

O-345-16

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION 3 096 244 FOR THE TRADE MARK:



IN CLASS 12 BY GRENVILLE REDMOND

AND

IN THE MATTER OF OPPOSITION THERETO BY JAGUAR LAND ROVER
LIMITED

Background and pleadings

1. Grenville Redmond (the applicant) applied to register the trade mark 3 096



244: in the UK on 25/02/2015. It was accepted and published in the Trade Marks Journal on 27/03/2015 in respect of vans in Class 12.

2. Jaguar Land Rover Limited (the opponent) opposes the trade mark on the basis of Section 5(2)(b), Section 5(3) and Section 5(4)(a) of the Trade Marks Act 1994 (the Act). The following are relied upon:
3. Under section 5(2)(b) and 5(3) UK Trade Mark No 1 579 651 LAND ROVER word only (from now on referred to as WO) and No 2 024



015 (from now on referred to as LAND ROVER oval). Both are relied upon in respect of registered goods "land Vehicles" in Class 12. In respect of both and under Section 5(2)(b) the opponent argues that the respective goods are identical or similar and that the marks are similar. Further that the earlier trade mark enjoys a higher than average degree of distinctive character as a result of use made.

4. As regards the Section 5(3) claim, the opponent argues that LAND ROVER (WO and oval) is a globally renowned brand in respect of its vehicles. The applicant has previously approached the opponent (in December 2014) with a view to negotiating a commercial agreement in respect of cargo vans which could be called LAND CARRIER. On 8 December 2014, the applicant applied



for the following trade mark: which was subsequently withdrawn following complaints from the opponent. The opponent notes that

this first mark bears a close resemblance to its earlier trade mark relied upon. This information is provided as, according to the opponent, it clearly demonstrates that the mark applied for has been filed with the link with the LAND ROVER brand very much in mind and that it is the applicant's intention to create this link in the minds of the average consumer. As such, use of the mark applied for would take unfair advantage by free-riding on the distinctiveness and reputation of the opponent's mark. It would gain attention and marketability by feeding on the fame of the opponent's mark and benefitting from the opponent's marketing efforts. Finally, use of the applicant's mark would damage the reputation of the opponent's mark if the goods provided are of inferior quality.

5. Further, under Section 5(2)(b), European Union Trade Mark No 1 346 5422



registered in respect of automobiles in Class 12.

Here the opponent argues that the respective goods are identical or similar and that the marks are similar.

6. Finally under Section 5(4)(a), earlier unregistered trade mark LAND ROVER used since 1948 throughout the UK in respect of Land vehicles.
7. The applicant filed a counterstatement denying the claims made.
8. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.
9. A Hearing took place on Wednesday 18th May 2016, with the opponent represented by Ms Jacqueline Reid of Counsel, instructed by Taylor Wessing LLP and the applicant, Mr Grenville Redmond appeared in person.

Evidence

Opponent's evidence

10. This is a witness statement, from Amanda Jane Beaton, dated 4th January 2015. Ms Beaton explains that she is a solicitor and is employed as Global Intellectual Property Counsel for the opponent. It is noted that Ms Beaton asserts that the purpose of her witness statement is to evidence the reputation of both LAND ROVER WO and LAND ROVER oval . In this respect, during the proceedings, the parties were in agreement regarding the reputation of both LAND ROVER WO and oval. The agreement being that both enjoyed a significant reputation in respect of Land vehicles in Class 12. As this has been agreed, the summary of the evidence filed will be succinct and focus on the nature of the reputation enjoyed. Further, it will include any information that is not agreed between the parties. To this end, it is noted that Ms Beaton describes the development of the nature of the reputation enjoyed by the earlier LAND ROVER WO and oval marks. In essence that it embodies notions of resilience, strength and flexibility and that this went on to include quality and luxury. It is accepted that this is the case as regards the nature of the reputation enjoyed. Ms Beaton also includes a decision of the Opposition Division at EUIPO which a) confirmed that LAND ROVER enjoyed a reputation and b) found in its favour in respect of identical and similar goods for the a trade mark including the verbal element LANDSCAPE. The content of this decision is noted. However, in terms of the outcome, it must be borne in mind that the decision would have considered factors not relevant here, most notably that non-English speakers would have been included within the relevant public (and for whom LANDSCAPE may have been meaningless). As such, while it is a useful decision in confirming LAND ROVER'S reputation, it is not as useful in establishing whether or not trade marks which include the word LAND can consistently fall foul of the opponent's earlier trade marks.
11. Ms Beaton ends her witness statement by describing the history between the parties. This has already been described in the pleadings (above) and so will not be repeated here. This argument will be considered further below.

Applicant's evidence

12. This is a witness statement from Mr Grenville Redmond, dated 16th March 2016. The following is of note:

- Mr Redmond explains that a large number of names were considered prior to application and that LAND CARRIER was one of his picks as it fits with what the business was aiming to do. To this end he includes an email as exhibit GR2, dated 2nd June 2014 as support.
- Mr Redmond notes that Toyota have used the brand LAND CRUISER for many years without (according to him) running into conflict with Land Rover. As such, other traders should also be able to use LAND.
- Mr Redmond accepts that he contacted Land Rover with a view to an agreement for LAND CARRIER to become part of the opponent's portfolio. However, he was turned down and told it was not a strategic fit. As such, Mr Redmond argues that there can be no detriment to the opponent as a result of the use and registration of LAND CARRIER.
- Mr Redmond questions the strength of the word LAND in respect of goods that are meant to travel over land. He refers to it as a rather generic prefix. As such, the addition of other words or a logo is enough to distinguish between trade marks.

DECISION

Section 5(2)(b)

13. Sections 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

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

Comparison of goods

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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 für 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”.

15. The earlier goods are “land vehicles” in Class 12 which fully encompass the contested “vans”. The goods are self-evidently identical.

Comparison of marks




16. 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 Court of Justice of the European Union 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.”

17. 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.

18. The respective trade marks are shown below:

<p>LAND ROVER</p>  	
<p>Earlier trade marks</p>	<p>Contested trade mark</p>

19. The comparison with the earlier LAND ROVER WO trade mark will be made first. In respect of the later sign, it is noted that there a word element “Land Carrier” and also a swish device appearing above the words. All of this matter is then encased in a red box. The words dominate though the swish also catches the eye and as regards the words, Land Carrier hangs together as a phrase. Likewise LAND ROVER hangs together, with neither LAND nor ROVER being more dominant or distinctive than the other and so neither being accorded greater relative weight.

20. Visually, the marks coincide in respect of the coincidental element LAND. They differ in respect of the respective second elements: ROVER and CARRIER. They also differ in respect of overall get up: the swirl device in the later mark and the red box in which it is encased. It is considered that the overall visual impression created is quite different with the impact of the

differences far outweighing the similarities. The marks are similar to only to a very low degree visually.

21. Aurally, there is coincidence in respect of LAND and difference in respect of ROVER and CARRIER. They are similar to only a low degree.
22. Conceptually, the word LAND is clearly known to describe the earth's surface that is not covered by water. The earlier ROVER describes a person who wanders or moves around and CARRIER is a person or indeed a thing that carries, holds, or transports something. It cannot be said that they are the exact same idea as a land rover creates the idea of someone or something that can move over land, whereas land carrier evokes an impression or someone or something being able to carry, hold or transport land. There is similarity in a broad sense and they are not so wildly different that a clear conceptual gap is created. There is therefore a degree of conceptual similarity here, though is it considered to be at the lower end of the spectrum.
23. In comparing the LAND ROVER oval , it is noted that it is encased in a badge with swirl devices at the end of the D of LAND and before the R of ROVER. The words dominate but the additional graphical elements also have an impact. The impact of the differences as between these marks is even greater than when compared with LAND ROVER alone. There is minimal visual similarity here.
24. The aural and conceptual comparison is identical to that which has already been discussed and decided.
25. In comparing the earlier LAND trade mark, it is noted that it appears in block capitals encased in a light coloured box. Again, the overall impression is quite different to the later mark and this is highlighted in even more clear ways, not least the length of the verbal elements. This coupled with all the other differences already identified leads to the conclusion that once again, the differences far outweigh the similarities. There is very low visual similarity here.

26. Aurally, there is an even greater degree of difference: one syllable against three. Though it is the first syllable that coincides, the overall length and difference provided by CARRIER is considered to be significant. There is very low aural similarity here.

27. Conceptually, as already stated, LAND means the earth's surface not covered by water and CARRIER as a person or thing that holds, carries or transports something. The earlier trade mark therefore conveys the concept of the earth whereas the later mark creates the idea of a person or thing that can carry, hold or transport the earth's surface. The later mark therefore introduces the idea of a person or thing that perform a carrying function. This is more complex a concept than the earlier trade mark (albeit still related to land) as it a physical, mobile entity. It has a more definite context and therefore is considered to be an idea clear enough to create a conceptual gap.

Average consumer and the purchasing act

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

29. 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.”

30. The goods in question here are vehicles in Class 12: cars, vans etc. These are items which will most likely be purchased infrequently. Further, they are expensive and it is likely that a good deal of research will have been undertaken by the average consumer prior to the purchasing act. This will be a considered purchase which will likely involve prior research regarding the presence of particular features and their benefits etc. The average consumer will be comprised both of the general public and also the business sector as the goods in question can potentially be used commercially. In the case of the latter, the purchasing decision is also likely to be considered as the choice of the correct vehicle as to functionality will be important. An example of this would be where a particular vehicle is used in the military or the emergency services. Thus, the correct choice is essential. There is likely to be a high degree of attention displayed during the purchasing process.

Distinctive character of the earlier trade mark

31. 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)."

32. It has already been agreed that LAND ROVER WO and the LAND ROVER oval enjoy a significant reputation in respect of land vehicles in Class 12. It is clear therefore that it enjoys an enhanced degree of protection as a result of a higher than average distinctive character. It should be noted however, that this is only in respect of the whole and not in respect of either LAND or ROVER alone.

33. In respect of the LAND trade mark, at the hearing, Ms Reid argued that LAND had also acquired a reputation, distinct and separate from that enjoyed by LAND ROVER. It is noted that throughout the evidence filed, LAND never appears alone. Rather it is always with LAND ROVER. However this is not fatal as I bear in mind the guidance in *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03, where the Court of Justice of the European Union held that:

"The distinctive character of a mark referred to in Article 3(3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the

Member States relating to trade marks may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.”¹

34. It is wholly accepted that a reputation may be acquired where a mark is used as part of or in conjunction with another registered trade mark. In the circumstances here, it is noted that LAND ROVER hangs together as a complete whole and is depicted in this manner throughout the evidence. There is nothing on file to demonstrate that LAND enjoys repute set apart from ROVER. As such, this claim is set aside and so the prima facie position must be assessed. To this end, it is noted that at the Hearing, Mr Redmond argued that LAND is inherently weak for vehicles that travel on land. To the contrary, Ms Reid strongly argued that LAND is not descriptive or devoid of distinctive character and that in assessing the matter, I should not be swayed by the classification term in Class 12 of “Land vehicles”. Rather, that I should consider how the average man on the street would refer to such goods, namely as cars, vans, trucks etc. As such, LAND is not weak for such goods and should be accorded the appropriate penumbra of protection. In considering the arguments of both parties, it is considered that whether or not LAND is applied to cars or “Land vehicles”, it cannot be viewed as a notably distinctive denomination. The same would apply to the word “SEA” applied to boats, “AIR” to aeroplanes and “TRACK” to trains. The earlier LAND trade mark is a registered trade mark and so it is accepted that it must be assumed to have at least some distinctive character. Further, it is not a word only trade mark which no doubt assisted its cause in gaining registration. However, the degree of distinctiveness to which LAND is accorded is certainly less than average and indeed, must be considered as low.

¹ See also: *L & D SA v OHIM*, Case C-488/06P, in which the Court of Justice upheld the General Court’s finding that the shape of an air freshener corresponding to the outline of a fir tree had acquired a particularly distinctive character as a result of its use with a word mark ARBRE MAGIQUE.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

35. 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.

The principles

(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 great 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 the earlier mark to mind, 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

36. There are three conclusions to reach here. The opposition based upon the earlier LAND ROVER WO will be considered first. Visually and aurally, the marks have been found to be similar only to a low degree. Conceptually, there is no clear conceptual gap and so there is a degree of similarity. Again this is pitched as being towards the lower end of the spectrum.

37. It is true that the marks have the word LAND in common. In this regard, I bear in mind the guidance in

Kurt Geiger v A-List Corporate Limited, BL O-075-13, when Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

38. It is noted that LAND ROVER WO enjoys a significant reputation (and an enhanced degree of distinctive character) and that this is also in respect of goods which are identical to those applied for. Having said that, its reputation lies in the combination of LAND ROVER, not LAND and so it is difficult to see how this effectively assists the opponent. This is a situation where the point in common between the marks is distinctive to only a low degree. The reputation in Land Rover therefore does not in reality assist the opponent as it only lies in the combination as a whole.

39. It is true that the goods are identical and so the interdependency principle is in full effect. However this is only one factor to consider.
40. These are goods which are expensive and purchased infrequently. They will be a highly considered purchase. As such, it is hard to imagine a situation where imperfect recollection can have any real impact (it has been fully considered in any case).
41. Bearing in mind all of the aforesaid, it is considered that there is no likelihood of direct confusion here and so in this respect, the opposition fails in so far as it is based upon the earlier LAND ROVER WO under Section 5(2)(b).
42. However, this is not the end of the matter as the issue of indirect confusion must also be considered. In this regard, I bear in mind the guidance in

L.A. Sugar Limited v By Back Beat Inc, Case BL-O/375/10, where Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

43. It is considered that a) and b) above do not apply. LAND is not strikingly distinctive as already discussed and CARRIER is not the kind of term one would expect to find in a sub brand or brand extension: LAND CARRIER hangs together as a differing complete whole to LAND ROVER. However, c) is worthy of analysis. The example used, namely FAT FACE and BRAT FACE is useful and serves to act as a strong indicator of the types of circumstances in which such indirect confusion is likely to occur. Both FAT FACE and BRAT FACE are strong in their own right, each containing the distinctive FACE which is the coincidental “stamp” of origin in each. It is true that LAND CARRIER and LAND ROVER contain LAND. However, this is clearly significantly weaker than the FACE example and so does not have the same impact. As already found, each of the marks in these proceedings hang together as (differing) complete wholes. The question therefore is would LAND CARRIER be seen as a logical and consistent brand extension of LAND ROVER? It is considered, that bearing in mind the aforementioned analysis, that, on balance, it would not. As such, the opposition based upon the earlier LAND ROVER WO, fails.

44. In considering the opposition under Section 5(2)(b) as based upon the earlier LAND ROVER oval , it is clear despite a significant reputation also present here, that the opponent is in no better position as there are additional differentiating features provided by the oval graphic. The opposition in this regard therefore also fails.

45. Finally, under Section 5(2)(b), the position must be considered with regards to the earlier trade mark LAND. Here, a number of the factors to be considered have equal impact, for example the goods are again identical and so the interdependency principle is in full effect. Having said that, this is again a situation where the purchase will be a considered one which weighs against the impact of imperfect recollection. It has already been found that LAND alone does not enjoy a reputation and that its inherent degree of distinctiveness is relatively low. Further, the degree of similarity between the marks is low. Bearing in mind all of the aforesaid, it is considered that there is no likelihood of direct confusion here. As to indirect confusion, again the weakness of LAND leads to the conclusion that LAND CARRIER will not fall into any of the categories identified above. As such, there is no likelihood of indirect confusion either. The opposition in respect of this trade mark also therefore fails.

Section 5(3) - Reputation

Legislation

46. Section 5(3) states:

“(3) A trade mark which-

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

47. The relevant case law can be found in the following judgments of the CJEU:

Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and *the court's answer to question 1 in L'Oreal v Bellure*).

48. As already found above, it is accepted that the opponent enjoys a significant reputation in respect of Land vehicles in respect of LAND ROVER word only and in respect of its LAND ROVER oval mark. The first part of the test under Section 5(3) is therefore cleared.

The Link

49. In Case C-408/01, *Addidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a

connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

50. In Case C-254/09P, the CJEU rejected an appeal against a judgement of the General Court rejecting an opposition against an application for what was then a Community trade mark (now a European Union trade mark) under what is now article 8(5) of the European Union Trade Mark Regulation, which is analogous to s.5(3) of the Act. The court held that:

“68. It should be noted that, in order for Article 8(5) of Regulation No 40/94 to be applicable, the marks at issue must be identical or similar. Consequently, that provision is manifestly inapplicable where, as in the present case, the General Court ruled out any similarity between the marks at issue.”

51. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the Court of Justice of the European Union stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

52. The respective trade marks have already been compared. However the above case law is taken into account as regards the degree of similarity required in respect of the establishment of a link. In establishing a link, the following is also borne in mind:

- the degree of similarity between the respective marks and between the goods/services,
- the extent of the overlap between the relevant consumers for those goods/services,
- the strength of the earlier mark's reputation and distinctiveness;

(Intel, paragraph 42)

53. In considering the degree of similarity, it is noted that the respective goods are identical as the contested vans is contained within the earlier land vehicles. The relevant consumers therefore clearly overlap. It has also been established that the earlier trade marks LAND ROVER WO and LAND ROVER oval enjoy a significant reputation. However, it is also noted that this is in respect of LAND ROVER as a complete whole. It is noted that there is similarity between the marks as a result of the coincidental element LAND. Having said that, this is the extent of the similarity. Having considered all matters in the round, it is felt that, on balance, no link will be established here as the respective trade marks hang together as wholes and they are sufficiently different from one another with enough distinguishing features. Even if a link were to be established, it is considered that it will be so fleeting so as to have no consequence.

54. As such, the opposition in so far as it is based upon Section 5(3), fails.

Section 5(4) – Passing Off

Legislation

55. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

General principles of Section 5(4)(a)

56. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

57. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

58. The opponent’s case under Section 5(4)(a) is identical in terms of scope and the signs as that already discussed and decided under Section 5(2)(b). If

there is no confusion, it is difficult to see how there can be a misrepresentation. As such, this does place the opponent in any better position. This ground of opposition also fails.

59. The sum of all this is that the opposition fails in its entirety.

Final Remarks

60. It is noted that much has been said about the history between the parties; the previous contact between them and the previous trade mark applied for by the applicant. This has been used by the opponent to demonstrate (in its view) the clear intention of the applicant to take advantage of its earlier marks and accompanying reputation. However, the trade mark the subject of these



proceedings is: and that is what has been assessed.

While the viewpoint of the opponent is fully appreciated, the Tribunal can only consider the trade mark applied for and it is in respect of this, that it is considered that no conflict exists

COSTS

61. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

- Considering notice of opposition and statement of grounds and preparing statement of case in reply - £200
- Preparing and filing evidence and considering evidence - £300
- Preparation for and attendance at a Hearing – £200

TOTAL - £700

62. I therefore order Jaguar Land Rover Limited to pay Mr Grenville Redmond the sum of £700. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19th day of July 2016

Louise White
For the Registrar