

Caterpillar's brand power finds fame in Jordan

September 2013

What

Trade Mark Cancellation Action

Who

The Complainant, Caterpillar, is a MNC with a stellar reputation built in heavy equipment and construction.

The Respondent is the registrant of Trade Mark Registration No. 85220 in Class 3 for Cat Wax in relation to "shoe cream, shoe accessories and shoe wax" ("the Registration").

Why

CAT is the Complainant's house mark, which it has cultivated over decades to become a household name in heavy equipment and construction machinery. The Complainant enjoys substantial goodwill and reputation in its CAT mark.

The Registration is unauthorised and detrimental to the Complainant as its registration is likely to create confusion amongst consumers that the registration is authorised by or belongs to the Complainant or is somehow related to the Complainant. Such registration is damaging to the Complainant's goodwill and reputation and results in brand dilution of its CAT mark.

Where

Trade Mark Registry of the Ministry of Industry & Trade in Jordan ("the Ministry")

Facts of the Case

The Respondent had registered the disputed trade mark Registration in 2006.

The Complainant has trade mark registrations for Caterpillar & CAT in a number of countries including Jordan and has been using both trade marks for decades.

The Complainant argued, inter alia, that the disputed Registration was confusingly similar to marks in which the Complainant has rights, and the Respondent has no rights or legitimate interests in the registration of the disputed Registration.

Ministry's Findings

1. Importantly, the Ministry found that the Complainant's CAT and CATERPILLAR trade marks satisfied the threshold for well known marks in Jordan. In reaching its finding, the Ministry referred to the extensive evidence filed by the Complainant. The Complainant had adduced voluminous evidence through affidavits to substantiate its claim of goodwill and reputation in its well known CAT and CATERPILLAR trade marks. Evidence of trade mark registrations in multiple classes in Jordan and abroad as well as reams of evidence demonstrating the vast amounts of advertising and promotion of its CAT and

CATERPILLAR trade marks was filed in the course of the proceedings to highlight the vault of goodwill and reputation, which the Complainant had painstakingly cultivated over decades of use.

2. The Ministry compared the Registration to the Complainant's well known trade marks and found that the most distinctive element of the Registration i.e. CAT was identical to the Complainant's well known CAT trade mark. The Ministry agreed with the Complainant that the disputed Registration had incorporated its CAT trade mark in its entirety and that the addition of the word, "wax", had done nothing to remove the confusion likely to be caused by the Respondent's use of the Complainant's CAT mark in the disputed Registration. Specifically, the Ministry found the word, "wax", to be a common word.

Accordingly, the Ministry found that the disputed Registration was confusingly similar to the Complainant's CAT mark.

In conclusion, the Ministry was satisfied that the Complainant had succeeded in proving its case and ordered that the disputed Registration be struck out from the register of trade marks in its decision dated 3 July 2013.

Learnings

Caterpillar was able to leverage on its well known CAT trade mark to strike out the registration of Cat Wax Caterpillar had argued successfully that Caterpillar was more than yellow iron and is highly diversified with broad ranging businesses.

This important case demonstrates Caterpillar's far reaching fame.

It is important to build brand equity in your trade mark as it will pay dividends in the years to come in arresting unauthorised use of your mark in similar trade marks, which seek to capitalize on the goodwill and reputation subsisting in your mark.

Brand owners ought to be vigilant in monitoring any unauthorised usage of their trade marks and to act swiftly and decisively in rooting out the problem by engaging trade mark counsel to keep watches of offending trade marks. The fact that Caterpillar had been vigilant in enforcing its rights against offenders was important in shoring up its arguments that any attempt to free ride on its substantial goodwill and reputation was damaging to its brand integrity and likely to cause brand dilution.

This significant case represents yet another decisive victory for the ATCO IP Dispute Resolution practice, part of our award winning IP practice which continues to counsel clients in ensuring that their valuable goodwill and reputation is well protected.