

O/077/19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3235718
BY BITS4LANDYS FOR THE TRADE MARK**

Bits4Landys

IN CLASSES 12 AND 42

AND

**THE OPPOSITION THERETO UNDER NUMBER 410277
BY JAGUAR LAND ROVER LIMITED**

Background

1. On 6 June 2017, Bits4Landys Ltd (“the applicant”) filed trade mark application number 3235718 for the mark Bits4Landys, for vehicle parts and design of vehicle parts services in classes 12 and 42. The full specifications are shown later in this decision.

2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 16 June 2017.

3. Jaguar Land Rover Limited (“the opponent”) opposes the application under sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”). Section 5(2)(b) is based upon the opponent’s seven earlier marks shown below, on the basis that there is a likelihood of confusion between the marks. The opponent relies upon part of its specifications, as detailed later in this decision and set out in the annex.

Number and mark	Classes relied upon	Date filed	Date registered/protected
EU 13538475 LANDY	12 and 35	8.12.2014	7.05.2015
UK 3035561 LANDY	12 and 35	19.12.2013	30.05.2014
EU 16134868 LANDY	37	5.12.2016	27.03.2017
IR 1342543 LANDY	37	7.12.2016	22.09.2017
EU 16493521 LAND ROVER	12, 35 and 41	21.03.2017	8.09.2017
UK 3181948 LAND ROVER	12	23.08.2016	25.11.2016
UK 1378096 LAND ROVER	35 and 37	21.03.1989	21.08.1992

4. Under Section 5(3), the opponent relies on a reputation in vehicles and their parts and vehicle maintenance and repair, business, retail and training services relating to vehicles. The registrations listed above are relied upon for section 5(3), with the exception of EU 16134868 and IR 1342543. It is claimed that the application would bring the opponent's marks to mind, resulting in dilution and/or tarnishing of the opponents' marks, and/or that the reputation of the opponent's marks would give the applicant an unfair advantage:

5. Under section 5(4)(a) of the Act, the opponent claims that it has goodwill attached to the signs LANDY and LAND ROVER. The opponent claims that LANDY was first used in the UK in 1970, in relation to "vehicles, parts, fittings and accessories for vehicles". The opponent states that LANDY has become a nickname for LAND ROVER vehicles and that the opponent has accrued goodwill in its "very famous LANDY nickname". The opponent claims goodwill in the sign LAND ROVER, which it states was first used in the UK in April 1948 in relation to "vehicles, parts, fittings, accessories for vehicles and associated services including maintenance, repair, servicing, reconditioning, restoration and customization of vehicles, dealership and retail services". The opponent claims that use of the applicant's mark is liable to be prevented under the law of passing off because use of the application would result in a belief by the public that the goods or services offered by the applicant were supplied by or under licence from the opponent.

6. Under section 3(6) of the Act, the opponent claims that the application was filed in bad faith, as follows:

"The Applicant has adopted the sign "BITS4LANDYS" for parts and fittings for vehicles and related services in an obvious attempt to associate itself with the Opponent and take unfair advantage of the Opponent's reputation. The Applicant, who is trading as Bits4Landys, states on his website (www.bits4landys.co.uk) that "Bits4Landys make and supply very high quality replacement parts, accessories, body panels, chassis and repair panels for the restoration of the classic Land Rover...". The Opponent is the UK's leading automotive manufacturer and owner of the iconic LAND ROVER marque. It is common knowledge in the automotive industry that LAND

ROVER vehicles have acquired a nickname, LANDY. It is clear from the Applicant's website, and its apparent knowledge in the field of automotives, in particular its knowledge of LAND ROVER vehicles, that at the time of filing the application, the Applicant was aware of the commonly known and used nickname LANDY. The Applicant's intention to register the sign "BITS4LANDYS" is to establish a connection or association to the Opponent's business and reputation so that the relevant public will assume the mark "BITS4LANDYS" originates from the Opponent, or that the Applicant is commercially linked to the Opponent. The sign "BITS4LANDYS" has not been filed in accordance with the norms of reasonable, honest and fair commercial behaviour and should therefore be precluded from registration under Section 3(6) Trade Marks Act 1994".

7. The applicant filed a defence and counterstatement, denying all the grounds. Although the opponent made a statement of use in respect of the single earlier mark which had been registered for more than five years at the publication date of the contested application, the applicant has ticked the 'no' box on the form TM8, in answer to the question as to whether it wishes the opponent to prove that it has used this mark (UK 1378096 LAND ROVER). As a consequence, the opponent can rely on LAND ROVER in relation to the services of that registration in class 35 and 37 upon which it relies, without having to prove that it has used its mark in relation to those services.

8. The counterstatement has been completed by Mr Christopher Wright. The main points made in the counterstatement are that:

- the applicant was formed in July 2009 first as a partnership, then traded as a sole trader, and then became a limited company.
- the applicant supplies parts to the opponent itself for the latter to use in its restorations of historic vehicles.

- the applicant makes parts which are superior to Original Manufacturer Equipment (“OEM”) and only makes parts for vehicles which the opponent no longer manufactures.
- the marks are not similar, pointing out that the opponent’s marks appear to ‘clash’ with other third-party rights.
- the opponent’s LAND ROVER mark is very well known but the opponent’s LANDY mark has never been used. The public will be unaware that the opponent owns LANDY, and so will not associate the applicant’s goods and services with the opponent.
- the applicant can find no use by the opponent of LANDY, although it has been used as slang for the last 40 years. The applicant believes the opponent has not used it because LANDY, as a slang term, conjures up images of dilapidated and ancient Land Rovers. The opponent’s LANDY trade marks will probably be the subject of applications to revoke them on the grounds of non-use, in December 2019.
- the opponent has recently begun pursuing small companies, like the applicant, which use LANDY, some of which have been trading for more than 30 years. The combination of brilliant design but poor build quality in classic Land Rover Defenders has created a whole industry of small companies that rebuild vehicles and manufacture higher quality replacement and upgrade parts.
- the applicant is an online-only business and it registered the domain name www.bits4landys.co.uk more than five years before the opponent registered its LANDY trade marks. The website contains content which makes it clear on every page that the applicant has no commercial link with the opponent: “Bits4Landys are independent non-franchised manufacturers & suppliers of parts for the Classic Land-Rover Marque LAND ROVER® and DEFENDER® are registered trade marks of Jaguar Land Rover Limited”.

- Landy is the adjective, not the noun, according to Mr Wright; i.e. bits (parts) for Landys, not by Landys.
- Bits4 is the more dominant part of the application.

9. Mr Wright states:

“Landys’ commonly means ‘Older Land Rover Vehicles’. Putting all this together ‘Bits4Landys’ can be taken to mean ‘Parts for Older Land Rover Vehicles’ which was our intension as we are a manufacturer and supplier of restoration parts for older Land Rovers vehicles.”

10. Both sides filed evidence and written submissions in lieu of a hearing. The opponent is represented by Reddie & Grose LLP. The applicant represents itself. I make this decision after careful consideration of all the documents filed.

Evidence

11. The opponent’s evidence-in-chief comes from Ms Amanda Beaton, the opponent’s Global IP Counsel. Her witness statement is dated 11 April 2018. Ms Beaton’s evidence goes to the use and reputation of both LAND ROVER and LANDY. Since the applicant, in its counterstatement, accepts that LAND ROVER is very well-known, I will give a briefer summary of the evidence in relation to this mark than I would otherwise. The headlines arising from Ms Beaton’s statement, in relation to the LAND ROVER mark, are as follows:

- Most of the opponent’s 40,000 employees are based in the UK. It is the UK’s largest automotive manufacturer, by volume, producing over 600,000 vehicles in 2017.
- Between 2011 and 2016/2017, turnover relating to the LAND ROVER vehicles increased from £1.9 billion to over £3 billion, with an increase from 40,000 vehicles to 75,000 vehicles sold in the UK between 2011 and 2016.

- LAND ROVER vehicles are ranked second highest in the UK in terms of production and have consistently had a 10% UK market share in the 'dual purpose' car segment.
- The average annual spend on advertising LAND ROVER vehicles in the UK is in excess of £10 million.

12. Exhibit ABJ4 comprises a collection of media articles and reviews referring to LAND ROVER, including the DEFENDER model. I note that there is no mention of 'Landy' by the journalists, including those writing for "Top Gear", "Autotrader" and "Honest John". Exhibit AJB9 comprises screenshots and information about the opponent's workshop which is dedicated to the preservation and restoration of classic LAND ROVER models. There is no mention in the exhibit of the mark LANDY. Exhibit AJB10 comprises screenshots supporting Ms Beaton's statement that the opponent maintains a number of LAND ROVER pages on social media platforms, including YouTube, Facebook, Twitter and Instagram. These screenshots do not feature the mark LANDY.

13. Ms Beaton states:

"As a result of the widespread and continuous use of the LAND ROVER marque for nearly 60 years, its vehicles have acquired a nickname, LANDY. The nickname LANDY has been around for at least 40 years and is widely known by the public to refer to a LAND ROVER vehicle. It is spelt as LANDY or LANDIE."

14. Ms Beaton states that industry specialists, owners and the general public refer to LAND ROVER vehicles by its nickname, LANDY (or LANDIE). Ms Beaton states that Exhibit AJB13 contains press articles referring to LANDY or LANDIE, and lists five quotations. I cannot see any of them in the articles headed as Exhibit AJB13. The evidence before me appears to be in original hard copy, including exhibits in colour. It is the same as the, earlier-filed, electronic version which was not admitted because the evidence was not properly paginated. I also note that the opponent's written submissions refer to quotations in Exhibits AJB4 and AJB13 and that one

quotation states “once you make a LANDY, it stays made.” It is not clear in which exhibit this is to be found but, in any event, I have been right through both exhibits and I cannot see this quotation. Exhibit AJB13 comprises the following:

- A print from the website of the Coventry Telegraph, dated 6 June 2017 (which is the date when the contested application was filed). Most of it comprises an advertisement for a Range Rover. The middle of the page carries a headline “Coventry car repair shop in web name row with Jaguar Land Rover”, with the incomplete sentence underneath “The domain name www.thelandyclinic.co.uk was used to promote the garage, but it infringed the...”. There is no other page to continue the text.
- A six-page article printed from a website called www.iol.co.za, which appears to be a South African motoring news website. The headline is “1948 Landy ‘show special’ to regain former glory”. This article is dated 10 January 2018, over 6 months after the relevant date in these proceedings.
- An article from the website of the Western Morning News (a Cornish publication) dated 14 April 2015. The article reports that a Cornish children’s author is to release a fourth book in the series called Landy the Landrover:

“Self-published children’s book author and illustrator, Veronica Lamond, has won the admiration of Jaguar Land Rover with her illustrated and heart-warming stories about two of their well-loved, classic vehicles.”

The characters are called Landy and Fender. Ms Lamond is quoted as having grown up in South Africa. There is no reference to LANDY being a nickname for the opponent’s LAND ROVER vehicles.

- The final article comprising Exhibit AJB13 is dated 17 January 2018, over six months after the relevant date in these proceedings. It is from the website of The Telegraph. The article is headed: “The Landy lives on: most powerful

Defender ever marks Land Rover's 70th birthday – two years after production ends." There are no other references to LANDY.

15. Although Ms Beaton states that the opponent takes brand protection very seriously and has been adding to its portfolio of registered marks since 1947, she is silent as to whether the opponent uses LANDY. Exhibit AJB14 comprises what Ms Beaton describes as a collection of quotations from judgments between 2015 and 2017, originating from decisions of either the High Court of England and Wales or the European Intellectual Property Office ("EUIPO"). The quotations all concern the accepted substantial and longstanding reputation of LAND ROVER. None refer to LANDY.

16. Ms Beaton refers to a complaint filed by the opponent to Nominet, the domain name dispute resolution service, in June 2017. The complaint concerned landyclinic.co.uk, which Nominet found to be an abusive registration and transferred the name to the opponent. The judgment is not exhibited and no reference or citation is given. Ms Beaton states that the adjudicator found that "there is a real possibility that an internet user arriving at the website linked to the domain name would assume that it relates to goods provided by Jaguar Land Rover and that it is a domain and site owned and provided by the company." However, without seeing the judgment or being given more information by Ms Beaton, I do not know whether this finding was based upon the existence of the opponent's LANDY trade marks, or if it was established that the opponent had a reputation in LANDY. In any event, I must consider the mark that has been applied for. The Nominet quotation is, therefore, of no assistance in these proceedings.

17. The final part of Ms Beaton's evidence concerns the applicant's website and the opponent's request that the applicant change some of the content on the website and on its social media platforms. Ms Beaton states that the applicant has made some changes, such as in the way in which it makes reference to LAND ROVER and DEFENDER. Exhibit AJB15 contains prints from the applicant's website from the Wayback Machine Internet Archive. This archive is often used by parties in trade mark litigation when researching the appearance and content of previous versions of websites. The earlier pages (from 2015 and 2016) refer to parts for the restoration

of the Classic Land Rover series and the Defender. Prints from the applicant's Facebook site are also shown, printed on 8 July 2017. These show the applicant's trade mark and various photographs of restored vintage LAND ROVER models and work-in-progress.

18. The applicant's evidence comes from Christopher Wright (who also completed the counterstatement). In its written submissions in lieu of a hearing, the opponent points out that the witness statement is deficient because it is not signed. The copy before the Tribunal is signed. It is a hard copy. The opponent also points out that Mr Wright does not identify what position he has in relation to the applicant. This is true. However, it is a more than reasonable inference that Mr Wright plays a major role in the applicant company. He has filed the counterstatement and the witness statement. Mr Wright refers to the applicant beginning as a partnership, then running as a sole trader. At the end of the applicant's written submissions in lieu of a hearing, which have been written by Mr Wright, he says (my emphasis) "Finally, on a personal note, it does seem very unfair to me that I have spent nearly ten years building a brand...and whilst all this is going on another part of the same corporate monster is quite happily buying goods & services from me. Annoyingly, I could have avoided this whole situation by trade marking 'Bits4Landys' in 2009 when I started...". I therefore accept that, whilst it is not identified, Mr Wright's position in the applicant's company enables him to speak for the applicant and that he has knowledge of the facts contained in his evidence.

19. The opponent makes other observations about the format of the evidence, such as the absence of signed header sheets and lack of pagination. The opponent notes that the evidence has been admitted, but nevertheless makes these criticisms in its written submissions in lieu of a hearing. Since the applicant's evidence was admitted, the opponent has filed evidence in reply of its own. The opponent did not raise these issues at that juncture. It is too late to do so now.

20. A good deal of the applicant's evidence repeats the information contained in the counterstatement, which I will not repeat here.

21. Mr Wright refers to the children's books and states that he obtained a copy printed in 2017, which has the following printed on the inside of the front cover: "Under licence from Jaguar Land Rover. This book is not a representation of Jaguar Land Rover or product performance." Mr Wright states this is as near as it gets to official use of LANDY by the opponent.

22. Mr Wright refers to earlier third-party rights which he considers conflict with the opponent's LANDY mark. I will come back to the reason why this is not relevant, later in this decision.

23. Mr Wright, at several points, says that the trade mark LAND ROVER "is not in dispute". I take this to mean, as stated in the counterstatement, that the applicant accepts that LAND ROVER has a reputation (but that LANDY does not). Mr Wright has filed copies of invoices for parts sold by the applicant to the opponent's Land Rover Classic Works division (after the relevant date). Mr Wright states that the applicant changed the way it refers to LAND ROVER on its website following the receipt of correspondence from the opponent in which the latter gave examples to the applicant as to how the opponent's trade marks should be used on the applicant's website.

24. As mentioned in the counterstatement, Mr Wright refers to the opponent's LANDY registrations being the subject of potential applications for revocation on the grounds of non-use in December 2019. He states that he will definitely make such an application for revocation if his contested application is refused registration because of the opponent's LANDY registrations (or if the applicant is forced out of business by the opponent).

25. The opponent filed evidence in response from Justine Lynch. Her witness statement is dated 1 October 2018. Ms Lynch is a trade mark attorney with Reddie & Grose LLP, the opponent's professional representatives in these proceedings.

26. A large part of Ms Lynch's evidence answers Mr Wright's confusion about the use of the Wayback Machine by giving an explanation as to how it works. She exhibits (Exhibit JL4) a print from the Wayback Machine showing that the website

bits4landys.co.uk had been captured 25 times between 22 April 2013 and 15 October 2017 (and a further four times by 1 September 2018).

27. The rest of her evidence gives details about the relationship between the opponent and Ms Lamond, the author of the children's books. She merely repeats facts already contained in Ms Beaton's evidence about the existence of the books, and refers to the licensing information on the inside cover, which Mr Wright states he found in one of Ms Lamond's books. She states that it is standard wording agreed between the opponent and Ms Lamond. The books can be purchased from the opponent's retail website, but she does not say when they were first available to purchase from the opponent. The exhibited prints from the opponent's website, showing the books and their prices, were printed on 1 October 2018.

Decision

Section 5(2)(b) of the Act

28. Section 5(2)(b) of the Act states:

“(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.”

29. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas*

AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

30. For procedural economy, I will begin by assessing this ground of opposition in relation to the opponent's LANDY marks, which cover classes 12, 35 and 37. The applicant is unrepresented and it is clear from its submissions, the counterstatement and its evidence that it places great importance on how its trade mark, goods and services have been presented to customers since 2009. I will attempt to explain here why it is that the applicant's current mode of business and its marketing plans play no part in the assessment under section 5(2)(b) of the Act.

31. A trade mark registration is a claim to a piece of legal property, i.e. the trade mark. The level of protection provided by the registration is normally based on a notional assessment of the likelihood of confusion between the earlier trade mark and any later mark. Marks are protected against the use of the same or similar marks in relation to goods or services which are the same or similar, if there is a likelihood of confusion.

32. Until a trade mark has been registered for five years, it is entitled to protection in relation to all the goods/services for which it is registered or (in the case of the IR)

protected. As explained earlier in this decision, the applicant chose not to put the opponent to proof of use in relation to the one earlier mark which was older than five years on the date of publication. The opponent's earlier marks are therefore entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier marks for the goods/services on which the opponent relies for the purposes of this opposition.

33. The applicant submits that the opponent's business is focussed on luxury vehicles, whilst its own is based upon restoration and repair of old Land Rover vehicles (particularly Defenders). I must consider notional and fair use of the parties' marks across all segments of the markets for the goods/services for which they are registered: in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Consequently, I must include consideration of the likelihood of confusion if both parties (and their successors in title to the marks) decide to target the same segment of the market. This is because the legal protection the applicant seeks is governed by the list of goods/services, not by its current intentions. Therefore, the fact that the parties are currently, or currently intend to, target different market segments is irrelevant where the goods/services at issue are fundamentally the same or similar. Either party could change its marketing plans tomorrow, or sell the mark to another trader with different plans. Consequently, no weight can be given to how the parties' have, or have not, used their marks when assessing whether there is a likelihood of confusion under section 5(2) of the Act.

34. Additionally, the fact that third parties may have registrations or applications for trade marks which, on the face of it, would appear to be open to objection from the opponent, is not relevant. This is because there is no information as to whether these marks have been used in the UK, whether the UK average consumer has become accustomed to telling them apart from the opponent's marks, or what agreements the parties may have come to about co-existence. The assessment must be made purely on the basis of the marks at issue in these proceedings.

Comparison of goods and services

35. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated, at paragraph 23 of its judgment:

“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.”

36. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], 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...”.

37. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

38. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

39. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

40. The competing goods and services are shown in this table:

Earlier LANDY marks	Application
<p>Class 12: <i>Vehicles; parts, components and accessories for all the aforesaid goods.</i></p> <p>Class 35: <i>Business management and advisory services, all relating to the manufacture, sale, repair and maintenance of motor vehicles; retail services connected with apparatus for locomotion by land, air or water, motor vehicles, commercial vehicles, vehicle parts and fittings.</i></p>	<p>Class 12: <i>Parts and fittings for vehicles; Splines (square -) [parts of land vehicle gearing]; Coupling sleeves (non-electric) [parts of engines for land vehicles]; Coupling sleeves (non-electric -) [parts of motors for land vehicles]; Cranks [parts of land vehicles]; Gear train parts for land vehicles; Splines (sliding -) [parts of land vehicle gearing]; Hydraulic servo valves being parts of vehicle braking systems; Braking systems for vehicles and parts thereof; Shock absorbers being parts of</i></p>

Class 37: Maintenance, repair, servicing, reconditioning, restoration, inspection, care, cleaning, painting and polishing of motor land vehicles, or of parts and fittings for all these goods; Assembly of accessories for vehicles (installation services); Automobile customization services; automotive upgrade services; information, consultancy and advice relating to any of the aforesaid services and for the supply of parts for motor land vehicles.

vehicle suspension; Shock absorbers [vehicle parts]; Suspension struts [vehicle parts]; Struts (Non-metallic -) parts of vehicles; Sun visors [vehicle parts]; Reservoirs (metal -) [parts of vehicles]; Reservoirs being parts of vehicle braking systems; Differentials [land vehicle parts]; Running boards [land vehicle parts]; Side shields as structural parts of vehicles; Crown wheels being parts of land vehicles; Reservoirs being parts of land vehicle clutches; Leaf springs [land vehicle suspension parts]; Sumps being parts of land vehicle gearboxes; Bodywork parts for vehicles; Shock absorbing cylinders [parts of vehicles]; Shock absorbing springs being parts of vehicle suspension; Drive gears [land vehicle parts]; Constant velocity joints [vehicle parts]; Wheels [land vehicle parts]; Connecting rods for land vehicles, other than parts of motors and engines; Power transmission parts [other than belts] for land vehicles; Drive belts [land vehicle parts]; Power transmission parts [belts] for land vehicles; Seat pillars [parts of vehicles]; Seat posts [parts of vehicles]; Mud guards [land vehicle parts]; Fenders [land vehicle parts]; Tire snow chains [land vehicle parts]; Axles [land vehicle parts]; Rearview mirrors [vehicle parts]; Steering wheels [vehicle parts]; Windshield visors [vehicle parts];

	<p><i>Reservoirs (non-metallic -) [parts of vehicles]; Windshields [land vehicle parts]; Consoles being parts of vehicle interiors; Sun visors being parts of vehicle bodywork; Elevating tailgates (Am.) [parts of land vehicles]; Mud flap brackets as structural parts of vehicles; Hydraulic servo valves being parts of vehicle hydraulic systems; Torsion/sway bars [land vehicle suspension parts]; Windshield wipers [vehicle parts]; Bug shields as structural parts of vehicles; Coupling rings (non-electric -) [parts of land vehicle engines]; Coupling rings (non-electric -) [parts of motors for land vehicles]; Ball joints [vehicle parts]; Idler arms [vehicle parts]; Coil springs [land vehicle suspension parts]; Transmissions [land vehicle parts]; Tire chains [land vehicle parts]; Hood shields as structural parts of vehicles; Brake parts (Vehicle -) made of materials having frictional properties.</i></p> <p><i>Class 42: Design of land vehicle parts; Design of tooling for the production of land vehicle parts; Design of vehicles and vehicle parts and components; Design of motor vehicle parts; Design services for parts of motor vehicles.</i></p>
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41. The opponent has cover for parts for vehicles. All the applicant's class 12 goods are parts for vehicles. These goods are identical.

42. The following of the applicant's class 42 services can be grouped together for consideration: *Design of land vehicle parts; Design of vehicles and vehicle parts and components; Design of motor vehicle parts; Design services for parts of motor vehicles*. These are not in the same nature as the opponent's class 12 goods, nor is the purpose or method of use the same. However, there is a degree of complementarity and shared trade channels. A customer looking for bespoke vehicle design and bespoke vehicle parts is likely to expect the same undertaking to manufacture and supply the said vehicle and its parts. Additionally, the opponent's automobile customization services in class 37 will involve the supply of parts for the finished vehicle, and with any customisation there is a degree of design involved. There is complementarity and shared trade channels. I find that the applicant's services in class 42, which I have grouped together, are similar to a medium degree to the opponent's goods and to the opponent's automobile customization services.

43. There is no similarity between the opponent's goods and the applicant's *Design of tooling for the production of land vehicle parts*. The consumers will be different: the consumer for the applicant's services will be a manufacturer of land vehicle parts, whilst the consumer purchasing the opponent's goods and services will be a business or customer repairing or constructing a vehicle. An undertaking providing vehicle repair or customization, even if the project requires bespoke parts, is not providing a separate design of tooling service: this is part of the undertaking's own business, analogous to a department store advertising its own goods for sale (it is not providing an advertising service). The parties' goods and services are not complementary¹ or in competition, and will not share channels of trade. They are not of a shared nature, purpose or method of use and the end-users will be different. As there must be some similarity between goods and/or services for a likelihood of confusion, the section 5(2)(b) ground fails in respect of *Design of tooling for the production of land vehicle parts*.

44. I also find that the opponent's position is not improved in respect of its LAND ROVER marks because there are no goods or services protected under those earlier

¹ See *Commercy AG v OHIM*, GC, Case T-316/07: there is no complementarity if the end-users are different.

marks which are any closer to the applicant's *Design of tooling for the production of land vehicle parts*².

Average consumer and the purchasing process

45. In his evidence, Mr Wright states:

“In addition (but possibly not relevant) it may also be noted that our customers are not just random members of the general public (the average person in the street has no use for a replacement battery tray for a 1965 series 2a for example), most of our customers are either classic car restoration businesses or Classic Land Rover enthusiasts and are all very knowledgeable about Land Rovers. I am 100% sure that there has never been any confusion between BITS4LANDYs Ltd and JAGUAR LAND ROVER Ltd.”

46. As explained earlier in this decision, the likelihood of confusion assessment is based upon a range of notional, rather than actual trade, factors. This includes the perception of the ‘average’, or typical, consumer for the goods and services for which the earlier marks are protected or for which the application has been made, not for the actual business model of the parties. In essence, whether there is a likelihood of confusion must be assessed objectively and notionally from the viewpoint of the average consumer. The average consumer is a hypothetical person, or ‘legal construct’, who is deemed to be reasonably well-informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

47. The average consumer for the parties’ goods and services will include members of the general public and vehicle repair businesses. The purchase of vehicles, automotive customization and vehicle design services will be subject to a higher than average level of attention. Parts will be researched to ensure they match vehicle

² Set out in the annex.

requirements, so will be subject to at least an average degree of attention, depending on the type of part in question. The purchasing process is likely to be primarily visual, after having inspected websites, brochures and packaging, although in this industry I am aware that parts may be asked for orally from motor factors. Therefore, I do not discount the potential for an aural aspect to the purchasing process.

Comparison of marks

48. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

49. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Opponent's mark	Applicant's mark
LANDY	Bits4Landys

50. The overall impression of the opponent's mark lies in the single word of which it is comprised. The applicant's mark is comprised of three conjoined elements: Bits, 4 and Landys. 4 is commonly used as an informal replacement for the word 'for'. The mark comprises a phrase, namely, Bits 4/for Landys, which forms the overall impression of the mark. Although Bits appears at the beginning of the mark, it is not more dominant than Landys because the latter is the element that qualifies 'Bits'. Contrary to the applicant's submission, Landys is not an adjective and does not perform an adjectival role in the mark. Bits is a noun, and the formulation of the mark, with 4 replacing 'for', means that Landys (even if an unknown word) also performs the role of a noun (e.g. bits for caravans).

51. The element common to both parties' marks appears at the end of the applicant's mark (Landy), albeit with an S right at the end. The marks are visually and aurally similar to a medium to low degree.

52. Landy is an invented word. As Landy has no meaning, the marks have no conceptual similarity.

Distinctive character of the earlier mark

53. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*³ the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

³ Case C-342/97

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

54. One of the principles which must be taken into account in deciding whether there is a likelihood of confusion is that there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it. Distinctive character is a measure of how strongly the mark identifies the goods and services of the opponent. As an unused mark, Landy is inherently highly distinctive as it is an invented word which does not describe or allude to the opponent’s goods and services or any characteristics thereof. The applicant states that “Landys commonly means ‘Older Land Rover Vehicles’” because it is a colloquialism or nickname for old, dilapidated classic Land Rover vehicles. The opponent has not shown in its evidence that it uses such a nickname itself, nor that it has made use of LANDY as a trade mark. As the caselaw sets out, in order to determine whether the distinctive character of a mark has been enhanced owing to the use made of it so that it identifies, or more strongly identifies, the goods and services as originating from a particular undertaking, it is necessary to take into account the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (my emphasis). The opponent cannot demonstrate any of these factors because it has not used the mark. It has not used the mark in accordance with its essential function, which is to distinguish its goods and services from those of other undertakings. There is very little evidence

that LANDY is used by third parties; even if this was relevant, the evidence goes nowhere near establishing that LANDY has acquired enhanced distinctiveness through use. Consequently, I find that the opponent is not entitled to claim that the distinctiveness of its LANDY marks have been enhanced in the UK through use.

Likelihood of confusion

55. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. I have found that there is no similarity between the opponent's goods and services and the applicant's *Design of tooling for the production of land vehicle parts*. The section 5(2)(b) ground fails in respect of these services.

56. The applicant's other goods and services are either identical or similar to a medium degree to the opponent's goods and services. The earlier mark, LANDY, is highly distinctive (inherently). The differences between the marks mean that there is no likelihood that they will be imperfectly recalled and therefore directly confused. However, I find that there is a likelihood of 'indirect confusion'. This type of confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from

the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

57. The applicant's mark will be perceived as meaning Bits for Landys. 'Bits' is an informal way of referring to parts or pieces. In the context of the goods and services, bits will be interpreted as meaning parts for Landys. Keeping in mind the notional test for confusion explained earlier in this decision, the mark will simply signify bits or parts for Landy (an unknown concept). Such a perception will cause the average consumer to conclude that the goods and services emanate from economically linked undertakings or the same undertaking using a variation on its brand. I consider that to be the case for all the goods and services which I have found to be similar. This finding is a consequence of the earlier mark being registered and not being subject to proof of its use.

Section 5(2)(b) outcome

58. The section 5(2)(b) ground of opposition succeeds against all the goods and services of the application except for *Design of tooling for the production of land vehicle parts*.

Section 5(3) of the Act

59. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a 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.”

60. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a

change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

61. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks are similar to the applicant's mark. Secondly, that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the

three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

62. I will begin with the opponent's LANDY marks. The first requirement of similarity between the marks is satisfied, as detailed earlier in this decision. The second requirement is a reputation in the goods and services relied upon under the LANDY marks: *Vehicles; parts, components and accessories for the aforesaid goods.*

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

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

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

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

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

64. The factors to consider are similar to those set out earlier in this decision in relation to assessing whether the inherent distinctiveness of the mark LANDY had

been enhanced by the use made of it. As similarly set out in the *Windsurfing Chiemsee* judgment, the CJEU specifies the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it. The undertaking, i.e. the opponent, cannot demonstrate any of these factors because it has not used the mark. The ground based on the LANDY marks fails.

65. I turn now to the opponent's case under section 5(3) based upon its LAND ROVER marks. These are relied upon in relation to:

Class 12: Vehicles; parts and fittings for all of the aforesaid goods.

Class 35: Business consultancy services and business management advisory services, relating to the manufacture, provision, distribution, sale, maintenance, restoration and repair of motor vehicles, export and import of vehicles, their parts and fittings; distributorship services and retail store services relating to motor land vehicles and parts, fittings and accessories for motor land vehicles; retail store services in the field of automobiles, automobile parts, fittings and accessories; advertising; market research; business advisory services relating to franchising for the establishment and maintenance of motor dealership and vehicle spare part enterprises.

Class 37: Repair and maintenance services all relating to motor vehicles, parts, fittings and accessories.

Class 41: Instruction and training services in the fields of automotive sales, maintenance and repair; education and training in the field of automotive engineering.

66. LAND ROVER is a famous mark in the UK in relation to cars (of the 4x4 type). That is borne out by the evidence, by the applicant's statements and is, I think, a notorious fact. However, as the wording of section 5(3) makes clear, the first requirement is that parties' marks must be identical or similar. The similarity of the marks must be assessed in the same way as under section 5(2)(b) of the Act

(although there is no requirement that there exists a likelihood of confusion under section 5(3))⁴. The parties' marks are shown below:

Opponent's mark	Applicant's mark
LAND ROVER	Bits4Landys

67. The only common element is 'LAND'. This is subsumed within the applicant's mark. There is, accordingly, only a very low level of visual and aural similarity. LAND ROVER creates a concept of something which roves or moves over land. As found earlier, on one view, Landys is an invented word, and the later mark creates the concept of parts or bits for the unknown 'landys' (which may be perceived as plural for the unknown word landy). However, the applicant states in its counterstatement:

“Landys' commonly means 'Older Land Rover Vehicles'. Putting all this together 'Bits4Landys' can be taken to mean 'Parts for Older Land Rover Vehicles' which was our intension as we are a manufacturer and supplier of restoration parts for older Land Rovers vehicles.”

68. As a consequence of the applicant's admission about what LANDY means and what its mark as a whole means in relation to the earlier mark, I rule out dismissing the section 5(3) ground on the basis that the low degree of similarity between the marks is not enough for the later mark to bring LAND ROVER to mind. This means that the marks are similar enough to engage section 5(3) of the Act.

69. The reputation of LAND ROVER, in relation to cars (of the 4x4 type), is huge. It is a highly distinctive mark, of considerable longevity. The parties' goods and services are identical or similar, with the exception of *design of tooling for the production of land vehicle parts*. There is no requirement under section 5(3) that goods and services are similar, although the more dissimilar they are, the less likely

⁴ *Adidas Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd*, C-408/01, CJEU.

it is that the earlier mark will be brought to the mind by the later mark (and create the necessary 'link'). The applicant's dissimilar services are in a connected field of commerce. The applicant's admission leads me to conclude that the relevant public will make a link between the marks in relation to all of the applicant's goods and services.

70. Having found similarity between the marks, the necessary level of reputation in relation to 4x4 cars and the existence of a link between the marks, the next step in the enquiry is to assess whether any of the three pleaded types of damage will arise. This section of the Act is not about whether the marks will be confused. The opponent claims that the applicant's mark takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier trade mark. Detriment to the distinctive character or repute is damage done to the earlier mark which means that the relevant public is less likely to buy the goods or services of the earlier mark (because its distinctive character is eroded or its reputation is degraded in some way). Unfair advantage is different. It has no effect on the consumers of the earlier mark's goods and services. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods and services of the later mark than they would otherwise have been if they had not been reminded of the earlier mark. Essentially, the later mark will get a marketing or commercial 'leg-up' because the link with the earlier, reputed, mark means that the owner of the later mark does not have to put as much effort into making the later mark known because it already feels familiar or sends a message to consumers as to what they can expect.

71. *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch), in which Arnold J. considered the earlier case law and concluded that:

"80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of

the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

72. LANDY does not have any reputation with the relevant public as a trade mark of the opponent. Although, as is common ground between the parties, LANDY would bring LAND ROVER to mind as an informal term for old LAND ROVER vehicles, this does not mean that the applicant's mark includes the trade mark with a qualifying reputation, i.e. LAND ROVER. Although the informal reference in the applicant's mark is liable to give the applicant an advantage in that it tells the relevant public that the applicant provides 'bits' (parts) for LAND ROVERS (and related services), it is not an unfair advantage. There is nothing unlawful about offering spare parts for third-party products. The mere fact that the applicant's mark informs the public that it provides spare parts and services for LAND ROVERS does not take unfair advantage of the reputation of LAND ROVER. In *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211, Floyd LJ (with whom Lord Kitchen and Sir Colin Rimer agreed) stated:

“108. That brings me to the central question of whether ASI's use of the sign ARGOS in relation to the service of provision of advertising space took unfair advantage of the trade mark. I reject Mr Mellor's contention that, in a case such as the present, unfairness is established by the fact of economic advantage and no more. So to hold would be to empty the word “unfair” of any meaning. Like the Court of Appeal in *Whirlpool* I do not consider the effect of the CJEU's judgment in *L'Oreal* to go that far.”

73. If the applicant's mark had been BITS4LANDROVERS, then it may have been liable to dilute the distinctiveness of the reputed trade mark. This is because it would mean that LAND ROVER no longer indicated the goods of just one undertaking.

However, there is no evidence that third party use of LANDY(S) has so far diluted the distinctiveness of LAND ROVER. In the absence of any reputation of LANDY as a trade mark of the opponent, it seems inherently unlikely that such use would change consumers' economic behaviour in relation to LAND ROVER vehicles, parts or services. Similarly, there is nothing inherently tarnishing of LAND ROVER caused by a third party using BITS4LANDYS for parts and parts design services for LAND ROVER vehicles. Speculation about quality is not a basis for a claim to detriment to repute⁵. It is not the opponent's case that the applicant's mark could be used in relation to parts and services for vehicles other than LAND ROVER vehicles. Even if it were, it seems highly improbable that the applicant's mark would gain any advantage, or cause any detriment, if it were used in relation to parts for non-LAND ROVERS. This is because parts are specific to individual vehicles and therefore attracting the public to a parts provider which does not provide the parts indicated by the name would be self-defeating and futile.

74. The opposition fails under section 5(3) of the Act.

75. 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.”

⁵ *Champagne Louis Roederer v J Garcia Carrion S.A. & Others* [2015] EWHC 2760 (Ch)

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

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

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

The relevant date

77. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for

a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent’s goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom’s TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

78. I will start from the premise that the relevant date is the date on which the contested application was filed, 6 June 2017. The opponent needs to show that it had goodwill in the signs relied upon, LANDY and LAND ROVER, 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.

79. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margerine Ltd* [1901] AC 217 at 223 (my emphasis):

“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.”

80. In the same case, Lord Lindley said:

“Goodwill regarded as property has no meaning except in connection with some trade, business, or calling. In that connection I understand the word to include whatever adds value to a business by reason of situation, name and reputation, connection, introduction to old customers, and agreed absence from competition, or any of these things, and there may be others which do not occur to me. In this wide sense, goodwill is inseparable from the business to which it adds value, and, in my opinion, exists where the business is carried on. Such business may be carried on in one place or country or in several, and if in several there may be several businesses, each having a goodwill of its own.”

81. Therefore, goodwill is generated by trade, or custom, and is capable of being owned. It is a type of property and passing off is a wrongful invasion of it. It is, therefore, an essential requirement that the opponent demonstrates that it has goodwill in the sign attached to the business. Goodwill is not the same as reputation. The difference between goodwill and reputation was explained by Professor Christopher Wadlow, in *The Law of Passing-Off: Unfair Competition by Misrepresentation*, 5th Edition:

“Goodwill as a form of legal property is also to be distinguished from mere reputation, which is primarily a matter of fact. In so far as reputation may be a legally protected interest, it is a non-proprietary one. It is true that the two are very closely related, and a business with goodwill (at least in the sense in which the term is used in passing-off) can hardly fail to have a reputation in some sense. The converse, however, is not true, and the existence of a reputation associated with a person, product, name or mark does not necessarily imply the existence of goodwill:

“[T]hat, as it seems to me, is to confuse goodwill, which cannot exist in a vacuum, with mere reputation which may, no doubt, and frequently does, exist without any supporting local business, but which does not by itself constitute a property which the law protects.” [Oliver LJ in *Anheuser-Busch v Budejovicky Budvar* [1984] FSR 413]”.

...

82. Reputation can exist without a supporting business, but goodwill can only exist via business or trade: in *Star Industrial Co Ltd v Yap Kwee Kor* [1976] FSR 256, at 269, Lord Diplock explained that “[g]oodwill, as the subject of proprietary rights, is incapable of subsisting by itself”, having “no independent existence apart from the business to which it is attached”. Dillon LJ observed in *Lonrho Plc v Fayed (no. 5)* [1993] 1 W.L.R. 1489 that goodwill “cannot mean some airy-fairy general reputation in the business or commercial community which is unrelated to the buying and selling or dealing with customers which is the essence of the business of any trading company.”

83. Bearing all this in mind, I find that the opponent had no goodwill at this date in relation to the claimed sign LANDY in respect of the goods identified in its notice of opposition: “vehicles, parts, fittings and accessories for vehicles.” The opponent has not used LANDY in any commercial capacity connected with the goods. Therefore, even though the applicant has stated that Landy commonly means old Land Rovers, i.e. is a nickname, the opponent cannot claim to own goodwill as it has not used the sign in connection with the goods. Landy has, at best, an ‘airy-fairy general

reputation'. The sum total of the opponent's evidence relating to LANDY can be summarised as follows:

- The article from the South African motoring website which is dated after the relevant date.
- The article from The Telegraph which is dated after the relevant date.
- The publication of children's books about an anthropomorphised vehicle called Landy.

84. This is nowhere near enough to establish the existence of goodwill as of 6 June 2017. I also note that the article in the Western Morning News says that the author of the children's books grew up in South Africa; in which case, she may be more familiar with Landy as a slang term, given the South African motoring website article. However, even without this possible point against it, and even if I were to take the view that the two post-relevant-date newspaper articles cast light backwards, only one of them is a UK publication. I also note the absence of any reference to LANDY, even as a nickname, in the articles referring to LAND ROVER in *Top Gear*, *Autotrader* and *Honest John*; the first of these, at least, might be classed as the sort of forum in which more informal or colloquial language would be used.

85. Furthermore, there is a question as to whether the 'Landy' books would entitle the opponent to claim goodwill, even in relation to children's books. This is because Landy appearing as it does in the book titles (e.g. Landy at the Factory) may not be distinctive of books. However, I do not need to decide this since the opponent does not rely upon LANDY in respect of books.

86. I have assessed the position at the date on which the contested application was filed. Both parties have filed website evidence which indicates that the applicant traded prior to that date; the applicant states that it began trading in 2009 (prior to the filing of the opponent's LANDY trade mark applications). The opponent submits that since its legal division became aware of the applicant's activities, it has taken steps to prevent registration and further use of the mark Bits4Landys, notwithstanding the applicant's evidence that another arm of the opponent, its classic

Land Rover workshop, has bought parts from the applicant. It is clear that the opponent had goodwill in a relevant business. The question is whether LANDY was distinctive of that goodwill. The meagre/non-existent evidence of any use of the word by the opponent itself combined with the applicant's pre-filing use of BITS4LANDYS and other slang uses of the term by third parties, such as *Top Gear*, was unlikely to have led consumers to believe that LANDY was a sign that distinguished only the opponent's goods. Indeed, to the extent that this use affected consumers' expectations, it was likely to have created the impression that LANDY was unlikely to be a sign used by, or with the consent, of the opponent itself. Therefore, the applicant's use would not have amounted to a misrepresentation at the relevant date.

87. The opponent clearly has a very substantial level of goodwill in relation to LAND ROVER, for the goods and services on which it relies under section 5(4)(a) of the Act. The opponent claims that use of the applicant's mark would result in a belief by the public that the goods or services offered by the applicant were supplied by or under licence from the opponent.

88. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt LJ 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].'"

89. In the same case, Morritt LJ stated:

"The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

90. I begin by reminding myself that the applicant's mark does not contain LAND ROVER. Although the opponent submits that it has “evidenced use of the trade mark LANDY”, the opponent has not provided any evidence that it has ever used LANDY (part of the applicant's mark) in relation to the goods relied upon in these proceedings. In its written submissions in lieu of a hearing, the opponent says that it has acquired unregistered rights in LANDY. It does not explain this submission, and there is no evidence to back it up (unless this is a reference to the children's books). The applicant has stated that Landy is a nickname for old and dilapidated classic Land Rover vehicles. The only possible connection between the opponent's sign and the applicant's mark is that the opponent's customers might know that Landy

means old classic Land Rovers and that parts for, and repair of, old classic Land Rover vehicles may be obtained from the applicant. If they do not know what Landy means, they will never see such a connection.

91. Assuming that a substantial section of the opponent's customers knows that Landy means old classic Land Rover vehicles, it seems to me that misrepresentation is unlikely. Firstly, the opponent's evidence is focussed upon the upmarket image of its vehicles. Secondly, this is a market in which very many independent traders are engaged in the supplying of parts for and the repair of third-party manufacturer vehicles. Confronted with 'Bits4' at the beginning of the applicant's mark, the opponent's customers will consider that 'bits' is a highly informal word for parts and not one which the opponent, given its image, is likely to use as a sign designating the trade origin of parts for its vehicles. Further, in this particular market, consumers are used to independent traders supplying non-original parts for third-party manufactured vehicles and referring to the vehicle marque as an indication of the intended purpose of the goods and services. In *Bayerische Motorenwerke AG and another v Deenik*⁶, the CJEU considered whether advertisements such as "Repairs and maintenance of BMWs" infringed a BMW trade mark. The court stated (at paragraph 64):

"In the light of the foregoing, the answer to be given to the fourth and fifth questions must be that Articles 5 to 7 of the directive do not entitle the proprietor of a trade mark to prohibit a third party from using the mark for the purpose of informing the public that he carries out the repair and maintenance of goods covered by that trade mark and put on the market under that mark by the proprietor or with his consent, or that he has specialised or is a specialist in the sale or the repair and maintenance of such goods, unless the mark is used in a way that may create the impression that there is a commercial connection between the other undertaking and the trade mark proprietor, and in particular that the reseller's business is affiliated to the trade mark proprietor's distribution network or that there is a special relationship between the two undertakings."

⁶ Case C-63/97, [1999] ETMR 339.

92. In this case, I find it unlikely that the mark, composed as it is of the highly informal 'Bits' and a nickname for old classic Land Rover vehicles, would cause the opponent's customers even to wonder if there might be a commercial connection between the parties. If they did, it would go no further than this. There would be no assumption of a commercial relationship. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, [2013] EWPC 18 (PCC), Mr Iain Purvis QC, as a Recorder of the Court stated:

"54. Mr Aikens stressed in his argument the difference between 'mere wondering' on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–17 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:

'This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former'."

93. The ground under section 5(4)(a) of the Act fails.

Section 3(6)

94. Section 3(6) of the Act states:

"(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

95. The law in relation to section 3(6) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of

the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the

relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

96. The applicant's counterstatement and evidence show that it clearly intends to use the mark for the purposes of fair competition. There is no evidence of bad faith. The mere fact that the opposition under section 5(2)(b) has succeeded is not enough to justify a bad faith finding in circumstances where the applicant could reasonably believe that the applied-for mark would not cause confusion, the opposition under s.5(2)(b) having succeeded on the basis of a notional comparison of the marks LANDY and Bits4Landys and the notional assumption, required under the law (as explained) that the opponent has, or will, use LANDY as a trade mark.

97. The section 3(6) ground of opposition fails.

Overall outcome

98. The opponent has been partially successful under 5(2)(b) ground of opposition, save in relation to *Design of tooling for the production of land vehicle parts*. The

other grounds of opposition have failed. The application will proceed to registration for *Design of tooling for the production of land vehicle parts* and is refused for all other goods and services.

Costs

99. The opponent has been mostly successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. The applicant conceded in its counterstatement that LAND ROVER is very well-known. Consequently, there was no need for the volume of evidence filed by the opponent in relation to LAND ROVER. There was hardly any evidence filed in relation to LANDY and, as can be seen from my findings, the opponent could not succeed under any of its claims to have used LANDY. I, therefore, make no award for the opponent's evidence-in-chief. I make a reduced award for its evidence-in-reply, which although short and of little assistance, was caused by the applicant's protests at the filing of the Wayback Machine prints. I also award only the minimum for the opponent's written submissions in lieu of a hearing (reduced further to take account of the applicant's partial success). These ran to 37 pages, including a full evidence summary and long lists of standard caselaw references of the sort found in the Registrar's decisions. This would have been unhelpful at a hearing; such submissions are meant to stand in place of what would have been said at a hearing. Only the section 5(2)(b) ground succeeded; I have assessed all the other grounds and they have all failed. The official fee for a section 5(2)(b) opposition is £100. It would, therefore, be unfair to expect the applicant to pay a £200 fee caused by the running of grounds other than 5(2)(b), which all failed. I award costs to the opponent as follows:

Official fee for the opposition	£100
Filing the opposition and considering the counterstatement	£200
Considering the applicant's evidence and filing evidence in reply	£200

Written submissions in lieu of a hearing £275

Total £775

100. I order Bits4Landys Ltd to pay to Jaguar Land Rover Limited the sum of **£775**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of February 2019

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

Annex: the opponent's registrations

The goods and services listed below are relied upon under section 5(2)(b); the underlined goods and services are also relied upon under section 5(3).

EU 13538475 LANDY

Class 12: *Vehicles; parts, components and accessories for the aforesaid goods.*

Class 35: *Business management and advisory services, all relating to the manufacture, sale, repair and maintenance of motor vehicles; retail services connected with apparatus for locomotion by land, air or water, motor vehicles, commercial vehicles, vehicle parts and fittings; advisory and consultancy relating to the aforesaid services.*

UK 3035561 LANDY

Class 12: *Vehicles; parts, components and accessories for the aforesaid goods.*

Class 35: *Business management and advisory services, all relating to the manufacture, sale, repair and maintenance of motor vehicles; retail services connected with apparatus for locomotion by land, air or water, motor vehicles, commercial vehicles, vehicle parts and fittings.*

EU 16134868 LANDY

Class 37: *Maintenance, repair, servicing, reconditioning, restoration, inspection, care, cleaning, painting and polishing of motor land vehicles, or of parts and fittings for all these goods; Assembly of accessories for vehicles (installation services); Automobile customization services; automotive upgrade services; information, consultancy and advice relating to any of the aforesaid services and for the supply of parts for motor land vehicles.*

Class 37: *Maintenance, repair, servicing, reconditioning, restoration, inspection, care, cleaning, painting and polishing of motor land vehicles, or of parts and fittings for all these goods; Assembly of accessories for vehicles (installation services); Automobile customization services; automotive upgrade services; information, consultancy and advice relating to any of the aforesaid services and for the supply of parts for motor land vehicles.*

EU 16493521 LAND ROVER

Class 12: *Vehicles; parts and fittings for all the aforesaid goods.*

Class 35: *Business consultancy services and business management advisory services, relating to the manufacture, provision, distribution, sale, maintenance, restoration and repair of motor vehicles, export and import of vehicles, their parts and fittings; distributorship services and retail store services relating to motor land vehicles and parts, fittings and accessories for motor land vehicles; retail store services in the field of automobiles, automobile parts, fittings and accessories.*

Class 41: *Instruction and training services in the fields of automotive sales, maintenance and repair; education and training in the field of automotive engineering.*

UK 3181948 LAND ROVER

Class 12: *Motor land vehicles; parts and fittings for vehicles.*

UK 1378096 LAND ROVER

Class 35: Business management and advisory services; all relating to the manufacture, sale, repair and maintenance of motor vehicles; advertising; market research; business advisory services relating to franchising for the establishment and maintenance of motor dealership and vehicle spare part enterprises.

Class 37: Repair and maintenance services all relating to motor vehicles, parts, fittings and accessories.