

O-009-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2616419
BY
CHEVRON CARS LIMITED
TO REGISTER THE TRADE MARK**

CHEVRON HERITAGE

IN CLASS 12

AND

**THE OPPOSITION THERETO
UNDER NO 104145
BY
CHEVRON RACING TEAM LIMITED**

Background, pleadings and the earlier opposition proceedings

1. Chevron Cars Limited (“the applicant”) has applied to register the trade mark CHEVRON HERITAGE in Class 12 for *Vehicles; apparatus for locomotion by land, air or water; road and racing vehicles; parts and fittings for all the aforesaid goods; but not including brake linings or fans for motor vehicles*. The application was filed on 2 April 2012.

2. Chevron Racing Team Limited (“the opponent”) objects to CHEVRON HERITAGE achieving registration because it claims there would be a likelihood of confusion with two of its own trade mark registrations. These are:

(i) 2239479

CHEVRON

Class 12: Road and racing vehicles; parts and fittings for all the aforesaid goods; all in Class 12, but not including brake linings or fans for motor vehicles.

Filed 15 July 2000; registration procedure completed 22 December 2000.

(ii) 2239477



Class 12: Road and racing vehicles; parts and fittings for all the aforesaid goods; all in Class 12, but not including brake linings or fans for motor vehicles.

Filed 15 July 2000; registration procedure completed 6 April 2001.

3. The section of the Trade Marks Act 1994 (“the Act”) under which the opponent makes its opposition is section 5(2)(b). This states:

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

(a) ...

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

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

Earlier trade marks are defined in section 6 of the Act:

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

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

(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK),

(ba) a registered trade mark or international trade mark (UK) which-

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

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

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry.”

4. Both of the trade marks upon which the opponent relies are registered trade marks which have dates of application for registration earlier than that of the trade mark in question. The trade mark in question is the applicant’s application which I set out in paragraph 1 of this decision. I say this because references have been made by the applicant in its counterstatement to earlier opposition proceedings between the parties, in which the current applicant successfully opposed¹ three trade mark applications made by the current opponent. The opposition was successful on the basis that registration of the current opponent’s applications for the marks CHEVRON B8, CHEVRON B16 and CHEVRON B19 (in class 12), made in August 2007, was liable to be prevented under the law of passing off on the basis of the current applicant’s rights in the unregistered sign CHEVRON.

¹ The decision reference is BL O/364/09, dated 25 November 2009. It was given by Allan James, acting for the Registrar of Trade Marks, and was upheld on appeal to the Appointed Person.

5. The applicant's counterstatement in the current proceedings states:

"It is the view of the Applicant that the objection is totally vexatious with no justification. The Applicants – Chevron Cars Limited – have been using the trademark permanently since 1983. It is merely the wish of the applicant (Chevron Cars Limited) to extend the use of the trademark in to a sister company – namely Chevron Heritage Limited..."

Having made references to the earlier opposition outcome, the counterstatement concludes:

"It is therefore clear that in the current application, Chevron Cars Limited are the senior user of the Chevron Trademark and that the Opponent has no grounds for opposition."

6. In relation to whether the applicant required the opponent to prove genuine use of its earlier marks, the applicant replied "not applicable"². The relevance of this is that the opponent is not required to file evidence to prove that it has used the marks it relies upon, which means that the earlier marks can be considered across the full range of goods for which they are registered. The Tribunal informed the parties at the start of the proceedings that they did not need to re-file evidence from the earlier proceedings, but should advise the Tribunal if they wished to adopt all or part of the evidence filed in the earlier proceedings. The applicant did not file evidence and did not adopt any of the evidence it filed in the earlier proceedings. The opponent filed brief evidence, but did not request adoption of any of its earlier evidence.

7. The earlier opposition was based upon section 5(4)(a) of the Act. This opposition is based upon section 5(2)(b). The earlier proceedings, in which the current applicant was found to be the senior user of the sign CHEVRON, did not involve the opponent's two earlier registrations. These remain *prima facie* valid as trade mark registrations, as per section 72 of the Act, which states:

"In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be *prima facie* evidence of the validity of the original registration and of any subsequent assignment or other transmission of it."

8. Since the opponent's two trade marks are both earlier (as per section 6(1)(a)) and are deemed to be valid (section 72), they may be relied upon for its opposition under section 5(2)(b) of the Act. I will say more about this later in this decision. In view of the stance it takes in the counterstatement, it is of no surprise that the applicant is silent as to whether there is similarity of goods and marks. Although it has not denied any similarity and whether there is a likelihood of confusion, this decision will address those issues in full.

9. The opponent is represented by trade mark attorneys and the applicant is self-represented. Neither party opted to be heard on the substantive merits of the

² In answer to question 7 on statutory form TM8 (notice of defence and counterstatement).

opposition. The applicant filed a brief letter as submissions in lieu of a hearing, which reiterated the content of its counterstatement. The opponent did not file written submissions in lieu of a hearing, but did file submissions during the evidence rounds, along with brief evidence, which I shall now summarise.

10. Helen Bashford-Malkie is a director of the opponent. She states that, until recently, she was Chair of the British Women Racing Driver's club and is Cheshire Business Ambassador and Cheshire Business Leader, representing the Chevron brand as an historic racing car manufacturer. Ms Bashford-Malkie gives some information about the historic nature of Chevron as a racing car brand:

- Derek Bennett started the Chevron range of cars in 1965, making about 900 cars until his death in 1978;
- Derek Bennett's company, "Derek Bennett Engineering Ltd manufacturers of Chevron cars & Chevron Racing Team Ltd", was liquidated in 1980.
- The opponent bought some of the assets of the liquidated company.
- In the 1980s, historic racing became popular and Bennett Chevrons were eligible to race in Historic Sports Car Club events.
- Vin Malkie and Ms Bashford-Malkie "continued to build their business" (there are no dates given) and maintain the name of the Chevron marquee by providing parts manufacture, car rebuilds, restoration and race preparation and news magazines.
- Chevron's significance today is as a British motor racing heritage brand.
- A print out from the applicant's website (exhibit HBM1) refers to the applicant's sister company, Chevron Heritage Limited, handling all aspects of the 'historic' business, which relates to Chevron cars built before 2005.

Decision

11. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Average consumer and purchasing process

12. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. Although the pleadings and evidence show that both parties are involved in the vintage motor racing market, the assessment of the nature and purchasing behaviour of the average consumer is to be carried out according to the notional scope of the parties' specifications. The average consumer for vehicles is the general public (legally able to drive). Purchasing a vehicle is an expensive, considered process and one to which a relatively high level of attention will be paid. This is particularly so where racing vehicles are concerned. The purchase is visual, in the research and the examination of the vehicle, although I bear in mind that there will also be an aural aspect (e.g. during discussion with a dealer or vendor).

Comparison of goods

13. The specifications of the opponent's two trade marks are the same. As said earlier, the opponent's specification can be considered for what it notionally covers, not what the mark has actually be used upon, because the applicant has not put the opponent to proof of use of its marks. I show below the competing specifications of the parties' marks:

Opponent	Applicant
<i>Road and racing vehicles; parts and fittings for all the aforesaid goods; all in Class 12, but not including brake linings or fans for motor vehicles.</i>	<i>Vehicles; apparatus for locomotion by land, air or water; road and racing vehicles; parts and fittings for all the aforesaid goods; but not including brake linings or fans for motor vehicles.</i>

14. The opponent's specification is, effectively, replicated within the applicant's specification; consequently, the applicant's *road and racing vehicles; parts and fittings for all the aforesaid goods* are identical.

15. As per the judgment of the General Court ("GC") in *Gérard Meric v OHIM* Case T-133/05, goods and services can be considered as identical when the goods of the earlier mark are included in a more general category, included in the specification of the trade mark application. Vice versa, if the goods or services of the application are included in a more general category included in the specification of the earlier mark, they must be identical. Applying this to the parties' specifications, the applicant's *vehicles* are identical to the opponent's *road and racing vehicles*, because the latter is included within the former. The applicant's *apparatus for locomotion by land* is identical to the opponent's *road vehicles*, because the latter is included within the former.

16. This leaves the applicant's *apparatus for locomotion by air or water*. The opponent has cover for racing vehicles at large (i.e. not limited to road racing vehicles). All vehicles have the capacity to be raced. The goods are identical.

17. In summary, all the applicant's goods are identical to the opponent's goods. I note that the applicant made no admission or denial in its counterstatement, regarding similarity of goods.

Comparison of trade marks

18. The opponent's word-only mark is the closest of its two marks when compared with the applicant's mark, because there is no additional stylisation. I will start by comparing this mark.

19. The marks to be compared are:

Opponent's marks	Applicant's mark
CHEVRON	CHEVRON HERITAGE

20. The authorities cited earlier in this decision direct that, in making a comparison between the marks, I must compare each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details, as per *Sabel BV v Puma AG*, paragraph 23:

"That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their dominant and distinctive components."

21. There is a good level of visual and aural similarity between the marks because the sole element of the opponent's mark, CHEVRON, is the first of the two words comprising the applicant's mark. Not only does CHEVRON form half of the applicant's mark, it is the first element which will be seen and spoken. This gives it some dominance over HERITAGE. Conceptually, the two marks share the meaning of chevron, which is one or more 'stacked' Vs, such as those which appear on road signs warning of bends in the road. The applicant's mark has the added concept provided by the word HERITAGE, which evokes something of historical value, inherited or transmitted for future posterity. Overall, there is a good deal of similarity between the parties' marks.

Distinctiveness of the earlier mark

22. I need to consider the distinctive character of the opponent's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion³. The distinctive character of a trade mark must be assessed

³ *Sabel BV v Puma AG* [1998] RPC 199.

by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁴. The opponent's evidence lacks any specificity as to when, how and in relation to what goods the opponent has used its mark, so I have only the inherent position to consider. The word CHEVRON, in relation to vehicles, has only the slightest of allusive qualities; it might allude to a sharp bend on a racing track, but does not describe any characteristic of vehicles. The mark CHEVRON, for the opponent's goods, has a reasonably high degree of inherent distinctive character.

Likelihood of confusion

23. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. It also includes the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). In these proceedings, I have found that the parties' goods are identical.

24. A factor which I should consider is the 'beginnings of marks' rule of thumb, which allows for the propensity of the average consumer to notice, particularly, the beginnings of marks because that is what is seen or heard first. It is a rule of thumb, and it does not always follow, but, in the current case, the position of CHEVRON as the first of the two words in the applicant's mark is important. The two words, Chevron and Heritage, do not 'hang together' as a composite phrase, such as an adjective qualifying a noun. Each word has an independent role to play in the applicant's mark.

25. In *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, the CJEU stated:

"29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an

⁴ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.

37 Accordingly, the reply to the question posed must be that Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.”

26. The applicant's mark is different to the opponent's mark but it has the identical distinctive element in common: CHEVRON. I, of course, bear in mind that the assessment means that I should not simply take just the CHEVRON component of the applicant's mark and compare it with CHEVRON (the opponent's mark). It is an assessment of the whole mark. Making that assessment, I consider that CHEVRON retains an independent role in the applicant's mark. In *Aveda Corporation v. Dabur India Limited* [2013] EWHC 589 (Ch), Arnold J said, at paragraph 45:

"I entirely accept the basic proposition which the Court of Justice has repeated many times, namely that the assessment of likelihood of confusion must be made by considering and comparing each of the signs as a whole. As the Court of Justice recognised in *Medion v Thomson*, however, there are situations in which the average consumer, while perceiving a composite sign as a whole, will recognise that it consists of two signs one or both of which has a significance which is independent of the significance of the composite whole. Thus when the well-known pharmaceutical company Glaxo plc acquired the well-known pharmaceutical company Wellcome plc, the average consumer of pharmaceutical goods confronted with the composite sign GLAXO WELLCOME or GLAXOWELLCOME would perceive the significance of both the whole and its constituent parts and conclude that this was an undertaking which combined the two previously separate undertakings (see *Glaxo Group Ltd v Glaxowellcome Ltd* [1996] FSR 388). The essence of the Court of Justice's reasoning in *Medion v Thomson* is that an average consumer of leisure electronic products confronted with the composite sign THOMSON LIFE could perceive both the whole and its constituent parts to have significance and thus could be misled into believing that there was a similar kind of connection between the respective undertakings.

27. As well as its independent role within the mark, CHEVRON is also the dominant and distinctive element of the applicant's mark. It is the first word in the mark. CHEVRON has a significance of its own within the composite mark CHEVRON HERITAGE: the significance is that CHEVRON will be perceived as a 'house' or company mark. Heritage, in the context of the goods, is descriptive, denoting cars with a historical significance. Indeed the evidence filed by the opponent, showing the applicant's website, indicates that this is how the applicant envisages its mark will be used. In my view, as per paragraph 31 of *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, the average consumer is likely to believe that the goods derive from companies which are linked economically; alternatively, that the HERITAGE part denotes an extension to the CHEVRON brand. Either way, this means that there is a likelihood of confusion. I say this despite the high level of attention which will be paid to the purchase of the goods. A high level of attention may lessen the likelihood of imperfect recollection. However, the situation here is that the average consumer will notice that there is a difference between the marks and so will not imperfectly recall them; but, they will put the point of similarity (CHEVRON) down to the marks, for identical goods, being another brand of the same company or a linked company, as explained above.

28. I said at the beginning of this decision that the opponent's earlier registrations are valid by virtue of section 72 of the Act, and may be relied upon for the purposes of an opposition under section 5(2)(b) of the Act. In the previous proceedings, the current applicant was able to oppose applications to register the Chevron B- marks because it was found to have senior rights in CHEVRON, although the applicant had not registered CHEVRON as a trade mark. The playing field in these proceedings is very different. Whilst the present applicant was been found in other proceedings to have certain rights in CHEVRON which enabled it to prevent the registration of the applications which it had opposed in those proceedings, those rights do not extend to the automatic right to register the mark CHEVRON. In *Ion Associates Ltd v Philip*

*Stainton and Another*⁵, the applicant, facing an opposition under section 5(2)(b), considered that its unregistered rights ought to mean that it had the right to register its mark. The Appointed Person, Ms Anna Carboni said:

“Even if the evidence were sufficient to establish the existence of an earlier right within a locality, of the sort recognised under article 6(2), that provision is about the owner of such a right being able to continue using it notwithstanding the registration of a national trade mark by a third party. As implemented in the Act, section 11(3) could be relied on to defend an action for infringement of a UK trade mark if, say, the defendant owned a local passing off right. I agree with the hearing officer that there is nothing in either article 6(2) (or, I would add, section 11(3)) to assist the Applicant in the second step of the argument to the effect that the owner of such a locally based right should itself be entitled to register the mark underlying its earlier right.”

29. Ms Carboni’s decision was referred to in the Registrar’s Tribunal Practice Notice 4/2009:

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

Even if the present applicant had had its own earlier registered trade mark which predated the opponent’s registrations, this still would not have assisted it; the same Tribunal Practice Notice states:

“1. A number of counterstatements in opposition and invalidation actions have sought to introduce as a defence that the applicant for registration/registered proprietor has a registered trade mark (or trade mark application) for the same or a highly similar trade mark to that which is the subject of the proceedings that predates the earlier mark upon which the attacker relies.

2. Sections 5(1) and 5(2) of the Act turn upon whether the attacker has an earlier trade mark compared to the mark under attack, as defined by section 6

⁵ BL O/211/09.

of the Act. Whether the applicant for registration/registered proprietor has another registered trade mark (or trade mark application) that predates the earlier mark upon which the attacker relies cannot affect the outcome of the case in relation to these grounds.

3. The position was explained by the Court of First Instance in *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) T-269/02*:

"24 Nor did the applicant claim, and even less prove, that it had used its earlier German mark to obtain cancellation of the intervener's mark before the competent national authorities, or even that it had commenced proceedings for that purpose.

25 In those circumstances, the Court notes that, quite irrespective of the question whether the applicant had adduced evidence of the existence of its earlier German mark before OHIM, the existence of that mark alone would not in any event have been sufficient reason for rejecting the opposition. The applicant would still have had to prove that it had been successful in having the intervener's mark cancelled by the competent national authorities.

26 The validity of a national trade mark, in this case the intervener's, may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned (*Case T 6/01 Matratzen Concord v OHIM - Hukla Germany (MATRATZEN) [2002] ECR II 4335, paragraph 55*). Moreover, although it is for OHIM to ascertain, on the basis of evidence which it is up to the opponent to produce, the existence of the national mark relied on in support of the opposition, it is not for it to rule on a conflict between that mark and another mark at national level, such a conflict falling within the competence of the national authorities."

30. An opposition raised under Section 5(2) operates on the basis of the 'first to file' UK trade mark registration system. The opponent got there first. As matters stand, its registrations are valid and may be relied upon to oppose a later application. I have found that there would be a likelihood of confusion with the opponent's earlier registration for the word CHEVRON. There is no need to look at its other registration. The opposition succeeds.

Outcome

31. The opposition succeeds. The application is to be refused.

Costs

32. The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. The opponent's evidence was very brief and did not assist me in finding of a likelihood of confusion, an assessment which I have made on a mark-for-mark basis. Consequently, I will not make an award for the opponent's evidence, but will make

an award as a contribution towards the cost of making the opposition and filing its submissions, which were brief (aside of citing standard case law):

Preparing a statement and considering the counterstatement	£200
Opposition fee	£200
Written submissions	£150
Total:	£550

33. I order Chevron Cars Limited to pay Chevron Racing Team Limited the sum of £550. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of January 2014

**Judi Pike
For the Registrar,
the Comptroller-General**