**

**IN THE UNITED KINGDOM**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 72372**

**BY**

**COLLECT CAR BV**

1) Shenzhen Greenwheel Electric Vehicle Co Ltd (Shenzhen) is the holder of the international registration for the trade mark **GREENWHEEL**. The United Kingdom was designated in respect of the international registration on 11 April 2011. The international registration was published, for opposition purposes, on 11 November 2011 for:

*automobiles; electric vehicles; cleaning trolleys; military vehicles for transport; vehicles for locomotion by land, air, water or rail; fork lift trucks; cycle cars; camping cars; motor homes; sports cars.*

The above goods are in class 12 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) Collect Car BV (Collect) filed a notice of opposition to the granting of protection of the registration. Collect relies upon sections 5(1), 5(2)(a), 5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act). The Act states:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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 earlier trade mark is protected, or

(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.

(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

3) In relation to all the grounds of opposition, Collect relies upon Community trade mark registration no 1561513 of the trade mark GREENWHEELS. The application for registration was filed on 23 February 2000 and the registration procedure was completed on 23 May 2001. The trade mark is registered for:

*vehicles;*

*rental of vehicles, garages and parking areas.*

The above goods and services are in classes 12 and 39 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

In relation to the grounds of opposition under sections 5(2)(b) and 5(3) of the Act, Collect relies upon Community trade mark registration no 1243476 of the trade mark:



The application for registration was filed on 15 November 1999 and the registration procedure was completed on 28 February 2001. The trade mark is registered for:

*vehicles;*

*rental of vehicles, garages and parking areas; transport of persons and goods.*

The above goods and services are in classes 12 and 39 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

4) As the trade marks had been registered for more than 5 years at the date of the publication of Shenzhen's trade mark, they are subject to the proof of use requirement under section 6A of the Act<sup>i</sup> and the Trade Marks (International Registration) Order 2008. Collect claims that it has made genuine use of both trade marks in the period from 12 November 2006 to 11 November 2011 (the material period for proof of use) in relation to all of the goods and services of the registrations. For the purposes of section 5(3) of the Act, it claims that both trade marks have reputations in relation to all of the goods and services.

5) Shenzhen filed a counterstatement in which it denies the grounds of opposition. It required Collect to furnish genuine use of the trade marks in respect of all goods and services.

6) Both parties filed evidence. Collect filed written submissions. Neither party requested a hearing.

**Evidence**

*Initial evidence of Collect – witness statement of David Tate of 11 July 2012*

7) Mr Tate is a trade mark attorney acting for Collect.

8) Mr Tate states that GREENWHEELS is used by Collect for car sharing services in the Netherlands. He states that the GREENWHEELS trade mark has been used by Collect’s wholly owned subsidiary, Greenwheels GmbH, in Germany for car sharing services.

9) Mr Tate describes car sharing as a form of car rental in the Netherlands and Germany.

10) Mr Tate states that GREENWHEELS was first used in the Netherlands by Collect for car sharing/rental services on 21 June 1995 and that the trade mark has been used continuously since then. He states that the trade mark GREENWHEELS was first used in Germany for car sharing/rental services in June 2004 and that it has been used continuously since then.

11) Mr Tate states that the estimated value of car sharing/rental services provided by Collect under the trade mark GREENWHEELS in the Netherlands since 21 June 1995 is approximately €97,170,000. The total value of the services provided in Germany is €21,197,000. Mr Tate gives the following turnover figures (in €000):

	2006	2007	2008	2009	2010	2011
Netherlands	6,529	7,684	8,961	8,973	9,647	10,414
Germany	4,209	3,050	2,527	2,105	1,920	1,686
Total	10,738	10,734	11,488	11,078	11,567	12,100

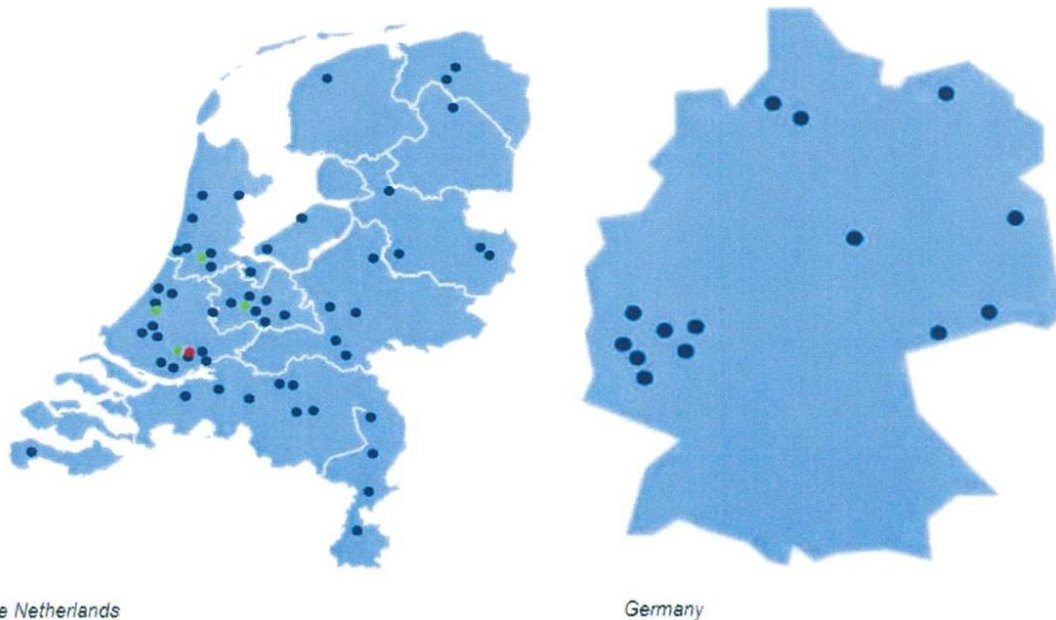
(Two of the totals, 2006 and 2010, given by Mr Tate are arithmetically incorrect, they have been corrected above.)

12) Mr Tate states that the estimated total spent on promoting car sharing/rental services under the trade mark GREENWHEELS in the Netherlands from 2003 – 2011 was €178,935.06. The total for Germany from 2005 – 2012 was €202,613.23. The annual breakdown was:

Netherlands                          Germany

2003 €	4,779.29	
2004 €	38,089.15	
2005 €	51,911.34	20,593.28
2006 €	17,630.23	37,966.01
2007 €	21,150.99	22,301.25
2008 €	18,826.16	68,133.51
2009 €	9,855.80	16,867.40
2010 €	7,161.00	14,873.55
2011 €	9,531.10	14,633.23
2012 €		7,245.00

13) Mr Tate states that Collect has 1,700 cars available in the Netherlands and 20,000 subscriptions. He states that there are 270 cars available in Germany and 7,000 subscriptions. Mr Tate includes a map to show the locations of where the cars are available:



14) Mr Tate exhibits the following:

DT1 – An article from dé Weekrant De Brug of 12 December 2007 with unattributed translation from Dutch. The article states that:

“The Greenwheels concept is based on people sharing a car and the accompanying parking place. The clearly recognisable bright green cars now stand in the 40 largest towns and cities in the Netherlands. In addition, through cooperation with the Dutch railways, cars are available at nearly all intercity stations. The „car sharer’ can reserve a car online. Access to the car is controlled by means of a smartcard. The car can be booked for a short period but also for a whole day.”

DT2 – A copy of a flyer, without indication of date, and an unattributed translation from Dutch. The flyer shows the composite trade mark.

DT3 – Material from Germany with unattributed translations:

- Press conference of 11 July 2007.
- Price list as of 1 January 2008.
- Advertisement with an offer expiring on 31 July 2010. Reference is made to “Greenwheels-CarSharing-Autos”.
- A transcript of a broadcast from WDR-TV on 13 May 2008. The transcript is headed “Ärger mit Car-Sharing” (trouble with car-sharing). It refers to the “car-sharing company, Greenwheels”. The broadcast includes: “ it would be better for customers to use the car hire service with which the car-sharing company cooperates. This is what Birger Holm, director of Greenwheels in Germany, would recommend”.

DT4 – Article from *International Herald Tribune* dated 5 July 2005. Included in the article is:

“But for thousands of people in the Netherlands – and hundreds of thousands worldwide – car sharing groups like Greenwheels have filled the gap between private car ownership and public transportation.....

....Private companies, including some of the giants of the rental car industry, like Hertz and Shell, are dabbling in commercial car-sharing....

Car rental companies want all their cars rented all the time. But car-sharing companies in Europe tend to view themselves more like savings banks whose currency is mobility.”

DT5 – A list of places in Germany and the Netherlands where GREENWHEELS cars are available.

DT6 – Articles with unattributed translations:

- *Consumentengids* (a Dutch magazine) for December 2008 about car sharing. Reference is made to GREENWHEELS being the best known car sharing company in the Netherlands. Included in the article is:

“The Vereniging voor Gedeeld Autogebruik (Association for Shared Car Use), the car-sharing companies’ umbrella organisation”.

- *ADAC Motorwelt* (a German magazine) for October 2008. Reference is made to “Greenwheels is Germany’s largest car-sharing company run by a sole proprietor”.

- *Die Welt* (German newspaper). The article is from 2008. It relates to car sharing in Germany. There does not appear to be any reference to GREENWHEELS in the article.
- Page 50 of the exhibit shows a price list for GREENWHEELS, the price list shows the composite trade mark.

DT7 – A copy of a 2007 Dutch promotional mailshot for GREENWHEELS.

A press release dated 23 April 2010 about an agreement between GREENWHEELS and NS (Dutch National Railways). NS “Business Card holders can use this card to rent a Greenwheels car on the larger NS Stations to travel to their end destination.....The Greenwheels cars can be opened with the NS business card. This way, business card holders have direct access to Greenwheels cars at railway stations and over 1250 on-street locations.....The invoice goes directly to their employer”.

DT8 – copies of invoices issued by Greenwheels GmbH in Germany. The composite trade mark appears on the invoices. The invoices were issued between 2007 and 2011.

DT9 – copies of invoices issued by Collect. The composite trade mark appears on the invoices. The invoices were issued between 2007 and 2011.

DT10 – translated versions of blank invoices. The invoices show a subscription fee and cost by time.

15) Mr Tate states that the total number of invoices issued in the Netherlands and Germany was:

2007	123,000
2008	132,000
2009	178,000
2010	193,000
2011	211,000

16) Exhibit DT11 contains the following:

- A printout from orangesplaash.blogspot.nl from July 2010 which relates to GREENWHEELS car sharing. GREENWHEELS is described as “the largest company that provides *autodelen* (car-sharing) services in the Netherlands”.
- A printout from AmsterdamTips.com downloaded on 11 July 2012, after the dates of application and publication of the international registration. The article is headed “Greenwheels Car Sharing Rental Scheme”. The article includes the following:

“Note, the major car rental firms will be cheaper for longer rental periods and (unlike car share schemes) will allow you to drop the car off in a different place”.

- A printout from Matbase downloaded on 11 July 2012, after the dates of application and publication of the international registration. The article is about “Greenwheels Carsharing”.
- A printout from MOMO “more options for energy efficient mobility through Car-Sharing” from June 2009. Reference is made to “Greenwheels (the largest Car-Sharing provider in the Netherlands and Amsterdam)”.
- An article headed “Dutch community car service Greenwheels” dated 21 December 2007. The article refers to the car users being charged per hour and there being a monthly subscription charge.
- An article from *Den Haag* of 10 May 2010. The article refers to an increase in car sharing locations in The Hague. Reference is made to GREENWHEELS as the biggest car sharing company in the Netherlands. The article states that the maximum number of members per car is fifteen.
- An article, without indication of date, from hollandtrade.com. The article includes the following:

“Although it sounds like traditional car-rental, the ethos is closer to that of public transport and is flexible and ultimately suited to short trips.”

- Pages from add-home.eu from April 2008. The pages relate to the cooperation between a building association in Hamburg and Greenwheels Gmbh for car sharing for the tenants of Wichernhof.
- Pages from greenwheels.com downloaded on 11 July 2012, after the dates of application and publication of the international registration.
- A screenshot without indication of date from info.nl. Info.nl describes itself as “the online partner of Greenwheels for optimising all Greenwheels services”.
- A screenshot without indication of date relating to the NS Business Card. Included in the screenshot is the advice that the card can be used for “renting an OV-fiets public transport bicycle or an NS-scooter or a Greenwheels car”.
- An article downloaded from *Wikipedia* on 11 July 2012 relating to car sharing. The article states:

“Carsharing differs from traditional car rentals in the following ways:

- Carsharing is not limited by office hours
- Reservation, pickup, and return is all self-service
- Vehicles can be rented by the minute, by the hour, as well as by the day



- Users are members and have been pre-approved to drive (background driving checks have been performed and a payment mechanism has been established)
- Vehicle locations are distributed throughout the service area, and often located for access by public transport
- Insurance and fuel costs are included in the rates
- Vehicles are not serviced (cleaning, fueling) after each use, although certain programs such as Car2Go continuously clean and fuel their fleet

Some carshare operations (CSOs) cooperate with local car rental firms to offer best value to their customers (in particular in situations where classic rental may be the cheaper option)."

The article refers to "Greenwheels in the Netherlands"

*Evidence of Shenzhen – witness statement of Sally Ann Shupke of 10 September 2012*

17) Ms Schupke is a trade mark attorney who is acting for Shenzhen.

18) Ms Schupke states that Shenzhen has used its trade mark in the United Kingdom. She states that "we attach marked "Exhibit 1" samples of such use in the UK taken from the Applicant's website ([www.greenwheeleev.com](http://www.greenwheeleev.com)) from which it should be noted that the text and product range are in English and directed at the UK market". The pages were downloaded on 6 September 2012. In relation to a claimed reputation of Shenzhen, Ms Schupke repeats in her statement part of what appears in the exhibit. The exhibit gives addresses in the United States of America and China. There is nothing in the exhibit which indicates any presence or trade within the United Kingdom.

19) The rest of the statement consists of submissions. In particular she submits that car rental services are completely different from the goods of the international registration.

*Witness statement of David Tate of 24 October 2012*

20) Exhibited at DT(2)1 is the following material:

- A screenshot, without an indication of date, from [peugeot.co.uk](http://peugeot.co.uk) promoting rental from Peugeot dealerships.
- A screenshot, without an indication of date, from [mercedes-benz.co.uk](http://mercedes-benz.co.uk) with the message "Welcome to Mercedes-Benz Leasing & Rental".
- A screenshot, without an indication of date, from [honda.co.uk](http://honda.co.uk) which gives details of Honda Contract Hire. The reader is advised that the "individually tailored contract gives you a car for an agreed period and mileage. At the

- end of that period you simply give the car back. All you have to do is insure the car and add petrol.... Fixed regular rentals together with our optional maintenance package make it easier to budget. You don't have to worry about reselling the car at the end of the agreement.”
- A screenshot, without an indication of date, from ford.co.uk. On the screen the words “[r]easons to hire a Ford Rental vehicle” appear.
  - A screenshot, without an indication of date, from toyota.co.uk. A page headed latest offers includes the following: “At Toyota, we want to help you with all aspects of choosing the right vehicles for your business. From affordable monthly rentals, to fixed cost motoring with no depreciation or disposal concerns, we’ve really thought of everything.”
  - Pages from “Motability Contract Hire Price Guide” for 1 October 2012 – 31 December 2012 from Vauxhall. There is a reference to fixed weekly rental. The following appears: “Our Motability New Car Contract Hire Scheme lets you drive a brand new Vauxhall in exchange for all or part of the Higher Rate Mobility Component of the Disability Living Allowance...”

21) Exhibited at DT(2)2 is a printout from genfluxexec.tumblr.com downloaded on 24 October 2012. There is no indication of from what jurisdiction the printout emanates. The article includes the following:

“However, the car sharing companies probably did not expect to see car makers want to get in on their game. But that is exactly what is happening as car makers see this business model as a way to build relationships with and make money of the wealthy young urban professionals who currently don't own a car.

BMW has teamed up with SIXT to offer DriveNow, which says it is aiming to have 1 million customers by 2020. Daimler has launched Car2Go. Both car makers refer to these offerings as mobility services.”

22) Exhibited at DT(2)3 are pages from Wikipedia downloaded on 24 October 2012 relating to Bundesverband CarSharing, the German industry association of the traditional car sharing organisations. Included in the pages is the following:

“The new car sharing companies formed by automobile makers car2go (Daimler AG), DriveNow (joint venture of BMW and Sixt) and Quicar (VW), who enter the car-sharing market by flooding a given city with hundreds of cars exclusively of their own brands, are not members of *bcs*”.

Also in the exhibit are pages from Wikipedia downloaded on 24 October 2012 about Car2Go, which is described as “a subsidiary of Daimler AG that provides carsharing services in several cities in Europe and North America”.

23) Exhibited at DT(2)4 are pages emanating from PR Newswire UK on 23 August 2012. The article refers to the increasing presence in the car sharing

market of vehicle manufacturers, leasing companies, transport operators and parking management companies. In addition to the car manufacturers already mentioned, Renault and Citroen are also mentioned.

24) Exhibited at DT2(5) are pages from an online question and answer session held on *The Guardian* website with Rachel Botsman on 14 June 2011. In a response to a question, Ms Botsman replies, inter alia, that in the past year Peugeot, BMW, Daimler and Volkswagen had all launched car sharing schemes, under the names Mu, DriveNow, Car2Go and Quicar respectively.

25) Exhibited at DT2(6) is an article from *The Independent* of 13 May 2011. The article relates to Volkswagen entering the car sharing business under the name Quicar. There are also references to the Mu and the DriveNow schemes of Peugeot and BMW respectively.

26) Exhibited at DT(2)7 is material relating to Mu by Peugeot. On page 33 the following appears: "Buy online credit and rent a vehicle, scooter, bike or accessory when you want". Other pages refer to the ability to rent these means of transport. Page 35 is a screenshot headed "Where can I rent a mobility solution". A page downloaded from whatcar.com, emanating from 4 February 2010, states that "Peugeot has launched a novel city based rental scheme to take advantage of its full range of vehicles available through dealers." The article advises that the products for hire will be collected from Peugeot dealers. An article from *The Guardian* of 10 July 2010 refers to "Peugeot's car club concept. Mu, mixes aspects of regular car hire and car clubs, and rents out bikes, scooters and even sports coupés at competitive prices". The article points out that users have to go to dealers and that there are no hourly rentals. The article states that "car club users need to do their sums to see if they would be better off with the likes of Hertz or even Mu". An article from *Mail Online* of 8 July 2010 also gives details of the Mu scheme.

***Proof of genuine use of the trade marks of Collect from 12 November 2006 to 11 November 2011***

27) In *Leno Merken BV v Hagelkruis Beheer BV* Case C-149/11 the Court of Justice of the European Union (CJEU) considered the issue of genuine use of a Community trade mark:

"29. It follows from that line of authority that there is „genuine use’ of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether there is

real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see *Ansul*, paragraph 43, *Sunrider v OHIM*, paragraph 70, and the order in *La Mer Technology*, paragraph 27).

30 The Court has also stated that the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not (see *Sunrider v OHIM*, paragraph 76).

31 That interpretation may be applied by analogy to Community trade marks since, in requiring that the trade mark be put to genuine use, Directive 2008/95 and Regulation No 207/2009 pursue the same objective.

32 Indeed, it follows both from recital 9 to the directive and from recital 10 to the regulation that the European Union legislature intended to make the preservation of the rights connected to the trade mark conditional upon it actually being used. As the Advocate General has pointed out in points 30 and 32 of her Opinion, a Community trade mark which is not used could obstruct competition by limiting the range of signs which can be registered as trade marks by others and by denying competitors the opportunity to use that trade mark or a similar one when putting onto the internal market goods or services which are identical or similar to those covered by the mark in question. Consequently, non-use of a Community trade mark also risks restricting the free movement of goods and services.

33 Account must none the less be taken, when applying by analogy to Community trade marks the case-law cited in paragraph 29 of this judgment, of the difference between the territorial extent of the protection conferred on national trade marks and that of the protection afforded Community marks, a difference which is in any event apparent from the wording of the provisions relating to the requirement for genuine use which apply to those two types of marks respectively.

34 Thus, on the one hand, Article 15(1) of Regulation No 207/2009 provides that, „[i]f, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use’. On the other, Article 10 of Directive 2008/95 lays down in essence the same rule in respect of national trade marks, whilst providing that they must have been put to genuine use „in the Member State’.

35 That difference between the two sets of trade mark rules as regards the territorial scope of „genuine use’ is also emphasised by Article 42(3) of Regulation No 207/2009. That provides that the rule set out in paragraph 2 of Article 42 – namely that where notice of opposition has been given, the applicant for a Community trade mark may require proof that the earlier Community trade mark has been put to genuine use in the Community – is also applicable to earlier national trade marks „by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community’.

36 It should, however, be observed that, as is apparent from the case-law referred to in paragraph 30 of this judgment, the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase „in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.....

.....44 It follows from the foregoing considerations that the territorial borders of the Member States should be disregarded in the assessment of „genuine use in the Community’ within the meaning of Article 15(1) of Regulation No 207/2009.

45 That interpretation is not undermined by either the Joint Statement referred to in paragraph 23 of this judgment, according to which „use which is genuine within the meaning of Article 15 in one country constitutes genuine use in the Community’, or the Opposition Guidelines of OHIM which contain in essence the same rule.

46 First, regarding the Joint Statement, it is settled case-law that, where a statement recorded in Council minutes is not referred to in the wording of a provision of secondary legislation, it cannot be used for the purpose of interpreting that provision (Case C-292/89 *Antonissen* [1991] ECR I-745, paragraph 18; Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 25; Case C-402/03 *Skov and Bilka* [2006] ECR I-199, paragraph 42, and Case C-356/05 *Farrell* [2007] ECR I-3067, paragraph 31).

47 Moreover, the Council and the Commission expressly acknowledged that limitation in the preamble to that Statement, according to which „since [t]he following statements of the Council and the Commission are not part of the legal text, they are without prejudice to the interpretation of that text by the Court.’

48 Second, it is to be noted that the OHIM Guidelines are not binding legal acts for the purpose of interpreting provisions of European Union law.

49 Nor can the Court accept the submission, made by some of the interested persons to have lodged observations in these proceedings, that the territorial scope of the use of a Community trade mark cannot under any circumstances be limited to the territory of a single Member State. That submission is based on Article 112(2)(a) of Regulation No 207/2009 pursuant to which it is possible, where the rights of the proprietor have been revoked on grounds of non-use, to convert a Community trade mark into a national trade mark application if, „in the Member State for which conversion is requested, the Community trade mark has been put to use which would be considered to be genuine use under the laws of that Member State’.....

50 Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as „genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.

51 As the Advocate General has observed in point 63 of her Opinion, it is only where a national court finds that, when account is taken of all the facts of the case, use in a Member State was insufficient to constitute genuine use in the Community, that it may still be possible to convert the Community trade mark into a national trade mark, applying the exception in Article 112(2)(a) of Regulation No 207/2009.

52 Some of the interested persons to have submitted observations to the Court also maintain that, even if the borders of the Member States within the internal market are disregarded, the condition of genuine use of a Community trade mark requires that the trade mark should be used in a substantial part of the Community, which may correspond to the territory of a Member State. They argue that such a condition follows, by analogy, from Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 28, Case C-328/06 *Nieto Nuño* [2007] ECR I-10093, paragraph 17, and Case C-301/07 *PAGO International* [2009] ECR I-9429, paragraph 27).

53 That argument cannot be accepted. First, the cases in question concern the interpretation of provisions relating to the extended protection conferred on trade marks that have a reputation or are well known in the Community or in the Member State in which they have been registered. However, the requirement for genuine use, which could result in an

opposition being rejected or even in the trade mark being revoked, as provided for in particular in Article 51 of Regulation No 207/2009, pursues a different objective from those provisions.

54 Second, whilst it is reasonable to expect that a Community trade mark should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market (see, by analogy, with regard to the scale of the use, *Ansul*, paragraph 39).

55 Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).

56 With regard to the use of the Community trade mark at issue in the main proceedings, the Court does not have the factual information necessary to enable it to provide the referring court with more specific guidance as to whether or not there is genuine use of that trade mark. As can be seen from the foregoing considerations, it is for the referring court to assess whether the mark in question is used in accordance with its essential function and for the purpose of creating or maintaining market share for the goods or services protected. That assessment must have regard to all the facts and circumstances relevant to the main proceedings, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.

57 The answer to the questions referred is therefore that Article 15(1) of Regulation No 207/2009 must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to „genuine use in the Community’ within the meaning of that provision.

58 A Community trade mark is put to „genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market

share within the Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

28) The evidence shows use of the two trade marks for car sharing services. There is not the slightest indication that Collect is creating or maintaining markets for vehicles, garages, parking areas or transportation of persons and goods. Certain of these goods and services are required for the delivery of car sharing services but this is not the same as maintaining or creating a market for the services; no more than a courier service is maintaining or creating a market for vans, motor bicycles or bicycles or a department store is maintaining or creating a market for display units, electric lighting or lifts.

29) In order to be able to consider whether there has been genuine use of the trade marks of Collect, it is necessary to decide upon what would be a fair specification. The nature of the services has to be considered in order to decide whether there has been genuine use as per the judgment of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV*. The judgment makes it clear that use, even if not sham use, will not necessarily equate to genuine use of a Community trade mark<sup>ii</sup>; the quantum has to be considered in relation to the goods and services within the context of the European Union.

30) There is no evidence that Collect is involved in the services of sharing vehicles other than cars; the specifications cover rental of vehicles at large. In the evidence Collect conflates car sharing with car rental at large. Car sharing is a form of car rental<sup>iii</sup>, however, car rental covers a number of areas as the evidence of Collect shows eg car leasing, traditional car rental as with the likes of Hertz and car sharing. The evidence of Collect gives descriptions of car sharing schemes. The printout from Amsterdam Tips at DT11 makes clear the difference between the car sharing scheme of Collect and the services provided by the major car rental firms:

“Note, the major car rental firms will be cheaper for longer rental periods and (unlike car share schemes) will allow you to drop the car off in a different place”.

In the same exhibit the article downloaded from *Wikipedia* identifies the differences:

“Carsharing differs from traditional car rentals in the following ways:

- Carsharing is not limited by office hours
- Reservation, pickup, and return is all self-service



- Vehicles can be rented by the minute, by the hour, as well as by the day
- Users are members and have been pre-approved to drive (background driving checks have been performed and a payment mechanism has been established)
- Vehicle locations are distributed throughout the service area, and often located for access by public transport
- Insurance and fuel costs are included in the rates
- Vehicles are not serviced (cleaning, fueling) after each use, although certain programs such as Car2Go continuously clean and fuel their fleet”

The entry also states:

“Some carshare operations (CSOs) cooperate with local car rental firms to offer best value to their customers (in particular in situations where classic rental may be the cheaper option).”

The transcript of a broadcast from WDR-TV exhibited at DT3 includes: “ it would be better for customers to use the car hire service with which the car-sharing company cooperates. This is what Birger Holm, director of Greenwheels in Germany, would recommend”. So Greenwheels itself clearly distinguishes between its services and a car hire service.

31) The article from the *International Herald Tribune* exhibited at DT4 states

“But for thousands of people in the Netherlands – and hundreds of thousands worldwide – car sharing groups like Greenwheels have filled the gap between private car ownership and public transportation.....

....Private companies, including some of the giants of the rental car industry, like Hertz and Shell, are dabbling in commercial car-sharing....

Car rental companies want all their cars rented all the time. But car-sharing companies in Europe tend to view themselves more like savings banks whose currency is mobility.”

32) The description of the use shown must not be pernickety<sup>iv</sup>. It is necessary to consider how the relevant public, would describe the goods and services<sup>v</sup>. The General Court (GC) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* held:

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is

registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of „part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but

the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

33) Car sharing schemes have particular characteristics and are a clear category of service. The closest that Collect’s business comes to traditional car hire is the ability of NS Business Card holders to use its services. However, there is no evidence as to the extent of this business and use by NS Business Card holders will still fall into the category of a car sharing scheme rather than traditional car hire. The use of the card effectively makes the card holders ad hoc members of the scheme. To describe the services as car rental would take into account categories of services in which Collect has no involvement eg car leasing. An appropriate specification, to consider the issue of **whether** there has been genuine use, is *car sharing services*.

34) There has been use of the trade marks in Netherlands and Germany. In the Netherlands, Collect is the largest car sharing scheme. Owing to the presence of the composite trade mark upon the cars used as part of the scheme, the service will have been brought to attention to many. In both the Netherlands and Germany, Collect has a presence at railway stations and so the service is likely to be brought to the attention of rail users. Mr Tate states that Collect has 20,000 subscriptions in the Netherlands and 7,000 subscriptions in Germany; Mr Tate made his witness statement in July 2012. The presence of Collect in Germany is more limited than the presence in the Netherlands. In *Leno Merken BV v Hagelkruis Beheer BV* the CJEU stated:

“50 Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as „genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

The statement above must be considered in the context of the questions with which the CJEU was seised; ie use in a single member state. Consequently, it is not a sequitur that use in two member states will amount to genuine use. The market for car sharing services pertains to all member states. Outside of the Netherlands, the use of the trade marks has been on a lesser scale in Germany; there has been no use in other member states. The use has been over a number of years and has been consistent use. It has been frequent and regular. The

use has been clear and in relation to third parties. The use has been of both trade marks. Although the use in Germany is not on a scale with the use in Netherlands, it is necessary to take into account that Germany is the largest member state. **Taking into account all “the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity”, Collect has established genuine use of its two Community trade marks in respect of car sharing services.**

*Section 5(3) of the Act and reputation*

35) Reputation of a Community trade mark in one member state can be sufficient to establish the requisite reputation for the purpose of section 5(3) of the Act<sup>vi</sup>. One of the requirements of section 5(3) of the Act is the establishment of a link in the mind of the average consumer of the goods or services<sup>vii</sup>. Collect has had no business in the United Kingdom. The borders of the Netherlands and Germany do not lend themselves to splash over of reputation to the United Kingdom; as might happen with the Republic of Ireland and the United Kingdom. A further hurdle is that the services have been supplied in Dutch and German, languages that are not commonly understood in the United Kingdom. As in the United Kingdom there is no reputation for the services of Collect, the average consumer will make no link to the trade mark of Collect as he or she will have no knowledge of it. Consequently, the ground of opposition under section 5(3) of the Act must fail.

36) Owing to the lack of reputation in the United Kingdom, Shenzhen can gain no advantage, let alone an unfair advantage in the United Kingdom and there can be neither dilution nor tarnishment of the trade mark of Collect in the United Kingdom, as it has no reputation to dilute or tarnish here. Moreover, Collect has put in no evidence to support a claim that the advantage would be unfair; unfairness is part and parcel of the consideration<sup>viii</sup>. In *L’Oreal SA and others v Bellure NV and others* Case C-487/07 the CJEU considered tarnishment:

“40 As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.”

The nature of the goods of Shenzhen and the services of the earlier registrations are not such that any tarnishing would arise from use on the goods of the international registration.

37) A requirement of section 5(3) is the establishment of a change or potential change of economic behaviour of the consumer<sup>ix</sup>; either for the services of the opponent, in the case of dilution or tarnishment, or of the goods of the applicant, in the case of unfair advantage. As Collect has no reputation in the United Kingdom there would be no change in economic behaviour.

**38) Consequently, the ground of opposition under section 5(3) of the Act cannot succeed and, therefore, it is not necessary to consider whether Collect has the necessary reputation for the purposes of section 5(3) of the Act. (Equally, Collect cannot benefit from any claim to enhanced distinctiveness through use, as its trade marks have not been used in the United Kingdom.)**

#### ***Section 5(1) of the Act***

39) As there has been no genuine use of the GREENWHEELS trade mark in respect of the class 12 goods of the earlier registration, Collect cannot rely on the class 12 specification. **Consequently, there are no identical goods and the ground of opposition under section 5(1) of the Act must fail.**

#### ***Likelihood of confusion – section 5(2)(a) and (b) of the Act***

40) As there is no device element, the better case of Collect will lie with its word only trade mark, **GREENWHEELS**.

41) In *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00 the CJEU considered when trade marks were identical. It stated:

“54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that 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.”

The difference between the respective trade marks is the letter s at the end of Collect’s trade mark. The letter s is constantly used to indicate plurality or possession. The presence of the s at the end of the international registration is so insignificant that the difference with the trade mark of Collect may go unnoticed by an average consumer; however careful and discerning. **The respective trade marks are identical.**

#### ***Average consumer and the purchasing process***

42) The average consumer and the purchasing process are analysed as they affect the likelihood of confusion where there are differences between trade

marks eg small differences may have a significant effect where the goods or services are purchased as a result of a particularly careful and educated purchasing decision. As the respective trade marks are identical, nothing can turn upon the nature of the average consumer and the purchasing process; he or she has nothing with which to distinguish the trade marks.

### *Comparison of goods and services*

43) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade<sup>x</sup>”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>xi</sup>. Consideration should be given as to how the average consumer would view the goods and services<sup>xii</sup>. In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch) at paragraph 12 Floyd J stated:

“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.”

The class of the goods in which they are placed may be relevant in determining the nature of the goods or services<sup>xiii</sup>. In relation to the consideration of services, Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

44) In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary<sup>xiv</sup>. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed<sup>xv</sup>. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 GC explained when goods are complementary:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and

Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

**45) Taking into account the nature of car sharing schemes, there are no points of conjunction within the parameters of the case law between *car sharing services and cleaning trolleys; military vehicles for transport; vehicles for locomotion by air, water or rail; fork lift trucks; camping cars; motor homes*. These goods are not similar to the services of Collect.**

46) *Automobiles, electric vehicles, vehicles for locomotion by land, cycle cars; sports cars* are all vehicles, or terms that include vehicles, that could be used for *car sharing services*. The goods do not require the services but the services require the goods. Consequently, there is not mutual dependency but there is a dependency on the part of the services. There is a degree of complementarity.

47) The evidence shows that car sharing services are viewed as an alternative to purchasing a vehicle. Consequently, the goods rehearsed in paragraph 46 are in competition with the services of Collect.

48) The end users of the goods of paragraph 46 and the services of Collect are persons seeking transportation by means of vehicle, they are the same. The purposes of the goods and services are the same, transportation by vehicle.

**49) The goods rehearsed in paragraph 46 are similar to car sharing services.**

*Conclusion – likelihood of confusion.*

50) It is a requisite for likelihood of confusion that goods and services are similar. Consequently, there can only be a likelihood of confusion in respect of the goods rehearsed in paragraph 46.

51) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>xvi</sup>. In this case the respective trade marks are identical. Owing to this identity there is nothing to allow the average consumer to distinguish the respective trade marks. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion<sup>xvii</sup>. 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<sup>xviii</sup>. In determining the distinctive character of a 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<sup>xix</sup>. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97 the CJEU held that “the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion”. The earlier trade mark has no reputation in the United Kingdom. GREENWHEELS is allusive to a transport service that is environmentally friendly. However, it is not an allusiveness that is so obvious that it greatly affects the inherent distinctiveness of the trade mark. GREENWHEELS has a reasonable degree of distinctiveness for *car sharing services*. The evidence of Collect shows that car manufacturers have entered the car sharing market, if under different trade marks. This shows that the connection between car sharing services and automobiles is not a mere legal construct from the case law with no basis in commercial reality. **There is a likelihood of confusion in respect of:**

***automobiles, electric vehicles, vehicles for locomotion by land, cycle cars; sports cars.***

**The application may proceed to protection for: *cleaning trolleys; military vehicles for transport; vehicles for locomotion by air, water or rail; fork lift trucks; camping cars; motor homes.***

If it had been decided that the respective trade marks are not identical, they are so similar that the case in respect of section 5(2)(b) of the Act would have been as strong as the case under section 5(2)(a) of the Act.

### **Costs**

50) As each side has achieved a measure of success, each will bear its own costs.

**Dated this 11th day of February 2013**

**David Landau  
For the Registrar  
the Comptroller-General**



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<sup>i</sup> Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

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

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

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

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

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<sup>ii</sup> Also see *Reber Holding GmbH & Co KG v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle) (HABM)* Rechtssache T-355/09, where the General Court decided that the quantum of a national trade mark was not sufficient for the use to be considered genuine use.

<sup>iii</sup> In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch)<sup>iii</sup> Floyd J stated:

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

To exclude car sharing from rental of vehicles would be to strain the language unnaturally to produce a narrow meaning.

<sup>iv</sup> *Animal Trade Mark* [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a picky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

<sup>v</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the *Premier Brands* case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor

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seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is-- how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

<sup>vi</sup> *PAGO International GmbH v Tirol Milch registrierte Genossenschaft mbH* Case C-302/07.

<sup>vii</sup> *Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07.

<sup>viii</sup> *L'Oreal SA v Bellure NV* [2010] RPC 23, *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753 and *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2012] EWCA Civ 24.

<sup>ix</sup> *Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07 paragraph 77.

<sup>x</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>xi</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>xii</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

"In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use"

<sup>xiii</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

<sup>xiv</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

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<sup>xv</sup> He considered that the following should be taken into account when assessing the similarity of goods and/or services:

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

<sup>xvi</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>xvii</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>xviii</sup> *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

<sup>xix</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.