

O/596/17

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 3164417  
BY AUTOMOTIVE MEDIA & EVENTS LIMITED**

**FOR THE TRADE MARK**

**CompanyCar**  
*Today*

**IN CLASSES 9, 16 AND 41**

**AND**

**THE OPPOSITION THERETO UNDER NUMBER 407320 BY  
BAUER CONSUMER MEDIA LIMITED**

## Background

1. Automotive Media & Events Limited (“the applicant”) applied for the trade mark shown below on 13 May 2016 in classes 9, 16 and 41:

**CompanyCar**  
Today

*Class 9: Recorded content; media content; downloadable electronic publications in the nature of magazines; downloadable electronic publications in the nature of magazines relating to fleet management.*

*Class 16: Printed matter; magazines; periodical magazines; newsletters; printed reports; printed guides; magazines relating to fleet management; newsletters relating to fleet management; printed reports relating to fleet management; printed guides relating to fleet management.*

*Class 41: Publishing and reporting; publication of magazines; publication of newsletters; publication of magazines relating to fleet management; publication of newsletters relating to fleet management; publication of electronic magazines; publication of electronic magazines relating to fleet management; publishing of web magazines; publishing of web magazines relating to fleet management; organisation of conferences, exhibitions and competitions; organisation of conferences, exhibitions and competitions relating to fleet management; organisation of competitions and awards; organisation of competitions and awards relating to fleet management; arranging and conducting conferences and seminars relating to fleet management.*

2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 3 June 2016. Bauer Consumer Media Limited (“the opponent”) opposes the trade mark application under section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The claim is based upon use of the sign COMPANY CAR IN ACTION since 1 January 1990, ‘throughout the UK’, in relation to events,

*conferences and exhibitions.* The statement of case refers to use in relation to the UK's most comprehensive driving event for fleet decision makers, where visitors can compare and drive vehicles prior to purchase. The opponent states that it has used the website [companycar.co.uk](http://companycar.co.uk) since 1998. It also states that the sign has been used in both word and logo format. The opponent claims that it has sufficient goodwill in the business attached to the sign to be able to prevent the applicant from using its mark, under the law of passing off.

3. The applicant filed a counterstatement in which it denies the claim. It states that the opponent does not have sufficient goodwill in the sign for the use of the application to be prevented under the law of passing off. It states that the use of [companycar.co.uk](http://companycar.co.uk) is immaterial since this is not the sign relied upon in the statutory notice of opposition (form TM7); nor has the opponent relied upon the logo in the notice of opposition form, although the logo was referred to in its statement of case. The applicant states that it believes that the opponent ceased use of the sign around 2008. It claims that any goodwill which may have accrued to the opponent prior to the cessation of use has since evaporated.

4. The applicant also states that the words COMPANY CAR in the sign relied upon are directly descriptive of the opponent's field of activity, and this is the only element common to both parties' marks. There will be no misrepresentation and no damage.

5. Both parties are professionally represented. The opponent filed evidence, and both parties filed submissions during the evidence rounds. Neither party has chosen to be heard. The opponent filed written submissions in lieu of attending a hearing. The applicant also filed a fall-back specification in class 41. I make this decision after carefully considering all of the papers filed.

## **Evidence**

6. The opponent's evidence comes from Tim Lucas, Managing Director of a division within the opponent's company.

7. Mr Lucas states that the opponent, under its previous name Emap Consumer Media Limited, purchased the rights to the sign COMPANY CAR IN ACTION and the event of the same name in 2006 from DMG World Media (UK) Limited. He explains that the COMPANY CAR IN ACTION event, held annually since 1990, is a driving event for decision makers within companies who have a requirement for a fleet of vehicles. It brings such individuals into contact with vehicle manufacturers who offer vehicle fleets, so that the individuals can test drive the vehicles. The event also offers a conference, exhibition, networking forum and place for discussion. Mr Lucas states that the opponent has run the event from 2007 but that due to the fact that it only acquired rights in 2006, it does not have access to full information prior to 2006.

8. Mr Lucas gives the following statistics relating to the holding of the COMPANY CAR IN ACTION event in the UK:

<b>Date</b>	<b>Visitors</b>	<b>Exhibitors</b>
19, 20, 21 & 22 June 2007	784	20
17, 18 & 19 June 2008	1,242	11
16, 17 & 18 June 2009	1,014	11
29 & 30 June 2010	803	19
28 & 29 June 2011	832	23
26 & 27 June 2012	788	22
11 & 12 June 2013	874	25
10 & 11 June 2014	929	23
16 & 17 June 2015	844	27
14 & 15 June 2016	716	27

9. Mr Lucas states that the event is free for visitors, but that its revenue is generated from the exhibitors. Marketing is conducted through FleetNews Magazine, through sister publications Driving Business and Fleet Leasing, via direct mail, online advertising and telemarketing. Mr Lucas gives the following revenue and marketing information:

Year	Revenue (£)	Marketing spend (£)
2008	In excess of 300K	57K
2009	In excess of 200K	20K
2010	In excess of 200K	47K
2011	In excess of 300K	41K
2012	In excess of 300K	42.5K
2013	In excess of 300K	50K
2014	In excess of 400K	48K
2015	In excess of 400K	45.5K
2016	In excess of 400K	48K

10. Mr Lucas refers to the opponent as having a website called company-car-in-action.fleetnews.co.uk, and exhibits homepage screenshots obtained using the Internet Archive Wayback Machine (Exhibit TL3) from 2007, 2008, 2011, 2012, 2013, 2014, 2015 and 2016. The 2014 homepage says that there will be 24 manufacturer brands with over 300 vehicles to test-drive and, whilst there is use of the word-only sign, there is also use of the following sign:



A similar logo appears for other years, but with the additional words 'Fleet News' above the words Company Car.

11. Exhibit TL4 contains prints from the current website, which are after the relevant date. I note that page 83 of the exhibit refers to the fact that visitors have to register to attend the event, and each registration is vetted to ensure that only serious buyers/fleet professionals have access to the test tracks. The exhibit also includes reviews from a selection of visitors (from Barclays Bank, Cheshire Police, the Environment Agency, Gateshead Council and GE) and also details of visitor profiles from the 2016 event (the relevant date is the date on which the opposed application

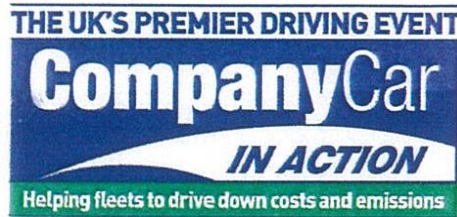
was filed, 13 May 2016). The visitor profiles show the number of visitors by fleet size and also job role. 41% were fleet managers, 21% were Chairmen or Directors, 12% were senior managers, 10% were finance directors/managers, 10% were from purchasing/procurement, 2% from human resources, and 1% were from administrative roles. The event receives visitors from all over the UK, with the most being from South East England and the Midlands.

12. Exhibits TL6 to TL16 comprise prints of advertisements for each year, 2006 to 2016, in FleetNews Magazine, for the opponent's event, which lists major motor manufacturers as taking part (such as Ford, Jaguar Landrover, BMW, Mercedes-Benz, Maserati, Nissan, Honda, Lexus and Volvo). The estimated circulation of the magazine in 2016 was 19,000 copies (the majority in printed format); in 2015, it was 18,900; and in 2014, it was 17,800. Exhibit TL18 comprises an article dated 27 July 2014, by IT Fleet Automotive Limited (which appeared on the website itfleet.co.uk). Fleet marketing managers from Jaguar Landrover UK and from Toyota and Lexus are quoted in the article, giving positive feedback about the 2014 event. Toyota and Lexus provided over 500 test drives at the event.

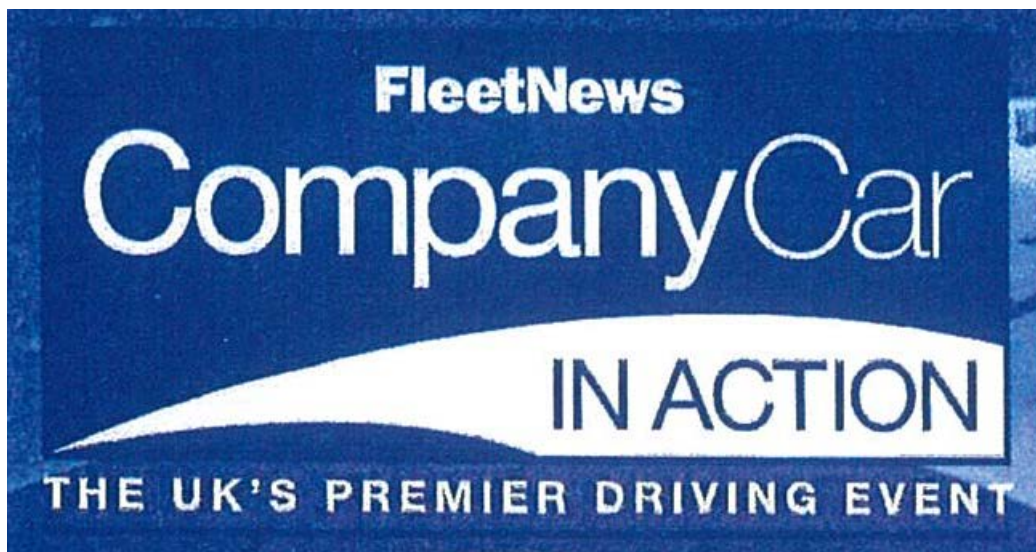
13. Between 2006 and 2013, the signs used in the advertisements were the following logos, although the plain word sign relied upon in these proceedings also appears in the text in the advertisements:



Whether you're ordering hundreds of cars a year for your organisation or are a fleet with just a hand full of vehicles, Company Car In Action is the must-attend event of the year.



From 2013, the logo includes the words 'Fleet News', and the references within the advertisements are either the word-only sign relied upon, or 'Fleet News Company Car In Action':



#### **Section 5(4)(a) of the Act**

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

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

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

(b)...

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

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

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

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

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

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

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



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

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

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

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

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

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

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

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

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

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

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

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

### Goodwill

17. The opponent needs to show that it had goodwill at the relevant date, sufficient to have been able to have prevented the applicant, at that date, from using its mark under the law of passing-off. The applicant has not claimed or filed any evidence that it is using its mark, so the relevant date is the date of application, 13 May 2016.

18. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates.”

19. The evidence shows that the opponent has a business in running an annual event which major car manufacturers attend in order for senior business managers, from all over the UK, to compare and drive different models as part of deciding on which company cars to buy for their businesses. As part of that event, there are exhibitions and conferences relating to company cars and fleet management. The

event is long-standing, draws significant revenue and the opponent consistently spends about 10% of that revenue on advertising for the following year's event.

20. What is the sign attached to the business? The applicant points out in its counterstatement that the opponent's use of the website *companycar.co.uk*, referred to in the opponent's statement of case, is irrelevant because this is not the sign relied upon in the statutory notice of opposition. The applicant also states that the opponent does not rely upon logo use in the notice of opposition.

21. It is true that the sign relied upon in the statutory notice of opposition is the word only COMPANY CAR IN ACTION. I agree with the applicant that any use of *companycar.co.uk* does not help the opponent's case. Firstly, this is because the opponent has not relied upon such a sign. Secondly, such a domain name is non-distinctive and would require very different evidence to that which has been filed.

22. The evidence shows a mixture of use of the sign as pleaded (although it appears in title case in the exhibits) and various logos, as shown in the evidence summary. Again, the applicant is correct that, whilst use in logo form is referred to in the opponent's statement of case, logos have not been relied upon in the statutory notice of opposition. However, the position is different to the website name, which is effectively simply 'company car'. The logos have changed over time, but the sign relied upon, COMPANY CAR IN ACTION, forms the main part of all of the logos. I find that the words COMPANY CAR IN ACTION have become distinctive of the opponent's annual 'drive and compare' company/fleet car event. The opponent's business has sufficient goodwill attached to the sign to enable it to bring the section 5(4)(a) claim.

### Misrepresentation

23. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148* . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175 ; and Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

24. Morritt L.J. also stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

25. The opponent refers to *THE PROPER PIZZA COMPANY*, BL O/206/15, a decision of Mr Daniel Alexander QC, sitting as the Appointed Person, to support its claim that its sign is sufficiently distinctive for misrepresentation to occur. In *THE PROPER PIZZA COMPANY*, Mr Alexander said (my emphasis):

“18. The first, and overarching criticism, is that the Hearing Officer failed to take proper account of the descriptiveness of the term in which goodwill was claimed. That, it is said, led him to take an erroneous approach in evaluating whether the opponent’s activities had generated goodwill, by giving a secondary meaning to the descriptive term.

19. A number of the individual arguments were directed to this point and I deal with them together. They centre on the point made by the Court of Appeal in the case concerning extended passing off *Diageo North America Inc. v. Intercontinental Brands (ICB) Ltd* [2011] RPC 2 at [24] that:

*“The more general and descriptive the name is, the more difficult it will be to establish the reputation and goodwill of the claimant in that term and the existence of a misrepresentation by the defendant in the use of the same name”*

20. As to this point, there is a spectrum of distinctiveness, running from marks which make no reference to the nature or quality of the goods to those which are wholly descriptive of them. In certain cases, terms are prima facie descriptive but, with use, may acquire a secondary meaning. In other cases, terms which have some descriptive connotation may nonetheless operate effectively to denote trade origin from the outset. As I read the decision, the Hearing Officer approached the case on the basis that “The Proper Pizza Co[mpany]” fell more naturally into the latter category. Although it has clear descriptive connotation, it is a term which is likely to be taken by a significant proportion of the relevant public to denote a particular undertaking and its goods and services and was used as such.

At para. [22] the Hearing Officer expressly rejected the suggestion that the term had been used descriptively.

21. Although it is true that he did not conduct a secondary meaning analysis, in the light of that finding, I am not persuaded that it was necessary for him to have done so. In effect, he was saying implicitly that the only real question in considering goodwill was the extent of use of the mark and that it was not necessary to undertake a separate analysis.

22. In approaching the case in this way, in the circumstances of this case, I do not think he can be criticized. The applicant, in applying for registration of a mark whose dominant and distinctive element was, in substance, THE PROPER PIZZA COMPANY, must have itself proceeded on the basis that this term had at least an element of distinctiveness. Moreover, the Hearing Officer found that the use in question was to identify not a type of business but a specific undertaking. Analysis of secondary meaning is more appropriate where a term naturally denotes a kind of goods or services but where it is then said that it has come to denote trade origin, not where it has been used to denote trade origin from the outset. I do not think that what was said in *My Kinda Town v. Soll* [1983] RPC 407 is therefore apposite to the present case where, in effect, both side are contending at least on this appeal, if not always consistently at other times, that the term in question is capable of, and is intended to denote, different trade origins.

23. Cases of passing off turn heavily on their specific facts and it is necessary to apply care in drawing analogies. *My Kinda Town* was an actual passing off case, not requiring the notional assessment called for under the Act with respect to potential activities. At first instance the claim succeeded. The basis upon which it failed on appeal was largely that the evidence of confusion was not proven to be caused by the similarity of name and that the court was of the view that an ordinary member of the public would only get the impression that both businesses sold the same kind of product, not that they were related. The Court of Appeal made it clear that the descriptiveness of the marks was one factor which needed to be considered

against the background of the facts as a whole in deciding whether there was a misrepresentation.”

26. It is the sign as a whole compared to the application as a whole which must be considered. I have already found that COMPANY CAR IN ACTION is distinctive of the opponent’s activities. However, the only common element between the parties’ marks, COMPANY CAR, is non-distinctive/descriptive for services relating to company cars. COMPANY CAR is not distinctive of the opponent’s business.

27. Where two marks share a non-distinctive feature the public can be expected to be alert to detailed differences between them so as to distinguish one from the other. This is a well-established approach to the use of descriptive marks under the law of passing off, the best known case being *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 30. Professor Christopher Wadlow, in *The Law of Passing-Off: Unfair Competition by Misrepresentation*, 5<sup>th</sup> Edition, explains (my emphasis):

**“8-89**

A descriptive term may be sufficiently distinctive to be protected against precise copying, but may still not enjoy protection of such wide scope as a term which is wholly arbitrary. Other traders are free to use similar descriptive expressions as their own trade names or marks, and smaller differences will suffice to distinguish them than in the case of fancy words. This may be expressed in terms of “the idea of the mark”. When an arbitrary mark is in use by the claimant, deception can occur by the defendant adopting a mark which incorporates the same predominant idea even if the expression differs. If, however, the only idea which can be identified is wholly descriptive then such distinctiveness as exists can only lie in the precise form of words used, or something even more specific, such as the manner in which they are written.<sup>384</sup> As may be seen from the *Office Cleaning*<sup>385</sup> case, there is an element of public policy here, in that a degree of confusion is held to be an acceptable price for keeping descriptive terms open to fair use by all.

“Foremost I put the fact that the Appellants chose to adopt as part of their title the words ‘Office Cleaning’ which are English words in common use, apt and more apt than any other words to describe the service they render. This is a trade name, not a trade mark, case, but I would remind your Lordships of the close analogy between the two classes of case found by Farwell J. in *Aerators v Tollit*<sup>386</sup> and by Parker J. in the *Vacuum Cleaner* case. So it is that, just as in the case of a trade mark the use of descriptive words is jealously safeguarded, so in the case of trade names the Courts will not readily assume that the use by a trader as part of his trade name of descriptive words already used by another trader as part of his trade name is likely to cause confusion and will easily accept small differences as adequate to avoid it. It is otherwise when a fancy word has been chosen as part of the name... .

It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”<sup>387</sup>”

28. In the present case, it cannot be said that the applicant’s mark copies the opponent’s sign. The only common element is COMPANY CAR. In my view, the case sits squarely within the explanation provided by Professor Wadlow, and Lord Simonds’ words in *Office Cleaning*. The distinctiveness of the earlier sign lies in the precise form of words, i.e. the whole sign COMPANY CAR IN ACTION. The opponent’s customers will not expect the common use of COMPANY CAR, in relation to services about company cars, to mean that the entities are linked in some way. They will not be deceived because they will be able to discriminate between the marks on account of the differences between them, the only common elements being entirely descriptive. There will be no misrepresentation and hence no



damage. The opposition fails. Consequently, there is no need to consider the applicant's fallback position.

### **Section 5(4)(a) outcome**

29. The section 5(4)(a) ground fails. The application may proceed to registration.

### **Costs**

30. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. The costs breakdown is as follows:

Considering the statement and preparing the counterstatement	£400
Considering the opponent's evidence and submissions	£800
Preparing written submissions	£400
<b>Total</b>	<b>£1600</b>

31. I order Bauer Consumer Media Limited to pay Automotive Media & Events Limited the sum of £1600 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

**Dated this 24<sup>th</sup> day of November 2017**

**Judi Pike  
For the Registrar,  
the Comptroller-General**