

O-002-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 2536677A & 2536677B
BY BAUER CONSUMER MEDIA LIMITED TO REGISTER THE TRADE MARK**



IN CLASSES 9, 16, 35 & 41 AND 35 & 41 RESPECTIVELY

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER NOS 100926 & 100932
BY LAND ROVER**

BACKGROUND

1) On 19 January 2010, Bauer Consumer Media Limited (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the following trade mark:



2) The application was subsequently divided and the two divided applications proceeded to publication in the Trade Marks Journal on 4 June 2010. The two applications are in respect of the following goods and services:

Application 2536677A

Class 9

Publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); electronic publications, electronic magazines; multi-media recordings and publications; computer software, computer programs, data recorded in electronic, optical or magnetic form; data carriers; audio and visual recordings; CD-ROMs; CDIs; CD-ROMs discs, cassettes and other data carriers containing information recorded in magazine form; computer databases.

Class 16

Printed matter, printed publications, magazines, journals; periodical publications; newspapers; books; newsletters; guides; printed programmes; stationery; diaries, calendars, note books, address books, writing implements; pens, pencils.

Class 35

Advertising, marketing and promotion services; provision of advertising, marketing and promotional services on-line from computer databases or the Internet (including web sites).

Class 41

Interactive information provided on-line from computer databases or the Internet, information provided on-line from computer databases or the Internet, provision of information for accessing via communication and computer networks, all relating to entertainment, education, sporting and cultural activities; publication of printed matter.

Application 2536677B

Class 35

Arranging, conducting and production of exhibitions, shows and events.


Class 41

Arranging and conducting courses, conferences, exhibitions, events and seminars; organising, conducting, production of shows, events, displays and parties; organisation of events for cultural, entertainment and sporting purposes; organisation of competitions.

3) On 6 September 2010, Land Rover (“the opponent”) filed notice of oppositions to both applications. The grounds of opposition in respect of both applications are in summary:

- a) The applications offend under Section 5(2)(b) of the Act because they are in respect of a mark that is similar to a number of earlier marks in the name of the opponent and in respect of identical or similar goods and services;
- b) The applications offend under Section 5(3) of the Act because they are in respect of a mark that is similar to a number of earlier marks that the opponent claims have a reputation. It claims that use of the mark at issue will take unfair advantage of the opponent because the applicant will benefit from the investment the opponent has made in its earlier marks. Such “free-riding, it is claimed, will result in the applicant obtaining benefit without cost. It further claims there will be detriment to the reputation of the earlier marks as the relevant public will believe that the mark applied for is connected with the opponent, but the opponent will have no control over the quality of the applicant’s goods and services. Finally, the opponent claims that the distinctive character of its earlier marks will be damaged (diluted) by use of the applicant’s mark because it would result in multiple origins of marks featuring LAND ROVER thereby destroying the function of its marks as indicators of origin.

The relevant details of the earlier marks relied upon by the opponent are detailed below:

Mark Details	Opposition and grounds where it is relied upon	Goods and services opposed
Community Trade Mark ("CTM") 4847604  Filing date: 19 January 2006 Date of entry in register: 18 December 2007	Section 5(2)(b) and Section 5(3) of Opposition 100926 against 2536677A Section 5(2)(b) and Section 5(3) of Opposition 100932 against 2536677B	All All
Goods and services relied upon All of the following except in respect of the Section 5(2)(b) grounds in Opposition 100932, where reliance is only in respect of the Class 41 services. Class 9: <i>Electrical, electronic, measuring, checking (supervision), testing, gauging, signalling, telephone, optical, photographic, fire extinguishing, control, diagnostic, and safety apparatus and instruments; cell phones; direction and location finding apparatus and instruments; apparatus, gloves and clothing, all for use in protection against accident or injury; meters and gauges; sound recording and sound reproducing apparatus and instruments, radio apparatus and instruments, and combinations thereof; parts, components and accessories for all the aforesaid goods; vehicle breakdown warning triangles; spectacles, sunglasses and driving glasses; eyeglass chains, eyeglass cases, eyeglass frames; clock radios; radios for vehicles; CD-Roms; computer software; video, audio and audio-visual tapes and discs; video games; compasses, binoculars, cameras, calculators.</i> Class 16: <i>Printed matter, stationery, maps, travel guides, books, periodicals, magazines, newspapers and printed publications; desk ornaments; office requisites (other than furniture); instructional and teaching materials (other than apparatus); writing and drawing instruments and materials; paper; articles made wholly or principally of paper, card and/or cardboard; drink mats, photographs, calendars, stickers, labels, decalcomanias, rulers, postcards, bookmarks, bookends, erasers, paperweights, and book covers; diaries, notebooks, appointment books, address books, combinations of such goods, and covers therefor, business card holders, cheque book covers, and passport covers and holders; folders, holders and covers, all intended for or containing notebooks, notepads, paper, pens, pencils, and/or erasers; road and vehicle tax disc holders made of plastic film or sheet materials; towels, napkins, serviettes, mats, coasters, handkerchiefs, tissues, cloths, absorbent wipes, and sanitary and hygienic materials, all made wholly or principally of paper and/or paper derivatives; wrapping and packing materials made wholly or principally of paper or plastics; plastic cling film; bags, sacks, and disposable covers all made wholly or principally of paper and/or plastic film or sheet materials; disposable paper protectors for carpets and seats; sheet materials wholly or principally of paper and/or paper derivatives for protecting, preserving and/or for storage purposes; disposable protectors for steering wheels and road wheels, all made of polythene or of plastic film or sheet materials.</i> Class 41: <i>Entertainment services; education and training services; competitions; sporting competitions; entertainment, training and competitions relating to vehicles, four-wheeled drive vehicles, bicycles, motorcycles; arranging and conducting of conferences, congresses, symposiums, workshops and seminars; club services; driving tuition and driving academy services; arranging and organisation of competitions and sporting competitions, sport camp services; off road driving courses; production of shows; advisory, information and consultancy services relating to all the aforesaid services; off-road driving instruction and tuition; education in four-wheel driving techniques, mechanics, map-reading, safety, and environmental matters; driving academy services; training, educational and entertainment services relating to motor vehicles.</i>		

Mark Details	Opposition and grounds where it is relied upon	Goods and services opposed
CTM 143644 LAND ROVER Filing date 01 April 1996 Date of entry in register 19 July 2000	Section 5(2)(b) and Section 5(3) of Opposition 100926 against 2536677A Section 5(2)(b) and Section 5(3) of Opposition 100932 against 2536677B	All All
Goods and services relied upon All of the following except in respect of the Section 5(2)(b) grounds in Opposition 100932, where reliance is only in		


respect of the Class 41 services.

Class 9: Electrical, electronic, measuring, checking (supervision), testing, gauging, signalling, telephone, optical, photographic, fire extinguishing, control, diagnostic, and safety apparatus and instruments; direction and location finding apparatus and instruments; apparatus, gloves and clothing, all for use in protection against accident or injury; meters and gauges; sound recording and sound reproducing apparatus and instruments, radio apparatus and instruments, and combinations thereof; parts, components and accessories for all the aforesaid goods; vehicle breakdown warning triangles; spectacles, sunglasses and driving glasses; computer software; video, audio and audio-visual tapes and discs; amusement apparatus and apparatus for games, all for use with television receivers or monitors; calculators.

Class 16: Printed matter, stationery, maps, travel guides, books, and printed publications, office requisites (other than furniture); instructional and teaching materials (other than apparatus); writing and drawing instruments and materials; paper; articles made wholly or principally of paper, card and/or cardboard; drink mats, photographs, stickers, labels, decalcomanias, playing cards, rulers, postcards, bookmarks, bookends, erasers, paperweights, and book covers; diaries, notebooks, appointment books, address books, combinations of such goods, and covers therefor, business card holders, cheque book covers, and passport covers and holders; folders, holders and covers, all intended for or containing notebooks, notepads, paper, pens, pencils, and/or erasers; road and vehicle tax disc holders made of plastic film or sheet materials; towels, napkins, serviettes, mats, coasters, handkerchiefs, tissues, cloths, absorbent wipes, and sanitary and hygienic materials, all made wholly or principally of paper and/or paper derivatives; wrapping and packing materials made wholly or principally of paper or plastics; plastic cling film; bags, sacks, and disposable covers all made wholly or principally of paper and/or plastic film or sheet materials; disposable paper protectors for carpets and seats; sheet materials wholly or principally of paper and/or paper derivatives for protecting, preserving and/or for storage purposes; disposable protectors for steering wheels and road wheels, all made of polythene or of plastic film or sheet materials.

Class 41: Off-road driving instruction and tuition; education in four-wheel driving techniques, mechanics, map-reading, safety, and environmental matters; driving academy services; club services; training, educational and entertainment services relating to motor vehicles.

Mark Details	Opposition and grounds where it is relied upon	Goods and services opposed
663199 LAND ROVER Filing date 11 October 1947 Date of entry in register 11 October 1947	Section 5(3) of Opposition 100926 against 2536677A Section 5(3) of Opposition 100932 against 2536677B	All All
Goods and services relied upon		
Class 12: Land motor-vehicles and parts thereof included in Class 12.		

Mark Details	Opposition and grounds where it is relied upon	Goods and services opposed
740778  Filing date 29 March 1955 Date of entry in register 29 March 1955	Section 5(3) of Opposition 100926 against 2536677A Section 5(3) of Opposition 100932 against 2536677B	All All
Goods and services relied upon		
Class 9: Fire-engines, fire escapes, fire-fighting appliances, and parts included in Class 9 of the aforesaid goods		
Class 12: Motor land vehicles and parts thereof included in Class 12		

Mark Details	Opposition and grounds where it is relied upon	Goods and services opposed
1378096 LAND ROVER Filing date 21 March 1989 Date of entry in register 21 August 1992	Section 5(2)(b) and Section 5(3) of Opposition 100926 against 2536677A	Class 35: Advertising, marketing and promotion services; provision of advertising, marketing and promotional services on-line from computer databases or the Internet (including web sites).
<p>Goods and services relied upon</p> <p>All goods and services relied upon in respect of Section 5(3), only Class 35 is relied upon in respect of Section 5(2)(b)</p> <p>Class 2: Paints, coatings and rust prevention compounds; all included in Class 2.</p> <p>Class 3: Substances for cleaning and polishing; scouring and abrasive preparations; soaps; all included in class 3.</p> <p>Class 4: Industrial oils and greases; lubricants; all included in Class 4.</p> <p>Class 5: First aid boxes (filled) included in Class 5.</p> <p>Class 6: Nuts, bolts, washers and fasteners; wire ropes, metal badges; all included in Class 6.</p> <p>Class 7: Boat engines, aeroplane engines; fuel pumps, carburettors and engine fuel injection apparatus; turbochargers, electric ignition devices, engine speed governors, oil filters; lubrication pumps and electric generators; parts and fittings for all the aforesaid goods; all included in Class 7.</p> <p>Class 8: Hand tools and hand instruments, all included in Class 8.</p> <p>Class 11: Car air conditioning apparatus; vehicle lights and lighting apparatus for vehicles; parts and fittings for all the aforesaid goods; all included in Class 11.</p> <p>Class 14: Jewellery, goods made out of or coated with precious metals; horological and chronological instruments; all included in Class 14.</p> <p>Class 18: Articles made from leather or imitation leather; trunks, travelling bags; umbrellas and parasols; all included in Class 18.</p> <p>Class 20: Badges included in Class 20.</p> <p>Class 27: Carpets and mats; all included in Class 27.</p> <p>Class 28: Games (other than ordinary playing cards), toys and playthings; models being toys; amusements contrivances and apparatus; all included in Class 28.</p> <p>Class 35: Business management and advisory services; all relating to the manufacture, sale, repair and maintenance of motor vehicles; advertising; market research; import and export agency services; computerised business management services; business information, planning and inspection services, all relating to the motor vehicle industry; business advisory services relating to franchising for the establishment and maintenance of motor dealership and vehicle spare part enterprises; all included in Class 35.</p> <p>Class 36: Financial and insurance services, all relating to the motor trade and to motor vehicles; all included in Class 36.</p> <p>Class 37: Repair and maintenance services all relating to motor vehicles, parts, fittings and accessories; all included in Class 37.</p> <p>Class 39: Leasing, rental and hire services for motor vehicles, storage facilities for motor vehicles, parts and apparatus; all included in Class 39.</p>		

Mark Details	Opposition and grounds where it is relied upon	Goods and services opposed
CTM 2374346 LAND ROVER Filing date 13 September 2001 Date of entry in register 24 January 2003	Section 5(2)(b) and Section 5(3) of Opposition 100926 against 2536677A Section 5(2)(b) and Section 5(3) of Opposition 100932 against 2536677B	Only Class 41 under the Section 5(2)(b) grounds, all goods and services under the Section 5(3) All
Goods and services relied upon		
<i>Class 41: Entertainment services; education and training services; competitions; sporting competitions; entertainment, training and competitions relating to vehicles, four-wheeled drive vehicles, bicycles, motorcycles; arranging and conducting of conferences, congresses, symposiums, workshops and seminars; club services; driving tuition and driving academy services; arranging and organisation of competitions and sporting competitions, sport camp services; off road driving courses; production of shows; advisory, information and consultancy services relating to all the aforesaid services.</i>		

c) The applications offend under Section 5(4)(a) because the two signs represented in the earlier marks detailed above are protected by the law of passing off. Use of these two signs is claimed from 1947 (word only) and 1955 (word and device) respectively. A list of goods and services for which use of these signs is claimed is provided as an annex to this decision.

4) All of the opponent's marks are earlier marks as defined by Section 6 of the Act. Further, with the exception of its CTM 4847604, the earlier marks relied upon are all potentially subject to the proof of use provisions contained in Section 6A(1) of the Act because they all completed their registration procedure before the start of the period of five years ending with the date of publication of the contested marks.

5) The applicant subsequently filed counterstatements denying the opponent's claims and putting it to proof of use in respect of all the goods and services upon which the oppositions are based.

6) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 10 April 2013 when the opponent was represented by Michael Edenborough QC of counsel, instructed by Grant Spencer LLP and the applicant represented by Tim Austen of counsel, instructed by Urquhart-Dykes & Lord LLP.

Opponent's Evidence

7) This takes the form of a witness statement by Susan Lesley Pearson, Company Secretary of the opponent company. It is sufficient that I note the main points that arise from this evidence, namely:

- LAND ROVER is a mark that has been extensively and continuously used in the UK since 1948;

- Registration of the LAND ROVER mark world-wide dates back many years with registrations in five EU countries dating back to 1949, a further four (including the UK) since the 1950s. Ms Pearson also provides information indicating that LAND ROVER was registered in at least nine other EU countries between the 1960s and 1990s. All products are sold under the mark LAND ROVER;
- Use was originally in respect of four-wheel drive vehicles;
- The LAND ROVER mark is famous and subject to world renown with significant volumes of vehicles sold throughout the EU. These total 693,000 vehicles throughout the EU between the years 2000 and 2006. 300,000 vehicles were sold in the UK between 2005 and 2012;
- LAND ROVER is primarily a vehicle manufacturer but also provides vehicle parts and accessories as well as a “wide range of services” to its customers. It provides literature to support its primary business as well as vehicle servicing and also products such as clothing, luggage, outdoor equipment, key rings, watches, wallets and bikes. The marketing budget relating specifically to products sold under the LAND ROVER mark was in excess of £7,000 million for the period 2003 to 2005;
- Turnover between 2007 and 2009 was a total of in excess of £13,000,000,000 ;
- Sales of LAND ROVER vehicles in the UK between 2005 and 2010 varied between about 33,500 and 48,750 a year. Sales are through a network of dealerships throughout Europe, 130 of which are in the UK;
- The opponent has web sites in 142 countries. Ms Pearson details visits to a number of its EU web sites illustrating that, in the years 2004 to 2006, the number of unique visitors jumped from less than 200,000 in 2004 to over 3 million in 2006. Visits to its web sites in France, Germany, Italy, Netherlands and Spain where all in the hundreds of thousands for each of the same years;
- The opponent uses its LAND ROVER mark on a wide range of printed matter when promoting its goods or providing supporting material such as handbooks and service booklets;
- The opponent produces a magazine names “Land Rover Onelife” that is sent out to over 450,000 LAND ROVER vehicle owners. An electronic version is also produced;
- The opponent advertises its vehicles in numerous magazines, such as CAR, AUTOCAR, circulated throughout the EU. Similarly, it advertises in publications other than car industry related publications;
- LAND ROVER continues to advertise its vehicles in national newspapers and magazines, on television and the Internet;
- Press reviews of LAND ROVER vehicles are provided at Exhibit SP12;
- LAND ROVER is also promoted through numerous annual European automobile shows, through organising driving competitions, driving courses, product placement and through sponsorship of events such as The Royal Windsor Horse Show, The Burghley Horse Trials and the

England rugby team. It has received numerous awards in relation to its vehicles;

8) Further, Ms Pearson states that LAND ROVER vehicles are the subject of numerous publications with the Internet facilitating the development of such communications between fans of LAND ROVER vehicles. Ms Pearson states that, where appropriate, formal and informal arrangements are made by the opponent in respect to this use of the LAND ROVER mark so that use of the mark indicates the content rather than the origin of the communications. Further, it is stated that LAND ROVER vehicles are the subject matter of many books in the English language and also some books in French and German.

9) Ms Pearson provides evidence of numerous magazines that use LAND ROVER as part of their title to describe the content. Such magazines include *Land Rover Monthly*, *Land Rover Enthusiast*, *Land Rover World* and the applicant's own *Land Rover Owner International*.

Applicant's Evidence

10) This takes the form of a witness statement by Robert Munro-Hall, Group Managing Director of the applicant company. He states that the mark LANDROVER OWNER INTERNATIONAL was first used in 1987 and that it has been in use since then. Its use has been in respect of printed publications, electronic publications, a web site and also in respect of shows and events. Mr Munro-Hall also states that it has been used in respect of the sale of advertising space within these publications and the related web site.

11) At Exhibit RMH2, Mr Munro-Hall provides copies of numerous front covers of the magazine, the oldest being from July 1992 where the title "LAND ROVER OWNER International" is prominently shown at the top of the cover in an unstylised form. Various other covers are shown from the late 1990s. The mark, in the form applied for, is first seen on the magazine cover of the February 2007 edition.

12) Mr Munro-Hall also provides independently verified circulation figures for the magazine between the years 1991 and 2010. This shows a circulation of just over 27,000 quickly growing to over 62,000 by 1996 before slowly reducing to in the region of 40,000 for the years 2008, 2009 and 2010. At Exhibit RMH3, Mr Munro-Hall provides information from the National Readership survey that indicates these circulation figures translate into readership figures in the region of 250,000 to 300,000.

13) Mr Munro-Hall states that the opponent has been aware of the applicant's use of its mark in respect of its printed publication and cites opposition proceedings O-44641 decided on 2 February 2001 between the parties. I note that the applicant's mark (2005555) that was the subject of those opposition

proceedings is in respect of the word mark LAND ROVER OWNER INTERNATIONAL and is registered for “magazines and periodical publications”.

14) Mr Munro-Hall also provides information regarding how the applicant’s mark is used online. This use is in the form of a digital version of the magazine and an associated website and this has been available since 1998. Exhibit RMH4 consists of historical extracts from this website, obtained from the archive *Waybackmachine*. These illustrate the sign LAND ROVER OWNER INTERNATIONAL, either in plain text or in the same text used in the contested mark, but without the flag device or background shadowing on a variety of pages dated between 1998 and 2010. Mr Munro-Hall states that it is generally recognised that such digital versions of magazines are equivalent to the printed version. This is recognised by organisations such as the Audit Bureau of Circulations and Exhibit RMH5 is an article from 2011 referring to this.

15) The mark has been used in respect of shows and events and they have been held in the UK since 1991. At Exhibit RMH6, Mr Munro-Hall provides copies of materials relating to use of the applicant’s mark in respect to these shows and events. One of these is an article, printed in 2010, from the website www.mantec.co.uk and it makes reference to “the first Land Rover Owner International Show at Billing Aquadrome” in 1991. Also included are promotional materials for the shows in 1998, 1999, 2000, 2004, 2005, 2006 and 2010. All appear to show the name LAND ROVER OWNER INTERNATIONAL in the form applied for or in word form.

16) Mr Munro-Hall also provides wholesale turnover figures. Between the years 1987 and 1995 the total was in excess of £7 million and between 2004 and 2010 the annual turnover has been in the region of £3 million to £3.6 million.

17) Promotional spend was about £200,000 in total between 1987 and 1995 and in the region of £160,000 to £260,000 between the years 2004 and 2010. Such promotional activity has taken the form of national press advertising, poster advertising campaigns, branded marquees at country shows and other similar events and the sale of branded merchandise.

18) Mr Munro-Hall states that, following such use since 1987, the applicant’s mark has become well known in the UK and that it does not conflict with, or inconvenience the opponent. He refers to the decision in respect of Opposition No. 44641 as support for this view and states that he does not believe the situation has changed since that decision was issued. Further, Mr Munro-Hall is not aware of any instances of confusion in the previous 23 years, claiming that the applicant’s use is both honest and concurrent with the opponent’s claimed use of its marks.

19) In support of the view that the opponent has been supportive of the applicant’s activities, Mr Munro-Hall, at Exhibit RMH7, provides an archive

Internet extract providing information about the 2005 LRO Show. It reveals that Land Rover's managing director, Matthew Taylor, had "agreed to kick off the fun He was among a host of celebrities enjoying the LRO Show." Similarly, Exhibit RMH8 is an Internet extract showing an advert for the applicant's 2004 show. It includes a prominent announcement that the show is supported by Land Rover (the opponent).

Opponent's Evidence in reply

20) This takes the form of the following:

- a second witness statement by Ms Pearson;
- a witness statement by Richard Streeton, Deputy Editor of Land Rover Monthly magazine;
- a witness statement by Simon Ward-Hastelow, Editor of Land Rover World magazine.

21) Ms Pearson states that third parties sometimes use the opponent's mark in a descriptive manner, but this does not indicate trade origin. Numerous parties do this because the opponent's vehicles are widely discussed in the media and use the mark LAND ROVER to indicate content of magazines and books. The opponent is aware of several magazines where the editorial content is directed to its vehicles.

22) Ms Pearson expressed the view that use of LAND ROVER in the title of these magazines is descriptive use defining the content of the magazine. The opponent does not object to, what it categorises as descriptive use. The opponent has, over the years, provided information about vehicles, test drive opportunities, technical information and images to these magazines.

23) Ms Pearson states that she has been informed, by the opponent's in-house solicitor, that the applicant's long standing use has not been as a trade mark in relation to its printed publications, electronic publications or any other goods and services. Rather, Ms Pearson holds the view that it has been used to describe content or subject matter. She states that every brand owner is keen to have their products referred to in a positive way in the media.

24) Ms Pearson provides evidence of other third party publications about LAND ROVER vehicles. In particular, she exhibits evidence relating to the magazine entitled LAND ROVER WORLD, LAND ROVER MONTHLY and up to the year 2010, LAND ROVER ENTHUSIAST. Ms Pearson offers the view that the LAND ROVER element in these titles is used descriptively as in the applicant's mark.

25) Ms Pearson also identifies numerous vehicle clubs. The Association of Land Rover Clubs, Aylesbury Land Rover Fanatics Club and Bristol Land Rover

Owners Club are but a few. However, I note that there is no evidence that these club names are used in trade.

26) The thrust of this evidence is that the opponent tolerates the use of its LAND ROVER mark as part of the title of magazines, books etc and in respect of enthusiast clubs because it believes such use is descriptive.

27) The witness statements of Mr Streeton and Mr Ward-Hastlelow both attest to their respective magazines being devoted exclusively to LAND ROVER enthusiasts and both confirm that the use of the words LAND ROVER in their respective magazine titles serves a purely descriptive purpose.

DECISION

Proof of use

28) At the hearing, Mr Edenborough was content to base his submissions only upon the opponent's earlier CTM 4847604 that is not subject to the proof of use provisions. Consequently, I too, will limit my considerations to the opponent's case based upon this CTM.

Section 5(2)(b)

29) Section 5(2)(b) reads:

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

(a) ...

(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.”

30) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

Comparison of goods and services

31) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 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 are complementary.'

32) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

33) I also bear in mind the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

34) Finally, in terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06* where it was stated:

"It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Segio Rossi v OHIM - Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseño original Juan Bolanos)* [2007] ECR I-0000, paragraph 48)."

35) More recently, the GC provided further guidance on the understanding of "complementary" in its judgment in *Sanco, SA v OHIM*, T-249/11, where it stated:

"48 ..., in order to assess the complementarity ..., it is necessary to determine not only the specialisation of the undertakings, but also whether the consumers of those goods and services may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking due to the connection between those goods and services. Consequently, the existence of undertakings specialising in the production of goods of the earlier mark and in the provision of the services of transport, storage and distribution of chickens is not sufficient to establish a lack of complementarity between those goods and services."

36) In his skeleton argument, Mr Edenborough helpfully provided a table setting out where he considered the respective goods are identical or similar, and I will bear this in mind when conducting the analysis.

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Class 9

37) As Mr Edenborough identified, the following of the applicant's goods as being identical to the corresponding terms in the opponent's specification: *CD-ROMs; computer software*. Further, I also consider that the applicant's *computer programs* are identical to the opponent's *computer software*.

38) Applying the guidance in *Meric* it is clear that the broad term *data carriers* in the applicant's mark includes *CD-ROMs; video, audio and audio-visual tapes and discs* in the opponent's specification. Therefore, they cover identical goods. Further, the opponent's *audio-visual tapes and discs* can include both recorded

and blank goods and, consequently, will include or be highly similar to the applicant's *CDIs; CD-ROMs discs, cassettes and other data carriers containing information recorded in magazine form.*

39) The applicant's *computer databases* can contain software and/or actually comprise of software, for example, an off the shelf database product can be purchased which can then be installed and have information loaded onto it thus becoming a database. These are at least similar to the opponent's *computer software.*

40) The remaining goods listed in the applicant's specification are *publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); electronic publications, electronic magazines; multi-media recordings and publications; data recorded in electronic, optical or magnetic form; audio and visual recordings.* These are all very similar to the opponent's *audio-visual tapes and discs*, insofar as they include recorded media. This is because a publication supplied on line or on an audio-visual disc will be very similar when considering the *Canon* criteria, the only difference being that one is stored in a portable format and the other is not. Further, these digital goods are also highly similar to the physical equivalents covered by the opponent's *printed matter, periodicals, magazines* etc in its Class 16 specification.

Class 16

41) Once again, as Mr Edenborough identified, the following goods are identical to the same terms that also appear in the opponent's specification: *Printed matter, printed publications, magazines; periodical publications; newspapers; books; stationery; diaries, calendars, note books, address books, pens, pencils.*

42) Further, it is self evident that the applicant's *guides* include *travel guides* listed in the opponent's specification and that the applicant's *writing implements* includes the opponent's *pens* and *pencils*. Consequently, applying the *Meric* guidance these are also identical.

43) The remaining goods, namely *journals, newsletters, printed programmes* are all covered by the opponent's broad term *printed matter* and once again, are identical.

Class 35

44) Whilst Mr Edenborough conceded that the applicant's Class 35 services are not "directly identical or similar" to any of the opponent's services, he did submit that they are all "related services to those associated with the publication of a magazine". By this, I understand Mr Edenborough to be claiming that the respective services are complementary. I do not agree. The normal

understanding of the consumer of these services is that they would access the services through a specialist provider of advertising, marketing and promotional services. As a rule, such a consumer would not approach a magazine provider to access such services. As a result, the consumer would not expect there to be a trade link between a business offering such services and a business providing a magazine. This is unlike the facts considered in the *Sanco* case, where the GC found that the relevant consumer for the goods and services at issue may well require both the goods and the transport services to deliver them and may have an expectation of procuring both from the same trader.

Class 41

45) Mr Edenborough identified that the term *entertainment* in the applicant's specification as being identical to the opponent's *entertainment services* and also that both parties' specifications include the term *education*. Mr Austen conceded these are identical.

46) Mr Edenborough also submitted that the applicant's *sporting and cultural activities* are similar to the opponent's *sporting competitions, arranging and organisation of competitions and sporting competitions* and *educational and entertainment services relating to motor vehicles*. I concur with this. Such sporting and cultural activities may be in the form of sporting competitions or an entertainment service relating to motor sports. Consequently, they are identical, if not identical, then at least highly similar.

47) The opponent did not identify any further identical or similar services listed in the Class 41 specification of application 2536677A.

Application 2536677B

Class 35

48) This application includes a Class 35 specification in respect of: *Arranging, conducting and production of ..., shows and events*. Whilst there is no equivalent in the opponent's lists of goods and services, the opponent's Class 41 specification does include *arranging and conducting of conferences, congresses, symposiums, workshops and seminars*. Whilst clearly not identical, not least because the term in Class 35 must be interpreted with the scope of that class as a business service and Class 41, the term must be understood within the context of entertainment and/or sporting and cultural activities. However, in reality, there can be a close connection because the business responsible for the business aspects of an event and also responsible for the subject matter of the event. Further, the reference to *events* in the applicant's specification can include *conferences, congresses, symposiums, workshops and seminars* referred to in the opponent's Class 41 specification. Taking all of this into account, I conclude that these respective services are very closely associated and share a high level

of similarity. Similarly, in respect of the applicant's *arranging, conducting and production of exhibitions*, there is a good deal of commonality between conferences and exhibitions and events often consist of both. Consequently, I also find that these services also share a high level of similarity with the opponent's services.

Class 41

49) The applicant's specification includes *arranging and conducting ... conferences, ... seminars*. This also appears in the opponent's specification. Further, it also contains *organisation of competitions* and the opponent's specification includes *competitions* at large. These terms are, self-evidently, identical.

50) In addition, the applicant's specification includes *arranging and conducting courses, ... exhibitions, events*. It is my view that these services share a good deal of similarity with the opponent's *arranging and conducting of conferences, congresses, symposiums, workshops and seminars* because both parties services are often provided at the same event. For example, workshops and seminars are often provided at exhibitions.

51) I also consider that the applicant's *organising, conducting, production of shows, events, displays and parties* and *organisation of events for cultural, entertainment and sporting purposes* includes services, or is included by terms, covered by the opponent's specification. For example, *entertainment, training and competitions relating to vehicles, four-wheeled drive vehicles* has a clear overlap with the applicant's services. Consequently, I find that these services share a good deal of similarity and may also be identical.

The average consumer



52) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, very depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

53) The range of goods and services covered by the scope of the application and those relied upon by the opponent are wide ranging and with a correspondingly broad range of average consumers. Electronic magazines and the printed equivalent will cover publications that are bought on a regular basis by ordinary consumers and who will pay no more than an average amount of attention during the purchasing process. Similarly, with goods such as diaries, note books and address books, the level of the consumer's attention during the purchasing

process will be no more than average with such items commonly being selected off a shelf where other similar goods are also likely to appear. In respect of services such as advertising and marketing, these are services normally provided business to business and, therefore, will involve a different group of consumers. Such business-to-business purchases will involve a greater deal of consideration, but not the greatest level.

Comparison of marks

54) For ease of reference, the respective marks are:

Opponent's trade mark	Applicant's trade mark
	

55) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details . The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

56) There cannot be an artificial dissection of the marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of the them and is deemed to be reasonably well informed and reasonably circumspect and observant . The assessment of the similarity of the marks must be made by reference to the perception of the relevant public.

57) It is not in dispute the words LAND ROVER are the dominant and distinctive elements of both marks.

58) Visually, the two marks demonstrate a number of differences. The opponent's mark includes a background oval device and border absent in the applicant's mark, and the words OWNER INTERNATIONAL and device of a Union Jack are elements of the applicant's mark absent in the opponent's mark. Further the words in the respective marks are presented in different ways. Of

course, there is one element of similarity, namely that both marks contain the words LAND ROVER. Taking all of this into account, I conclude that the respective marks share moderately high level of visual similarity.

59) Aurally, only the word elements will be expressed. In this respect, as already noted, the applicant's mark includes the two additional words OWNERS INTERNATIONAL and consequently it is expressed as a ten syllable phrase. The opponent's consists of only three syllables, but these are also the first three syllables of the applicant's mark. Taking all of this into account, I conclude that the respective marks share moderately high level of aural similarity also.

60) The words LAND ROVER, present in both marks, are likely to be understood as meaning a vehicle for use on tough terrain over land¹. The additional words OWNERS INTERNATIONAL present in the applicant's mark indicate individuals who own Land Rovers and that the goods and services have an international dimension. Mr Edenborough submitted that these words are descriptive and fail to diminish the distinctive character of the words LAND ROVER. Mr Austen submitted at the hearing that because LAND ROVER OWNER is present in the applicant's mark then it is understood as a reference to the owner of a Land Rover vehicle rather than to the vehicle itself. I note these comments and concur with them both and take them into account in concluding that the respective marks share a moderately high level of conceptual similarity.

Distinctive character of the earlier trade mark

61) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

62) Mr Edenborough submitted that LAND ROVER is a very mark well known in respect of vehicles and this is certainly the case in respect of land vehicles. In fact, it is appropriate that I take judicial notice of this. However, as the earlier mark being relied upon by Mr Edenborough does not contain vehicles, this does not improve the opponent's case. In respect of other goods and services where the level of distinctive character is not enhanced through use, I find that, nevertheless, the mark is endowed with a moderate level of inherent distinctive character.

¹ Oxford Dictionary of English
(http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0720820?rskey=7n6OjQ&result=11)

Likelihood of confusion

63) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

64) There is little doubt in my mind that in respect of goods and services that are identical or similar to those of the opponent, there is a strong likelihood of confusion. This is because of the prominence in the applicant's mark of the words LAND ROVER. However, there are two other additional factors in this case that may have an impact upon such a *prima facie* conclusion. Firstly, there is the issue of whether the applicant's mark is descriptive use or not, and here I must consider the issue taking account of the use made of the mark by the applicant. Secondly, I must consider the impact of the concurrent use of the marks.

65) At the hearing, Mr Edenborough advanced a claim that the applicant's mark was descriptive in character. He submitted that there had been no confusion to date because the applicant's mark does not indicate trade origin and, consequently, there cannot be confusion. He supports his submission by reference to an earlier case issued by this tribunal in *NELLIE THE ELEPHANT* [2004] ETMR 79. This was a revocation case based upon a claim for non-use. The Hearing Officer found that use of the sign *NELLIE THE ELEPHANT* in respect of videos did not demonstrate genuine use because the sign served purely to describe the subject matter of those videos. Whilst I accept there are some parallels between the two cases, there are also some important differences. Firstly, unlike in the earlier case, the mark at issue in these proceedings consists of a composite mark where the words LAND ROVER and OWNER INTERNATIONAL are presented in stylised form, with the addition of colour, a representation of the union jack flag and a block background. Taking all these elements together and considering the mark as a whole, it has an impact over and above conveying a purely descriptive message. Secondly and importantly, the impact of use upon the consumer may not be the same in these proceedings as in the *NELLIE THE ELEPHANT* case. Thirdly, in the case of magazines at least, the consumer is familiar with descriptive titles indicating trade origin. This is a factor absent in the *NELLIE THE ELEPHANT* case.

66) In considering the impact of use, I note the evidence illustrates that the words LAND ROVER OWNER INTERNATIONAL have been in use as a magazine title since 1987 and that it has been used continuously since then. The mark, as

applied for, appears to have been used in respect of the magazine since at least the year 2002 (see the magazine front cover shown on page 80 in Exhibit RMH4 of Mr Munro-Hall's evidence). Turnover has been in the region of £3 million per year and the magazine has a circulation of 40,000 a year. At £4 per copy, Mr Austen submitted that these figures demonstrate that a significant amount of the applicant's business is derived from activities other than the sale of the magazine itself. These activities include, in particular, organising an annual show (since at least 1998). In her second witness statement, Ms Pearson submits that the applicant only uses the sign "LRO" to identify its shows and not its full name. This appears not to be the case. A number of examples in Exhibit RMH6 of Mr Munro-Hall's witness statement show LAND ROVER OWNER INTERNATIONAL being used in respect of the show in 1998 and 1999. Whilst it is true that the exhibits appear to show that after this time it was referred to as "The LRO Show", the same exhibit illustrates the mark at issue appearing directly below the words "The LRO Show" in respect of material promoting the 2010 show. Further, in respect of the 2004 show, the copy of the web page appearing in the same exhibit includes the text "Brought to you by Land Rover Owner International". Finally, a copy of a page entitled "Brookwell Land Rover News" carries the title "2005 Land Rover Owner International Show: new dates, new venue". Taking all of this together, whilst not overwhelming evidence, I find that the show organised by the applicant has been promoted as, and known by, interchangeably, "The LRO Show" and the "Land Rover Owner International Show" and that the magazine known as Land Rover Owner International was the trader behind the show. Consequently, I dismiss Ms Pearson's assertion.

67) Taking all of the above into account, I also conclude that the applicant has used its mark to such an extent that the consumer will perceive it as indicating trade origin and that the mark has acquired a distinctive character in respect of, at least, magazines (printed and online) and the organisation of an annual motor vehicle show. Unlike in the NELLIE THE ELEPHANT case, the use by the applicant is such as for the consumer to attach trade origin significance, rather than perceiving it as purely descriptive.

68) I should further add, that even if I had found no enhanced distinctive character through use, it is my view that the mark has a *prima facie* distinctive character. I feel able to take judicial notice that it is common place for magazines to have descriptive titles and the consumer is familiar with perceiving such titles as indicating trade origin. The presentation of the mark adds a visual hook for the consumer to identify the mark. I accept that the word LAND ROVER that appear in the mark will be perceived as indicating the subject matter of the magazine and the show, but this does not counteract my finding in respect of the mark when viewed as a whole.

69) Having concluded that the contested mark has distinctive character, I now turn to consider the impact of concurrent use. For a defence of concurrent use to be successful, it is necessary for me to be satisfied that the parties have traded

in circumstances that suggest consumers have been exposed to both marks and have been able to differentiate between them without confusion as to trade origin (see to that effect the Court of Appeal in *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45 and Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18)

70) Therefore, for concurrent use to be of assistance to an applicant I must be satisfied that the effect of concurrent trading has been that the relevant public has shown itself able in fact to distinguish between goods and services bearing the marks in question i.e. without confusing them as to trade origin. That implies that both parties are targeting an approximately similar, or at least overlapping, audience and that the use by the parties in nature, extent and duration of trade has been sufficient to satisfy me that any apparent capacity for confusion has been adequately tested and found not to exist. In the current case, I concluded earlier that there is an overlapping consumer by virtue of the identity or similarity between some of the respective goods and services. The opponent is very well known in respect to motor vehicles and the applicant's business model is to produce a magazine and organise a show about those same vehicles. It follows that the consumer of both parties' goods and services is essentially the same.

71) I note Mr Edenborough's criticisms of the claim made on behalf of the applicant that it is not aware of any instances of confusion, but to claim that this is because the consumer perceives the applicant's mark as being only descriptive is something I have dismissed. The opponent has produced evidence of how third parties view the applicant's mark, namely the witness statements of Mr Ward-Hastelow and Mr Streeton. However, the independence of these witnesses from the opponent cannot be guaranteed. They are both from competitor magazines of the applicant and will undoubtedly benefit from support from the opponent (in the same way as the applicant has). Further, both attest to a view that the words LAND ROVER are used descriptively in the applicant's mark. This is not in doubt in my mind, but as I have already concluded it is necessary to consider the mark as a whole and also to factor in the effect of the long use made of it. When doing so, I have concluded the applicant's mark indicates trade origin to the consumer.

72) There is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little. See, for example, *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. However, in this case where the respective consumers are essentially the same and where there has been a long period of concurrent use,

the absence of actual confusion in the market place is a relevant factor in these proceedings

73) In fact, the evidence illustrates that there has often been a close relationship between the parties with the opponent's CEO attending and opening the applicant's show in 2005 and also being credited with supporting the event over a number of years. This is a clear indication that the opponent must also believe that there is no actual confusion. Whilst the opponent may have taken the view that this was because the applicant's use was purely descriptive, I have found that not to be the case when factoring in the perception of the consumer. However, the opponent's position on this point does suggest that it believes that, despite the long concurrent use, there is no confusion in the market place.

74) When factoring this into the global assessment, I conclude that whilst there is a *prima facie* case that there is a likelihood of confusion, in respect to certain goods and services such a *prima facie* finding is mitigated by the concurrent use made of the applicant's mark. Consequently, I conclude that there is no likelihood of confusion in respect to the following goods and services of interest to the applicant:

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Class 9: *Electronic magazines; CD-ROMs, discs, cassettes and other data carriers containing information recorded in magazine form; **all the aforesaid relating to motor land vehicles**; publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites), electronic publications, ...; multi-media recordings and publications, ..., audio and visual recordings, **all relating to motor land vehicles**.*

Class 16: *Magazines **relating to motor land vehicles**.*

Class 41: *Publication of printed matter **relating to motor land vehicles**.*

Application 2536677B

Class 35: *Arranging, conducting and production of shows and events; **all the aforesaid relating to motor land vehicles**.*

Class 41: *Organising, conducting, production of shows [and] events; **all the aforesaid relating to motor land vehicles**.*

75) In respect of all other goods and services that I found to be identical or similar to that of the opponents, the application is not saved by concurrent use and I find that the *prima facie* finding of a likelihood of confusion stands.

Section 5(4)(a)

76) I will comment briefly of the grounds based upon Section 5(4)(a) of the Act. The opponent has had a degree of success in respect of its grounds based upon Section 5(2)(b). In respect of where it has not been successful it is either because of the long period of concurrent use or because there is no similarity between the respective goods and services. It can be implied from the long concurrent use without confusion and with acquiescence from the opponent that the respective goodwill that each party enjoys has been developed and maintained in parallel whilst sharing the same group of consumers. It follows that there is no misrepresentation and any claim under Section 5(4)(a) must fail.

77) In summary therefore, I conclude that the opponent is no better off under Section 5(4)(a) than when relying upon Section 5(2)(b) of the Act.

Section 5(3)

78) I turn to consider the ground for opposition under Section 5(3) of the Act which reads as follows:

“5.-(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 Community trade mark or international trade mark (EC), 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.”

79) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA (CHEVY)* [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited (TYPHOON)* [2000] FSR 767, *Daimler Chrysler v Alavi (MERC)* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application (VISA)* [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines (LOADED) O/455/00, Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7, *Davidoff & Cie SA v Gofkid Ltd (DAVIDOFF)* [2003] ETMR 42, *Intel Corporation Inc. v CPM United Kingdom Ltd (INTEL)* [2009] RPC 15, *L'Oreal v Bellure* [2010] RPC 1 and *Whirlpool Corp v Kenwood Limited* [2010] RPC 2.

80) The applicable legal principles arising from these cases are as follows:

- a) 'Reputation' for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services covered by that mark (paragraph 26 of the CJEU's judgment in *CHEVY*).
- b) Under this provision the similarity between the marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier mark and the later mark or sign (*Adidas Salomon v Fitnessworld*, paragraphs 29-30).
- c) Whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case (*INTEL*).
- d) The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link between the conflicting marks, within the meaning of *Adidas-Salomon and Adidas Benelux*. (*INTEL*)
- 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 (per Neuberger J. in *Premier Brands*, and the CJEU in *CHEVY*, paragraph 30).
- f) Whether use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case (*INTEL*).
- g) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous mark or an attempt to trade upon its reputation (*Spa Monopole v OHIM*).
- h) The use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique; a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark; 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*).

i) Taking unfair advantage of the distinctive character or repute of a mark relates not to detriment caused to the earlier mark but to the advantage taken by the third party. Such an advantage may be unfair even where the use is not detrimental to the distinctive character or to the repute of the mark (*L'Oreal v Bellure*). It is not sufficient to show that an advantage has been obtained. There must be an added factor of some kind for that advantage to be categorised as unfair (*Whirlpool Corp v Kenwood Limited*).

81) I will restrict my considerations to the parts of the applications that have survived the attack based upon Section 5(2)(b). In summary, the goods and services surviving are:

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Class 9: *Electronic magazines; CD-ROMs, discs, cassettes and other data carriers containing information recorded in magazine form; **all the aforesaid relating to motor land vehicles**; publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites), electronic publications, ...; multi-media recordings and publications, ..., audio and visual recordings, **all relating to motor land vehicles**.*

Class 16: *Magazines relating to motor land vehicles.*

Class 41: *Publication of printed matter relating to motor land vehicles.*

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Class 35: *Arranging, conducting and production of shows and events; **all the aforesaid relating to motor land vehicles**.*

Class 41: *Organising, conducting, production of shows [and] events; **all the aforesaid relating to motor land vehicles**.*

Reputation

82) 'Reputation' for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services covered by that mark (paragraph 26 of the CJEU's judgment in *General Motors Corp v Yplon SA (CHEVY)* [1999] ETMR 122 and [2000] RPC 572).

83) Taking account of the long period of use, the very significant turnover and the publicity of the opponent's marks in respect of motor land vehicles, it is self

evident that in respect of the opponent's 663199 and 740778 marks, they enjoy a substantial reputation. I would go as far as to say that the applicant's mark is a household name in the UK. Its reputation is both substantial and widespread.

The Link

84) Having established the existence and scope of a reputation, I need to go on to consider the existence of the necessary link. I am mindful of the comments of the CJEU in *INTEL* that it is sufficient for the later trade mark to bring the earlier trade mark with a reputation to mind for the link, within the meaning of *Adidas-Salomon and Adidas Benelux*, to be established. The CJEU also set out the factors to take into account when considering if the necessary link exists:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

85) The applicant's business model is based upon exploiting the reputation of the opponent's mark by attracting customers and potential customers of the opponent to its own goods and services. It uses the opponent's mark LAND ROVER as part of the title of its magazines and shows. Therefore, the existence of the necessary link is clearly established.

Heads of damage

86) In *INTEL*, the CJEU summarised that heads of damage as follows:

“26 Article 4(4)(a) of the Directive establishes, for the benefit of trade marks with a reputation, a wider form of protection than that provided for in Article

4(1). The specific condition of that protection consists of a use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark (see, to that effect, in respect of Article 5(2) of the Directive, *Marca Mode*, paragraph 36; *Adidas-Salomon and Adidas Benelux*, paragraph 27, and *Case C-102/07 adidas and adidas Benelux* [2008] ECR I-0000, paragraph 40).

27 The types of injury against which Article 4(4)(a) of the Directive ensures such protection for the benefit of trade marks with a reputation are, first, detriment to the distinctive character of the earlier mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark.”

87) The CJEU went on to state that just one of these heads of damage will suffice. The opponent has claimed that all three heads apply in this case.

88) Firstly, I will consider the claim of detriment to distinctive character (sometimes referred to as “dilution”). The opponent claims that use of the applicant’s mark would result in multiple origins of marks featuring LAND ROVER and this would destroy the function of the marks as indicators of origin.

89) For this case to be made out, it was stated by the CJEU in *INTEL*, paragraph 77 that this:

“... requires evidence of a change of the economic behaviour 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.”

90) The CJEU in *Environmental Manufacturing LLP v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-383/12 P, elaborated on this point:

“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 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.”

91) Taking this guidance into account and considering the circumstances of the current case, the evidence provided fails to establish that there has been any change in the economic behaviour of the average consumer of the opponent’s goods or services or that, consequent on the use of the later mark, there is a serious likelihood that such a change will occur in the future. In fact, the evidence illustrates that despite a long period of concurrent use, there is no suggestion that the economic behaviour of the opponent’s customers and potential customers has been changed. Consequently, I find that this claim fails.

92) Next, I will consider the claim to unfair advantage to the distinctive character or the repute of that opponent’s mark. In considering this issue I must assess whether any advantage is unfair. In *L’Oreal SA v Bellure NV* [2010] EWCA Civ 535 Jacob LJ stated:

“49 Turning to the substance of the point, the ECJ’s reasoning runs thus:

(a) art.5(2) applies to same mark/same goods case, see cases cited at [35];

(b) If a “link” in the mind of the public is established between the sign complained of and the registered mark, then there may be art.5(2) type infringement;

(c) For such infringement it is necessary to show one of the types of injury against which art.5(2) is directed, namely detriment to distinctive character, detriment to the repute of the mark or unfair advantage taken of the distinctive character or repute of the mark—see [36]–[38].

(d) The court explains the first two types of injury a little more in [39]–[40]. It is not necessary to go into these here because of the factual

findings of no blurring and no tarnishment. What matters is its explanation of the third type—unfair advantage. Here is what it says:

“[41] As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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.

[49] ... where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coat-tails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of his own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark.”

So far as I can see this is saying if there is “clear exploitation on the coat-tails” that is *ipso facto* not only an advantage but an unfair one at that. In short, the provision should be read as though the word “unfair” was simply not there. No line between “permissible free riding” and “impermissible free riding” is to be drawn. All free-riding is “unfair”. It is a conclusion high in moral content (the thought is clearly that copyists, even of lawful products should be condemned) rather than on economic content.”

93) In *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753 Lloyd LJ stated:

“136. I do not consider that Kenwood's design involves anything like a transfer of the image of the KitchenAid mark, or of the characteristics which it projects, to the goods identified by Kenwood's sign (see *L'Oréal v Bellure* paragraph 41). Of course, as a newcomer in a specialist market of which KitchenAid had a monopoly, and being (necessarily) in the basic C-shape of a stand mixer, the kMix would remind relevant average consumers, who are design-aware, of the KitchenAid Artisan. That, however, is a very different phenomenon, in very different commercial circumstances, from the situation considered in *L'Oréal v Bellure*. I find the Court's judgment instructive, but it does not seem to me to lead to the conclusion in favour of Whirlpool for which Mr Mellor contends. On the contrary, having rejected his radical submission that the word "unfair" could just as well have been left out of the article, it seems to me that the decision points away from, rather than towards, liability under the article

on the facts of the present case. It is not sufficient to show (even if Whirlpool could) that Kenwood has obtained an advantage. There must be an added factor of some kind for that advantage to be categorised as unfair. It may be that, in a case in which advantage can be proved, the unfairness of that advantage can be demonstrated by something other than intention, which was what was shown in *L'Oréal v Bellure*. No additional factor has been identified in this case other than intention.”

94) Finally, I also take note of the judgment of Kitchin LJ in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2012] EWCA Civ 24:

“127. The Court may reasonably be thought to have declared, in substance, that an advantage gained by a trader from the use of a sign which is similar to a mark with a reputation will be unfair where the sign has been adopted in an attempt to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, and without making efforts of his own, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.”

95) Taking all this guidance together, it is clear that “intent” is part of the consideration as to whether any advantage is unfair. There is a symbiotic relationship between the parties, where the opponent benefited from the additional promotion of its products that it obtains through the products of the applicant and the applicant benefits from trading in products that rely upon the reputation of the opponent's mark and products. The opponent has actively supported these activities as can be seen from the fact that the opponent's Managing Director has attended “and kicked off” proceedings at some of the applicant's shows. In all this time, the applicant's magazine was just one of a number of publications whose subject matter was the opponent's vehicles. The average consumer will be aware of this relationship and also of the fact that the parties are not connected.

96) Consequently, I conclude that the applicant's use of its mark in respect of the goods and services identified in paragraph 82 above would not be taking unfair advantage of the distinctive character or the repute of the opponent's mark. Any advantage is not unfair.

97) Even if the opponent had made established a case in respect of detriment and/or unfair advantage, the applicant would, because of its own long use of its mark, have a defence of its use being with due cause.

98) In summary, I find that the case based upon Section 5(3) fails to achieve any greater degree of success than already achieved under the grounds based upon Section 5(2)(b) of the Act.

Summary

99) In summary, the opposition fails in respect of the following:

Application 2536677A

Class 9: *Electronic magazines; CD-ROMs, discs, cassettes and other data carriers containing information recorded in magazine form; **all the aforesaid relating to motor land vehicles**; publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites), electronic publications, ...; multi-media recordings and publications, ..., audio and visual recordings, **all relating to motor land vehicles**.*

Class 16: *Magazines **relating to motor land vehicles**.*

Class 41: *Publication of printed matter **relating to motor land vehicles**.*

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Class 35: *Arranging, conducting and production of shows and events; **all the aforesaid relating to motor land vehicles**.*

Class 41: *Organising, conducting, production of shows [and] events; **all the aforesaid relating to motor land vehicles**.*

100) The opposition succeeds in respect of all other goods and services listed in the applicant's specifications.

COSTS

101) At hearing, Mr Edenborough submitted that any costs award should take into account that the applicant requested proof of use in respect of all its goods and services resulting in the need to provide copious amounts of evidence, when in fact judicial notice could be taken of the opponent's reputation in respect to vehicles at the very least. Mr Austen maintained that it was not necessary to file such copious amounts of evidence to illustrate its use. Both positions have some merit. Certainly, no evidence should have been required of the opponent's use in respect of vehicles. The applicant's whole business model is based upon such use. On the other hand, the opponent filed a large amount of evidence when a more targeted sample of exhibits would have sufficed. Further, it was not unreasonable for the applicant to require proof of use in respect of goods and services other than vehicles.

102) Taking all of this into account, together with the fact that a hearing has taken place, I decline to make an award with both parties bearing their own costs.

Dated this 6th day of January 2014

**Mark Bryant
For the Registrar,
the Comptroller-General**

ANNEX

Goods and Services in respect of which the earlier mark has been used

Motor land vehicles and parts thereof; parts and components for internal combustion engines; winches, pumps, and parts and components therefor; exhausts and turbochargers for motors and engines; machines and machine tools for automotive use; air conditioning systems for cars; vehicle lights and vehicle lighting anti-freeze; brake fluid; chemical products and substances for use in the automotive industry; de-misting, de-icing, de-frosting, anti-moisture and anti-incrustant preparations, all for automotive use; substances for cleaning, polishing and for scouring, abrasive preparations, soaps; industrial oils and greases; hand tools and hand instruments; articles made of leather or imitation leather; badges; tow rope; carpet, mats; toys; sporting articles; business management and advisory services; all relating to the manufacture, sale, repair and maintenance of motor vehicles; advertising; market research; import and export agency services; computerised business management services; business information, planning and inspection services, all relating to the motor vehicle industry; business advisory services relating to franchising for the establishment and maintenance of motor dealership and vehicle spare part enterprises; repair and maintenance services; leasing, rental and hire services for motor vehicles, storage facilities for motor vehicles, parts and apparatus; apparatus, gloves and clothing, all for use in protection against accident or injury; electrical, electronic, measuring, checking (supervision), testing, gauging, signalling, telephone, optical, photographic, fire extinguishing, control, diagnostic, and safety apparatus and instruments; cell phones; direction and location finding apparatus and instruments; apparatus, gloves and clothing, all for use in protection against accident or injury; meters and gauges; sound recording and sound reproducing apparatus and instruments, radio apparatus and instruments, and combinations thereof; parts, components and accessories for all the aforesaid goods; vehicle breakdown warning triangles; spectacles, sunglasses and driving glasses; eyeglass chains, eyeglass cases, eyeglass frames; clock radios; radios for vehicles; CD-Roms; computer software; video, audio and audio-visual tapes and discs; video games; compasses, binoculars, cameras, calculators; printed matter, stationery, maps, travel guides, books, periodicals, magazines, newspapers and printed publications; desk ornaments; office requisites; instructional and teaching materials; writing and drawing instruments and materials; paper; articles made wholly or principally of paper, card and/or cardboard; drink mats, photographs, calendars, stickers, labels, decalcomanias, rulers, postcards, bookmarks, bookends, erasers, paperweights, and book covers; diaries, notebooks, appointment books, address books, combinations of such goods, and covers therefor, business card holders, cheque book covers, and passport covers and holders; folders, holders and covers, all intended for or containing notebooks, notepads, paper, pens, pencils, and/or erasers; road and vehicle tax disc holders made of plastic film or sheet materials; towels, napkins, serviettes, mats, coasters, handkerchiefs, tissues, cloths, absorbent wipes, and sanitary and hygienic materials, all made wholly or principally of paper and/or paper derivatives; wrapping and packing materials made wholly or principally of paper or plastics; plastic cling film; bags, sacks, and disposable covers all made wholly or principally of paper and/or plastic film or sheet materials; disposable paper protectors for carpets and seats; sheet materials wholly or principally of paper and/or paper derivatives for protecting, preserving and/or for storage purposes; disposable protectors for steering wheels and road wheels, all made of polythene or of plastic film or sheet materials; clothing, footwear, headgear; financial, insurance, warranty, credit and leasing services; vehicle hire-purchase and financing services; banking and money-lending services; Leasing, rental and hire services for motor vehicles, storage facilities for motor vehicles, parts and apparatus; arranging and/or providing holiday travel, safari travel, travel and off-road driving; tour arranging and tour operating services; arranging transportation of vehicles, drivers and passengers; travel agency, tourist agency, and travel information and advice services; booking of seats and issuing of tickets for travel; seat, berth and travel ticket reservation services; escorting of travellers; entertainment services; education and training services; competitions; sporting competitions; entertainment, training and competitions relating to vehicles, four-wheeled drive vehicles, bicycles, motorcycles; arranging and conducting of conferences, congresses, symposiums, workshops and seminars; club services; driving tuition and driving academy services; arranging and organisation of competitions and sporting competitions, sport camp services; off road driving courses; production of shows; advisory, information and consultancy services relating to all the aforesaid services; off-road driving instruction and tuition; education in four-wheel driving techniques, mechanics, map-reading, safety, and environmental matters; driving academy services; training, educational and entertainment services relating to motor vehicles.