

O/761/22

TRADE MARKS ACT 1994

CONSOLIDATED
PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003590769

BY MAKAI YACHTS LTD

TO REGISTER THE FOLLOWING MARK (SERIES OF THREE):



IN CLASS 12

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000425298

BY OMEGA OTOMOTIV SANAYI VE TICARET LIMITED SIRKETI

AND

IN THE MATTER OF APPLICATION NO. UK00003598967

BY MAKAI YACHTS LTD

TO REGISTER THE FOLLOWING MARK:

MAKAI

IN CLASS 12

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000425305

Background and pleadings

Lead case: OP000425298

1. On 5 February 2021, MAKAI Yachts Ltd (referred to in these consolidated proceedings as “Party B”) applied to register the trade mark shown below (a series of three) – No. UK00003590769 – and the application was published for opposition purposes on 2 April 2021.



2. The registration is sought for the following goods:

Class 12 Fishing boats; Hydrofoils being boats; Leisure boats; Boats; Pleasure boats; Recreational jet boats; Ski boats; Vessels [boats and ships].

3. Omega Otomotiv Sanayi Ve Ticaret Limited Sirketi, (referred to in these consolidated proceedings as “Party A”) opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application and is reliant upon the trade marks and the goods detailed below.
4. Trade mark No. UK00003305414 (“the first earlier mark”), filed on 20 April 2018 and registered on 12 October 2018.



- Class 7 Air filters and oil filters for land vehicles; radiators for vehicle engines; radiators for vehicles; parts and fittings for any of the aforesaid goods.
- Class 9 Vehicle batteries; vehicle instrumentation namely tire pressure gauges, temperature gauges, water gauges, exhaust gas temperature gauges, petrol gauges, fuel gauges, speedometers; parts, fittings and components for vehicle instrumentation systems.
- Class 11 Vehicle lighting; vehicle lighting apparatus and installations; heater apparatus, cooling apparatus, all for motor vehicles; heater components; parts and fittings for any of the aforesaid goods.
- Class 12 Motor vehicles and engines for motor vehicles; parts and fittings for motor vehicles; parts and fittings for engines for motor vehicles; parts, fittings and components of motor vehicle suspensions; parts, fittings and components for steering mechanisms of motor vehicles; chassis parts, body parts, door seals, weather strips, rubber parts and components, rubber profiles and extrusions, hinges, mirrors, wiper blades, steps, side steps, rear steps, wheel steps, snorkels, windows, window frames, glass, glazing, all being parts of or fittings for motor vehicles; sunroofs, parts and fittings for sunroofs, roof vents, roof hatches; emergency hatches, all being parts and fittings for motor vehicles; hydraulic parts, fittings and components for motor vehicles; hydraulic parts, fittings and components for engines for motor vehicles; roof racks for motor vehicles; load

carriers for motor vehicles; spare wheel carriers for motor vehicles; wheels, tyres and seat covers, all for motor vehicles; trailers; parts and fittings for trailers; parts and fittings for any of the aforesaid goods.

5. Trade mark No. UK00909326877 (“the second earlier mark”), filed on 20 August 2010 and registered on 30 July 2020.

MASAI

Class 12 Motor vehicles and engines for motor vehicles; parts and fittings for motor vehicles; parts and fittings for engines for motor vehicles; parts, fittings and components of motor vehicle suspensions; parts, fittings and components for steering mechanisms of motor vehicles; chassis parts, body parts, door seals, weather strips, rubber parts and components, rubber profiles and extrusions, hinges, mirrors, wiper blades, steps, side steps, rear steps, wheel steps, snorkels, windows, window frames, glass, glazing, all being parts of or fittings for motor vehicles; sunroofs, parts and fittings for sunroofs, roof vents, roof hatches; emergency hatches, all being parts and fittings for motor vehicles; hydraulic parts, fittings and components for motor vehicles; hydraulic parts, fittings and components for engines for motor vehicles; roof racks for motor vehicles; load carriers for motor vehicles; spare wheel carriers for motor vehicles; wheels, tyres and seat covers, all for motor vehicles; trailers; parts and fittings for trailers; parts and fittings for any of the aforesaid goods; none of the aforesaid goods being bicycles, electric bicycles, standing scooters, electric standing scooters, tricycles, electric tricycles or parts and accessories specifically adapted thereof, electric motors for bicycles, standing scooters

and tricycles, or parts and accessories specifically adapted for such motors.

6. Trade mark No. UK00003179805 (“the third earlier mark”), filed on 11 August 2016 and registered on 6 January 2017.

MASAI

The goods registered for this mark are the same as those registered under the first mark brought in opposition – figurative mark No. UK00003305414.

Second case: OP000425305

7. On 22 February 2021, Party B applied to register the trade mark shown below – No. UK00003598967 – and the application was published for opposition purposes on 16 April 2021.

MAKAI

8. The registration is sought for the following goods:

Class 12 Water vehicles; vessels (boats and ships); marine craft; boats; personal water craft; yachts; sail boats and sailing boats; pleasure boats; catamarans; coasters; launches; leisure boats; motor yachts; motorboats; hydrofoils being boats; recreational jet boats; ski boats; fishing boats; ferry boats; air cushion vehicles; boat hulls; superstructures for boats and yachts; masts for boats; hydrofoils for boats; parts and fittings for all the aforesaid.

9. Party A opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application and is reliant upon the same trade marks and goods detailed in paragraphs 4 to 6.

The consolidated proceedings

10. In its two separate Form TM7s and accompanying statements of grounds, Party A argues that Party B’s mark is similar to its earlier marks and that the competing goods are identical or similar.

11. Party B filed two separate Form TM8s and counterstatements denying the claims made.

12. On 5 October 2021, the lead and second cases were joined together in consolidated proceedings.

13. Both parties filed written submissions in lieu of a hearing.

14. Party B filed evidence.

15. I have considered the submissions and the evidence when carrying out my analysis and making my decision.

16. Party A is represented by Swindell & Pearson Ltd and Party B is represented by Downing IP Limited.

Evidence

17. Party B filed a witness statement from Jay Nolan, a director of Party B, signed and dated 19 April 2022.

18. Along with the witness statement, there are three exhibits, JN1 to JN3.

DECISION

Lead case: OP000425298

19. Section 5(2)(b) of the Act reads as follows:

“5(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.”

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

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

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

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

21. Given their earlier filing dates, the trade marks upon which Party A relies qualify as earlier trade marks as defined above. The dates on which they were registered/protected mean that the earlier marks are not subject to the proof of use provisions in section 6A of the Act.

Section 5(2)(b) – case law

22. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to make reference to the trade mark case-law of EU courts.

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of the goods

24. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

25. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

26. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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) (IP TRANSLATOR)* [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.”

27. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

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

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

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

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

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

28. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

29. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the GC stated that “complementary” means:

“... 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 the responsibility for those goods lies with the same undertaking.”

30. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective

goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

While on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

31. The goods in question are as below.

Party A's goods	Party B's goods
<p data-bbox="193 1332 794 1366"><u>For the first and third earlier marks</u></p> <p data-bbox="193 1377 794 1411"><u>Class 7</u></p> <p data-bbox="193 1433 794 1646">Air filters and oil filters for land vehicles; radiators for vehicle engines; radiators for vehicles; parts and fittings for any of the aforesaid goods.</p> <p data-bbox="193 1657 794 1691"><u>Class 9</u></p> <p data-bbox="193 1713 794 1973">Vehicle batteries; vehicle instrumentation namely tire pressure gauges, temperature gauges, water gauges, exhaust gas temperature gauges, petrol gauges, fuel gauges,</p>	<p data-bbox="798 1332 1390 1366"><u>Class 12</u></p> <p data-bbox="798 1377 1390 1590">Fishing boats; Hydrofoils being boats; Leisure boats; Boats; Pleasure boats; Recreational jet boats; Ski boats; Vessels [boats and ships].</p>

speedometers; parts, fittings and components for vehicle instrumentation systems.

Class 11

Vehicle lighting; vehicle lighting apparatus and installations; heater apparatus, cooling apparatus, all for motor vehicles; heater components; parts and fittings for any of the aforesaid goods.

Class 12

Motor vehicles and engines for motor vehicles; parts and fittings for motor vehicles; parts and fittings for engines for motor vehicles; parts, fittings and components of motor vehicle suspensions; parts, fittings and components for steering mechanisms of motor vehicles; chassis parts, body parts, door seals, weather strips, rubber parts and components, rubber profiles and extrusions, hinges, mirrors, wiper blades, steps, side steps, rear steps, wheel steps, snorkels, windows, window frames, glass, glazing, all being parts of or fittings for motor vehicles; sunroofs, parts and fittings for sunroofs, roof vents, roof hatches; emergency hatches, all being parts and fittings for motor vehicles; hydraulic parts, fittings and components for motor vehicles; hydraulic parts, fittings and components

for engines for motor vehicles; roof racks for motor vehicles; load carriers for motor vehicles; spare wheel carriers for motor vehicles; wheels, tyres and seat covers, all for motor vehicles; trailers; parts and fittings for trailers; parts and fittings for any of the aforesaid goods.

For the second earlier mark

Class 12

Motor vehicles and engines for motor vehicles; parts and fittings for motor vehicles; parts and fittings for engines for motor vehicles; parts, fittings and components of motor vehicle suspensions; parts, fittings and components for steering mechanisms of motor vehicles; chassis parts, body parts, door seals, weather strips, rubber parts and components, rubber profiles and extrusions, hinges, mirrors, wiper blades, steps, side steps, rear steps, wheel steps, snorkels, windows, window frames, glass, glazing, all being parts of or fittings for motor vehicles; sunroofs, parts and fittings for sunroofs, roof vents, roof hatches; emergency hatches, all being parts and fittings for motor vehicles; hydraulic parts, fittings and components for motor vehicles; hydraulic parts, fittings and components for engines for motor vehicles; roof

racks for motor vehicles; load carriers for motor vehicles; spare wheel carriers for motor vehicles; wheels, tyres and seat covers, all for motor vehicles; trailers; parts and fittings for trailers; parts and fittings for any of the aforesaid goods; none of the aforesaid goods being bicycles, electric bicycles, standing scooters, electric standing scooters, tricycles, electric tricycles or parts and accessories specifically adapted thereof, electric motors for bicycles, standing scooters and tricycles, or parts and accessories specifically adapted for such motors.	
--	--

32. I note the witness statement and supporting exhibits from Jay Nolan that seek to show that boats and motor vehicles are sold and marketed through different channels and that motor vehicle parts are not suitable for watercraft.

33. Mr Nolan reports that on his visits to the Dusseldorf Boat Show and the St Petersburg Power & Sailboat Show, he has seen no motor vehicles or automotive parts advertised or on display. Exhibit JN1 consists of the exhibitor list from the 2022 St Petersburg Power & Sailboat Show and Mr Nolan states that none of the exhibitors are motor vehicle companies.

34. Exhibit JN2 features the Association of Brokers and Yacht Agents' guide to buying a boat. Mr Nolan says that this exhibit "demonstrates that purchasing a boat is an involved process, which can include negotiating a contract, arranging a pre-purchase survey, paying a deposit, and arranging insurance."

35. In Mr Nolan's experience, "boats and water vessels are typically advertised at boat shows and via specialist "enthusiast" magazines and online websites ... aimed at sailors and boating enthusiasts and do not include adverts for motor vehicles or their parts." He provides Exhibit JN3 in support of this statement, showing publications from Active Interest Media such as "YACHTS INTERNATIONAL" and "POWER & MOTORYACHT". He says that adverts for boats are often found in such publications, but they do not "in my knowledge, contain adverts for motor vehicles."
36. Paragraph 15 of the witness statement provides a detailed breakdown of why, in Mr Nolan's experience, motor vehicle parts are not in competition with watercraft parts. For example, "The alternator in a marine engine includes an extra plate on the back of the fan and an extra spark arrestor screen. These additions keep the bilge from sparking, preventing the boat from catching on fire while at sea."
37. While I cannot consider how a particular party utilises its goods in practice, being obliged to consider them on a notional basis, I can take account of information provided by Mr Nolan in relation to the nature of the goods at issue and the trade channels through which they are commonly marketed and sold.
38. In comparing Party B's "Fishing boats", "Hydrofoils being boats", "Leisure boats", "Boats", "Pleasure boats", "Recreational jet boats", "Ski boats" and "Vessels [boats and ships]" with Party A's Class 12 "Motor vehicles ...", I am conscious of the definition of "motor vehicle" in the Collins online dictionary being: "a road vehicle driven by a motor or engine, esp an internal-combustion engine". As such, the two sets of goods are fundamentally different, boats (the term which I use as a shorthand for Party B's goods) being water-borne and motor vehicles being land-borne. The goods are different in nature, for example, boats do not have wheels whereas motor vehicles do. They also differ in terms of their purposes and methods of use - the former to be sailed or piloted on the water and the latter to be driven on land. Their users are also different – specific sub-sets of the general public – sailors and drivers.

The trade channels through which the goods are sold also differ markedly. Boats are sold through specialist boat retailers, while motor vehicles are sold through car show rooms. The goods are manufactured by different entities and (given that they serve very different purposes) are not in competition, nor are they complementary. The goods are dissimilar, as are Party A's Class 12 parts.

39. I compare Party B's boats with Party A's Class 12 "trailers". Trailers are designed for transporting items such as cars that have broken down and are pulled along by lorries or cars. They are wheeled and travel on land. They therefore differ in nature, purpose and method of use. Their users only overlap to the extent that a small subset of users might need a trailer to transport a boat. The trade channels are generally separate in that trailers are made and sold by specialist companies. The goods are not in competition, nor are they complementary. While it is possible that one good could be important to the other, the relevant public will not think that responsibility for the goods lies with the same or economically connected undertakings. I find the goods (together with Party A's Class 12 "Parts and fittings for trailers") to be dissimilar to Party B's boats.

40. I now consider the Class 7, 9 and 11 goods in Party A's specifications for its first and third earlier marks.

41. It should be noted that Party A has motor vehicles (hence land vehicles) and motor vehicle parts in Class 12 and it follows that the parts listed in Classes 7, 9 and 11 are for motor vehicles. Indeed, many of the terms are expressly limited to land vehicles or motor vehicles. Even those parts that are not so limited are either not suitable for boats or the connection between them and boats is tenuous and at odds with the fact that boat parts are ordinarily found in Class 12. While it is possible to construe a boat as a type of vehicle, in that it can be used to transport people and goods, that interpretation strains the natural meaning of the word "vehicle" in that boats are never referred to as such in common parlance.

42. In Class 7, “Air filters and oil filters” are limited to “land vehicles”. In respect of “radiators for vehicle engines”, it is not clear that boats use radiators, for example the Collins online dictionary defines “radiator” as follows: “The radiator in a car is the part of the engine which is filled with water in order to cool the engine.”
43. In Class 9, in respect of “Vehicle batteries”, it is not clear that boats use batteries, for example the Collins online dictionary defines “battery” as follows: “A car battery is a rectangular box containing acid that is found in a car engine. It provides the electricity needed to start the car.” In the case of “vehicle instrumentation namely tire pressure gauges, temperature gauges, water gauges, exhaust gas temperature gauges, petrol gauges, fuel gauges, speedometers” and “parts, fittings and components for vehicle instrumentation systems”, “tire pressure gauges” are manifestly dissimilar and there is nothing to say that the remaining instrumentation is intended for boats.
44. Party A’s Class 11 goods are as follows: “Vehicle lighting; vehicle lighting apparatus and installations; heater apparatus, cooling apparatus, all for motor vehicles; heater components; parts and fittings for any of the aforesaid goods.” Given that the specification states “all for motor vehicles”, I take that to mean for all of the preceding goods, otherwise that clause would say “both for motor vehicles”. It follows that “heater components”, being component parts of “heater apparatus”, are also intended for motor vehicles.
45. I find all of the above Class 7, 9 and 11 goods to be dissimilar. If I am wrong about those parts that are not manifestly dissimilar or are not expressly limited to land vehicles or motor vehicles (or wrong to say that Party A’s Class 11 goods are so limited), the level of similarity is very low.
46. As some degree of similarity between the goods is required for there to be a likelihood of confusion¹, the opposition based on Party A’s second earlier

¹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

mark falls away. The same would apply to Party A's first and third earlier marks, except that I have considered the possibility that I am wrong to find dissimilarity for a small number of Party A's Class 7, 9 and 11 goods. I move on to consider the first and third earlier marks on the basis of their goods being of very low similarity to Party B's boats.

The average consumer and the nature of the purchasing act

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

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

48. When considering the competing goods, boats are expensive items that would necessitate very careful thought on the part of the potential purchaser, a member of the general public. The consumer would also give consideration to matters such as the design, functionality and technical specification of a boat. The average consumer would pay a high level of attention during the purchasing process.

49. Visual factors, whether researching boats online, or looking at them on the premises of a boat retailer, would predominate during the purchasing

process. Verbal interaction would take place after the mark had already been scrutinised, taking the form of the supplementary questioning of sales representatives.

50. Regarding those of Party A's goods which I found to be similar to a very low degree to Party B's boats, visual factors will predominate whether the transaction takes place at physical premises or online, although I do not discount aural considerations completely. The average consumer, who will either be a member of the general public or a vehicle repair business, would pay a reasonable level of attention as the purchaser will need to deliberate carefully as to whether they had selected the correct part for the vehicle in question. A medium to high level of attention would be paid during the purchasing process.

Comparison of the trade marks

51. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:


“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

52. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of

the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

53. The opponent's second earlier mark has fallen away. The opponent's first earlier mark, its figurative mark, is further away from the applicant's mark than its third earlier mark, a word mark. Therefore, I have conducted my analysis solely using the opponent's third earlier mark.

54. The opponent's mark (that of Party A) and the applicant's mark (that of Party B) are shown below.

Party A's trade mark	Party B's trade mark
<p>MASAI</p>	

55. Party A's mark consists of the plain word "MASAI". This is the only thing that forms the overall impression of this mark.

56. Party B's mark is a series of three. The word "MAKAI" is rendered in (black or red) large, stencil-style, block capitals. The words "POWER CATAMARANS" in smaller, black block capitals, form a strapline underneath the word "MAKAI". The stylistic elements have a visual impact, although to a lesser extent than the word "MAKAI" which is the dominant and distinctive element of the mark. The words "POWER CATAMARANS" (a catamaran being a boat with twin parallel hulls) are descriptive of Party B's products.

57. Visually, the words “MASAI” and “MAKAI” are identical in their first two and last two letters, only differing in their middle letter. However, Party B’s mark contains the additional descriptive phrase “POWER CATAMARANS” and the mark as a whole has some stylisation. Overall, I find these marks to be visually similar to a medium degree.
58. Aurally, the comparison is between Party A’s “MASS-AYE” and Party B’s “MACK-AYE POWURR CATAH-MAHRANS”. The words “MASAI” and “MAKAI” begin similarly, with the letters “S” and “K” in the middle of the marks sounding differently, and they end identically. It is unlikely that Party B’s two-word strapline would be voiced by the average consumer. On this basis, I find the marks to be highly similar aurally. If I am wrong about the strapline not being articulated, the marks would be of low aural similarity.
59. Conceptually, the average consumer of the goods in question would regard the word “MASAI” as a made-up word without any particular meaning. While a small number of consumers might associate the word with a nomadic people who inhabit Kenya and Tanzania (and Party B contends that the word would be seen as such), those consumers would not constitute a significant proportion of typical consumers.
60. “MAKAI” would also be regarded as a made-up word without any particular meaning, the remaining words in the mark, “POWER CATAMARANS”, being descriptive of Party B’s products. Party B says that “MAKAI” will be seen by some consumers as “a reference to its meaning in Hawaiian and other Pacific languages, “On the water””. However, I do not consider that a significant proportion of average consumers would see it as such.
61. I consider the marks to be conceptually neutral, so there is neither a conceptual similarity nor a difference.

Distinctive character of the earlier mark

62. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

63. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

64. The word “MASAI” is not descriptive of the goods for which the mark is registered. It would be seen as an invented word. Where the mark features

a figurative element, that does not affect the inherent distinctiveness of the mark. I find the earlier marks to be inherently distinctive to a high degree.

Likelihood of confusion

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

66. Earlier in this decision, I found that the goods are either dissimilar or similar to a very low degree. I have found the earlier mark to be of a high level of inherent distinctiveness. The average consumer of the parties' goods will be a member of the public or a vehicle repair business (in the case of the earlier goods) who will pay a medium to high level of attention, or a member of the public who will pay a high level of attention (in the case of the applied for goods). Visual factors will predominate in the purchasing process, although I do not discount aural considerations.

67. I have found the parties' marks to be visually similar to a medium degree. The marks are highly similar aurally, unless I am wrong to consider that Party

B's strapline would not be voiced, in which case the marks are of low phonetic similarity. The marks are conceptually neutral.

68. The words "MASAI" and "MAKAI" differ in terms of their middle letter, namely the letters "S" and "K". While the word that is common to the marks is conceptually neutral, Party B's mark contains the strapline "POWER CATAMARANS" and the mark's figurative elements have a visual impact which cannot be discounted.

69. Overall, I find that the visual (and possibly aural) differences between the marks, combined with the very low level of similarity of the goods in question and the high degree of attention purchasers of boats will pay when selecting the goods, mean that there is no likelihood of direct confusion. Furthermore, it is highly unlikely that the average consumers, having noticed the differences between the marks, will believe that Party B's mark is a brand variation of Party A's mark.

CONCLUSION

70. The opposition has failed. Subject to appeal, the application will proceed to registration.

DECISION

Second case: OP000425305

71. Given their earlier filing dates, the trade marks upon which Party A relies qualify as earlier trade marks. The dates on which they were registered/protected mean that the earlier marks are not subject to the proof of use provisions in section 6A of the Act.

Comparison of the goods

72. The goods in question are as below.

Party A's goods	Party B's goods
<p data-bbox="193 302 796 342"><u>For the first and third earlier marks</u></p> <p data-bbox="193 344 796 385"><u>Class 7</u></p> <p data-bbox="193 387 796 616">Air filters and oil filters for land vehicles; radiators for vehicle engines; radiators for vehicles; parts and fittings for any of the aforesaid goods.</p> <p data-bbox="193 618 796 658"><u>Class 9</u></p> <p data-bbox="193 660 796 1108">Vehicle batteries; vehicle instrumentation namely tire pressure gauges, temperature gauges, water gauges, exhaust gas temperature gauges, petrol gauges, fuel gauges, speedometers; parts, fittings and components for vehicle instrumentation systems.</p> <p data-bbox="193 1111 796 1151"><u>Class 11</u></p> <p data-bbox="193 1153 796 1489">Vehicle lighting; vehicle lighting apparatus and installations; heater apparatus, cooling apparatus, all for motor vehicles; heater components; parts and fittings for any of the aforesaid goods.</p> <p data-bbox="193 1491 796 1532"><u>Class 12</u></p> <p data-bbox="193 1534 796 1937">Motor vehicles and engines for motor vehicles; parts and fittings for motor vehicles; parts and fittings for engines for motor vehicles; parts, fittings and components of motor vehicle suspensions; parts, fittings and components for steering mechanisms of</p>	<p data-bbox="798 302 1398 342"><u>Class 12</u></p> <p data-bbox="798 344 1398 996">Water vehicles; vessels (boats and ships); marine craft; boats; personal water craft; yachts; sail boats and sailing boats; pleasure boats; catamarans; coasters; launches; leisure boats; motor yachts; motorboats; hydrofoils being boats; recreational jet boats; ski boats; fishing boats; ferry boats; air cushion vehicles; boat hulls; superstructures for boats and yachts; masts for boats; hydrofoils for boats; parts and fittings for all the aforesaid.</p>

motor vehicles; chassis parts, body parts, door seals, weather strips, rubber parts and components, rubber profiles and extrusions, hinges, mirrors, wiper blades, steps, side steps, rear steps, wheel steps, snorkels, windows, window frames, glass, glazing, all being parts of or fittings for motor vehicles; sunroofs, parts and fittings for sunroofs, roof vents, roof hatches; emergency hatches, all being parts and fittings for motor vehicles; hydraulic parts, fittings and components for motor vehicles; hydraulic parts, fittings and components for engines for motor vehicles; roof racks for motor vehicles; load carriers for motor vehicles; spare wheel carriers for motor vehicles; wheels, tyres and seat covers, all for motor vehicles; trailers; parts and fittings for trailers; parts and fittings for any of the aforesaid goods.

For the second earlier mark

Class 12

Motor vehicles and engines for motor vehicles; parts and fittings for motor vehicles; parts and fittings for engines for motor vehicles; parts, fittings and components of motor vehicle suspensions; parts, fittings and components for steering mechanisms of motor vehicles; chassis parts, body

<p>parts, door seals, weather strips, rubber parts and components, rubber profiles and extrusions, hinges, mirrors, wiper blades, steps, side steps, rear steps, wheel steps, snorkels, windows, window frames, glass, glazing, all being parts of or fittings for motor vehicles; sunroofs, parts and fittings for sunroofs, roof vents, roof hatches; emergency hatches, all being parts and fittings for motor vehicles; hydraulic parts, fittings and components for motor vehicles; hydraulic parts, fittings and components for engines for motor vehicles; roof racks for motor vehicles; load carriers for motor vehicles; spare wheel carriers for motor vehicles; wheels, tyres and seat covers, all for motor vehicles; trailers; parts and fittings for trailers; parts and fittings for any of the aforesaid goods; none of the aforesaid goods being bicycles, electric bicycles, standing scooters, electric standing scooters, tricycles, electric tricycles or parts and accessories specifically adapted thereof, electric motors for bicycles, standing scooters and tricycles, or parts and accessories specifically adapted for such motors.</p>	
---	--

73. I compare Party B's "Water vehicles", "vessels (boats and ships)", "marine craft", "boats", "personal water craft", "yachts", "sail boats and sailing boats", "pleasure boats", "catamarans", "coasters", "launches", "leisure boats", "motor yachts", "motorboats", "hydrofoils being boats", "recreational jet boats", "ski boats", "fishing boats", "ferry boats" and "air cushion vehicles" (air cushion vehicles, or hovercraft, being primarily intended for use on the water) with Party A's goods. The same findings stand as for the goods comparison detailed in paragraphs 32 to 46.

74. Party B's "boat hulls", "superstructures for boats and yachts", "masts for boats" and "hydrofoils for boats" are major parts of boats. They are dissimilar to Party A's motor vehicles and trailers. They are also dissimilar to Party A's various parts, none of them being required for these goods.

The average consumer and the nature of the purchasing act

75. The same findings stand as for the analysis of the purchasing act detailed in paragraphs 48 to 50, except to say that major boat parts would also require a high degree of attention.

Comparison of the trade marks

76. The opponent's second earlier mark has fallen away. The opponent's first earlier mark, its figurative mark, is further away from the applicant's mark than its third earlier mark, a word mark. Therefore, I have conducted my analysis solely using the opponent's third earlier mark.

77. The opponent's mark (that of Party A) and the applicant's mark (that of Party B) are shown below.

Party A's trade mark	Party B's trade mark
MASAI	MAKAI

78. Party A's mark consists of the plain word "MASAI". This is the only thing that forms the overall impression of this mark.

79. Party B's mark consists of the plain word "MAKAI". This is the only thing that forms the overall impression of this mark.

80. Visually, the words "MASAI" and "MAKAI" are identical in their first two and last two letters, only differing in their middle letter. I find these marks to be highly similar.

81. Aurally, the comparison is between Party A's "MASS-AYE" and Party B's "MACK-AYE". The words "MASAI" and "MAKAI" begin similarly, with the letters "S" and "K" in the middle of the marks sounding differently, and they end identically. I find the marks to be highly similar aurally.

82. Conceptually, the average consumer of the goods in question would regard the word "MASAI" as a made-up word without any particular meaning. While a small number of consumers might associate the word with a nomadic people who inhabit Kenya and Tanzania (and Party B contends that the word would be seen as such), those consumers would not constitute a significant proportion of typical consumers.

83. "MAKAI" would also be regarded as a made-up word without any particular meaning. Party B says that "MAKAI" will be seen by some consumers as "a reference to its meaning in Hawaiian and other Pacific languages, "On the water"". However, I do not consider that a significant proportion of average consumers would see it as such.

84. I consider the marks to be conceptually neutral, so there is neither a conceptual similarity nor a difference.

Distinctive character of the earlier mark

85. See paragraph 64.

Likelihood of confusion

86. Earlier in this decision, I found that the goods are either dissimilar or similar to a very low degree. I have found the earlier mark to be of a high level of inherent distinctiveness. The average consumer of the parties' goods will be a member of the public or a vehicle repair business (in the case of the earlier goods) who will pay a medium to high level of attention, or a member of the public who will pay a high level of attention (in the case of the applied for goods). Visual factors will predominate in the purchasing process, although I do not discount aural considerations.

87. I have found the parties' marks to be visually and aurally similar to a high degree. The marks are conceptually neutral.

88. The words "MASAI" and "MAKAI" differ in terms of their middle letter, namely the letters "S" and "K". I find that the visual difference between the marks, combined with the very low level of similarity of the goods in question and the high degree of attention purchasers of boats will pay when selecting the goods, mean that there is no likelihood of direct confusion. Furthermore, it is highly unlikely that the average consumers, having noticed the difference between the marks, will believe that Party B's mark is a brand variation of Party A's mark.

CONCLUSION

89. The opposition has failed. Subject to appeal, the application will proceed to registration.

OVERALL CONCLUSION

90. In both the lead case, OP000425298, and the second case, OP000425305, the oppositions have failed. Subject to appeal, the applications will proceed to registration.

COSTS

91. Party B has been successful in these consolidated proceedings, and I award costs accordingly.

92. In line with Annex A of Tribunal Practice Notice 2 of 2016, I award costs to Party B as below.

Preparing statements and considering the other side's statements:	£400
Preparation of submissions:	£300
Preparing evidence:	£500
Total:	£1200

93. I order Omega Otomotiv Sanayi Ve Ticaret Limited Sirketi to pay MAKAI Yachts Ltd £1200. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of September 2022

JOHN WILLIAMS
For the Registrar