

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1410265
BY CHRYSLER MOTORS CORPORATION TO
REGISTER A MARK IN CLASS 12**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 35801 BY KENNETH COOK**

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

5
**IN THE MATTER OF Application No 1410265
by Chrysler Motors Corporation to register
a mark in Class 12**

10 **and**

**IN THE MATTER OF Opposition thereto
under No 35801 by Kenneth Cook**

15

DECISION

On 12 January 1990 Chrysler Motors Corporation, of Michigan, USA applied under
20 Section 17 of the Trade Marks Act 1938 (the old Act) to register the mark VIPER in
Class 12, in respect of:-

25
Motor vehicles and parts and fittings therefor; all included in Class 12; but not
including anti-theft and anti-tampering articles and apparatus, and not including parts
or fittings for any of these excluded goods, or any goods of the same description as
any of these excluded goods.

On 21 May 1993 Kenneth Cook, of Bournemouth, Dorset, filed notice of opposition to this
application. The grounds of opposition are, in summary:-

30

(i) under Section 11, by reason for the opponent's use of and reputation in the
mark VIPER, and

(ii) under Section 17 in that the applicants do not own the mark VIPER and their
35 adoption of it is not bona fide.

The opponent asks the Registrar to refuse the application in the exercise of his discretion and
to award costs in his favour.

40 The applicants deny these grounds. They ask for the dismissal of the opposition and an award
of costs in their favour.

Both sides filed evidence in these proceedings and the matter came to be heard on 16 February 1998. At the hearing, the applicants were represented by Mr Christopher Morcom, of Her Majesty's Counsel, instructed by Messrs Mewburn Ellis. The opponent was represented by Mr B J King, of Kings Patent Agency.

5

By the time this matter came to be heard, the old Act had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this
10 decision are references to the provisions of the old law, unless otherwise indicated.

The evidence filed in the proceedings

The opponent, Mr Kenneth Cook claims that the mark VIPER has been used by him in
15 connection with the business of the manufacture of sports cars, fully built or in kit form. Use of the mark commenced around February 1986, and seems to have continued right up to the material date in these proceedings, despite the various changes in its fortunes and despite the dissolution of the original manufacturing company, Brightwheel Replicas Limited. Material exhibited by Mr Cook in my view confirms that the mark was used fairly prominently in the
20 relevant, though highly specialised and limited, market. Mr Cook's evidence is supported by Mr Marcus Kunzli, of Oberoringen, Switzerland, who has acted as agent for the importation into Switzerland of VIPER cars.

The evidence put in by the applicants in these proceedings does not bear directly on their own
25 claim to be entitled to registration. Instead it raises the matter of a dispute between rival claimants to ownership of the mark; one of these being their own witness, Mr R D Busbridge, and the other being the opponent in these proceedings, Mr Cook. In my view it is not possible from this evidence to determine which of these, if any, is the true proprietor of the mark. At first sight, Mr Cook appears to have the stronger claim in view of Cobretti
30 Engineering's own letterheads in which they describe themselves variously as "Agents for Brightwheel Replicas Ltd" (Exhibit MK4) and "Suppliers of VIPER V4, V8 and V12" (Exhibit MK5). (Cobretti Engineering is, or was, Mr Busbridge's firm.) However, for the purposes of these proceedings I do not feel it is necessary for the Registrar to come to a view on that aspect. In these opposition proceedings neither of these persons is an applicant for
35 registration, and I therefore believe that the Registrar has no part to play in any matter between them. Ownership of an unregistered mark is not a matter in which the Registrar has any jurisdiction, I believe, unless one of the parties to that dispute is an applicant for registration of that mark. That said, I now turn to consider the matter under Section 11. That Section reads as follows:-

“11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

5

The established test for an objection under this section is set down in Smith Hayden & Co Ltd’s application (Volume 1946 63 RPC 101) as adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. In relation to the matter in hand, the Smith Hayden test may be expressed as follows:

10

“(a) (under Section 11). Having regard to the user of the mark VIPER is the tribunal satisfied that the mark applied for, VIPER if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?”

15

As I have already noted, the opponents evidence in these proceedings shows that the mark has been used for a number of years, in respect of ‘specials’ ie sports cars supplied made up or in kit form. The use is small when judged in terms of actual numbers of cars/kits supplied, but I believe it is reasonable to suppose that that is in the nature of things when ‘special’ cars are supplied in a limited market. It may be, therefore, that the use made of the mark actually represents a significant share of the relevant market.

20

The applicants, however, did not respond to this evidence with evidence of their own user, or of other special circumstances which might entitle them to registration. Instead they provided evidence that Mr Cook’s claim to own the mark is not undisputed, and as I have already stated that is not a matter in which, in these proceedings, the Registrar has any part to play.

25

I therefore conclude that there is no concurrent use or other special circumstance to be taken into account. The marks being identical and the goods on which they are used/proposed for registration being the same I feel I have no alternative but to find that deception and confusion seem reasonably likely. The opposition under Section 11 succeeds accordingly.

30

I next turn to consider the matter under Section 17(1). This matter, however, was not addressed in the opponent’s evidence, and I can find nothing in the papers to indicate that the applicants’ adoption of the mark was anything other than bona fide. The opposition under Section 17(1) fails accordingly.

35

There remains the matter of the Registrar's discretion. The opponent having succeeded under Section 11, however, and the consequences of that being mandatory. An exercise of discretion would not be possible or appropriate in this case.

- 5 The oppositions having succeeded, I order the applicants to pay to the opponent the sum of **£1050** as a contribution towards his costs.

Dated this 5 day of March 1998

10

M J TUCK

For the Registrar

the Comptroller-General