

O-130-04

DECISION OF THE TRADE MARKS REGISTRY

TRADE MARKS ACT 1994

APPLICANT: LE MANS AUTOPARTS LIMITED

APPLICATION N^o. 2214076

AND

OPPONENT: AUTOMOBILE CLUB DE L'OUEST DE LA FRANCE (A.C.O.)

OPPOSITION N^o. 90792

CLASSES 6, 7, 9 AND 12

LE MANS

TRADE MARKS ACT 1994

BACKGROUND

1. The above trade mark was applied for on 12th November 1999. The applicant is Le Mans Autoparts Ltd PO Box 475, Bedford, United Kingdom MK40 3YF for:

Class 6: Articles of common metals or their alloys, all for use with motor land vehicles; adaptors, T-pieces, pipelines, boot and bonnet fastenings, pull cables, petrol pipes, oil pipes, joiners, P-clips, hose clips, braided hose, overbraid, cable protectors, gear knobs, valve caps, door lock pins, nuts and bolts, dashpot covers, grille buttons and rampipes; all made wholly or principally of common metals or their alloys.

Class 7: Parts and fittings for engines and motors for land vehicles; turbo dump valves and parts and fittings therefor; electric fans for engines and motors; air filters and oil filters for engines and motors.

Class 9: Electrical apparatus and instruments, all for use with motor land vehicles; gauges, electrical toggle switches, fuse boxes, battery cut-out switches, push-button switches, alarm-security switches, electrical relays, fire extinguishers.

Class 12: Horns for motor land vehicles; safety belts, safety straps, harnesses and parts and fittings therefor, all for use in motor land vehicles; steering wheels and steering wheel bosses.

2. The application is opposed by Automobile Club de l'Ouest de la France (A.C.O.), who explain they are an association incorporated in 1906 by the organisers of the French Le Mans motor racing event, also known as the '24 Heurs du Mans', for the purpose of managing that event, but also 'since 1978, to hold and exploit intellectual property rights arising from' it. They are the owners of the marks in the ANNEX. They claim that the mark has been used by the opponent since 1906 'in relation to the organisation and management of an annual motor racing event'. Further, it 'has acquired an international reputation ... and is accordingly entitled to protection under the Paris Convention as a well-known trade mark.' The mark thus qualifies as an 'earlier mark' by virtue of s. 6(1)(c) of the Act. The opponent states that the applicant has no connection with the Le Mans event, and is not authorised by them to apply for the mark in suit. Other grounds in their Statement of Case are as follows:

- s. 3(3)(b), as the mark is of such a nature as to deceive the public;
- s. 3(1)(b) and (c), in that the applicant's mark is devoid of distinctive character, and/or consists exclusively of signs or indications which may serve in trade to designate characteristics of the applicant's goods, and the applicant's mark has not, before the date of application for registration, in fact acquired a distinctive character as a result of the use made of it by the applicant;
- s. 5(2)(a), in that the applicant's mark is identical to the opponent's LE MANS trade mark and covers goods which are similar to the services for which the opponent's LE MANS trade mark is well-known;

- s. 5(3), as the applicant's mark is identical, or similar, to the opponent's LE MANS trade mark and covers goods which are dissimilar to the services for which the opponent's LE MANS mark is well known, and use of the applicant's mark would take unfair advantage of, or would be detrimental to the distinctive character or the repute of the opponent's LE MANS trade mark; and
- s. 5(4)(a), on the ground that the applicant's use of its mark in the United Kingdom is liable to be prevented by the opponent under the law of passing off.

3. The applicant denies the grounds as set out and both parties ask for their costs.

HEARING

4. The hearing took place in London on 16th December 2003. The applicant was represented by Mr. Lutkin of Messrs, David Lutkin & Associates, while Mr. Reddington, of Messrs. Jones Day Gouldens, appeared on behalf of the opponent.

EVIDENCE

5. I discuss this in the body of my decision.

LAW

6. The relevant sections of the Act are:

“3.-(1) The following shall not be registered

(a) ... ,

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) ... ;

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

“(3) A trade mark shall not be registered if it is

(a), or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) ... ,

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

(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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 Community trade mark, in the European Community) 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.

(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, or

(b)

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

“6.-(1) In this Act an ‘earlier trade mark’ means -

(a) ... ,

(b) ..., or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

DECISION

The opponent’s evidence

7. It seems to me that the opponent has to prove, in relation to his own rights under the name, that LE MANS is an indication in the UK that is recognised as a trade mark. In other words, the average consumer in this country sees it an instrument, a brand indicative representative of

business activity. Looking at the evidence supplied by the opponent, they also seek to show that they are known as the organiser of the race.

8. In his Witness Statement, dated 7th October 2003, Mr. Reddington seeks to draw support from his belief that the commercial interest of the organisers of sporting events and sporting teams in exploiting the reputation of those events is widely acknowledged. In other words, there is an expectation that the famous events or venues will be the property of someone, even if the someone is not known (though, in this case, the opponent contends that they are well known in the UK). This principle is well established for goods, but may also be true of a service: ‘... the customer does not know or care who the manufacturer is, but it is a particular manufacture that he desires’ (*The Birmingham Vinegar Brewery Company, Limited Appellants v Powell*. [1897] A.C. 710).
9. In support of his proposition, Mr. Reddington refers to a decision of Advocate General Colomer (Exhibit JR3), to extracts from the UK and Community trade marks registers (Exhibit JR3) and to the following websites (see JR5):
 - “(i) www.fifa.com - the official website of the Federation Internationale de Football Association
 - (ii) www.letour.fr - the official website of the Association du Tour de France
 - (iii) www.olympic.org - the official website of the Olympic movement
 - (iv) www.lords.org - the official website of the Marylebone Cricket Club
 - (v) www.wimbledon.org - the official website of the All England Law Tennis Club (Wimbledon) Limited
 - (vi) www.rugby2003.com.au - the official website of Rugby World Cup Limited
 - (vii) www.formula1.com - the official Formula 1 website
 - (viii) www.arsenal.com - the official Arsenal FC website
 - (ix) www.tottenham.com - the official Tottenham Hotspurs FC website”.
10. I feel that it is not proven that the link between the organisers of such events and exploitation of their reputation is now widely acknowledged. If it is, Mr. Reddington has not shown that it is so, as there is no evidence that this is a common expectation amongst consumers in general- the ‘state of the Register’ evidence he cites (Exhibit JR4) does not establish this. Advocate General Colomer’s comments seem to me to be restricted to football. And does the name WIMBLEDON conjure an event in the minds of the public? Is it seen as commercial property of the All England Tennis Club? Is it both? The same questions might be asked of the other events and sporting venues cited by Mr. Reddington. I am inclined to believe that such connections must depend on the facts of each case, and I need to refer to the evidence the opponent has submitted to determine the matter here.
11. And this is extensive. It appears, for the most part, in the Witness Statement of Sophia Clare Bristow, a solicitor employed by the opponent’s representatives, and in two large files of material appended to that Statement.

12. At the start, I must admit to finding this material to be, for the most part, unhelpful. A very large amount of it is, for one reason or another, irrelevant. The exhibits in the following ‘Tabs’ (in the two large files) are of little or no import at all to their case:

Reason	After the relevant date	No certified translation	Overseas publications
Tab Numbers	2, 7, 8, 9, 21, 22, 23, 24, 30, 31, 40, 42, 48, 52, 54, 55, 56, 57, 58, 59, 61 and 62.	6, 32, 33, 34, 35, 36, 37, 38, and 39	Tabs 13 to 18, 25, 26, 28, 29, 49 and 63 to 71.

I will return to this matter in costs. In the meantime, as a consequence of my contention that the material is of mixed quality, I wish to comment on each part thereof. Before I do, I want to quote from the Statement made on behalf of the applicant by Mr. Stuart Cumming, their Managing Director:

“It seems that Ms Bristow’s Clients, whatever they are called, are or have been race organisers or, according to her paragraph 5, race sponsors. Closer examination of the extraordinary (physical) weight of her ‘tabs’ shows something contrary to what she disingenuously would like the Registry to believe. That close examination shows that the race was not even called ‘Le Mans 24 Hour’ or ‘24 Heures du Mans’ in the early years and that the race has never, ever, been called ‘Le Mans’ by her Clients – only by other people. As shown in ‘Tab 3’, it was called the ‘24 Hour Endurance Grand Prix’ or simply ‘A 24 Hour Race’ until, it seems, the 1960’s (according to Tab 3) when it became ‘24 Heures du Mans’. Ms Bristow continues to be disingenuous in her paragraph 7 when she talks of ‘the yearbook produced for the 1984 Le Mans race’ to describe what the exhibit in question (Tab 4) clearly says that the yearbook is ‘devoted to the 1984 edition of the 24 Hours’. Of course, I am quite prepared to acknowledge that someone – possibly Ms Bristow’s Clients – have established a reputation for organising races under the names ‘24 Heures du Mans’ and ‘Le Mans 24 Hours’ at the town of Le Mans.”

13. The first document referred to by Ms. Bristow (Tab 1) is described as a potted history of the race. Ms Bristow cites the following passage, taken from page 4, beginning in the third paragraph in the right hand column:

“In 1923, the first Le Mans 24 Hour event took place ... it was to be the first of a series that would celebrate its sixtieth race in June 1992. The prestige of the Le Mans 24 Hour race has never dimmed 50,000 British supporters cross the Channel every year and head to Le Mans as well as many Japanese enthusiasts, the latter accompanied by national television crews. The effect of the magic words ‘Le Mans’ are easily recognisable when one travels abroad.”

14. The history contains a brief introduction to the race and, in the main, consists of individual descriptions of each race from 1923 onwards to 1991. I note that the name LE MANS 24 HOURS dominates. But LE MANS also appears (see the quote above, and in the first sentence of the ‘Preface’, for example, but also throughout the document itself), as the name of the race, but also as a reference to ‘Le Mans’, the city. Nevertheless, though this document mentions the opponent, I note it is an English translation of a French publication, and there is no indication of the extent to which it has been made available in the UK.

15. Tab 2 is after the relevant date and I have ignored the reference made to the opponent on this basis as it could have had no contribution to its notoriety in the UK before the application was made. I also note that the opponent is described as ‘a suitable sponsor’ of the event, not as its organiser. Again, LE MANS is used as the name of the race.
16. The copies of the posters (Tab 3) do not refer to LE MANS at all, but, for the most part, to 24 HEURES DU MANS. Further, though they are on sale at the race, there is no information on how many have been sold and to whom. Though I note that earlier reproduction posters use the expression ‘organisé par’ of the opponent, the later ones do not, and the citation of the name could easily be taken as a reference to sponsorship only. The opponent is described as ‘France’s largest and best known automobile club’ (see Tab 7), a very likely sponsor. In this respect (though after the relevant date) the use of the opponent’s name alongside Mobil, SARTHE and other brands, in the 2000 poster would tend to confirm what must, these days, be a very familiar expectation in the average consumer.
17. The criticism levelled at the posters, that I have no idea of the extent of their exposure to the UK public, can also be made of the year books, an extract of which is given in Tab 4, referred to by Ms. Bristow (paragraph 7ff). Though they have been sold at the race for ‘many years’, I am not told how many. And, again, I note that many of the examples of the books, the covers of which are shown in Tab 5, refer to the 24 HEURES DU MANS or THE LE MANS 24-HOURS RACE. Where the name LE MANS is used – as in Tab 4 by the President of the A.C.O. (the opponent) – it is as the name of the race, and of the city, as before.
18. The extent of the exposure of the official programme of the race (Tab 52) – which is also after the relevant date – is, again, unknown, as I do not know how many of these items are sold to UK consumers. English is described as ‘.. the International language to speak if you want to feel that you belong to motor racing’ (Tab 4) – simply because these documents are in English does not mean they were purchased by UK attendees. Again, the placement of the name of the opponent alongside that other brand names (DUNLOP, DATA SPORT – see Tab 52) might encourage the conclusion that the opponent is a sponsor, and that is all. At the very least it will send out mixed messages to that population of UK consumers who did see them.
19. All these comments can be repeated of the leaflets in Tab 7. The distribution of the 15,000 and 30,000 of these took place after the relevant date (Bristow, paragraph 10).
20. Much is made of the television coverage of the race in the UK (Bristow, paragraphs 12 to 19). However, most of the data enclosed is after 12th November 1999 (Tabs 8 and 9). As for the coverage before that date (Tabs 10 and 11), I am not told what it consisted of and can come to no conclusion as to how the race was ‘held out’ to UK consumers in terms of being depicted as a brand. And what were the viewing figures? Even if they are large, I tend to believe that they would increase the fame of the race as such, and not the connection the opponent is trying to establish.
21. Turning to press coverage, this is described by Ms. Bristow at paragraphs 20 to 22 of her Statement, and it is irrelevant: there is no indication of the numbers of journalists from the UK attending the race and ALL the publications cited (other than those in this country) are without evidential value. Tabs 14 to 33 are a complete waste of everyone’s time – mine, the opponent’s agents in collecting and appending this material and the applicant’s efforts in assessing it. I have totally ignored it.

22. In relation to the coverage ‘about the Automobile Club de l’Ouest’, that in Tab 30 is all after the relevant date, and few of the publications were in the UK anyhow. This is the limit of this press coverage.
23. As to the opponent’s website (Tab 31), it might, as far as Ms. Bristow is concerned, convey ‘the message that the Opponent is the official body behind the Le Mans 24 Hour Race, and the owner of the intellectual property rights in the website’ but that material is clearly directed to the French market and, again, is after the relevant date.
24. Ms. Bristow also refers to other websites, which she calls ‘unofficial’. Again, this material is after the relevant date and I have ignored it as informative of the status of LE MANS as a mark of trade before this. The extract in Tab 42 is copied five times. I have no idea why. Further, it is not clear that it is a UK site. That in Tab 43, certainly is, but is also after the relevant date. And there is no indication of number of ‘hits’ each received from the UK. The existence of a website providing information on accommodation and travel to fans of a particular event seems to me not an unusual feature of the Internet these days – populated as it is by ‘special interest’ sites – and I can come to no conclusion as to the notoriety of the event it seeks to ‘cash in on’.
25. More significantly, the fact that an ‘unofficial’ website (Tab 43) uses the name LE MANS – and, freely, LE MANS 24 HRS – suggests that both are regarded as descriptive, and not a brand. The opponent claims no attempt to protect its trade mark by injuncting the owner of the website in the UK to stop this activity; which is surprising in that they appear to be involved in similar commercial enterprises themselves (see Tab 7).
26. The references to websites in Tabs 61 and 62 are equally irrelevant as they are also dated well after 12th November 1999. That in Tab 44 is undated and I have also ignored it.
27. Under ‘Merchandising and licence agreements’, Ms. Bristow states that the opponent ‘is the official owner of the trade mark rights in the Le Mans 24 Hour Race’. The extent of these rights in the UK remain to be seen. If I am to base them on the evidence given in paragraphs 30 to 41 of Ms. Bristow’s Statement, a pale thing they would be too. The agreements in Tabs 32, 33, 34, 35, 36, 37 and 38 are all in French, without certified translations. I have no idea of their jurisdiction, content and extent. I have ignored them. The same is true of the agreement with Dunlop (Bristow, paragraph 37). And I do not regard 65,000 or so tyres, sold some nine years before the relevant date – in what must be a vast market – as enough to create a protectable reputation in the UK. I note, also, that Ms. Bristow is careful in her use of language: she does not say that Dunlop purchased this right for the UK – which would imply they accepted that the opponent had rights in the name in that jurisdiction. The closest is ‘Europe’: with no translation of the French available to me, that might, or might not, include the UK. If the latter, any goodwill under the name would have ‘mapped’ to Dunlop, and not to the opponent. This evidence is worthless.
28. I note that Porsche produced a limited edition of ‘Le Mans’ cars in 1980/81. I am not told how many were sold in the UK, only that they were ‘released’ (see Tab 60). Was use of the name licensed by the opponent? I am not told.
29. The licence to Infogames (Bristow, paragraph 39) took place after the relevant date. As did the sales listed. The licence with Sega (Bristow, paragraph 40) is, again, in French. The sales listed, though before the relevant date, appear to apply ‘world-wide’ and not to the UK. Even if they were so restricted, the number sold, set against the video games market as a whole, must be considered pitiful.

30. As to the sale of Bentley cars (Bristow, paragraph 41), were these in the UK? Do the negotiations referred to apply to the UK? Again, I am not told.
31. Ms. Bristow mentions a film called ‘Le Mans’, released in 1970 and starring Steve McQueen (Bristow, paragraph 42). When a film is described as a cult classic, it usually means it was a failure at the box office but, subsequently enjoys ongoing, if not widespread, popularity. I have no information on the extent of its circulation, particularly in the UK, and I am not told whether the opponent is even mentioned in the film. If I assume that this film was a great success in the UK (this is quite an assumption) without this detailed information as to its content, I can only infer that it would have increased the fame of the race as a race and nothing else, and not ‘feed’ any a connection of the name to the opponent. But I can’t even do that.
32. Ms Bristow does attempt to include ‘UK-based’ material (Bristow, paragraph 44ff), but this is also of limited value. Most is after the relevant date (see Tabs 21 and 48, for example). Despite this, the ‘fame’ of the race is referred to. I note the following, typical example, from Tab 21, from the Times, 16 June 2001:

“For many motorsport fans, Le Mans is quite simply the greatest race on Earth ... the event’s special atmosphere is intoxicating and addictive, which is why up to 60,000 British fans make the annual pilgrimage to northern France ... Although, back in 1923, the inaugural 24-hour road race was largely a French affair, the novelty of racing through the night quickly found appeal on this side of the Channel, and the midsummer marathon has been close to the eccentric British heart ever since”.

33. Ms. Bristow refers to a ‘sample of British newspaper and magazine articles about the Le Mans race’. Again, many are after the relevant date. Those that are not, are:
- Tab 19: Le Mans & Sports Car Racer. I note that the first issue was published in April 1999. But what was the extent of its circulation? Is the opponent mentioned in the magazine?
 - Tab 53: Autosport Magazine, 28th May 1998. The same comments can be made. The uniqueness of the race is referred to, but there is no reference to the opponent.
 - Tab 55: Autosport Magazine, again, this time from 1996. The numbers of British fans attending is mentioned. The address of the opponent is provided, but only as a ‘USEFUL ADDRESS’ together with that of the Office of Tourism.
34. The survey in Tab 49 has not been translated, and I have ignored it, largely. However, I note the enthusiasm of the UK attendees, reported by Ms. Bristow.
35. I am prepared to accept that the name is known in the UK. This is despite the fact that a significant amount of the opponent’s evidence refers to ‘world’ knowledge and not to that within the UK as such. The following quote (Tab 42), is an example:

“The 24 Hours of Le Mans ... is a race that is run over rural roads, combined with a main highway and a small section of sanctioned race circuit ... Teams made up of motorsport professionals from all over the world come to this event ... Nearly every automobile manufacturer has competed in this race at one time or another. For the manufacturers, winning this race means huge sales in the market place – some manufacturers will build

a team JUST FOR THIS RACE. For the teams and drivers, having won such a race is a most impressive feat to have in one's bio. The 24 Hours of Le Mans ... is to Europe what the Indy 500 is to the United States. Nearly 300,000 spectators attend this race every year and it is broadcast via satellite to nearly every country in the world – it's a big deal folks!"

36. Indeed, my overall impression of the opponent's evidence is that most of it – the vast majority in fact – does not consist of material that is made available in the UK at all, but at the race itself. True, some of the 50,000 or so UK fans (only 23,000 in 2001, see Bristow, paragraph 53) make their way to the race each year, but this is a tiny fraction of the UK population (less than 0.1%), and I assume that a good proportion of this number will be enthusiasts returning year on year (see Bristow, paragraph 53). In short the, exposure of the UK population to material that might set out a link between the name LE MANS and the opponent is small.
37. However, there is enough information from UK publications – see the citations above – to conclude that the name is, as I say, known in the UK. Nevertheless, on the basis of the evidence I have seen I do not believe that the opponent has shown that the name is *well* known in the UK. There is no material showing that the name has a currency beyond the 'motorsport fans' mentioned in the Times article quoted above. – In my view, the opponent has not *proved* that the name has a reputation like 'The Grand National' has for horse racing, which extends beyond the mere enthusiast to consumers at large. The opponent's evidence, I believe, fails even in this respect. Despite this conclusion, I think, were I pressed, I would take judicial notice of the fact that the name LE MANS is famous for a race, as a 'notorious fact'; one would have to be living in a cave in the UK not to have heard of it in that context. I think this conclusion can also be inferred from Mr. Cumming's statement, where he says (Cumming, paragraph 7):

"The evidence shows that 'Le Mans' has become a colloquialism or a generic term for a race which takes place in the town of Le Mans...."

38. In summary, LE MANS has a well-known significance as the name of a place at which an annual motor racing event occurs – it is indicative a race in a place – but there is nothing to show that there is any belief that it has commercial import in the minds of the UK public in general – which is the *sine qua non* that must be shown of a famous mark. In particular, the opponent has not shown it is famous in the name in the UK as race organiser.
39. In my view, the name LE MANS will not be seen as a trade mark in the UK. The opponent has not filed any independent evidence to assist their case. Even accepting the term is well known, if it has acquired a secondary meaning as a brand, there is insufficient evidence to conclude that this is now the principal signification, and it is likely that most consumers, particularly outside the immediate field of motor racing enthusiasts, would see it mainly or exclusively as a name of a race. The opponent has not provided evidence to show that the public regard the term as a trade mark. In my view, the following extract, from Tab 3, sums this up:

"Le Mans is a word that conjures up motor racing in the minds of people all over the world, and it is a city that we are proud to live in"

Indeed, I note that Ms. Bristow herself states that, 'the only real draw of Le Mans as a town is the car race itself'. This is my conclusion from the opponent's evidence.

S. 3(3)(b)

40. In my view this ground is a ‘non-starter’. *KERLY’S LAW OF TRADE MARKS AND TRADE NAMES* (13th Edition), paragraph 7-164:

“Section 3(3)(b) of the 1994 Act prevents the registration of deceptive marks ... The paragraph itself cites some non-exhaustive examples: trade marks which are of such a nature as to deceive the public as to nature, quality or geographical origin of the goods or services. In general, if a mark gives rise to an expectation which will not be fulfilled, then registration will be refused. The expectation (and hence the objection) must be a real one, as opposed to something obscure or fanciful, arising from the mark itself.

There are two features of this provision to note. First, it is an absolute and not a relative ground for refusal. It is concerned with deceptiveness which is inherent in the mark itself, as opposed to deception caused by the similarity of the mark to another. The latter type of objection arises under the relative grounds in section 5. Likewise, an objection that use of a mark would result in passing off arises under section 5(4)(a) and not under section 3(3)(b). Secondly, the paragraph refers expressly to deception caused by the nature of the mark itself. This does not mean that the mark has to be considered in a vacuum. It must be considered against the goods or services applied for and in the general context of the relevant trade.”

41. Though I do not believe that either party departed from the view that ‘Le Mans’ is famous for a race involving high performance cars, I do not believe the name could be taken as deceptive, that is, giving rise to an expectation which will not be fulfilled amongst consumers
42. Such deception can occur in a number of ways: as *KERLY’S* states, the list given in the Act is not exhaustive. One example might occur where a name is indicative of quality, as in *STAINLESS SUREFIT* for ‘exhausts’, in that stainless steel exhausts are of greater value, being more durable than others made of inferior metal. Though the name ‘Le Mans’ might be allusive of speed and durability, I do not believe this is enough to make the mark ‘inherently deceptive’ when used on the goods in the specification. The expectation in the consumer would not be real enough.
43. It might have been, however, if Le Mans, the place – and this is an alternative example – was renowned for the manufacture of car parts; thus a ‘Le Mans oil pressure gage’ would convey geographical, not trade origin. It is not, and the sign does not. As a consequence, I do not see how this ground can succeed and it fails.

s. 3(1)(b) and (c)

44. The opponent contends that, as per the words of Mr. Reddington at the hearing, that:

“Le Mans is the name of a French geographical location which has hosted the motor racing event known as Le Mans since 1923. The opponent’s evidence shows that the motor racing event is well known in the United Kingdom under the name Le Mans. The name embodies ideals such as speed, excitement, competitiveness, durability, reliability in relation to motor racing and, by extension, motorcars more generally. As such the name refers the consumer to qualities and characteristics which are highly desirable in relation to motorcars and their parts and fittings and is in the prima facie case objectionable pursuant to 3(1)(b) and (c).”

Though I note from the Statement of Case that the opponent pleads its ‘relative’ rights ‘in the alternative’, the claim of Mr. Reddington that the commercial interest of the organisers of sporting events in exploiting the reputation of those events is widely acknowledged does not fit well with his claim here that LE MANS cannot act as a mark of trade *prime facie*.

45. As I have said, I have examined the opponent’s evidence and concluded that it does not show that the name is famous in the UK as a symbol of the various characteristics given. I concluded, however, on the basis of a statement made by the applicant – and by virtue of judicial knowledge – that the name is indicative in the UK of a car race in France. I am prepared to suggest that, on seeing the sign, many will call to mind the race. Many of these will understand that the name carries a certain cachet because the race involves high performance cars. There is no evidence to show that the most consumers will read into the sign all that Mr. Reddington has read into it.
46. But, even if they did, I do not see how the s. 3(1)(c) ground can succeed. The name, viewed from this perspective, does not consist exclusively of a sign that may serve, in trade, to specify the kind of the good (Le Mans gauges (for example) do not exist as might a ‘rip’ saw for tools), nor quantity, intended purpose, value, geographical origin (Le Mans is not recognised as a manufacturer of car parts), the time of production of goods or of rendering of services, or other characteristics of goods or services. The closest the opponent might come, here, is to quality, but even that fails, in my view, as the name insinuates quality in the goods, but does not describe it.
47. That leave s. 3(1)(b). It is possible that the mark could be one of those species of sign that lacks the character to be a mark of trade without falling foul either of section 3(1)(c) (as I have already found) or 3(1)(d)? That is, will it, simply not be seen by consumers as a mark of trade? I do not see this is the case here. Consumers, as I have stated, will think of the race, but I do not believe this connection is enough to make the sign one that might be applicable to any undertaking and not only one. I believe that the mark is registerable *prime facie*.
48. Even if I am wrong in this, the applicant has submitted evidence of use of the mark on his goods. I note the following from Mr. Reddington’s submissions at the hearing:

“Evidence of distinctiveness acquired through use must show a clear link between the sales figures, the goods and the trade mark, and the purpose of exhibiting materials is to show that the goods sold are goods bearing the trade mark especially where the applicant sells a mixture of third party goods, generic goods and own brand goods. The applicant’s approach has been not to discriminate between these various types of goods. The price lists and brochures for 1996 to 1998 show no use of the Le Mans trade mark in relation to the specified goods. There is not a single illustration of any product bearing the trade mark. On the contrary, the lists refer to branded goods manufactured and sold under third party trade marks and those are marks which are well known in the motor industry, such as SW gauges, SU carburettors, Richbrook, Piper Cross and so on. Absent any breakdown of sales figures between these branded items, unbranded items and, later on, the Le Mans branded items, the applicant’s sales figures are meaningless and unreliable.”
49. The applicant’s evidence appears in Exhibit DBL1 to the Witness Statement of David Brain Lutkin, a trade mark attorney acting for him. He explains that the evidence was filed during ‘the course of prosecution of the application’ in suit. That in Exhibit DBL1 is a copy.

50. The latter consists of a Statement from Mr. Stuart Cumming, the Managing Director of the applicant since 1996. He states the mark has been used by the applicant (and its predecessors in title) since ‘as early as 1990’ in respect of all the goods for which registration is sought’. Sales under the name are given as:

Year	Sales value:
1990	£30,000
1991	£45,000
1992	£60,000
1993	£90,000
1994	£150,000
1995	£200,000
1996	£250,000
1997	£325,000
1998	£400,000
1999	£480,000
2000	£510,000

51. I can consider only the data up to 1999, the year of the relevant date. Mr. Cumming states that the ‘mark up’ at retail is ‘on average’ 100%. Advertising is by virtue of the price lists exemplified in evidence, which I will consider shortly. The applicant has also exhibited at ‘Autosport International’ in 1998, 99 and 2000. The annual expenditure has been in the region of 5% of turnover. Mr. Cumming adds:

“My Company’s LE MANS products have been sold throughout the United Kingdom, including approximately 150 ‘A1’ Motorstores since 1996, 500 ‘Caar’ stores since 1997 and 500 ‘Halfords’ stores since 1999 and to approximately 800 direct account customers.”

The price lists cited by Mr. Cumming appear in Exhibit A of Exhibit DBL2. They relate to the years 1996, 7, 8 and 99. There is no material evidence before 1996. The Exhibit is hard to comment on because it has not been properly numbered, but I will do my best to comment on the documents it contains.

52. The first price list in Exhibit A is titled ‘Le Mans Autoparts Ltd.’, a reference to the company name of the applicant, and it states ‘JULY 1996 PRODUCT LISTING WHOLESALE PRICE LIST’. I assume that the pages that follow are part of the same document, though this is not obvious: the next page is titled ‘JULY 1996/JAN 1997 PRICE LIST DISCOUNT STRUCTURE’. Nevertheless, dates are before the relevant date. I note that the first six pages of this document refer to other trade marked goods (TIM GAUGES, RICHBROOK, PIPERCROSS, SPEEDWELL etc.), but not to any goods clearly marked with the LE MANS mark. The seventh page, entitled ‘MAIN INDEX JULY 1996’ has a list of sections, which describe the pages that follow. Section 1, (typical of the majority of the sections) contains ‘AUTO-ELECTRICAL PARTS’: there is a significant range of these, including fuse boxes, push button switches, warning lights, toggle switches key switches, electric horns, etc. In the pages that follow their whole sale price is given, but there is nothing to show that any of these products were marked with the Le Mans mark. The same can be said of most of the other sections that follow, which cover a range of parts and accessories that appear to include the range of products specified with the application. Where trade marks of third parties appear in these sections, this is for identification purposes (see ‘STROMBERG SPARES’ in section 5.5). I note also that each of these earlier sections all end with the ‘codicil’: ALL PRODUCT PACKAGED AND BARCODED. The codicil is different for sections that clearly list

branded products (see next paragraph) – for example, in section 13, where the statement ‘SEE CLOVAFAN BROCHURE FOR COMPLETE SPECIFICATIONS’ appears. An exception to this appears in Section 10, where ‘ALL GAUGES ARE BOXED BY LMA WITH INSTRUCTIONS...’ etc, even branded ones (‘SW’). ‘LMA’ is the acronym for ‘Le Mans Autospares’.

53. The applicant stocks extensive third party goods: see section 11, where ‘TIM’ gauges are cited. Though it is not wholly clear, sections 12, 13 and 14 can be included in the latter category as well. These refer to ‘PIPERCROSS FILTERS’, ‘CLOVAFANS’ and ‘SPEEDWELL ACCESSORIES’.
54. The next catalogue is dated ‘DEC 99’, and follows much the same pattern, though with branded goods, perhaps, being more apparent. I also note that the applicant markets its own ‘labelled’ goods, as well (see the unnumbered page 5 of the 1999 catalogue); I also note that, further on in this document, ‘LE Mans Styling’ is referred to. In my view, though I note the comments of Mr. Reddington, I believe the applicant has overcome any weaknesses in its choice of trade mark – if such exist – by the use it has made of it. It has a reputation in its own goods, and that as a sort of supermarket for the goods of others. This ground also fails.
55. In passing, I note that the applicant has argued that the market for his goods is a specialised one. The opponent says that it is not, noting that the car parts market is some £13B per year (Bristow, paragraph 59). In response to this, Mr Cumming states that it is evident from the brief description in ‘Tab 50’ that the car parts market is not homogenous. He adds:

“As an expert in that market [t]he ‘car parts market’ ... is dominated by sales to the OEM market, followed by sales of replacement parts (sold as generic parts or under brands such as FORD, TOYOTA and RENAULT) for when the original parts wear out or break down. The market we are discussing is the specialist, bespoke components market sold under distinct brands, which ‘Tab 50’ does not discuss. Removing the OEM and replacement market, the picture is very different LE MANS is one of the leading brands in the relevant market, supplying customers with ‘custom’ components since 1990.”
56. In his Statement in Exhibit DBL1, Mr. Cumming states that his products are made to the highest standard of engineering quality. And are marketed to ‘those people with the skill and enthusiasm to enhance their motor vehicles’.
57. Though I recognise that many of the items listed in the applicant’s specification are of a specialist nature, it also appears to cover items that will be of interest to all the trade, not just enthusiastic consumers. This is a wide market and I do not feel I can restrict it in the manner in which Mr. Cumming suggests. The specification does not do so and his definition is too ill-defined to provide a sensible limitation. It would seem to include a very significant number of car owners and ‘Halfords’ – one of the retail stores to which the applicant’s products are supplied – are a high street name in motor accessories.
58. Nevertheless, though the reputation associated with the applicant’s business is small against the background of the trade motor vehicle spare-parts in the UK, in my view it is not *de minimis* and it is real. The average consumer includes the trade with whom the applicant deals with directly – and with consumers in general. I cannot assume any specialist knowledge of the latter, but I can of the former. It seems to me, therefore, that the mark does enjoy sufficient a reputation amongst its customer-base so as to generate a trade mark right under the

proviso to s. 3(1), even if my conclusion in respect of the *prima facie* registerability of the mark is wrong.

S. 5(2)(a)

59. The applicant's goods are set out on the first page of this decision. The opponent is the proprietor of the earlier marks listed in the Annex. In my view, the only goods specified with the application that could come close to those of the opponent's goods are those in Class 3; 'Bleaching preparations and other substances for laundry use in connection with motor vehicles and their accessories; cleaning, polishing, grease removing, scouring and abrasive preparations for use in connection with motor vehicles and their accessories'. I also believe that it is reasonable to find that the opponent's registration No. 709878 is the closest to that of the applicant's; this mark is



60. The other is certainly not identical. The ECJ, in *LTJ Diffusion SA v Sadas Vertbaudet SA* (Case C-291/00) [2003] ETMR 83, ruled on this issue. The Court said:

“50 The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Article 5(1)(a) of the directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the directive.

51 There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52 However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C 342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I 3819, paragraph 26).

53 Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

54 In those circumstances, the answer to the question referred must be that Article 5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements

constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

61. In my view, neither of the signs are identical in this sense, as the between them are not so insignificant that they may go unnoticed by an average consumer. This ground fails.

s. 5(3)

62. I note the following based on the *RARE* trade mark case (BL SRIS 0-470-01), the purpose and scope of Section 5(3) of the Act being considered in *General Motors Corp. v Yplon SA (Chevy)* 1999 ETMR 122 and 2000 RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited* 2000 FSR 767 (*Typhoon*), *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, C.A. *Sheimer (M) Sdn Bh's TM Application (Visa)* 2000 RPC 484 and *Davidoff & Cie SA v Gofkid Ltd* [2003] E.T.M.R. 42 (*Davidoff*). The points that come out of these cases are as follows:

- a) ‘Reputation’ for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (paragraph 26 of the ECJ’s judgment in *Chevy*);
- b) Protection is available where the respective goods or services are similar or not similar (paragraph 29 of the Advocate General’s opinion in *Chevy* and *Davidoff*);
- c) The provision is not intended to give marks ‘an unduly extensive protection’ - there must be actual detriment or unfair advantage (not merely risks) which must be substantiated to the satisfaction of the national court or tribunal (paragraph 43 of the Advocate General’s Opinion in *Chevy* and paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J in the *Typhoon* case);
- e) The stronger the earlier mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it (paragraph 30 of the ECJ’s judgment in the *Chevy* case);
- f) Confusion as to the trade source of the goods or services offered for sale under the later mark is not a necessary condition before there can be detriment, but is one form of detriment (paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- g) Detriment can take the form of either making the earlier mark less attractive (tarnishing) or less distinctive – blurring (paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- h) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in *Visa* at page 505, lines 10-17).

63. In my view, this ground must fail because the mark is not a famous trade mark: it is a description of an event: there is no commercial notoriety associated with the name, widely, in the public domain. Certainly, the opponent has no fame in the UK for the goods specified with its registrations. As a consequence, when consumers see the name, it is the indication of

the contents of the event it labels. A member of the public will know that LE MANS is a place where a car race is held; if better informed, they might know it lasts for 24 hours. To some enthusiasts it may signify more than this, for the vast majority the name is nothing more than a descriptor of a location.

64. Following from this, there is nothing for any registered trade mark right to ‘bite-on’ and, consequently, there can be no advantage taken from, or detriment to, the opponent’s registrations. This ground also fails.

The earlier right: s. 5(4)(a)

65. Appointed Person, in the *Wild Child Trade Mark* [1998] RPC 455 case, at 459 to 461, states:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purpose of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the applicants could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in *Halsbury’s Laws of England* (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

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

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

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

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

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

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

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

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

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

66. From my analysis of the evidence, I believe that it is a reasonable conclusion to find that the opponent has no goodwill in the UK at the relevant date. If (as I believe) the name LE MANS is famous as the appellation of a race, such that any other likely significance it has is swamped, it cannot be the ‘cypher’ of goodwill under the name, then this ground fails at the first hurdle. With no goodwill, there can be no misrepresentation and no damage to the opponent’s property.

67. I note, following *Cadbury Schweppes Property Ltd v The Pub Squash Co Ltd* [1981] RPC 429, 494 as per Lord Scarman (also cited in *Inter Lotto (UK) Ltd v. Camelot Group plc* [2003] EWCA Civ 1132) the relevant date in passing off is taken to be the date of the commencement of the conduct complained of. This is the application date.

68. Taking this date as the relevant date for the purposes of passing off, I do not believe this is the end of the matter. Tab 7 shows that the opponent charges spectators for entry to the race. Though this material is after the relevant date, I think it reasonable to believe that this practice was in place before that time. If one assumes that it has continued for some years, and make the further assumption that, at least, a significant proportion of UK fans were aware of the A.C.O. as race organisers (neither assumption is shown by the evidence), in the context of the large numbers of UK enthusiasts who attend the race regularly, one may come to the conclusion that the opponent has a goodwill that might fall under ‘entertainment’ in Class 41, that is, as the organiser of the Le Mans race. Mr. Cumming appeared to concede that the opponent had such goodwill, if not in the name LE MANS, but:

“... I am quite prepared to acknowledge that someone – possibly Ms Bristow’s Clients – have established a reputation for organising races under the names ‘24 Heures du Mans’ and ‘Le Mans 24 Hours’ at the town of Le Mans.”

This is almost an admission against interest, and somewhat peculiar. If I am to accept that the opponent has a goodwill under the name LE MANS 24 HOURS this, it seems to me, is still rather close to LE MANS *per se* and thus the applicant’s mark.

69. Assuming some goodwill as a race organiser on behalf of the applicant, I note that the fields of activity of the two parties is far apart. Though, turning to the case law, a ‘common field of activity’ (*McCulloch v May* [1947] 65 RPC 58) is no longer a requirement in passing off, clearly the similarity of the trade(s) in question is a factor which must be considered

(Annabel's (Berkeley Square) Ltd. v Schock [1972] RPC 838) when determining confusion in respect of passing off. Consumers are more likely to assume a connection or be confused where trades are closely related or the same. Against this, there is the case of *Lego System Aktielskab and Another v Lego M. Lemelstrich Limited* (FSR 1983 155), where the plaintiffs were manufacturers of the famous building bricks and succeeded in a passing-off action against an old established Israeli company which manufactured irrigation equipment, including garden sprays and sprinklers constructed wholly or substantially of brightly coloured plastic material. But here there was at least a tenuous link between the products insofar as both sets of goods were made from similar materials. Further, there was substantial evidence of likely confusion in that case.

70. There is no evidence that the opponent has been engaged in extensive merchandising under the sign in the UK, that might have extended the scope of protection of its rights. Even assuming some goodwill under the name, I cannot come to the conclusion that misrepresentation is likely following use of the applicant's marks in their goods. This ground also fails.

CONCLUSION

71. The opposition fails on all the grounds, and the application proceeds to registration.

COSTS

72. The applicant has won and this requires a payment to be made by the opponent towards the cost of defending this case. Returning to issue of evidence I have never come across a case with so much irrelevant material. It seems to me that the opponent's approach to this matter was based on the principle of 'never mind the quality, feel the width'. Their evidence seems to have been submitted with no application of critical attention at all. The object of good evidence is to marry the grounds pleaded to the material needed to be adduced to support them. This the opponent singularly failed to do.
73. I felt at the hearing – and still feel – that I should recognise in costs the poor quality of this material. That fact that I have not done so is due to the following exchange, with the applicant's representative, at the hearing,:

“THE HEARING OFFICER: Costs. Any comments? To follow the event?

MR. REDDINGTON: Yes.

THE HEARING OFFICER: Are you making any submissions on the amount of evidence and the value thereof?

MR. LUTKIN: No.

THE HEARING OFFICER: So just to follow the event?

MR. LUTKIN: Yes, thank you.”



74. I order the opponent to pay the applicant £2000. This is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th Day of May 2004.


**Dr W J Trott
Principal Hearing Officer
For the Registrar**

ANNEX

International Registrations

Mark	Number	Date	Goods & Services
	709878	19.02.1999	Class 3: Bleaching preparations and other substances for laundry use in connection with motor vehicles and their accessories; cleaning, polishing, grease removing, scouring and abrasive preparations for use in connection with motor vehicles and their accessories; soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices.
	712233		

UK Registrations

24 HEURES DU MANS	1336594	25.02.1998	Toys, games, playthings; sporting articles; parts and fittings for all the aforesaid goods; all included in Class 28 and all relating to motor sport.
	1336597		