

O/1091/22

TRADE MARKS ACT 1994

IN THE MATTER OF

**APPLICATION NO. UK00003620195
IN THE NAME OF ARNAGE MOTORS
FOR THE TRADE MARK:**

CarJager

IN CLASSES 35, 36, 37 AND 39

AND

**OPPOSITION THERETO UNDER NO. 427192
BY JAGUAR LAND ROVER LIMITED**

Background and pleadings

1. Arnage Motors (“the applicant”) applied to register the trade mark shown on the cover page on this decision in the UK on 01 April 2021. The application was made pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union. This provision allows those who have applied for EUTMs that were pending on 1 January 2021 to file for a UK comparable right and claim the earlier EU filing date. As the application for the comparable mark in the UK right was correctly made within nine months of the end of the transition period, the applicant is entitled to rely on the filing date of its EUTM as the priority date for its comparable UK mark. Therefore, the priority date for the applicant’s mark is 10 November 2017.

2. The application was accepted and published in the Trade Marks Journal on 25 June 2021 in respect of services in classes 35, 36, 37 and 39. The contested services will be set out later in this decision.

3. On 27 September 2021, Jaguar Land Rover Limited (“the opponent”) opposed the application on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the services in the application.

4. Under Section 5(2)(b) the opponent relies on the trade marks set out in the table below:

UK00914398127 (“the ’27 mark”)

JAG

Filing date: 22 July 2015; Date of entry in register: 18 January 2017

The opponent opposes all the applied-for services and relies on the following goods and services:

Class 12: *Motor land vehicles; engines for motor land vehicles; wheels for vehicles; alloy wheels; wheel trims; wheel rims; hub caps for wheels; hub centre caps; wheel covers; wheel sprockets; arm rests for vehicle seats; luggage bags specially*

adapted for fitting in the boot of vehicles; car interior organizer bags, nets and trays specially adapted for fitting in vehicles; head-rests for vehicle seats; vehicle head rest covers; wing mirror protective and vanity covers; car seat covers; covers for vehicle steering wheels; fitted covers for vehicles; spoilers for vehicles; covers for vehicles; seats for vehicles; safety harnesses for vehicles; radiator grilles for vehicles; trim panels for vehicle bodies; bicycles; non-motorised scooters; parts, fittings and accessories for bicycles or scooters; strollers and prams, and their parts and accessories; baby, infant and child seats for vehicles.

Class 37: *Maintenance, repair, servicing, reconditioning, restoring, remanufacturing, inspecting, care, cleaning, painting and polishing of motor land vehicles and of parts and fittings for these goods; diagnostic or inspection services, all for motor cars or for parts and fittings therefor, or for internal combustion engines; consultancy services relating to maintenance, repair, servicing, reconditioning, restoration, remanufacturing, inspection, care, cleaning, painting and polishing of vehicles and their parts and fittings and for the supply of parts and fittings for motor land vehicles; installation of accessories for motor land vehicles; information and advisory services relating to all of the foregoing.*

UK00003218193 (“the ’93 mark”)

JAG

Filing date: 13 March 2017; Date of entry in register: 02 June 2017

The opponent opposes the applied-for services in class 35 and relies on the following services:

Class 35: *Business consultancy services and business management advisory services, relating to the manufacture, provision, distribution, sale, maintenance, restoration and repair of motor vehicles, export and import of vehicles, their parts and fittings; organisation of promotional goods programmes; consultancy services relating to organisation of promotional goods programmes; distributorship services and retail store services relating to motor land vehicles and parts, fittings and accessories for motor land vehicles; promoting the sale of goods and services of others in the automotive industry by dissemination of promotional materials and*

product information through an online global computer network, through the distribution of printed material, audio and video recordings, television and radio recordings, online advertising, internet web-sites and promotional contests; retail store services in the field of automobiles, automobile parts, fittings and accessories; automobile dealerships; organization, operation and supervision of loyalty and incentive schemes; customer loyalty services and customer club services, for commercial, promotional and advertising purposes; membership club services providing discounts; retail services in the field of clothing, footwear, headgear, luggage, toys, jewellery, jewellery boxes, horological and chronometric articles, pedometers, watches, leather goods, luggage, bags, wallets, purses, belts, stationery, prints, pictures, posters, postcards, greeting cards, playing cards, artwork, keyrings, umbrellas, sports equipment, printed matter, books, stationery, DVDs, CDs, sound recordings, video recordings, video games, interactive and digital entertainment, apps for mobile phones, bicycles, bicycle parts and accessories, fragrance, perfumery, cleaning and polishing preparations, eyewear and cases, chargers, holders and accessories for computers, tablet computers or mobile phones, flashlights, torches, smoking articles, textile and textile goods, homewares, crockery, cutlery, tableware, knives, glassware, drinking bottles, coolers, humidors, lanyards, furniture, plastic goods, mineral and aerated water and other non-alcoholic drinks; organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; advertising and promotional services; production of advertising materials; business marketing services; publicity and sales promotion services; providing information about automobiles for sale by means of the Internet; providing a database of information in the field of automotive maintenance and repair; providing consumer information services and making referrals in the field of entertainment services for products, services, events, activities, facilities and locations; information and advisory services relating to all of the foregoing.

UK00917279531 (“the ’31 mark”)

JAGUAR

Filing date: 03 October 2017; Date of entry in register: 31 October 2018

The opponent opposes all the applied-for services and relies upon the following goods:

Class 12: *Vehicles; motor vehicles; apparatus for locomotion by land, air and/or water; motor land vehicles; land vehicles; off-road vehicles; ATVs; driverless motor vehicles; autonomous motor vehicles; racing cars; reconditioned classic vehicles; vehicles sold in kit form; commercial vehicles; electric vehicles; hybrid vehicles; military vehicles; vehicles for use by emergency services, search and rescue services; powertrains for land vehicles; engines for land vehicles; motors for land vehicles; engines for motorcycles; motors for motorcycles; engines for bicycles; motors for bicycles; engines for racing cars; trailers; arm rests for vehicle seats; luggage bags specially adapted for fitting in the boot of vehicles; car interior organizer bags, nets and trays specially adapted for fitting in vehicles; head-rests for vehicle seats; steering wheels; voice activated steering wheels and devices; devices for steering vehicles; joysticks for steering vehicles; airbags; vehicle head rest covers; wing mirror protective and vanity covers; car seat covers; covers for vehicle steering wheels; fitted covers for vehicles; shaped or fitted mats and floor coverings for motor vehicles; wheels for vehicles; alloy wheels; wheel trims; wheel rims; spare wheels; hub caps for wheels; hub centre caps; wheel covers; wheel sprockets; tyres; automobile tyres, bicycle tyres; inner tubes for tyres; spoilers for vehicles; covers for vehicles; seats for vehicles; safety seats for vehicles; safety belts for vehicles; safety harnesses for vehicles; safety signals [audible] for vehicles; anti-theft, security and safety devices and equipment for vehicles; radiator grilles for vehicles; trim panels for vehicle bodies; doors for vehicles; vehicle windows; vehicle windshields; window glass for vehicle windows and windshields; roof windows for vehicles; skylight windows for vehicles; vehicle bumpers; vehicle centre consoles sold as parts of vehicles and which incorporate electronic interfaces; disposable paper protectors for vehicle carpets and seats; disposable protectors for steering wheels and road wheels, all made of polythene or of plastic film or sheet materials; bicycles; tricycles; parts, fittings and accessories for bicycles; self-balancing electric scooters; hover boards; scooters; quadricycles; motorised unicycles; go-karts; strollers and prams, and their parts and accessories; baby, infant and child seats for vehicles; sun blinds, roof racks, luggage carriers and nets, cycle carriers, sail board*

carriers, ski carriers, and snow chains, all for vehicles; drones; unmanned aerial vehicles; personal air vehicles; hovercraft; underwater vehicles; jet vehicles for water sports; remote control vehicles, not toys; parts and fittings for all of the aforesaid goods.

UK00911949666 (“the ’66 mark”)

JAGUAR

Filing date: 02 July 2013; Date of entry in register: 24 March 2020

The opponent opposes the applied-for services in classes 35 and 36 and relies upon the following services:

Class 35: *Retail services connected with land vehicles, automotive parts and accessories, bicycles, bicycle parts and accessories, flashlights, torches, DVDs, CDs, sound recordings, video recordings, video games, interactive and digital entertainment, eyewear, phone accessories, computer accessories, smoking articles, fragrances, cleaning and polishing preparations, perfumery, toilet preparations for personal use, pictures, posters, postcards, greeting cards, playing cards, printed matter, books, stationery, paper, cardboard, goods made of paper and cardboard, goods made of plastic film and sheet materials, articles of jewellery, jewellery boxes, horological and chronometric articles, pedometers, leather and imitation of leather goods, luggage, bags, wallets, purses, belts, clothing, footwear, headgear, umbrellas, textile and textile goods, crockery, cutlery, tableware, knives, glassware, drinking bottles, coolers, humidors, lanyards, furniture, plastic goods, toys, gymnastic and sporting articles, mineral and aerated water and other non-alcoholic drinks, and general consumer merchandise; automobile dealerships; organization, operation and supervision of loyalty and incentive schemes; customer loyalty services and customer club services, for commercial, promotional and advertising purposes; membership club services providing discounts; promoting the goods of others, namely, providing information regarding discounts, coupons, rebates, vouchers and special offers for the goods and services of others; business management; business administration; provision of business information; market research and analysis; organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; advertising and promotional*

services; production of advertising materials; business marketing services; publicity and sales promotion services; providing information about automobiles for sale by means of the Internet; providing information in the field of automotive maintenance and repair; providing consumer information services and making referrals in the field of entertainment services for products, services, events, activities, facilities and locations; providing a portal which is accessible by customers via a mobile device or website to provide access to motor vehicle functions and functions relating to driver safety, convenience, communication, entertainment, and navigation, and to allow users to track and locate stolen vehicles, charge electronics, and store and synchronize collected personalized user and vehicle information.

UK00915099997 (“the ‘97 mark”)

JAGUAR

Filing date: 11 February 2016; Date of entry in register: 26 August 2016

The opponent opposes the applied-for services in classes 36, 37 and 39 and relies upon the following services:

Class 37: *Vehicle repair and maintenance diagnostic services, namely, providing vehicle diagnostic information, vehicle mileage, vehicle maintenance needs, vehicle diagnostic readings and diagnostic trouble codes to drivers and car dealers regarding vehicles via cellular technology; Automobile repair and maintenance diagnostic services, namely providing interactive information concerning the status and power of vehicles via mobile phones and computer.*

UK00916492332 (“the ‘32 mark”)

JAGUAR

Filing date: 21 March 2017; Date of entry in register: 24 July 2017

The opponent opposes the applied-for services in classes 36, 37 and 39 and relies upon the following services:

Class 39: *Rental, leasing or hiring of vehicles or of agricultural equipment; rental of unmanned aerial vehicles; rental of drones; rental of bicycles; rental of electric bicycles; rental of scooters; rental of recreational vehicles; vehicle contract hire;*

Transport; Rescue, towing and salvage; recovery services; transportation of people in vehicles; transportation of people and goods in autonomous vehicles; warehousing and distribution of vehicle parts; Packaging and storage of goods; travel agency; Travel clubs; Booking of travel tickets; arrangement of tours; Navigation services; Providing customized driving directions; Car parking and Vehicle storage; parking services; parking space reservation service; Providing real-time information concerning vehicle parking space availability; valet parking; provision of information about parking with electric charging points; electricity supply and distribution; Making reservations and bookings for transportation; car rental club; Carpooling services, namely, matching drivers of motor vehicles with individuals needing rides; car-sharing services; provision of information to users about availability of cars for car-sharing; Chauffeur services; Vehicle-driving services; vehicle routing by computer on data networks; Traffic information; Mobile information services, namely, traffic information and directional guidance to motor vehicle operator; Vehicle location services; Tracking of vehicles by computer or via GPS; Information, consultancy and advice relating to any of the aforesaid services.

UK00915358451 (“the ’51 mark”)



Filing date: 21 April 2016; Date of entry in register: 31 January 2017

The opponent opposes the applied-for services in classes 36, 37 and 39 and relies upon the following services:

Class 37: *Maintenance, repair, servicing, reconditioning, restoration, inspection, care, cleaning, painting and polishing of motor land vehicles, civil engineering construction machines, automotive manufacturing machinery, agricultural machines, internal combustion engines or of parts and fittings for all these goods; diagnostic or Inspection services, all for motor cars or for parts and fittings therefor, or for internal combustion engines; Assembly of accessories for vehicles (installation services); Vehicle breakdown assistance [repair]; Providing emergency roadside assistance service; Tuning of engines and motor vehicles; Providing maintenance and vehicle repair assistance and information to drivers regarding their vehicles;*

maintenance, upgrading and diagnostic repair services for in-car electronics systems or in-car entertainment systems; Charging station services for electric vehicles; vehicle battery charging; Automobile customization services; automotive upgrade services; information, consultancy and advice relating to any of the aforesaid services and for the supply of parts for motor land vehicles.

5. Under Section 5(3), the opponent relies upon the following mark:

UK00917279531 (“the ’31 mark”)

JAGUAR

Filing date: 03 October 2017; Date of entry in register: 31 October 2018

The opponent opposes all the applied-for services and relies upon the following goods:

Class 12: *motor land vehicles; parts and fittings for all of the aforesaid goods.*

6. The opponent’s trade marks have filing dates that are earlier than the priority date of the application and, therefore, they are earlier marks, in accordance with Section 6 of the Act. The opponent’s marks had not completed their registration process more than five years before the priority date of the application at issue. The conditions of use do not, therefore, apply and the opponent can rely on all the goods and services for which its marks are registered.

7. Under Section 5(2)(b), the opponent relies on the earlier marks as a family of marks.¹ It claims that there is a likelihood of confusion because the applicant’s mark is similar to its own marks, and the respective goods and services are identical or similar.

8. Under Section 5(3) the opponent states that the earlier mark has acquired a reputation in relation to the goods relied upon and that use of the applicant’s mark

¹ The opponent listed the marks JAG, JAGUAR and JAGUAR CARE but the latter was not pleaded.

would, without due cause, take unfair advantage or be detrimental to the distinctive character or repute of the earlier mark.

9. Lastly, under Section 5(4)(a) ground, the opponent relies on the sign 'JAGUAR' and claims to have used it throughout the UK since 1935 for *vehicles, parts, fitting and accessories for vehicles*.

10. The applicant filed a defence and counterstatement denying the claims made. The applicant claims that 'Jager' is a German word meaning "hunter" and that the applied-for mark "*literally means car hunter*". It also states:

8.2 The Applicants services are aimed at those who are knowledgeable in the automotive world. It is particularly aimed at those who are passionate about motoring and those who seek to own or maintain classic, vintage or veteran cars. Such consumers are prepared to spend significant sums of money to realise their dreams, with one car on the Applicants site in excess of €1 million, whilst even the least expensive cars on the site start at €1000. Therefore this is not akin to shopping in a supermarket and consumers will paying a higher than average degree of attention. This was affirmed in the case T-63/09 GTI v Swift GTI.

8.3 The Applicants have been trading under CarJager since 2018 and are unaware of any confusion and the Opponents have not made the Applicants aware of any such confusion.

11. The applicant accepts that the respective services in class 37 and 39 are identical. In relation to the contested services in class 35, the applicant states:

Whilst the Applicant accepts that some of the services in Class 35 might be identical to those in the Opponents registration UK00911949666 until the Opponent specifically clarifies which services it deems to be identical and which services are similar, the Applicant denies the claim.

12. Only the opponent filed evidence during the evidence rounds. The applicant filed written submissions dated 18 July 2022. I shall refer to the evidence and submissions to the extent that I consider necessary.

13. The applicant is represented by Lewis Silkin LLP and the opponent by Reddie & Grose LLP. A hearing took place before me on 4 November 2022 at which the applicant was represented by Kendal Watkinson of Counsel (instructed by Lewis Silkin

LLP) and the opponent by Henry Edwards of Counsel (instructed by Reddie & Grose LLP).

EU Law

14. 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. This is why this decision continues to make reference to the trade mark case law of EU courts.

THE EVIDENCE

15. The opponent's evidence is provided by Amanda Jane Beaton, the global counsel for IP for the opponent's company. Ms Beaton's witness statement is dated 16 May 2022 and is accompanied by 47 exhibits (AJB1-47).

DECISION

Section 5(2)(b)

16. Section 5(2)(b) of the Act is as follows:

“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,

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

17. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

18. 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 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.

Comparison of goods and services

19. Section 60A of the Act states that:

“(1) For the purposes of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

21. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- (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.

22. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

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

24. The goods and services to be compared are as follows:

The applicant’s services	The opponent’s goods and services
	<p>The '27 mark – under this mark the opponent relies upon the following goods to oppose all of the applied-for services:</p> <p>Class 12: <i>Motor land vehicles; engines for motor land vehicles; wheels for vehicles; alloy wheels; wheel trims; wheel rims; hub caps for wheels; hub centre caps; wheel covers; wheel sprockets; arm rests for vehicle seats; luggage bags specially adapted for fitting in the boot of vehicles; car interior organizer bags, nets and trays specially adapted for fitting in vehicles; head-rests for vehicle seats; vehicle head rest covers; wing mirror protective and vanity</i></p>

covers; car seat covers; covers for vehicle steering wheels; fitted covers for vehicles; spoilers for vehicles; covers for vehicles; seats for vehicles; safety harnesses for vehicles; radiator grilles for vehicles; trim panels for vehicle bodies; bicycles; non-motorised scooters; parts, fittings and accessories for bicycles or scooters; strollers and prams, and their parts and accessories; baby, infant and child seats for vehicles.

The '31 mark – under this mark the opponent relies upon the following goods to oppose all of the applied-for services:

Class 12: *Vehicles; motor vehicles; apparatus for locomotion by land, air and/or water; motor land vehicles; land vehicles; off-road vehicles; ATVs; driverless motor vehicles; autonomous motor vehicles; racing cars; reconditioned classic vehicles; vehicles sold in kit form; commercial vehicles; electric vehicles; hybrid vehicles; military vehicles; vehicles for use by emergency services, search and rescue services; powertrains for land vehicles; engines for land vehicles; motors for land vehicles; engines for motorcycles; motors for motorcycles; engines for bicycles; motors for bicycles; engines for racing*

cars; trailers; arm rests for vehicle seats; luggage bags specially adapted for fitting in the boot of vehicles; car interior organizer bags, nets and trays specially adapted for fitting in vehicles; head-rests for vehicle seats; steering wheels; voice activated steering wheels and devices; devices for steering vehicles; joysticks for steering vehicles; airbags; vehicle head rest covers; wing mirror protective and vanity covers; car seat covers; covers for vehicle steering wheels; fitted covers for vehicles; shaped or fitted mats and floor coverings for motor vehicles; wheels for vehicles; alloy wheels; wheel trims; wheel rims; spare wheels; hub caps for wheels; hub centre caps; wheel covers; wheel sprockets; tyres; automobile tyres, bicycle tyres; inner tubes for tyres; spoilers for vehicles; covers for vehicles; seats for vehicles; safety seats for vehicles; safety belts for vehicles; safety harnesses for vehicles; safety signals [audible] for vehicles; anti-theft, security and safety devices and equipment for vehicles; radiator grilles for vehicles; trim panels for vehicle bodies; doors for vehicles; vehicle windows; vehicle windshields; window glass for vehicle windows and windshields; roof windows for vehicles; skylight windows for vehicles; vehicle bumpers; vehicle centre consoles sold

	<p><i>as parts of vehicles and which incorporate electronic interfaces; disposable paper protectors for vehicle carpets and seats; disposable protectors for steering wheels and road wheels, all made of polythene or of plastic film or sheet materials; bicycles; tricycles; parts, fittings and accessories for bicycles; self-balancing electric scooters; hover boards; scooters; quadricycles; motorised unicycles; go-karts; strollers and prams, and their parts and accessories; baby, infant and child seats for vehicles; sun blinds, roof racks, luggage carriers and nets, cycle carriers, sail board carriers, ski carriers, and snow chains, all for vehicles; drones; unmanned aerial vehicles; personal air vehicles; hovercraft; underwater vehicles; jet vehicles for water sports; remote control vehicles, not toys; parts and fittings for all of the aforesaid goods.</i></p>
<p><i>Class 35: Administration of business affairs; Administration of the business affairs of franchises; Administration of foreign business affairs; Management assistance in business affairs; Commercial management; Provision of commercial information; Market reports and studies; Research of business information; Computerised business research; Benchmarking services; Price analysis services; Arranging of buying</i></p>	<p>The '93 mark – under this mark the opponent relies upon the following services to oppose the applied-for services in class 35:</p> <p>Class 35: <i>Business consultancy services and business management advisory services, relating to the manufacture, provision, distribution, sale, maintenance, restoration and repair of motor vehicles, export and</i></p>

<p><i>and selling contracts for third parties; Commercial information and advice for consumers [consumer advice shop]; Mediation of contracts for purchase and sale of products; Negotiation and conclusion of commercial transactions for third parties; Negotiation and conclusion of commercial transactions for third parties via telecommunication systems; Arranging subscriptions to telecommunication services for others; Price comparison services; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Advisory services relating to the purchase of goods on behalf of others; Business intermediary and advisory services in the field of selling products and rendering services; Arranging of contracts for the purchase and sale of goods and services, for others; Arrangement of advertising; Classified advertising; Advertisements (Placing of -); Arranging and placing of advertisements; Promoting the goods and services of others; Advertising; Online advertisements; Advertising via electronic media and specifically the internet; Promoting the goods and services of others over the Internet; Advertising services relating to the motor</i></p>	<p><i>import of vehicles, their parts and fittings; organisation of promotional goods programmes; consultancy services relating to organisation of promotional goods programmes; distributorship services and retail store services relating to motor land vehicles and parts, fittings and accessories for motor land vehicles; promoting the sale of goods and services of others in the automotive industry by dissemination of promotional materials and product information through an online global computer network, through the distribution of printed material, audio and video recordings, television and radio recordings, online advertising, internet web-sites and promotional contests; retail store services in the field of automobiles, automobile parts, fittings and accessories; automobile dealerships; organization, operation and supervision of loyalty and incentive schemes; customer loyalty services and customer club services, for commercial, promotional and advertising purposes; membership club services providing discounts; retail services in the field of clothing, footwear, headgear, luggage, toys, jewellery, jewellery boxes, horological and chronometric articles, pedometers, watches, leather goods, luggage, bags, wallets, purses, belts, stationery, prints, pictures, posters,</i></p>
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vehicle industry; Advertising services relating to the sale of motor vehicles; Advertising services relating to the provision of business; Advertising services provided via a data base; Advertising services provided via the internet; Advertising services relating to newspapers; Advertising services relating to books; Advertising services relating to data bases; Banner advertising; Electronic billboard advertising; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Auctioning of vehicles; Wholesale services in relation to vehicles; Retail services in relation to vehicles; Vehicle fleet (business management of a -) [for others]; Vehicular registration and title transfer.

postcards, greeting cards, playing cards, artwork, keyrings, umbrellas, sports equipment, printed matter, books, stationery, DVDs, CDs, sound recordings, video recordings, video games, interactive and digital entertainment, apps for mobile phones, bicycles, bicycle parts and accessories, fragrance, perfumery, cleaning and polishing preparations, eyewear and cases, chargers, holders and accessories for computers, tablet computers or mobile phones, flashlights, torches, smoking articles, textile and textile goods, homewares, crockery, cutlery, tableware, knives, glassware, drinking bottles, coolers, humidors, lanyards, furniture, plastic goods, mineral and aerated water and other non-alcoholic drinks; organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; advertising and promotional services; production of advertising materials; business marketing services; publicity and sales promotion services; providing information about automobiles for sale by means of the Internet; providing a database of information in the field of automotive maintenance and repair; providing consumer information services and making referrals in the field of entertainment services for products,

services, events, activities, facilities and locations; information and advisory services relating to all of the foregoing.

The '66 mark – under this mark the opponent relies upon the following services to oppose the applied-for services in classes 35 and 36:

Class 35: *Retail services connected with land vehicles, automotive parts and accessories, bicycles, bicycle parts and accessories, flashlights, torches, DVDs, CDs, sound recordings, video recordings, video games, interactive and digital entertainment, eyewear, phone accessories, computer accessories, smoking articles, fragrances, cleaning and polishing preparations, perfumery, toilet preparations for personal use, pictures, posters, postcards, greeting cards, playing cards, printed matter, books, stationery, paper, cardboard, goods made of paper and cardboard, goods made of plastic film and sheet materials, articles of jewellery, jewellery boxes, horological and chronometric articles, pedometers, leather and imitation of leather goods, luggage, bags, wallets, purses, belts, clothing, footwear, headgear, umbrellas, textile and textile goods, crockery, cutlery, tableware, knives, glassware, drinking*

	<p><i>bottles, coolers, humidors, lanyards, furniture, plastic goods, toys, gymnastic and sporting articles, mineral and aerated water and other non-alcoholic drinks, and general consumer merchandise; automobile dealerships; organization, operation and supervision of loyalty and incentive schemes; customer loyalty services and customer club services, for commercial, promotional and advertising purposes; membership club services providing discounts; promoting the goods of others, namely, providing information regarding discounts, coupons, rebates, vouchers and special offers for the goods and services of others; business management; business administration; provision of business information; market research and analysis; organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; advertising and promotional services; production of advertising materials; business marketing services; publicity and sales promotion services; providing information about automobiles for sale by means of the Internet; providing information in the field of automotive maintenance and repair; providing consumer information services and making referrals in the field of</i></p>
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	<p><i>entertainment services for products, services, events, activities, facilities and locations; providing a portal which is accessible by customers via a mobile device or website to provide access to motor vehicle functions and functions relating to driver safety, convenience, communication, entertainment, and navigation, and to allow users to track and locate stolen vehicles, charge electronics, and store and synchronize collected personalized user and vehicle information.</i></p>
<p>Class 36: <i>Insurance for garages; Provision of vehicle warranties; Motor mechanical breakdown insurance warranty services; Insurance underwriting; Insurance consultancy; Insurance brokerage; Insurance information; Consulting and information concerning insurance; Advisory services relating to insurance contracts; Insurance services relating to motor vehicles; Insurance services relating to sport; Consultancy and brokerage services relating to vehicle insurance; Service insurance contracts; Financial guarantee services for the reimbursement of expenses incurred as a result of vehicle accident; Financial guarantee services for the reimbursement of expenses incurred as a result of vehicle breakdown; Financial</i></p>	

<p>guarantee services for the reimbursement of expenses incurred as a result of vehicle accident or breakdown; Financial services relating to insurance; Financial services for the purchase of vehicles; Financial services relating to the maintenance of vehicles; Financial services relating to motor vehicles; Appraisal of used automobiles; Lease purchase financing of vehicles; Providing information relating to the appraisal of used automobiles; Secured loans to fund the provision of bailment of motor vehicles; Secured loans to fund the provision of instalment credit agreements on motor vehicles; Secured loans to fund the provision of contract hire of motor vehicles; Provision of finance for the purchase of vehicles.</p>	
<p>Class 37: Roadside repair of automobiles; Maintenance of parts and fittings for commercial motor land vehicles; Installation of automobile accessories; Car wash; Rental of vehicle maintenance equipment; Automobile polishing; Vehicle cleaning; Refurbishment of vehicles; Tuning of engines; Automotive refinishing; Overhaul of vehicles; Provision of information relating to the maintenance of vehicles; Provision of information relating to the repair of vehicles; Gasoline refuelling service for motor</p>	<p>The '27 mark – under this mark the opponent relies upon the following services to oppose all of the applied-for services:</p> <p>Class 37: Maintenance, repair, servicing, reconditioning, restoring, remanufacturing, inspecting, care, cleaning, painting and polishing of motor land vehicles and of parts and fittings for these goods; diagnostic or inspection services, all for motor cars or for parts and fittings therefor, or for internal combustion engines; consultancy</p>

vehicles; Information and consultancy services relating to vehicle repair; Advisory services relating to vehicle maintenance; Vehicle conversions [engine]; Garage services for the maintenance and repair of motor vehicles; Painting of vehicles; Mobile vehicle tuning services; Maintenance of vehicle washing installations; Maintenance, servicing and repair of vehicles; Vehicle lubrication [greasing]; Inspection of automobiles and their parts prior to maintenance and repair; Installation of electric and electronic equipment in automobiles; Installation of vehicle security devices; Providing information relating to the repair of land vehicles; Providing information relating to the repair or maintenance of two-wheeled motor vehicles; Providing information relating to the repair or maintenance of vehicle washing installations; Providing information relating to the repair or maintenance of automobiles; Assembly [installation] of parts for vehicles; Arranging for the maintenance of motor land vehicles; Vehicle tuning; Vehicle polishing; Fitting of windscreens in motor vehicles; Fitting of armour plating to vehicles; Fitting of windows in motor vehicles; Arranging for the fitting of replacement vehicle windscreens; Arranging for the

services relating to maintenance, repair, servicing, reconditioning, restoration, remanufacturing, inspection, care, cleaning, painting and polishing of vehicles and their parts and fittings and for the supply of parts and fittings for motor land vehicles; installation of accessories for motor land vehicles; information and advisory services relating to all of the foregoing.

The '97 mark - under this mark the opponent relies upon the following services to oppose the applied-for services in classes 36, 37 and 39:

Class 37: Vehicle repair and maintenance diagnostic services, namely, providing vehicle diagnostic information, vehicle mileage, vehicle maintenance needs, vehicle diagnostic readings and diagnostic trouble codes to drivers and car dealers regarding vehicles via cellular technology; Automobile repair and maintenance diagnostic services, namely providing interactive information concerning the status and power of vehicles via mobile phones and computer.

The '51 mark – under this mark the opponent relies upon the following

replacement vehicle windows; Vehicle fueling services; Inspection of vehicles prior to maintenance; Inspection of vehicles prior to repair; Garage services for vehicle maintenance; Vehicle washing; Recharging services for electric vehicles; Vehicle service stations [refuelling and maintenance].

services to oppose the applied-for services in classes 36, 37 and 39:

Class 37: *Maintenance, repair, servicing, reconditioning, restoration, inspection, care, cleaning, painting and polishing of motor land vehicles, civil engineering construction machines, automotive manufacturing machinery, agricultural machines, internal combustion engines or of parts and fittings for all these goods; diagnostic or Inspection services, all for motor cars or for parts and fittings therefor, or for internal combustion engines; Assembly of accessories for vehicles (installation services); Vehicle breakdown assistance [repair]; Providing emergency roadside assistance service; Tuning of engines and motor vehicles; Providing maintenance and vehicle repair assistance and information to drivers regarding their vehicles; maintenance, upgrading and diagnostic repair services for in-car electronics systems or in-car entertainment systems; Charging station services for electric vehicles; vehicle battery charging; Automobile customization services; automotive upgrade services; information, consultancy and advice relating to any of the aforesaid services and for the supply of parts for motor land vehicles.*

Class 39: *Rental of vehicle parking spaces; Rental of garages and parking places; Providing information relating to vehicle parking services; Depot services for the storage of vehicles; Car parking; Valet parking; Chartering of transport; Chartering of vehicles for travelling; Rental of vehicle parts; Vehicle rental; Providing information relating to car rental services; Provision of hired vehicles; Arranging of vehicle hire; Loan of vehicles; Booking of hire cars; Providing information about automobiles for lease by mean of the internet; Vehicle location services; Reservation services for vehicle rental; Hired car transport; Transport services; Delivery services; Chartering of vehicles for transportation; Filling of vehicles with freight; Loading and unloading of vehicles; Recovery services for vehicles; Storage of vehicles; Transportation of vehicles; Rental of vehicle roof racks; Rental of traction vehicle and trailers; Arrangement of vehicle recovery; Arranging vehicle breakdown recovery; Arranging vehicle towing; Booking of seats for transportation by motor vehicles; Automobile salvage agency services; Vehicle-driving services; Vehicle salvage services; Services for the garaging of vehicles; Vehicle parking and storage; Storage of vehicle parts.*

The '32 mark - under this mark the opponent relies upon the following services to oppose the applied-for services in classes 36, 37 and 39:

Class 39: *Rental, leasing or hiring of vehicles or of agricultural equipment; rental of unmanned aerial vehicles; rental of drones; rental of bicycles; rental of electric bicycles; rental of scooters; rental of recreational vehicles; vehicle contract hire; Transport; Rescue, towing and salvage; recovery services; transportation of people in vehicles; transportation of people and goods in autonomous vehicles; warehousing and distribution of vehicle parts; Packaging and storage of goods; travel agency; Travel clubs; Booking of travel tickets; arrangement of tours; Navigation services; Providing customized driving directions; Car parking and Vehicle storage; parking services; parking space reservation service; Providing real-time information concerning vehicle parking space availability; valet parking; provision of information about parking with electric charging points; electricity supply and distribution; Making reservations and bookings for transportation; car rental club; Carpooling services, namely, matching drivers of motor vehicles with individuals*

	<p><i>needing rides; car-sharing services; provision of information to users about availability of cars for car-sharing; Chauffeur services; Vehicle-driving services; vehicle routing by computer on data networks; Traffic information; Mobile information services, namely, traffic information and directional guidance to motor vehicle operator; Vehicle location services; Tracking of vehicles by computer or via GPS; Information, consultancy and advice relating to any of the aforesaid services</i></p>
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Class 37 and Class 39 services

25. The applicant has conceded that the applied-for services in classes 37 and 39 are identical to the opponent’s services in the same classes.² Consequently, there is no need for me to say more about these services.

Class 35 services

26. In her skeleton argument, Ms Watkinson on behalf of the applicant states:

“28. The Opponent has two registered marks for JAG in classes 12, 35 and 37 (UK Trade Mark No. UK00914398127 and UK Trade Mark No. UK00003218193).

[...]

30. The Applicant admits that the Applicant’s Services in classes 35 and 37 are identical and/or similar to the class 35 and class 37 services for which the Opponent’s JAG Mark is registered. However, the Applicant submits that this is

² See the Forms TM8s and applicant’s skeleton argument

wholly irrelevant in light of the fact that the Applicant's Mark and the Opponent's JAG Mark are not confusingly similar."

27. However, in paragraph 40, Ms Watkinson seems to backtrack from the admission that the services in class 35 are identical. She stated:

"38. The Opponent has four registered trade marks for JAGUAR in classes 12, 35, 37 and 39 (UK Trade Mark No. UK00917279531, UK Trade Mark No. UK00911949666, UK Trade Mark No. UK00915099997 and UK Trade Mark No. UK00916492332).

40. The Applicant admits the Applicant's Services in class 37 and class 39 are identical to the Opponent's class 37 and 39 services. However, the Applicant submits that this is wholly irrelevant in light of the fact that the Applicant's Mark and the Opponent's JAGUAR Mark are not confusingly similar.

41. Whilst the Applicant accepts that some of the class 35 services in the Application may be identical to the Opponent's class 35 services, the Opponent has failed to clarify which services in the Application it considers to be identical and which services it considers to be similar."

28. As the opponent relies on two different specifications in class 35, namely that of the '93 mark (JAG) and that of the '66 mark (JAGUAR), I can only assume that the applicant's position is that it admits that the applied-for services in class 35 are identical to the services in class 35 for which the opponent's '93 mark is registered, but it maintains the position set out in the counterstatement in relation to the '66 mark, (i.e. that whilst the applicant accepts that some of the class 35 services may be identical, it denies the claim because the opponent has failed to clarify which services it considers to be identical and which services it considers to be similar).

29. As the opponent's claim that the class 35 services of the '66 mark is half admitted, I will, for the sake of completeness, carry out the comparison briefly.

30. The applied-for *Arrangement of advertising; Classified advertising; Advertisements (Placing of -); Arranging and placing of advertisements; Promoting the goods and services of others; Advertising; Online advertisements; Advertising via electronic media and specifically the internet; Promoting the goods and services of others over the Internet; Advertising services relating to the motor vehicle industry; Advertising services relating to the sale of motor vehicles; Advertising services relating to the provision of business; Advertising services provided via a data base; Advertising services provided via the internet; Advertising services relating to newspapers; Advertising services relating to books; Advertising services relating to data bases; Banner advertising; Electronic billboard advertising; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes;* are all encompassed by the opponent's *advertising and promotional services*. These services are identical (*Meric*).

31. The applied-for *Wholesale services in relation to vehicles; Retail services in relation to vehicles* are identical (or if not identical, *Wholesale services* are highly similar) to the opponent's *Retail services connected with land vehicles*.

32. The applied-for *Vehicle fleet (business management of a -) [for others]* is encompassed by the opponent's *business management*. These services are identical (*Meric*).

33. The applied-for *Administration of business affairs; Administration of the business affairs of franchises; Administration of foreign business affairs; Management assistance in business affairs; Commercial management; Provision of commercial information; Market reports and studies; Research of business information; Computerised business research; Benchmarking services; Price analysis services;* are all encompassed by the opponent's *business management; business administration; provision of business information; market research and analysis*. These services are identical (*Meric*).

34. The applied-for *Arranging of buying and selling contracts for third parties; Mediation of contracts for purchase and sale of products; Negotiation and conclusion of commercial transactions for third parties; Negotiation and conclusion of commercial transactions for third parties via telecommunication systems; Arranging subscriptions to telecommunication services for others; Advisory services relating to the purchase of goods on behalf of others; Business intermediary and advisory services in the field of selling products and rendering services; Arranging of contracts for the purchase and sale of goods and services, for others* are all types of intermediary services which might be provided to businesses. These services are similar to the opponent's *business management* because they have the same purpose (supporting or helping other companies to do business or to improve their businesses) and relevant public (the professional public). The services also have the same providers (companies providing business management services may also provide commercial intermediary services), so there is a coincidence in trade channels. These services are similar to a medium degree.

35. Although differently worded, the applied-for *Price comparison services* are identical to the opponent's *providing information about automobiles for sale by means of the Internet* (insofar as *Price comparison services* can relate to the sale of cars). If not identical, the services are highly similar because they have a similar nature and purpose (i.e. they provide information about cars available for sale on the Internet), target the same users (i.e. those who wish to purchase a car), and have the same trade channels (i.e. through online marketplace websites). These goods are either identical or similar to a high degree. Similar considerations apply to the applied-for *Commercial information and advice for consumers [consumer advice shop]* (insofar as the information and advice can relate to the same goods, i.e. automobiles).

36. The applied-for *Auctioning of vehicles* cover services whereby a public sale is taking place with the highest bidder obtaining the auctioned item. There is similarity with the opponent's *retail services connected with land vehicles* as they have a similar nature and purpose (i.e. the sale of cars), and share the same users. The services could also be offered via the same online marketplace websites, so there would be a coincidence of trade channels. There is also the potential for the same undertaking to offer the respective services, resulting in a certain degree of complementarity. In

addition, it is very common for retailers to select traditional or auctioneering marketplaces or even use them interchangeably to sell their products. As a result, there is a degree of competition between the respective services. Therefore, I find these services to be similar to a medium degree.

37. Lastly, *Vehicular registration and title transfer*. I understand this service as a service provided to facilitate the transfer process of a vehicle. The service would be provided to those who buy a car or to businesses selling cars, so there is a degree of overlap with the opponent's *retail services connected with land vehicles* and *automobile dealerships* because the services target the same users and are complementary to a certain degree. I find these services to be similar to a low degree.

Class 36

38. Mr Edwards's submissions on the similarity between the applied-for services in class 36 and the opponent's goods and services rely on the evidence that the opponent's offers Jaguar-branded insurance and car purchase financing services. He also asked me to take judicial notice of the fact that similar services can be obtained from most other car manufacturers. He stated:

"The services are in many cases complementary: breakdown insurers providing services in class 36 commonly provide vehicle recovery services, a service in class 39, or vehicle repair and maintenance services under class 37; likewise, a consumer purchasing a vehicle on loan-purchase terms may be required to purchase vehicle insurance or product warranty protection at the same time (both class 36 services)".

"Many of the class 36, 37 and 39 services of the Application are complementary to the 'motor land vehicle' products of the Opponent's earlier marks. For example: under class 36, third party motor insurance is compulsory for all drivers and drivers commonly purchase product warranties or hire- or loan purchasing finance when they buy a car; as for class 37 and 39, car maintenance or recovery services are commonly sold by car manufacturers and

are indispensable or important for the use of these products in the sense set out in Boston Scientific”.

“The identified Class 36 and 39 services of the contested Application are:

- Breakdown insurance and vehicle warranty services*
- Vehicle recovery services.*

Many insurers or warranty providers offer vehicle repair and maintenance services. Likewise, many insurers or warranty providers provide vehicle recovery services.

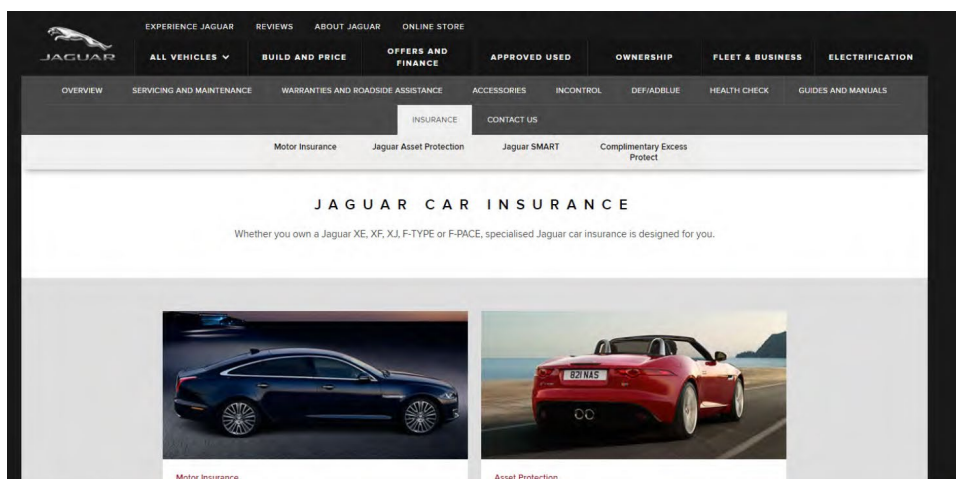
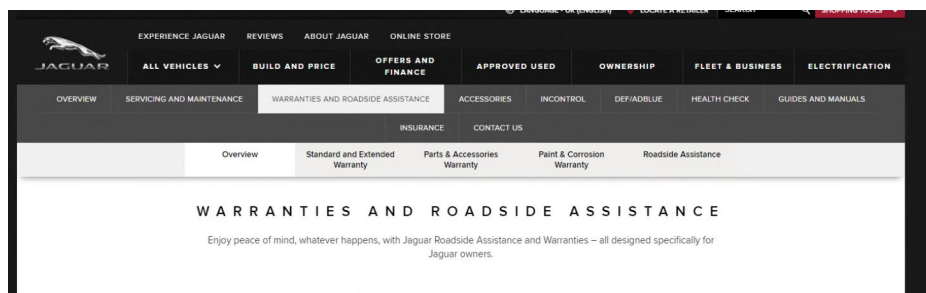
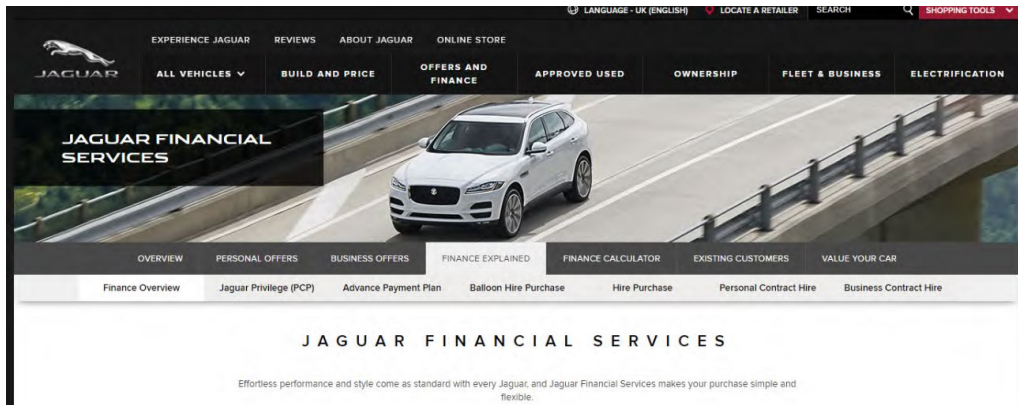
Vehicle manufacturers offer vehicle warranty or insurance products, sometimes in conjunction with underwriters. These services may be offered in conjunction with the digital repair and maintenance diagnostic services of the earlier mark.

Accordingly, these services are offered by the same undertakings to the same end users through the same trade channels. They are complementary to a high degree”.

“Cars are commonly bought on hire purchase or loan purchase terms and this financing is offered by or through the retailer. Likewise, vehicle warranties and road insurance is commonly sold by or through vehicle retailers. The Contested Application’s Class 36 services are highly complementary to the Class 35 services, offered by the same undertakings and targeted at the same end user”.

39. In her evidence, Ms Beaton states that the opponent offers various types of payment plans to customers who purchase ‘JAGUAR’ vehicles and that *“over the last decade the opponent has seen a distinct and growing trend in its own business and in the UK automotive market at large for its customers to lease a vehicle rather than purchase one outright”*. She also states that *“the retail location, whether in person or online, will provide customers with options for loans and finance for the purchase or lease of ‘JAGUAR’ vehicles”*.

40. These statements are corroborated by evidence of webpages (dated 2017) showing that the opponent supplies car insurance and financial services in relation to the purchase, rental and/or lease of its vehicles, as well as roadside assistance and warranties:



41. In its written submissions of 18 July 2022, the applicant criticised this evidence as not being supported by way of invoices or contracts with third parties. There is, in my view, nothing in this criticism. First, Ms Beaton gave clear evidence that the opponent offers the financial services described above, and there is nothing to disprove or

displace her evidence. Second, while there are no invoices, the exhibits corroborate Ms Beaton's account that the services are actually provided by the opponent under the mark 'JAGUAR'.

42. Turning now to the weight to be given to this evidence, although Ms Beaton's witness statement does not address the issue as to whether it is commonplace in the UK to buy or lease a car whilst obtaining insurance and other financial services for the purpose of the purchase or lease from the car manufacturer or the retailer, the opponent is a major player in the relevant market.

43. Ms Watkinson maintained the applicant's position that the applied-for services in class 36 are dissimilar, because "*warranty services are typically financial and insurance policies from specialist providers and vehicle breakdown recovery is provided by a handful of operators who do not operate repair shops*", however, she did not specifically address the evidence produced by Ms Beaton.

44. The Internet evidence filed by the opponent shows that the goods and services can be offered to the same classes of customers (those who wish to purchase or lease a car) through the same channels of trade. This demonstrates that there is a degree of relatedness and complementarity between the opponent's goods in class 12 and related retail services in class 35 (on one side) and some of the applied-for insurance and financial services (on the other), namely those specified as relating to motor vehicles. I agree with Mr Edwards that the same conclusion applies to the applied-for services that are specified without limitation because they are broad enough to cover services related to motor vehicles. Consequently, I find that the following services in the application are similar to a low degree to the opponent's goods and services:

Provision of vehicle warranties; Motor mechanical breakdown insurance warranty services; Insurance underwriting; Insurance consultancy; Insurance brokerage; Insurance information; Consulting and information concerning insurance; Advisory services relating to insurance contracts; Insurance services relating to motor vehicles; Consultancy and brokerage services relating to vehicle insurance; Service insurance contracts; Financial guarantee services for the reimbursement of expenses incurred as a result of vehicle

accident; Financial guarantee services for the reimbursement of expenses incurred as a result of vehicle breakdown; Financial guarantee services for the reimbursement of expenses incurred as a result of vehicle accident or breakdown; Financial services relating to insurance; Financial services for the purchase of vehicles; Financial services relating to the maintenance of vehicles; Financial services relating to motor vehicles; Lease purchase financing of vehicles; Secured loans to fund the provision of bailment of motor vehicles; Secured loans to fund the provision of instalment credit agreements on motor vehicles; Secured loans to fund the provision of contract hire of motor vehicles; Provision of finance for the purchase of vehicles.

45. This leaves *Insurance for garages; Insurance services relating to sport; Appraisal of used automobiles; Providing information relating to the appraisal of used automobiles.*

46. The opponent's specification in class 35 cover automobile dealerships. A car dealership, or vehicle local distribution, is a business that sells new or used cars at the retail level. Although there is no evidence on the point, from my experience most dealerships provide appraisal services to customers who trade-in (i.e. those who wish to sell their used car to a dealership). There is therefore a degree of complementarity between the opponent's services and the applied-for *Appraisal of used automobiles; Providing information relating to the appraisal of used automobiles*, in addition to a coincidence in terms of users and trade channels. I find these services to be similar to a low degree.

47. Finally, in relation to *Insurance for garages; Insurance services relating to sport*, I find that these services are one step removed from the opponent's goods and services. These services are dissimilar.

Average consumer

48. 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. 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.”

49. In his skeleton argument, Mr Edwards submitted that the average consumer of the majority of the relevant goods and services “*will normally be a member of the general public with no special attributes*”. He also stated that whilst “*the nature of the purchasing act and the degree of attention paid will vary*” it is important to bear in mind that (a) the applied-for services are purchased in a wide variety of different circumstances, generally by normal members of the public who have cars and (b) the applied-for services will normally cost a lot less than the car itself and this has an impact on the degree of attention paid when purchasing them. According to Mr Edwards, these factors, combined with the non-specialist character of the average consumer in question, suggest an average degree of attention.

50. Ms Watkinson’s submission on the point was as follows:

“The applicant’s business is aimed at those who have extensive knowledge of the automotive world. In particular, its services are aimed at those who seek to own or maintain classic, vintage or veteran cars and are willing to pay significant sums of money to do so. As such, the applicant’s customers will pay a high degree of attention to the applicant’s Mark, and in particular, the differences between the applicant’s mark and the ‘JAGUAR’ mark”.

51. Although the applicant might wish to target a specific segment of the market, namely that concerning classic, vintage or veteran cars, this is not reflected in the specification. As regard the applied-for wholesale and retail services in relation to vehicles – these are the services which are closer to the opponent’s business – whilst it is true that goods and retail of goods are not the same thing, the type of goods involved in the retail services dictate the level of attention. This is because retail services are services aimed at attracting consumers to buy goods from one seller rather than another, but they ultimately lead to sale of the goods. Cars are high-priced products which will be purchased after careful consideration; given their value, sophistication and impact on safety, it may be considered that consumers will pay a high level of attention to the selection of the goods as well as the connected retail services. The other services covered by the applied-for specification include, *inter alia*, various business related services in class 35, insurance and financial services in class 36, vehicles repair services in class 37 and parking services and rental of vehicles in class 39, in relation to which I must consider all notional and fair uses; this includes use by an average consumer with an average knowledge of the automotive world who owns an averagely expensive car.

52. I find that the relevant public is composed of businesses and the general public – for most of the goods and services concerned is someone who drives motor vehicles. In my view, given the nature of the services at issue, the average consumer will pay a level of attention between average (for example a member of the public selecting a car parking service) and above average (for example a business selecting business-related services in class 35 or a member of the public selecting a car insurance) or high (for example a member of the public purchasing a car or selecting a retailer for the purchase of a car).


53. The goods and services will be selected from catalogues, brochures or on the internet, or by visiting a specialist provider where the goods and services will be selected after having viewed the vehicles instore or from a catalogue which, in my view, will be followed by a discussion with a salesperson. The visual component is likely to dominate the purchasing/selection process although I do not discount an aural component playing a part by way of word-of-mouth recommendations or advice from a salesperson.

Comparison of marks

54. 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.”

55. 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. The respective marks are shown below:

The applicant's mark	The opponent's marks
CarJager	JAG (the '27 and '93 marks)
	JAGUAR (the '31, '66, '97 and '32 marks)
	 JAGUAR (the '51 mark)

56. The opponent's 'JAG' and 'JAGUAR' marks consist of single words and, self-evidently, the distinctive character of each mark resides in these.

57. The opponent's figurative mark consists of the word 'JAGUAR' presented in slightly stylised letters; above the word 'JAGUAR' there is a figurative element representing a jumping feline. Although the eye is naturally drawn to the element of the mark which can be read, given the size of figurative element above it, I consider that it plays a roughly equal role in the overall impression with the word element.

58. The applied-for mark consists of the letters 'C', 'a', 'r', 'J', 'a', 'g', 'e', 'r'. At the hearing Mr Edwards argued that the application consists of two components, 'Car' and 'Jager', and that the dominant and most distinctive component of the mark is the word 'Jager' because the component 'Car' is descriptive of the services for which the applicant seeks registration. The applicant's position, as set out in its counterstatement, is that the opponent has dissected the respective marks. Mr Edwards also pointed out that the applicant admitted³ that its mark will be seen as "*CAR followed by either a family name JAGER, or an invented word JAGER*". I agree with Mr Edwards that the average consumer will inevitably recognise the two words 'Car' and 'Jager' in the applicant's mark; this perception will be assisted by the use of the capital letters 'C' and 'J' which reinforces the impression of the mark being made up of two separate words, albeit conjoined. Although the element 'Car' is descriptive in relation to the applied-for services which relate to vehicles, it is not negligible or aurally invisible and therefore contributes to the overall impression the mark creates. Further, the fact that the word 'Car' and 'Jager' are conjoined emphasises the unitary character of the mark.

'CarJager' and 'JAG'

59. Ms Watkinson's submissions at the hearing was that although the applicant admits that the marks at issue have the letters 'J', 'A', 'G' in common, it maintains that, in the light of the many differences between them, those marks are not visually similar.

³ Paragraph 10.7 of counterstatement

60. When comparing the marks 'CarJager' and 'JAG', visually, the signs are similar to the extent that they coincide in the word 'JAG', albeit written in upper-case letters in the opponent's mark and in title case in the applicant's mark. They differ in the additional sequence of letters 'Car' placed at the beginning of the applicant's mark and joined to the letters 'Jag' followed by the letters 'er'.

61. The marks differ substantially in length, as they are made up of eight and three letters, respectively. Although the word 'Car' at the beginning of the applied-for mark describes some of the applicant's services its visual impact is not negligible especially given that it is placed at the beginning of the mark. The marks as wholes are visually similar to a low degree.

62. Aurally, Ms Watkinson said that the word 'Jager' in 'CarJager' will be pronounced according to the German pronunciation because it is a word of German origin meaning 'hunter', and the mark effectively translates as 'car hunter'. She said that the applied-for mark will be pronounced as 'C-A-R-Y-A-G-E-R', whereas the opponent's 'JAG' mark will be articulated as 'J-A-G'.

63. Mr Edwards pointed out at the hearing that the correct version of the word 'Jager' in German has two dots, which are not reproduced in the applicant's mark, with the result that the UK consumer will not be aware that the word 'Jager' is a word of foreign origin and will pronounce it as an English word. He stated:

"The Opponent understands the word 'jäger' or 'jaeger' to have this meaning in German. However, there is no evidence before the Tribunal (and it appears highly unlikely) that the average consumer of the relevant goods and services in the UK (generally an English speaker only), would know this German word or would adopt this German pronunciation of the Application. In light of this, the Tribunal is invited to reject these arguments".

64. I agree with Mr Edwards that 'Jager' in 'CarJager' is likely to be pronounced as 'JAG-GER' with a hard "J". Whilst it is possible that some UK consumers who speak German may recognize the word and pronounce it as 'YAGER', there is no evidence that this will represent a significant proportion of the UK average consumer. Mr

Edwards also pointed out at the hearing that in its counterstatement the applicant admitted that if the average consumer were to fail to recognise 'Jager' as a German word, they would see it as an invented word or possibly a family name sounding like Mick Jagger. The marks are aurally similar to a low degree.

65. Conceptually, Ms Watkinson stated that there is no similarity between the respective marks because *"the opponent's JAG mark will be perceived as having no particular meaning, whilst the applicant's mark is a multilingual form of "Car Hunter", which is an appropriate simile for a collector of classic, vintage and collectable cars"*.

66. I have already rejected the argument that the applicant's mark will be understood as meaning 'car hunter'. The only meaning that the applicant's mark will convey to the UK average consumer is that of the word 'Car', which is descriptive in relation to the services which are related to automobiles and will be regarded as being associated with the applicant's field of activity. Nevertheless, that concept has no counterpart in the opponent's mark.

'CarJager' and 'JAGUAR'

67. Mr Edwards argued that 'JAGUAR' is visually and aurally very similar to 'Jager', the dominant and distinctive component of the application, differing only in the vowels of the second syllable.

68. The words 'JAGUAR' and 'Jager' share the first three letters, 'JAG', in the same position and coincide in the last letter 'R'. The word 'JAGUAR' is one letter longer, and the letters 'UA' and 'E', which are placed in the middle of the mark, are different. In my view the words 'JAGUAR' and 'Jager' share a slightly above medium (but not high) level of visual and aural similarity. When the word 'Car' in the applicant's mark is factored in, the marks are visually and aurally similar to a slightly less than medium degree.

69. Conceptually, the word 'JAGUAR' refers to a large animal of the cat family with dark spots on its back. I repeat here what I have said about the word 'Jager' in the

applicant's mark being perceived as an invented word and the word 'Car' being associated with some the applicant's services. The marks are conceptually different.

'CarJager' and 'JAGUAR' logo

70. The only difference between the 'JAGUAR' logo mark and the 'JAGUAR' word mark is the presence of the leaper device. This is unlikely to alter how the opponent's trade mark is referred to by the consumer as it merely reinforces the word element, which retains its meaning, rather than adding any aural difference. Aurally and conceptually, I apply the same conclusions set out above at paragraphs 68 and 69. Visually, the leaper device creates a visual difference between the mark, reducing the overall similarity to a low degree.

Distinctive character of earlier mark

71. 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).”

72. Registered trade marks possess various 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. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

73. I will begin by assessing the inherent distinctive character of the earlier marks.

74. The earlier marks are not descriptive of any characteristic of the goods and services. At the hearing Mr Edwards submitted that the earlier marks are inherently highly distinctive because they are plainly not descriptive of the goods and services in question, nor can they be said to obviously allude to features or characteristics of those goods and services. Mr Edwards also submitted that the mark ‘JAGUAR’ has become extremely distinctive through use and that the applicant’s admission that the opponent has a reputation in relation to the mark ‘JAGUAR’ for at least cars and the retail of cars⁴ should be treated as an admission of acquired distinctiveness as well, as per the decision of Philip Johnson as Appointed Person in CX02 BL O/393/19 at [39].

75. In relation to cars, the mark ‘JAGUAR’ has some allusion to speed, being a desirable quality of the goods. Nonetheless it retains an above medium level of inherent distinctive character for all the goods and services for which it is registered as the association is quite fanciful. The same goes for the ‘JAGUAR’ logo mark, which, if anything, is even more distinctive than the word mark, due to the presence of the large figurative element. Moving to the mark ‘JAG’, although the applicant referred in its counterstatement to the word ‘JAG’ meaning, inter alia, “*a short period when somebody behave repeatedly*”, at the hearing Ms Watkinson accepted that ‘JAG’ will have no meaning for the average consumer. I have never heard of the word ‘JAG’ being used in the sense suggested by the applicant in its counterstatement, and I

⁴ Submissions at §28

consider the position adopted by Ms Watkinson at the hearing to reflect the likely perception of the average consumer. As an invented word, the mark 'JAG' is distinctive to a high degree.

76. The last point I must consider is whether I still need to assess the opponent's evidence of reputation given the concession contained in Ms Watkinson's skeleton argument that "*the applicant admits that the opponent's mark has a reputation in relation to goods and services relating to the manufacture and retail of luxury performance cars*" but denies "*that the opponent has a reputation in relation to the remaining goods and services in question*". At the hearing Mr Edwards correctly pointed out that the opponent's claim to reputation relates to vehicles only, and that the applicant's statement that it denies the opponent's reputation for goods and services other than cars is inaccurate, because the opponent did not make such a claim. Whilst the applicant concedes the opponent's reputation in relation to the goods for which the reputation is claimed, i.e. cars, (and even beyond that for the connected retail services), I will consider the evidence filed in order to determine the strength of the opponent's reputation and the degree to which the distinctiveness of its trade marks have been enhanced.

77. The main points emerging from Ms Beaton's evidence are as follows:

- The opponent is a globally renowned manufacturer of luxury performance cars and sports utility vehicles;
- The opponent is the largest UK automobile manufacturer by volume, having produced over 600,000 vehicles in 2017. Its two iconic car brands are 'JAGUAR' and 'LAND ROVER' which operate independently in the sense of public profiles, branding, endorsement and such like;
- The 'JAGUAR' brand was founded in 1935. Some of its vehicles are amongst the most famous in the world. The 'JAGUAR' mark relied on in this opposition has been in use by the opponent or its predecessor since at least as early as 1935;
- Such is the longstanding fame and success of the 'JAGUAR' vehicle that it has, over time, acquired the nickname 'JAG';

- By 2018 there were 83 Jaguar retailers operating in the UK, which at the relevant date in 2017, were selling the vehicles to which the 'JAGUAR' mark is applied;
- The 'JAGUAR' marks have a long history and have been used extensively in the UK. The 'JAGUAR' vehicles and associated goods and services are well-known to the public throughout the world, and in particular to the public in the UK, because the opponent is a pre-eminent British automotive company. The 'JAGUAR' vehicles have played a prominent role in the history of the British automotive industry and continue to do so;
- The 'JAGUAR' vehicles are prestigious, high value and are known for their quality and design throughout their history. The 'JAGUAR' vehicles have always had significant exposure to the public, even to those who would not have the opportunity to purchase a 'JAGUAR' vehicle, by virtue of a long and distinguished connection with motor racing and sponsorship of sports teams and event, their popularity amongst high-profile celebrities over the years, from being featured in television programmes, news programmes and feature films over a long period, their participation in Auto Shows around the world, an online presence;
- The Opponent invested significant amounts on advertising and marketing in the five years before the relevant date, spending over £20 million a year on advertising and sponsorships;
- The 'JAGUAR' vehicles earned their initial fame as outstanding race cars, and 'JAGUAR' competes in motor racing to this day;
- Jaguar cars are or have been driven by celebrities like David Beckham, Elton John and Frank Sinatra. Jaguar cars have been used as the official Prime-Ministerial car since the 1980's and are also used by members of the Royal Family;
- Between 2012 and 2017 there were in excess of 120,000 'JAGUAR' vehicles sold in the UK. The turnover relevant to the sale of 'JAGUAR' vehicles in the UK for the financial year 2016/17 was in excess of £3 billion, and for the financial year 2017/18 was in excess of £4 billion;
- The 'JAGUAR XJ' and the 'JAGUAR XF' models have consistently been placed in the top five vehicles registered in the luxury and executive segments of the

automobile market respectively, throughout the relevant period, holding a market share of between 23.3% and 11.5% and 7.5% and 11.3% respectively:

Year	JAGUAR XJ – Luxury segment		JAGUAR XF – Executive segment	
	Ranking	Market share	Ranking	Market share
2012	1 st	23.3%	5 th	9.4%
2013	2 nd	15.9%	5 th	10.6%
2014	2 nd	16.1%	5 th	10.5%
2015	5 th	12%	5 th	11.3%
2016	3 rd	11.7%	5 th	8.6%
2017	3 rd	11.5%	5 th	7.5%

78. Notwithstanding the applicant’s concession about the opponent’s reputation, Ms Watkinson insisted that I should disregard some evidence that is dated after the relevant date of 10 November 2017. I am not quite sure that that would make any difference.

79. The mark ‘JAGUAR’ has a lengthy history having been first used on cars in 1935 and it is not in dispute that it has been heavily promoted to the public gaining worldwide recognition. Further, the evidence accords with my experience that ‘JAGUAR’ has a massive reputation for luxury cars. I am therefore satisfied that the brand name ‘JAGUAR’ benefits from a high level of recognition in the UK which enhances its distinctive character to an exceptionally high degree in relation to cars. In his skeleton argument Mr Edwards states:

“The Applicant has admitted that the Opponent has a reputation in JAGUAR for at least cars and the retail of cars (see Submissions at §28). This should normally be treated as an admission of acquired distinctiveness as well (see CX02 BL O/393/19 at [39] per Philip Johnson as Appointed Person).”

80. The opponent claimed reputation only for goods in class 12, namely motor land vehicles (and parts and fittings). Although the opponent did not specifically plead enhanced distinctiveness in relation to retail services in connection with the sale of cars, this does not prevent me from finding that the distinctiveness of the mark has also been enhanced in relation to those services.

81. In her statement, Ms Beaton provided evidence that “*over time, the public referred to the ‘JAGUAR’ vehicles by the abbreviation ‘JAG’*” and exhibited a collection of independent articles from the UK press, including the well-known newspaper ‘The Telegraph’. Whilst this evidence corroborates Ms Beaton’s account that ‘JAG’ is used as a nickname for ‘JAGUAR’, I am not satisfied that it has acquired the same level of recognition of the name ‘JAGUAR’ (not least because ‘JAG’ is not the brand used by the opponent), although it still has a high degree of distinctiveness.

Likelihood of confusion

82. 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 marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

83. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained 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).”

84. The applicant argued that it is significant that there is no evidence of actual confusion in this case. However, as no evidence of use has been filed by the applicant, I cannot see how the applicant can rely on the argument. Absence of confusion would, in fact, be relevant only if there had been actual coexistence of the marks in the market. Hence, I reject the argument.

85. Whilst Mr Edwards did not abandon the argument that the opponent relies on a family of marks, he made no submissions on the point. The opponent relies upon seven earlier marks in these proceedings, some of which cover identical marks in different classes. Effectively, the evidence filed by opponent shows use of three different marks, namely the word mark ‘JAGUAR’, a figurative mark incorporating the word ‘JAGUAR’ and the word mark ‘JAG’ (although the latter is not used by the opponent in relation to the goods or services, but it is the way the name ‘JAGUAR’

appears to be abbreviated in the press). I do not consider this to be use of a sufficient number of marks as to be capable of constituting a family (or series) of trade marks for the purposes of the assessment of the likelihood of confusion. I therefore reject the argument. Since the opponent cannot rely on the existence of a family of marks, I will assess each mark individually on its own merits.

86. Mr Edwards submitted that there is a risk of both direct and indirect confusion because (a) the marks are highly similar, (b) the services are in many cases identical or highly similar to the goods in relation to which the distinctiveness of the earlier marks has been enhanced – this it is claimed reinforces the potential for the application to be misread as the earlier trade marks – and (c) normal and fair use of the contested mark include the provision of services in relation to the opponent’s products: for example in offering retail services in relation to cars under class 35, the applicant may end up selling new or second-hand versions of the opponent’s cars – this according to Mr Edwards, points towards a likelihood of confusion.

87. The crux of Mr Edwards’s submissions was that the word ‘Jager’ is likely to be misread (or misheard) for the word ‘JAGUAR’. He said that broadly similar considerations arise from the comparison with the mark ‘JAG’ and the ‘JAGUAR’ (figurative) mark. He also argued that the ‘Car’ component of the application is likely to enhance or reinforce this potential misreading, given the fact that the name ‘JAGUAR’ is a well-known car brand. In this connection, my attention was drawn to the decision in *Kennedy Fried Chicken* BL O/227/04 at [18] where Richard Arnold QC (as he then was) sitting as Appointed Person held that:

“I consider that there is force in the appellant’s submission that human beings have a tendency to see what they expect to see, and so some consumers would be likely to misread KENNEDY FRIED CHICKEN as KENTUCKY FRIED CHICKEN because, on a quick visual scan, they would see the overall structure KEN ... Y FRIED CHICKEN and jump to the conclusion that the phrase was KENTUCKY FRIED CHICKEN. I consider that there would also be potential for mishearing for similar reasons”.

88. On the likelihood of indirect confusion, Mr Edwards submitted as follows:

“As set out at paragraph 17(b) in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, indirect confusion is likely where the main difference between the earlier trade mark and the application is a non-distinctive element: here the main difference is the ‘Car-‘component of the Application which is non-distinctive. Likewise, the earlier trade marks are distinctive and well-known. As set out at paragraph 17(a), this is another circumstance in which indirect confusion can arise.”

89. The opponent’s case on the likelihood of both direct and indirect confusion seems therefore to be that the element ‘Jager’ in ‘CarJager’ will be misread or misheard as ‘JAG’ or ‘JAGUAR’ and that if any trade mark significance is given to the word ‘Car’ in ‘CarJager’ it will be put down to brand extension.

90. Earlier in this decision I found the marks ‘JAG’ and ‘CarJager’ to be visually and aurally similar to a low degree and the marks ‘JAGUAR’ and ‘CarJager’ to be visually and aurally similar to a slightly less than medium degree. Conceptually, neither the words ‘JAG’ nor the word ‘Jager’ in ‘CarJager’ have a clear meaning, but the opponent’s mark ‘JAGUAR’ conveys a concept that has no counterpart in the application. The same goes for the word ‘Car’ in the applicant’s mark which has no counterpart in the opponent’s marks - although the concept of a car is descriptive in relation to some of the contested services. The average consumer will select the goods and services visually, although I do not discount aural consideration, paying a degree of attention which varies between medium and high. The degree of similarity between the goods and services varies from identical to similar to a low degree. The earlier marks ‘JAG’ and ‘JAGUAR’ (I refer to both the ‘JAGUAR’ word mark and the ‘JAGUAR’ figurative mark) are inherently distinctive to a high degree and an above medium degree respectively, however, the distinctiveness of the mark ‘JAGUAR’ has been enhanced through use to an exceptionally high degree in relation to cars.

91. I shall start with the earlier mark ‘JAG’. The elements ‘JAG’ and ‘Jager’ are in themselves visually and aurally similar to a low to medium degree because the additional letter ‘er’ in ‘Jager’ make it look (and sound) significantly longer. The words ‘Jager’ and ‘JAG’ are insufficiently similar from a visual or aural point of view to be

directly confused, even considering their imperfect recollection. Furthermore, this is not simply a case of one mark getting tangled up with the other one in the minds of the average consumers because (a) the average consumer will appreciate that the overall impression conveyed by the application is that of a unitary mark composed of the two words 'Car' and 'Jager' albeit conjoined and (b) the descriptive character of the element 'Car' at the beginning of the applied-for mark does not make it visually or aurally invisible (I shall return to this point below).

92. Turning to the earlier word-mark 'JAGUAR', the visual and aural similarity between the elements 'Jager' and 'JAGUAR' is more pronounced. As it will be recalled, I have pitched it to a slightly above medium (but not high) degree. Conceptually, the opponent's mark conveys the concept of a jaguar, which is a large cat, whilst the application conveys the impression of a unitary mark composed of two elements the first conjuring the concept of a car and the second being an invented word with no meaning.

93. Whilst conceptual differences may counteract visual and aural similarities, they do not always (or necessarily) do so. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

93. On the contrary, in *Nokia Oyj v OHIM*, Case T-460/07, the GC stated that:

"Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98)."

94. I also bear in mind that the earlier mark 'JAGUAR' is distinctive to an exceptionally high degree in relation to cars and that there is a greater likelihood of confusion where the earlier mark has a high distinctive character.

95. The opponent's highest case is that there is a likelihood of confusion in relation to retail services connected with the sale of vehicles, because, as I have just said, the distinctiveness of the mark 'JAGUAR' has been enhanced to an exceptionally high degree in relation to cars and there is a strong degree of relatedness between the goods and service in the relevant field – for the reason that the retail of cars is intrinsically linked to the offer to sell cars. However, the fact that the services are directed at consumers who wish to purchase a car and that the relevant public is expected to pay a high degree of attention when selecting the services, is a consideration that weights against a likelihood of confusion. It is true that a high degree of attention of the relevant public does not automatically rule out a likelihood of confusion and that a likelihood of confusion can exist despite a high degree of attention. In this case, the opponent claims that the average consumer will misread (or misheard) the word 'Jager' in 'CarJager' as the opponent's well-known car brand 'JAGUAR' and that this is all more likely because of the massive reputation of the brand 'JAGUAR'.

96. In those circumstances, having carefully considered the question of the likelihood of confusion, my conclusion is that it is unlikely that the average consumer of retail services connected with the sale of cars (or a significant proportion of the relevant public for these services) will misread or mishear 'Jager' for 'JAGUAR'. This is because, notwithstanding the exceptionally high degree of distinctiveness of the earlier mark 'JAGUAR', the specialised nature of the relevant goods and/or services and the high degree of attention means that the slightly more than medium (but not high) overall similarity between the element 'Jager' and 'JAGUAR' in the respective marks and the conceptual gap that exists between these elements of the marks are not sufficient to cause the average consumer to confuse the marks. I also reiterate here what I have said above at paragraph 91, about the unitary character of the applied-for mark and the fact that consumers normally perceive a mark as a whole. In those circumstances, the average consumer is unlikely to disregard the element 'Car' and

the different structure of the marks renders the principle that the average consumer has a tendency to see what he expects to see and to hear what he expects to hear less relevant. It follows that the average consumer is less predisposed to jump to the conclusion that the element 'Jag..r' in the applied-for mark is the opponent's brand 'JAGUAR' without reading the word. The differences between the marks are therefore sufficient in my view to dispel a likelihood of confusion.

97. Finally, I should also address Mr Edwards argument that the element 'Car' in the application may bring to mind the goods in relation to which the distinctiveness of the mark 'JAGUAR' has been enhanced increasing the likelihood of confusion. The fact that the word 'Car' in the application introduces a concept which is relevant to the type of goods for which the opponent is famous would only assist with the creation of a link between the marks but it would neither reinforce the similarity nor reduce the differences between 'JAG' and 'Jager' or 'JAGUAR' and 'Jager' because the average consumer would still immediately perceive the differences between 'CarJager' and 'JAG'/'JAGUAR' (this conclusion also applies to the mark 'CarJager' presented in capital letters which fall within notional use of the mark).

98. I also reject the opponent's argument that because the applicant could offer for sale second-hand 'JAGUAR' cars through its retail services, this would make consumers more prone to misread the element 'Jager' in 'CarJager' as 'JAGUAR'. As I have found that the marks will not be confused it is irrelevant whether the applicant's mark is used in relation to the sale of second-hand Jaguars.

99. The last point I should address is whether there is any likelihood of confusion in relation to the remaining services, including those for which the word 'Car' is not descriptive. Any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation inevitably diminishes as one moves away from the core products in relation to which the mark has been used.⁵ Here the public have become used to identifying 'JAGUAR' as a car brand and not in the context of other services, which means that the enhanced distinctiveness of the mark is less impactful in relation to the other services in the applied-for specification. Finally, even where the

⁵ Roja Dove trade mark BL-O-016/10

consumer's level of attention is lower than high, i.e. medium, the differences between the marks and the goods and services are still sufficient to avoid confusion.

100. There is no likelihood of confusion. The opposition under Section 5(2)(b) fails in its entirety.

Section 5(3)

102. 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”.

103. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

104. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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* and *Environmental Manufacturing, paragraph 34*.

(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*).

Reputation

105. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

106. The relevant date to assess whether the opponent has a reputation is the priority date of the contested application, namely 10 November 2017.

107. Under Section 5(3) the opponent relies on the mark 'JAGUAR' and claims reputation in relation to *motor land vehicles; parts and fittings for all of the aforesaid goods*.

108. I refer to what I have said above about the distinctiveness of the mark. There is no doubt that 'JAGUAR' has a massive reputation for the goods claimed.

Link

109. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

I found the marks "JAGUAR' and 'CarJager' to be visually and aurally similar to a slightly above medium degree. Conceptually, the opponent's mark 'JAGUAR' conveys a clear concept that has no counterpart in the application; this makes the marks conceptually different. The same goes for the word 'Car' in the applicant's mark which has no counterpart in the opponent's marks - although the concept of a car is descriptive in relation to some of the contested services.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or

dissimilarity between those goods or services, and the relevant section of the public.

The applied-for services are either identical or similar to various degrees to the goods and services covered by the opponent's registrations, however, they are not identical to the opponent's goods so far as motor land vehicles are concerned – these are the goods in relation to which the earlier mark has a reputation. With the exception of *Wholesale services in relation to vehicles; Retail services in relation to vehicles, Auctioning of vehicles;* which I find to be similar to a medium degree to the opponent's motor land vehicles, I find that the remaining services in class 35 are dissimilar. I also found that with the exception of *Insurance for garages; Insurance services relating to sport,* the applied-for services in classes 36 are similar to the opponent's motor land vehicles to a low degree. As regards the applied-for services in class 37, which cover a range of repair and maintenance services for vehicles, I find that they are similar to a very low degree to the opponent's vehicles because it is usual in the relevant market sector for manufacturers of cars to also provide technical assistance and support services, including vehicle repair and diagnostics. Moreover, using the same undertaking to provide both the goods and the maintenance and repair services gives a certain guarantee of quality, namely that the services will be rendered appropriately and using original spare parts. There is therefore a certain relatedness between the opponent's goods and the applied-for services, which gives rise to a degree of complementarity. These goods and services have the same relevant public and may have the same distribution channels. Finally, Ms Beaton's evidence refers to the opponent providing car hire and fleet hire services,⁶ which suggests a slight degree of overlap between the opponent's goods and the applied-for car rental and car hire services to the extent that the goods and services may have the same commercial origin and that the relevant public and the distribution channels may be the same. Finally, I find that the remaining services in class 39, namely the various transportation, delivery, storage and parking services, are one step removed from the opponent's goods.

⁶ AJB35-39

The strength of the earlier mark's reputation.

I found that the mark 'JAGUAR' has a massive reputation for cars.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

The distinctiveness of the mark 'JAGUAR' is enormously high in relation to cars and in relation to retail services connected with the sale of cars.

Whether there is a likelihood of confusion.

For the reasons already given, there is no likelihood of confusion.

110. I find that the reputation and distinctiveness of 'JAGUAR' is such that a significant proportion of the relevant public would make a link with 'JAGUAR' on seeing (or hearing) 'CarJager'. This is because by bringing to mind the goods for which the opponent is well-known, i.e. cars, the element 'Car' in 'CarJager' may predispose the average consumers to associate (but not misread or mishear) the element 'Jager' with 'JAGUAR' and call the latter mark to mind even where the applied-for services do not relate to cars.

Damage

111. In terms of damage, the opponent's claim both unfair advantage and detriment to the distinctive character and reputation. Its pleadings are as follows (emphasis added):

- Unfair advantage:

"The taking of a mark which is similar to the mark of the opponent is feeding off the reputation acquired through their use, and this makes the applicant's advertising and marketing much easier, involving far less risk to the applicant in introducing a new service onto the UK market. This is unfair advantage";

- Detriment to the reputation:

“If the applicant’s mark is registered and used, the earlier mark’s ability to identify goods and services coming from the opponent is weakened. Use of the later mark leads to dilution and blurring of the identity of the mark JAGUAR. There is a risk that the strong image of the earlier mark JAGUAR or the characteristics it projects in terms of performance, decades of manufacturing expertise and world famous market success are transferred onto the services of the applicant’s mark, which stand to damage the distinctive character of the earlier mark in all these areas. Its advertising, communication, investment and licensing function are damaged as the images and expectations are transferred to another service, which does not originate from the opponent. The applicant would unfairly benefit from the established selling power of the opponent’s products and services”

- Detriment to the distinctive character:

“We discuss above the serious risk of image transfer and the damage this does to the opponent’s trade mark and brand. The applicant will enjoy the benefit from the reputation associated with the distinctive character of the opponent’s mark JAGUAR. The opponent keeps very tight control over the application of the mark JAGUAR and the vehicles it makes which are sold under the JAGUAR marque are considered legendary in the automotive industry. If a similar mark is being used by others for a broad range of goods and services this has the effect of diluting the exclusivity and pulling power of the opponent’s mark and its business, particularly if these goods and services relate to the motor industry. The opponent therefore keeps a watchful eye and acts to stop use and registration of conflicting marks by others. The reputation of the earlier mark would be tarnished and its guarantee function impaired if the mark of the application were used in relation to goods and services which are incompatible with the opponent’s brand and cause the public to think badly of the opponent”.

113. Although under detriment to the reputation and detriment to the distinctive character the opponent refers to dilution/blurring and tarnishment, it confined itself to merely stating that “*use of the later mark leads to dilution and blurring of the identity of the mark JAGUAR*” and that “*the reputation of the earlier mark would be tarnished and its guarantee function impaired if the mark of the application were used in relation*

to goods and services which are incompatible with the opponent's brand and cause the public to think badly of the opponent", whilst going back to the risk of "image transfer". However, the concept of "image transfer" is relevant only in the context of unfair advantage, the inference being that the later mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark.

114. The reasoning used by the opponent is rather muddled and it is not clear whether the claims of damage to reputation and damage to the distinctive character address the risk of dilution and tarnishment or the risk of free-riding/unfair advantage. Further, whilst detriment to the reputation normally involves a negative association which is liable to damage the reputation of the earlier mark, the opponent seems to mix up detriment to reputation with detriment to the distinctive character (as it refers to "dilution and blurring" under detriment to reputation and to tarnishment under detriment to the distinctive character) and unfair advantage (as it refers to the risk that the strong image of the earlier mark 'JAGUAR' or the characteristics it projects are transferred onto the services of the applicant's mark, which would damage the distinctive character of the earlier mark and cause the applicant to unfairly benefit from the selling power of the opponent's products and services).

115. In its skeleton argument Mr Edwards submitted that the risk of unfair advantage is particularly foreseeable in relation to the applied-for retail of cars services in class 35, because second-hand and vintage 'JAGUAR' cars can be sold through the applicant's retail services. He stated:

"It is not insignificant that the Applicant appears to intend to use the Application as part of a business selling 'classic, vintage or veteran cars' (see Amended TM8 §8.1). This is a context where image transfer is particularly foreseeable: the Opponent is famous among classic car enthusiasts for its Jaguar C-, D- and E-Type models, amongst others.

For all these reasons, the Application is likely to take unfair advantage of the Opponent's large investment in marketing and advertising."

116. As regards the other two heads of damage, Mr Edwards expanded on the reasons provided in the TM7 stating as follows:

“Tarnishment: Use of the Application creates a substantial risk of tarnishment, or harm to the reputation of the earlier trade mark. The Opponent is not in any position to control the quality of any goods or services provided by the Applicant under and by reference to the Application.

In light of the proximity of the Applicant’s business as a car retailer to the Opponent’s business as a car manufacturer and retailer, there is a risk that quality complaints or problems raised against the Applicant, will tarnish the Opponent’s brand by association.

Detriment to distinctive character: The Application is also likely to damage the distinctive character of the Opponent’s ‘531 Mark. There is no evidence before the Tribunal of other undertakings in this area with similar trade names or brands to JAGUAR. However, there is evidence of the Opponent’s efforts over decades to make its brand distinctive through substantial spending on marketing and advertising.

This is a context in which it is appropriate to infer damage to distinctive character (see *Lonsdale Sports Ltd v Erol* [2013] EWHC 2956 (Pat) at [32(f)] and [34]): this damage is caused by ‘putting into circulation products [or services] which do not proclaim distinctiveness but rather affinity with a reputable brand.’

117. The case which has been pleaded under detriment to reputation and detriment to the distinctive character appear to be different from that put forward by Mr Edwards at the hearing. It also seems to me that the real nub of the opponent’s claim is that there will be an unfair advantage as a result of a transfer of image in the context of retail services relating to the sale of cars. Although the opponent also pleaded detriment to reputation and detriment to the distinctive character there appears to have been some difficulty in pinning down precisely how the damage would occur.

118. In my view the opponent's claims to damage to reputation and damage to the distinctive character are bound to fail because the pleadings have not been amended and the way the pleadings were drafted does not correctly identify the particular form of damage that would be regarded as detriment to reputation and detriment to the distinctive character. In any event, the way these heads of damage were pleaded does not add much to the claim of unfair advantage. In case I am wrong, I will nevertheless, briefly assess the case as advanced by Mr Edwards.

Detriment to reputation

119. Mr Edwards argued that detriment to the reputation will occur by association, although it is not clear whether he meant that consumers would believe that there is an economic connection between the parties. Claims that use of the applied-for mark will cause detriment to the reputation of the earlier mark, because of the potentially poor quality of the applied-for services are usually rejected because the suggested consequences of the mental link between the marks are so speculative. In *Unite The Union v The Unite Group Plc*, Case BL O/219/13, Ms Anna Carboni as the Appointed Person considered whether a link between an earlier mark with a reputation and a later mark with the mere potential to create a negative association because of the identity of the applicant or the potential quality of its goods/services was sufficient to found an opposition based on detriment to reputation. She said:

“46. Indeed, having reviewed these and other opposition cases, I have not found any in which the identity or activities of the trade mark applicant have been considered in coming to a conclusion on the existence of detriment to the reputation of an earlier trade mark. I can understand how these matters would form part of the relevant context in an infringement case, but I have difficulty with the notion that it should do so in an opposition. After all, many, if not most, trade mark applications are for trade marks which have not yet been used by the proprietor; some are applied for by a person or entity that intends to license them to a third party rather than use them him/itself; and others are applied for by an entity that has only just come into existence.

47. I do not exclude the possibility that, where an established trading entity applies to register a mark that it has already been using for the goods or services to be covered by the mark, in such a way that the mark and thus the trader have already acquired some associated negative reputation, perhaps for poor quality goods or services, this fact might be taken into account as relevant “context” in assessing the risk of detriment to repute of an earlier trade mark. Another scenario might be if, for example, a trade mark applicant who was a known Fascist had advertised the fact prior to the application that he was launching a new line of Nazi memorabilia under his name: I can see how that might be relevant context on which the opponent could rely if the goods and services covered by the application appeared to match the advertised activities. But I would hesitate to decide an opposition on that basis without having had confirmation from a higher tribunal that it would be correct to take such matters into account.”

120. Accordingly, I reject the opponent’s claim based on the potential poor quality of the applicant’s services. Insofar as Mr Edwards’ argument that “*quality complaints or problems raised against the Applicant, will tarnish the Opponent’s brand by association*” alleges that the potential sale of inferior services by the applicant under the mark ‘CarJager’ would be detrimental to the reputation of ‘JAGUAR’ if consumers believed that ‘CarJager’ is economically associated/connected with ‘JAGUAR’, the answer to this is that I found that there is no likelihood of such confusion. The claim to detriment to reputation also fails.

Detriment to the distinctive character

121. In his oral submissions, Mr Edwards argued as follows:

“We say that the existence of another car-related brand with a very similar name is very likely to damage the distinctive character of the brand, particularly because as far as I am aware there are not that many Jaguar or Jaguar-themed car brands on the market.”

122. This point is clearly misconceived because the application does not cover cars or any other vehicle in class 12. When this oral submission is read in conjunction with Mr Edwards' written submission that detriment to the distinctive character would be caused by "*putting into circulation products [or services] which do not proclaim distinctiveness but rather affinity with a reputable brand*" and the reference to the decision in *Lonsdale Sports Ltd v Erol* which involved a case of a "look-alike mark" – the premises of damage caused by "look-alike marks" is that they are applied to identical products – it is clear that the opponent is incorrectly treating the application as seeking registration for cars or incorrectly equating the services (i.e. retail of cars services) to the goods (i.e. cars). In this connection it must be noted that the claim to reputation is limited to land motor vehicles (and part and fittings) but does not extend to retail services.

123. In any event, Section 5(3) only covers detriment to the distinctiveness of a mark in relation to the categories of goods/services for which the mark is registered and has a reputation⁷ and in this case there is no direct competition between the parties because 1) the applicant does not seek registration for cars and 2) the opponent did not claim reputation for retail services relating to the sale of cars. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated that:

"34. According to the Court's case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words '[i]t follows that', immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous

⁷ Roger Maier and Another v ASOS, [2015] EWCA Civ 220

paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that 'the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the proprietor of that mark'.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'."

124. In this case there is no evidence that even if the applicant's mark 'CarJager' were to 'bring to mind' the mark 'JAGUAR' this will result in a change in the economic behaviour of the average consumer of the opponent's goods. I see no reason why the mere co-existence of 'CarJager' for wholesale services in relation to vehicles and retail services in relation to vehicles (or any other services for which the applicant seeks registration) would make the mark 'JAGUAR' any less distinctive and/or compromise the capacity of 'JAGUAR' to distinguish the cars of one particular undertaking.

Unfair advantage

125. The highest case that the opponent has put forward is that use of the applied-for mark would cause a transfer of image which would benefit the applicant's business, especially in relation to the applied-for *retail services in relation to vehicles*. At the hearing Mr Edwards put the case as follows:

"On unfair advantage, the association between the applicant and the opponent's brand is likely to lead to significant advantage to the applicant. The applicant is obviously a car business and association with a prestigious and well-liked car brand is only going to enhance its image. In the counterstatement

it is said that the applicant is particularly focused on selling high end classic or vintage cars. This is set out at paragraph 8.2 of the counterstatement. That suggests it is particularly likely that the applicant will enjoy some brand enhancement from association with the opponent. That is because the opponent is associated with a number of very famous car models, the D and E-Types particularly. The advantage we say is unfair because it rides on the coat tails of the opponent's large investment in advertising and marketing”

126. At the hearing, Ms Watkinson pointed out that contrary to Mr Edwards’ submission there would be no competition between the opponent's retailers and the applicant because the applicant offers services relating to a wide range of classic and vintage cars and the opponent's retailers sell new Jaguar cars and the respective services are aimed at different markets entirely.

127. With respect to Ms Watkinson’s argument, the fact that the applicant sells second-hand vintage cars is not reflected in the specification and notional and fair use of the applied-for mark covers the sale of any type of car or vehicle (new or otherwise). Although I found that there is no likelihood of confusion, unfair advantage does not necessarily require the consumer to be confused as to the origin of the goods and services. Instead, the matter I need to decide is whether, in the context of the specific goods and services at issue, there is a risk of image transfer in the sense that the image and brand values of ‘JAGUAR’ would transfer to the applied-for mark ‘CarJager’ and this would give the applicant a significant commercial advantage.

128. *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods/services offered under the later trade mark was required to establish unfair advantage.

129. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited and Anor*, [2019] EWHC 2003 (IPEC).

130. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

131. See also *Manpower Direct (UK) Limited v Manpower Group Inc.* [2019] EWHC 849 (Ch).

132. In *Aktieselskabet af 21. november 2001 v OHIM*, Case C-197/07P, the CJEU stated that:

“22. With regard to the appellant's argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded *prima facie* that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38).

23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgment under appeal, properly established the existence of an unfair advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude prima facie that there was a risk, which was not hypothetical, of unfair advantage in the future.”

133. In *Mäurer + Wirtz GmbH & Co KG v OHIM* , Case T-63/07, the General Court held that:

“40. It is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it is also possible that the mark applied for does not, at first sight, appear capable of giving rise to one of the risks covered by Article 8(5) of Regulation No 40/94 with respect to the earlier mark with a reputation, even though it is identical with or similar to the earlier mark, in which case the non-hypothetical, future risk of detriment or unfair advantage must be established by other evidence, which it is for the opposing party to put forward and prove (Case T-215/03 *Sigla v OHIM –Elleni Holding* (VIPS) [2007] ECR II-711, paragraph 48).”

134. Whilst unlike the Lonsdale look-alike case, there would be no attraction for consumers to merely say or show that they bought their car – Jaguar or not – from a retailer called ‘CarJager’, after careful consideration I am satisfied that the images of luxury, high-value and high-performance cars and the values of speed, excellence, reliability and quality associated with the trade mark ‘JAGUAR’ (and evoked by the applied-for mark ‘CarJager’) could be transferred to the wholesale and retail services connected with the sale of vehicles covered by the applied-for mark. There is therefore an ‘image transfer’ in the present case because members of the public targeted by the applicant’s wholesale and retail services (i.e. those who intend to purchase a vehicle) are likely to consider that the positive values and images conveyed by the mark ‘JAGUAR’ in relation to cars are transferred to the wholesale and retail services

offered under the applied-for mark, in the sense that the vehicles offered for sale through the services have similar positive qualities.

135. The image transfer (and unfair advantage) is also plausible in my view for other applied-for services that are strongly linked to the automobile sector through the transfer of images of prestige and luxury, such as high-end auctioning of vehicles (in class 35), repair and maintenance of vehicles (in class 37) or rental and hire of vehicles (in class 39). However, I consider that unfair advantage cannot be established for the remaining services in the application, namely the various insurance and financial services (in class 36), parking services (in class 39) and business/advertising/intermediary services (in class 35). In those circumstances, I find that given the radically different nature of the goods and services at issue and the differences between the marks, even if a link is made, it is unlikely to cause any image transfer and unfair advantage. Further, the opponent did not put forward any convincing reason to demonstrate that the use of the applied-for mark in respect of services which in normal discourse would not be associated with the qualities and values of the earlier mark would confer a commercial advantage to the applicant.

136. The claim under Section 5(3) is successful in relation to the following services which will be refused registration:

Class 35: *Auctioning of vehicles; Wholesale services in relation to vehicles; Retail services in relation to vehicles.*

Class 37: *Roadside repair of automobiles; Maintenance of parts and fittings for commercial motor land vehicles; Installation of automobile accessories; Car wash; Rental of vehicle maintenance equipment; Automobile polishing; Vehicle cleaning; Refurbishment of vehicles; Tuning of engines; Automotive refinishing; Overhaul of vehicles; Provision of information relating to the maintenance of vehicles; Provision of information relating to the repair of vehicles; Gasoline refuelling service for motor vehicles; Information and consultancy services relating to vehicle repair; Advisory services relating to vehicle maintenance; Vehicle conversions [engine]; Garage services for the maintenance and repair of motor vehicles; Painting of vehicles; Mobile vehicle tuning services;*

Maintenance of vehicle washing installations; Maintenance, servicing and repair of vehicles; Vehicle lubrication [greasing]; Inspection of automobiles and their parts prior to maintenance and repair; Installation of electric and electronic equipment in automobiles; Installation of vehicle security devices; Providing information relating to the repair of land vehicles; Providing information relating to the repair or maintenance of two-wheeled motor vehicles; Providing information relating to the repair or maintenance of vehicle washing installations; Providing information relating to the repair or maintenance of automobiles; Assembly [installation] of parts for vehicles; Arranging for the maintenance of motor land vehicles; Vehicle tuning; Vehicle polishing; Fitting of windscreens in motor vehicles; Fitting of armour plating to vehicles; Fitting of windows in motor vehicles; Arranging for the fitting of replacement vehicle windscreens; Arranging for the replacement vehicle windows; Vehicle fueling services; Inspection of vehicles prior to maintenance; Inspection of vehicles prior to repair; Garage services for vehicle maintenance; Vehicle washing; Recharging services for electric vehicles; Vehicle service stations [refuelling and maintenance].

Class 39: *Rental of vehicle parts; Vehicle rental; Providing information relating to car rental services; Provision of hired vehicles; Arranging of vehicle hire; Loan of vehicles; Booking of hire cars; Providing information about automobiles for lease by mean of the internet; Reservation services for vehicle rental; Hired car transport; Services for the garaging of vehicles.*

137. The claim under Section 5(3) fails in relation to the following services which can proceed to registration:

Class 35: *Administration of business affairs; Administration of the business affairs of franchises; Administration of foreign business affairs; Management assistance in business affairs; Commercial management; Provision of commercial information; Market reports and studies; Research of business information; Computerised business research; Benchmarking services; Price analysis services; Arranging of buying and selling contracts for third parties; Commercial information and advice for consumers [consumer advice shop];*

Mediation of contracts for purchase and sale of products; Negotiation and conclusion of commercial transactions for third parties; Negotiation and conclusion of commercial transactions for third parties via telecommunication systems; Arranging subscriptions to telecommunication services for others; Price comparison services; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Advisory services relating to the purchase of goods on behalf of others; Business intermediary and advisory services in the field of selling products and rendering services; Arranging of contracts for the purchase and sale of goods and services, for others; Arrangement of advertising; Classified advertising; Advertisements (Placing of -); Arranging and placing of advertisements; Promoting the goods and services of others; Advertising; Online advertisements; Advertising via electronic media and specifically the internet; Promoting the goods and services of others over the Internet; Advertising services relating to the motor vehicle industry; Advertising services relating to the sale of motor vehicles; Advertising services relating to the provision of business; Advertising services provided via a data base; Advertising services provided via the internet; Advertising services relating to newspapers; Advertising services relating to books; Advertising services relating to data bases; Banner advertising; Electronic billboard advertising; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Vehicle fleet (business management of a -) [for others]; Vehicular registration and title transfer.

Class 36: *Insurance for garages; Provision of vehicle warranties; Motor mechanical breakdown insurance warranty services; Insurance underwriting; Insurance consultancy; Insurance brokerage; Insurance information; Consulting and information concerning insurance; Advisory services relating to insurance contracts; Insurance services relating to motor vehicles; Insurance services relating to sport; Consultancy and brokerage services relating to vehicle insurance; Service insurance contracts; Financial guarantee services for the reimbursement of expenses incurred as a result of vehicle accident; Financial guarantee services for the reimbursement of expenses incurred as a result of vehicle breakdown; Financial guarantee services for the*

reimbursement of expenses incurred as a result of vehicle accident or breakdown; Financial services relating to insurance; Financial services for the purchase of vehicles; Financial services relating to the maintenance of vehicles; Financial services relating to motor vehicles; Appraisal of used automobiles; Lease purchase financing of vehicles; Providing information relating to the appraisal of used automobiles; Secured loans to fund the provision of bailment of motor vehicles; Secured loans to fund the provision of instalment credit agreements on motor vehicles; Secured loans to fund the provision of contract hire of motor vehicles; Provision of finance for the purchase of vehicles.

Class 39: *Rental of vehicle parking spaces; Rental of garages and parking places; Providing information relating to vehicle parking services; Depot services for the storage of vehicles; Car parking; Valet parking; Chartering of transport; Chartering of vehicles for travelling; Vehicle location services; Transport services; Delivery services; Chartering of vehicles for transportation; Filling of vehicles with freight; Loading and unloading of vehicles; Recovery services for vehicles; Storage of vehicles; Transportation of vehicles; Rental of vehicle roof racks; Rental of traction vehicle and trailers; Arrangement of vehicle recovery; Arranging vehicle breakdown recovery; Arranging vehicle towing; Booking of seats for transportation by motor vehicles; Automobile salvage agency services; Vehicle-driving services; Vehicle salvage services; Vehicle parking and storage; Storage of vehicle parts.*

138. As regards the applied-for services in class 35, I should clarify that the reason why I have allowed the application for a range of advertising services which relate to cars – or notionally include the promotion and advertising of cars for sale, for example *Price comparison services; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Promoting the goods and services of others; Advertising; Online advertisements; Advertising via electronic media and specifically the internet; Promoting the goods and services of others over the Internet; Advertising services relating to the motor vehicle industry; Advertising services relating to the sale of motor vehicles; Advertising services provided via a data base; Advertising services provided via the internet* – is that these are all advertising services provided for other

businesses (advertising, or providing information about one's own goods is not a service) and although they may be provided for sale purposes, they do not include sale services. Consequently, I am not satisfied that use of the applied-for mark in relation to those services would give rise to any image transfer or unfair advantage.

139. For the sake of completeness, I should also mention that I have not overlooked Ms Watkinson's references to the decisions in *DaimlerChrysler AG v Alavi* (t/a MERC) [2001] RPC 42 and *Swatch AG v Office for the Harmonisation in the Internal Market (Trade Marks and Designs)* (T-71/14), in both of which the court held that unfair advantage was not established. In the first case, the car manufacturer Mercedes Benz brought a claim against a clothing company called MERC for trade mark infringement. The claim was rejected partly because the defendant had been using his brand for a very long time before the claim was brought and partly because of the difference between the two businesses. In the second case, the manufacturer of watches called Swatch was opposing an application for a trade mark called SWATCHBALL by a film equipment company called Panavision. The opposition failed because the goods in issue were so different. As Mr Edwards correctly pointed out at the hearing, these cases do not establish any general principle that is relevant to this case as they were based on their own facts, which are different from the case at hand.

Section 5(4)(a)

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

“(4) 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, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

(c)

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.”

141. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

142. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation *requires* “*a substantial number of members of the public are deceived*” rather than whether the “*average consumer are confused*”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here. Whilst I accept that the opponent has a massive goodwill in the UK, for similar reasons to those I have outlined above under the likelihood of confusion, I find that members of the public are not likely to be misled into purchasing the applicant’s services in the belief that they come from the opponent.

143. The ground based upon Section 5(4)(a) also fails.

OVERALL OUTCOME

144. The opposition is partially successful under Section 5(3) of the Act. The application will be refused for the services listed at paragraph 136. The application will proceed to registration for the services listed at paragraph 137.

COSTS

145. At the hearing, Ms Watkinson requested the applicant to be awarded costs on the top of the scale because the evidence filed by the opponent was unnecessary given the concessions made by the applicant. I reject the submission. The evidence filed by the opponent was, in my view, necessary to establish the degree of reputation of the opponent's mark as the strength of the earlier mark's reputation is one of the factors that need to be taken into account when assessing whether the relevant public would make a link. Further, the strength of the earlier mark's reputation is also relevant to other arguments, such as whether the distinctiveness of the mark has been enhanced through use and the image transfer. Finally, the evidence filed was helpful when assessing the similarity of the goods and services.

146. As both sides had achieved a measure of success, I order that each should bear its own costs.

Dated this 12th day of December 2022

**Teresa Perks
For the Registrar**