

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2054566
BY SIMON JAMES EMPSON
FOR THE TRADE MARK ISSIGONIS IN
CLASS 12**

AND

**IN THE MATTER OF OPPOSITION No 48156
BY ROVER GROUP LIMITED**

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BACKGROUND

1. On 30 January 1996 Mr Simon James Empson of Colchester, England applied to register the trade mark ISSIGONIS (in plain block capitals), under No. 2054566. After examination and acceptance the trade mark was published in the Trade Marks Journal for a specification which reads as follows:

"Modified cars and parts and fittings therefor".

2. On 5 February 1998 the Rover Group Limited filed Form TM7, Notice of Opposition to the application for registration. The grounds of opposition are, in summary, as follows:
 1. Alec Issigonis is world famous as the designer of inter alia the Mini and Morris Minor cars produced by the opponents and or their predecessors. Because of this fame and the distinctiveness of the surname, nationally and internationally, the only meaning attached to the trade mark in suit is a product produced to Alec Issigonis' design or in the same or similar style; alternatively using his know how or otherwise connected with him. Thus the trade mark does not satisfy the requirements of Section 3(1)(a) of the Trade Marks Act 1994 since it does not consist of a sign which is capable of distinguishing the goods or services of one undertaking from those of other traders.
 2. Under Section 3(1)(b) of the Act because the trade mark is devoid of any distinctive character.
 3. Under Section 3(1)(c) of the Act the because trade mark consists exclusively of a sign or indication which may serve in the trade to designate kind, quality, value or other characteristics of the goods.
 4. Under Section 3(1)(d) of the Act as it consists exclusively of a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade.

5. Under Section 3(3)(b) as the trade mark is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods.
6. Under Section 3(6) as the application was made in bad faith or (in reference to Section 32(3) of the Act) on the grounds of lack of use, or lack of intention to use, the trade mark.
3. The opponents seek an award of costs in their favour.
4. The applicant did not file a counterstatement (a late filed form TM8 and counterstatement was not admitted into these proceedings). Only the opponents filed evidence in these proceedings and the matter came to be heard on 14 December 2000. The applicant, Mr Simon James Empson was present and Miss Gould of Marks & Clerk represented the opponents.

Opponents' Evidence

5. This consists of 4 statutory declarations by Mr Phillip John Cooper, together with 43 exhibits.
6. The first of Mr Coopers' statutory declarations is dated 4 May 1999. He states that he is the Head of Trade Marks for Rover Group Limited and that he is empowered by that company to make the statements on their behalf.
7. Alec Issigonis (whose full name was Alexander Arnold Constantine Issigonis) worked as a Designer for Rover Group's predecessors Morris Motors Limited and then The British Motor Corporation Limited during the 1940's and 50's. He is famous for being the designer of the Morris Minor motorcar introduced in 1948 and the vehicle launched in 1959 which came to be known as the Mini. Some biographies of Alec Issigonis are exhibited. Mr Cooper goes on to provide some background on the Morris Minor car and its success during the periods 1948 to 1971.
8. In 1959 the Rover Group's predecessors, the British Motor Corporation Limited and its subsidiaries the Austin Motor Company Limited and Morris Motors Limited, introduced onto the market a car known initially as the Austin Seven and Morris Mini Minor but later the Mini. As its designer Alec Issigonis was associated with it from the start. Various publications, articles etc. are exhibited which provide further background on this launch. Mr Cooper further states that Alec Issigonis continued to be associated with the revolutionary small car which was officially designated the Mini about 10 years after its original launch.
9. The Mini gained an enormous reputation as a result of its sales of over 5 million vehicles. The number of Minis sold in and exported from the United Kingdom in 1990 for example was 41,000 in 1990; the figure for 1996 was 17,500. By 1997 total sales of the Mini amounted to more than £100 million.

10. Mr Cooper goes on to state that Alec Issigonis continues to be celebrated as a successful designer, particularly through his work in relation to the Mini. As examples of that he provides copies of articles from newspapers and magazines together with books about the Rover Group and the Mini. He also provides details of an exhibition held by the British Motor Industry Heritage Trust which celebrated the life and works of Alec Issigonis. The Trust have also provided Mr Cooper with a list of papers and material concerning Alec Issigonis and held by the British Motor Industry Heritage Trust.
11. Finally, he states that the surname Issigonis is a very unusual surname as witnessed by the fact that there are no individuals or businesses listed under the name in the current London Telephone Directories.
12. Mr Coopers' second statutory declaration is dated 10 June 1999. This is filed in order to exhibit details of a television programme broadcast on 20 December 1998 and entitled "The Mini Man" which was a biography of Alec Issigonis. Mr Cooper says that on 25 May 1999 he contacted the Channel 4 television company which produced the programme and spoke to Sarah Down in their Research Department who informed him that the number of people who watched the programme amounted to 1.4 million. His view is therefore that the name Alec Issigonis would be recognised as a reference to the said Alec Issigonis and moreover as meaning a product produced to his design or in the same or similar style or using his know how.
13. The third statutory declaration is also dated 10 June 1999, this refers to various internet searches conducted by Mr Cooper on 2 March 1999 for pages featuring the name Issigonis. He exhibits the results which generally refer to the said Alec Issigonis and or the Rover Group and or its predecessors and or motor cars produced therefrom.
14. On 8 March 1999 Mr Cooper conducted an internet search for web pages featuring the name ISSIGONIS and thus the web-site identified as www.broadspeed.com. From the results (exhibited) he notes that these refer specifically to:
 - (a) Alec Issigonis and/or Rover Group and cars produced by them
 - (b) Alec Issigonis' world beating Austin and Morris Mini Coopers and their re-creation and restoration by Broadspeed:
 - (c) Simon J Empson of Broadspeed Engineering Limited, England as being the author of the broadspeed website with Unit 2, Steps Farm, Rectory Hill, Pulser, Colchester, CM6 5AE England being the corresponding contact address.
15. The final statutory declaration by Mr Cooper is dated 25 June 1999. Mr Cooper refers to an online search under the key word ISSIGONIS undertaken on the Reuters Business Briefing electronic database and undertaken by Nichola Amsel of the firm Amsel and Company. The search results based upon the word ISSIGONIS, shows all of the 192 published news and editorial items generally refer to the said Alec Issigonis and or Rover Group and or its predecessors and or motor cars produced by them.

16. That concludes my review of the evidence so far as it is relevant.

DECISION

17. The first four grounds of the opponents' objection are based on Section 3(1) of the Act, the relevant parts of which read as follows:

- “3.- (1) The following shall not be registered -
- (a) signs which do not satisfy the requirements of section 1(1),
 - (b) trade marks which are devoid of any distinctive character,
 - (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
 - (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

18. Section 3(1) has to be read in conjunction with Section 1(1) which in turn reads:

“1.- (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

19. There have been several decisions of the courts at both national and European level considering the extent and scope of the provisions contained in Section 3(1). Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Maasland NV Trade Mark* (SRIS No 397/99) reviewed the state of the case law in relation to Section 3(1). I draw on the following extracts from that decision for guidance.

"3....., in order to be free of objection under Sections 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive) a sign must possess "***a distinctive character***". The four paragraphs of Sections 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive) are not mutually exclusive in this respect; and the proviso to Section 3(1) of the Act (Article 3(3) of the Directive) is applicable only to signs which are "capable" of affording the required distinction because there is no point in considering whether a sign which is not capable of affording the required distinction has come to do so

through use: Bach Flower Remedies Trade Marks [2000] RPC 513, see in particular paragraph 33 of the judgment of Morritt LJ. A sign cannot be free of objection under all four paragraphs if it does not possess enough of "**a distinctive character**" to be perceived as an indication of trade origin by "*the relevant class of persons or at least a significant proportion thereof*": paragraphs 44, 46 and 52 of the Judgment of the European Court of Justice in Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee Produktions-und Vertriebs v. Boots-und Segelzubehör Walter Huber and Franz Attenberger [1999] ETMR 585.

4. Paragraph 29 of the Judgment in the Windsurfing case confirms that the "*relevant class of persons*" consists of "*the trade and ... average consumers of that category of goods in the territory in respect of which registration is applied for*". The "*average consumer*" of the products concerned is to be regarded as "*reasonably well-informed and reasonably observant and circumspect*": Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v. Klijsen Handel BV [1999] ETMR 690 paragraph 26; Bach Flower Remedies Trade Marks [2000] RPC 513. The part played by the hypothetical average consumer in the more recent case law of the European Court of Justice is examined in the Opinion delivered by Advocate General Fennelly in Case C-220/98 Estée Lauder Cosmetics GmbH & Co. v. Lanvaster Group GmbH (16th September 1999). Procter & Gamble Company's Application ('Complete') [1999] ETMR 664 at 668 is an example of a sign being assessed for registrability by the Third Board of Appeal of the Community Trade Marks Office with reference to the perceptions of the hypothetical average consumer of the relevant goods.

5. A sign possesses enough of "**a distinctive character**" to be registrable as a trade mark if goods identified by it would for that reason be thought by "*the relevant class of persons or at least a significant proportion thereof*" to have come (directly or indirectly) from one and the same undertaking as envisaged by the Judgment of the European Court of Justice in Case C-39/97 Canon Kabushiki Kaisha v. Metro-Goldwyn Mayer Inc. [1999] ETMR 1:

"27. Indeed, Article 2 of the Directive provides that a trade mark must be capable of distinguishing the goods or services of one undertaking from those of other undertakings, while the tenth recital in the preamble to the Directive states that the function of the protection conferred by the mark is primarily to guarantee the indication of origin.

28. Moreover, according to the settled case-law of the Court, the essential function of the trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-10/89 HAG GF (HAG II) [1990] ECR I-3711, paragraphs 13 and 14).

A sign which cannot (yet) be expected to perform that "*essential function*" to the required extent is liable to be excluded from registration by one or more of the provisions of Sections 3(1)(a) to (d) of the Act (Articles 3(1)(a) to (d) of the Directive): Bach Flower Remedies Trade Marks [2000] RPC 513."

20. The opponents allege that the trade mark in suit is incapable of fulfilling the requirements of Section 3(1)(a). The applicant has filed no evidence at all. Therefore, I only have the opponents' evidence and the facts established by it on which to base my decision. They establish that the word ISSIGONIS is a very rare surname. Considering it against all the criteria used by the Trade Marks Registry to judge such matters such a word would be acceptable, prima facie, as a trade mark. However, the bearer of that surname Sir Alec Issigonis came to fame as the designer of motor vehicles, principally the Morris Minor and the Mini; he was also involved in the design of motor vehicle parts. But the latter does not mean that the word ISSIGONIS could not be a registrable trade mark for goods (or services) to which his name attaches. Simply because some fame now attaches to that word as the surname of a designer involved with motor vehicles does not mean that it is a term which is unable to distinguish the goods and services of one trader from those of another even in that field. In that respect I take note of the comments of Aldous LJ in *Philips Electronics NV v Remington Consumer Products Ltd* [1999] ETMR 816, where, noting that the proviso as to subsequent use did not apply to Section 3(1)(a), he stated:

“That suggests that the capability of distinguishing depends upon the features of the trade mark itself, not on the result of its use. Thus a person who has had monopoly use of a trade mark for many years may be able to establish that it does in fact denote his goods exclusively, but that does not mean that it has a feature which will distinguish his goods from those of a rival who comes into the market. The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of the use, whether or not it be monopoly use and whether or not there is evidence that the trade and public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader's welded mesh from other traders' welded mesh.”

21. In assessing the matter I adopt the stance of the average consumer and assume all of his/her various attributes. In doing so, I believe that the word ISSIGONIS, although a surname is a very rare one, and, although it is the surname of a famous designer of motor vehicles, and their parts and fittings, I do not consider that the evidence shows that the word can be said to directly describe the goods covered by the application in suit. It may therefore function as a badge of origin and is capable of functioning as a trade mark. The grounds of opposition based upon Section 3(1)(a) are therefore dismissed.
22. The fact that I have found that the trade mark is capable of distinguishing and does not fall foul of Section 3(1)(a) does not, of course, mean that it has a distinctive character or is not otherwise open to objection. I go on therefore to consider the matter under Section 3(1)(b) and 3(1)(c).
23. It is clear from the evidence; all of the publications, newspaper articles, internet extracts etc. that Sir Alec Issigonis was very well known as the designer of the 'Mini', and also, to a lesser extent, the 'Morris Minor'. From my own knowledge I am aware that there is an interest in classic cars and indeed in the restoration of vehicles which might be termed such. That being so, it seems to me that the word ISSIGONIS could be an apt term for anyone involved in the business of reproducing or restoring classic cars (and their parts and fittings) to indicate the particular type or model of vehicle, associated with him as a designer, and which is being re-produced or restored by them. I have therefore reached the view that the term ISSIGONIS could describe a characteristic of the goods covered by the specification and for that reason is devoid of distinctive character in relation to them. The trade mark therefore falls foul of Sections 3(1)(b) and 3(1)(c) of the Act.
24. I turn to the final ground of opposition based upon Section 3(1) of the Act and this falls under sub-section (d) where the opponents allege that the word ISSIGONIS has become customary in the current language or in the bona fide and established practices of the trade. The evidence, as indicated above, certainly indicates that the name ISSIGONIS is associated with the manufacture and design of motor vehicles. However, there is no evidence as far as I can see that it is a term customarily and currently used in the trade. Therefore this ground of opposition fails.
25. I go on to consider the objections raised under Section 3(3)(b) which states:-
 - (3) A trade mark shall not be registered if it is-
 - (a)
 - (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).
26. I have not seen anything in the evidence which suggests to me that the public would be deceived as to the nature, quality, or geographical origin of the goods sold under the term ISSIGONIS. And I did not understand Ms Gould to pursue the point. This ground of opposition is dismissed.

27. Finally I come to the ground of opposition based upon Section 3(6) of the Act which states:-

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

28. There were, as I understood it, two principal strands to the submissions by the opponents. The first was that the applicant well knew that the name ISSIGONIS was associated with the designer of the Mini etc. and that they could not lay claim to it. Secondly, that any goodwill associated with the name ISSIGONIS accrued to the opponents and the applicants must have known that. There was also the allegation that there was no intention to use as required by Section 32(3) but that aspect was not pursued and I do not need to refer to it.

29. In considering matters under Section 3(6) I take into account the decision of Lindsey J in *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* 1999 RPC 367:-

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

30. In my view there is absolutely no evidence that the applicant's behaviour was anything less than straightforward. He has not sought to register anyone else's trade mark. Either that of Sir Alec Issigonis himself or indeed any property right owned by the opponents. As stated in *Elvis Presley* [1997] RPC 143 there are no rights within this jurisdiction in a name. In all of the circumstances this ground is not made out.

31. In reaching these views I have not taken into account statements made by Mr Empson, the applicant, at the hearing. However, I believe that the following extract from the Hearing indicates why and how he uses the word ISSIGONIS:-

"What we have tried to do here, in the absence of any use by Rover or its associates or by BMW, was to commemorate Issigonis for what he did, not for what he does because he is dead, but for what he did in the late Fifties in designing the Mini and, as far as I am concerned, the one thing that has never occurred has been either the recognition or commemoration of his achievements, and one of the reasons that we would like still to produce both vehicles and memorabilia, if you like, accessories and so on, accessories in particular, bearing his name is that they do hark back to his original designs. You talked about the enthusiasts. Many of those enthusiasts would argue that Issigonis's design was actually lost permanently in 1969, but when the new Mini, the Mark III, arrived in 1970 many of his original space-saving ideas and

the trends that he had started off in 1959 were thrown out of the window, both in terms of economy and modernity, and it is that classic element, that originality of what he actually designed; just as one specific example, the sliding windows, it is what everybody has these days, we recreated the sliding windows and we fit sliding windows into new cars, which is specifically what the enthusiasts asked us to do. We want our new Mini to resemble the Mini that Issigonis designed back in 1959. Our business was actually centre on recreating what he did, taking out what BL in 1970 did, which was to remove a lot of the charm and the character of his original car by putting in thick reclining seats and jazzy colours and all this sort of thing; we go back to that originality and recreate it."

32. My decision does not, of course, mean that the applicant may not continue to use the term in a descriptive way to indicate to customers and potential customers precisely the nature of the products he is offering. And in due course depending upon the nature of the use made of the term ISSIGONIS, the proviso to Section 3(1) may be appropriate. This enables the Registrar (and the Courts) to take use of the trade mark into account in determining whether or not it should be registered, on the basis that, despite prima facie objections, the term in question has become factually distinctive.
33. For the reasons outlined above, this application for registration will be refused because it does not meet the requirements set out in Section 3(1)(b) and Section 3(1)(c). The opponents have therefore been successful and are entitled to an award of costs. I order the applicant to pay to the opponents therefore the sum of £500. 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 15TH day of February 2001

M KNIGHT
For the Registrar
the Comptroller General