

O/633/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS

3236024, 3236025 AND 3236028

BY JAGUAR LANDROVER LIMITED

AND

OPPOSITIONS THERETO UNDER NO.S

411046, 411048 AND 411049

BY INEOS INDUSTRIES HOLDINGS LIMITED

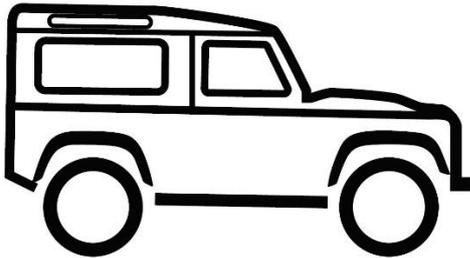
BACKGROUND

1. On 7 June 2017 Jaguar Landrover Limited (JLR) applied to register the following three trade marks:

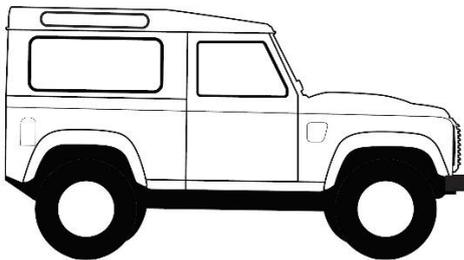
3236024



3236025



3236028



2. All three trade marks were applied for in respect of a range of goods in classes 6, 9, 14, and 25. 3236024 and 3236025 were also applied for in classes 18 and 21, while 3236028 includes goods in class 16. The full list of goods in each class is shown at Annex A. These goods can be broadly categorised as small metal goods which are, or could be parts and accessories for vehicles in class 6; electrical goods which are,

or could be, accessories for vehicles in class 9; jewellery, watches and badges in class 14; luggage, bags, wallets and a number of other items in class 18; household items, including mugs, coasters and car cleaning cloths in class 21, as well as clothing, footwear and headgear in class 25. 3236028 also includes a range of printed matter and stationery items in class 16. The specifications are lengthy, I will consider them in more detail as necessary throughout this decision.

3. Oppositions were filed against all three applications by Ineos Industries Holdings Limited (Ineos) on 15 December 2017. At the outset, the opponent relied on grounds under sections 3(1)(b), 3(1)(c), 3(1)(d), 3(3)(a) and 3(6) of the Act. The ground under section 3(3)(a) was struck out by a letter from the Tribunal dated 1 May 2018¹ and the grounds which remain are as follows:

Under ss.3(1)(b) and (c) of the Act because the marks are descriptive of the goods/services or otherwise devoid of any distinctive character;

Under s.3(1)(d) of the Act because the marks consist of signs that have become customary in the bona fide and established practice of the trade in the goods/services at issue;

Under s.3(6) of the Act because the applications were filed in bad faith as (a) JLR had no intention to use the marks for all of the goods for which registration is sought and/or (b) the marks are designs which should be in the public domain.

4. JLR filed counterstatements defending its applications and denying all grounds relied upon by the opponent in respect of all three applications. The applicant submits, in respect of the oppositions under section 3(6) of the Act:

“The Applicant’s position is that the application[s] in suit were applied for in good faith and the Applicant is entitled to registration of the mark[s] as a trade mark...”.

¹ No hearing was requested by the opponent following that letter.

5. Both parties filed evidence and skeleton arguments. A hearing subsequently took place by video conference at which the applicant was represented by Ms Linsey Lane of Counsel, instructed by Mills & Reeve LLP. The opponent was represented by Mr Michael Bloch QC, instructed by Potter Clarkson LLP.

The opponent's evidence

Witness statement by John Peacock and exhibits JBP1-JBP4

6. Mr Peacock is a partner at the opponent's representative. His statement is dated 23 April 2018. He submits:

"3.9...that the Applications do not serve to identify the goods in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods claimed from those of other undertakings for a number of reasons:

(A) numerous examples of similar merchandise that is manufactured and sold by third parties, unconnected with the Applicant, and bear identical or similar signs or logos to the Applications at the time of filing can be adduced, of which some are given at Exhibit JBP1 and Exhibit JBP4 filed with this Statement;

(B) the Applications do not substantially differ in form and shape from depictions of other similar vehicles which are used in connection with the same or similar goods to those for which registration is sought by the Applications - this is illustrated by comparing the Applications with line drawings depicting various similar vehicles in the same style as the Applications, which were prepared by Frazer-Nash Consultancy Limited and I have been provided with, as shown in Exhibit JBP2 filed with this Statement; and

(C) the Applications, when used by the Applicant on classes of goods for which registration is sought, are used in conjunction with other "Land

Rover", "Defender" or similar branding, and it is submitted that it is this branding (not the Applications) which serves to designate the undertaking of origin of the goods - see the examples set out in Exhibit JBP3 filed with this Statement."

7. I have not summarised the evidence referred to at point B of Mr Peacock's statement since it appears to have been prepared for these proceedings and consists of line drawings of other vehicles and not the trade marks at issue; nor do the line drawings appear to be in use. They show nothing more than the fact that it is possible to create line drawings of numerous vehicles, a fact which I accept but it is not relevant to the matter to be decided.

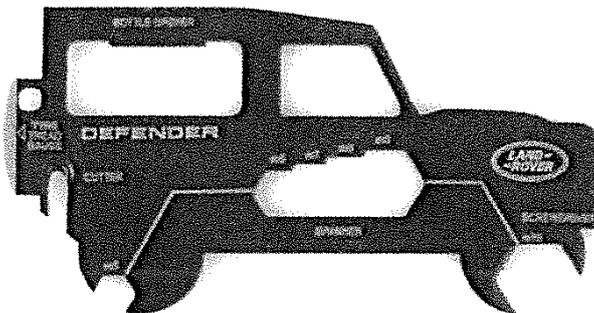
8. Mr Peacock also provides undated examples of goods which have, on their surface, images of 4x4 vehicles and have been made available on Amazon UK,² for example:



² See exhibit JBP5.



9. Mr Peacock further provides examples of the applicant's merchandise which he submits is used in conjunction with "other 'Land Rover', Defender' or similar branding which serves to designate the undertaking of origin of the goods."³ For example:



³ See exhibit JBP3.

The applicant's evidence

Witness statement of Amanda Jane Beaton and exhibits AJB1-AJB18

10. Ms Beaton is the applicant's Global Intellectual Property Counsel, a position she has held since 8 May 2012. Her statement is dated 25 June 2018. Ms Beaton provides the following history of the Land Rover Defender:

"7. The shape of the Defender vehicle has been developed over the closely-related Land Rover Series I, Series II, and Series III models, to the present day Defender. In 1983, production of the Land Rover 110 began ("110" denotes the vehicle's 110-inch wheelbase). The Land Rover 90 (with a 90 inch wheelbase) followed shortly after. The vehicle was rebranded as the Land Rover Defender in 1990 and has been sold as the Defender ever since. Its shape has, in essence, remained unchanged since 1983. In 2015, the two millionth Defender came off the production line, which was accompanied by significant interest and publicity in the UK and overseas."

11. With regard to the shape of the Land Rover Defender Ms Beaton submits:

"8. It appears from press coverage and consumer advertisements in the second hand market (and as supported by Land Rover advertisements themselves), that since the Land Rover was launched, the relevant consumer has been able to identify the origin of the vehicles by sight of their shape, including at a distance when no other badges, marks or logos can be seen. The vehicle conveyed a message to the public, enabling them to identify the vehicles as those of Land Rover. The shape performed, and still performs, the function of indicating origin, without the need for any supporting indicia. As a result, the shape has been used by JLR in its advertisements, brochures, merchandise and other products. There is extensive independent commentary as to the inherent distinctiveness of the overall shape of the Defender."

12. Ms Beaton provides examples of 'independent commentary as to the inherent distinctiveness of the overall shape of the defender':⁴

An article from *The Mirror* newspaper by Quentin Wilson, dated 13 October 2013, includes the following:

"Over the years the Defender has crossed deserts and the Arctic, climbed mountains, forded rivers, cleared mines, been dropped by parachute, seen action in virtually every warzone in the world, starred in a Bond movie and is one of the Queen's favourite cars. In Third World countries it's sometimes the only vehicle people have ever seen and remains the most recognised automotive silhouette on the planet."

13. An article from *Auto Express* by Graham Hope, dated 25 June 2015, includes the following:⁵

"The original Mini apart, there's arguably no other British car that is as instantly recognisable and has made such a huge impact globally'."

14. An article from *The Telegraph* by Ben Fogle, dated 29 January 2016, is titled "Land Rover Defender: My life-long love affair with a British icon."⁶ It includes the following:

"Part of the appeal, no doubt, is how the Defender is at odds with the rapidly changing world in which we live. As cars become rounder, curvier, shinier and more aerodynamic, the boxy, angular Defender looks ever more like a child's drawing of a car ... indeed it has changed little from the original Series 1, 67 years ago.

It is said that for more than half the world's population, the first car they remember having seen is a Land Rover Defender, so recognisable is it, from every angle (bonnet, tailgate, even the gear stick is distinctive).

⁴ See exhibit AJB1.

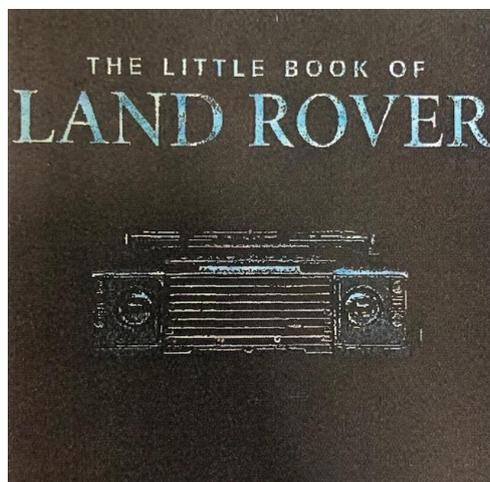
⁵ See exhibit AJB2.

⁶ See exhibit AJB3.

... this utilitarian vehicle has become part of the fabric of what it is to be British, as quintessentially British as fish and chips or bulldogs. No wonder the Queen is partial to it.

...more than 66 per cent of indefatigable Defenders ever produced are still on the roads; which hopefully will ensure they will be around, in one form or another, for at least another seven decades."

15. Two further examples are provided,⁷ the first is "THE LITTLE BOOK OF LAND ROVER" which has the following front cover:



16. The introduction reads:

"This is the story of Land Rover, a British institution, one that in its predominantly dark green livery is nearly as recognisable as the scarlet post boxes, or London buses, or the old dark blue policeman's helmet. It was a victory of content over style, a triumph of functionality that over the years was paradoxically to become an icon of style."

17. The second is an article from the Gov.UK website. It is titled, "Land Rover Defender: Unbeatable British IP." The article was written by Dan Anthony and is dated 25 January 2016. The first paragraph reads:

⁷ See exhibit AJB4.

“At the end of this month, after 67 years continuous production, the last Land Rover Defender will roll off the production line at Solihull. As work on the next generation of Defender continues, its time to celebrate a classic.”

18. Ms Beaton submits the following with regard to the shape of the applicant’s ‘Defender’ vehicle:

“14. For decades Land Rover has taken steps to educate the public that the shape of the Land Rover Defender indicates the origin of the vehicle. It has done this through various marketing and advertising campaigns devised in collaboration with its advertising agencies. The advertisements mentioned were put into circulation in the UK. I set out several examples below; they are attached in order of reference at Exhibit AJB5 -AJB10.

14.1. Land Rover launched an advertisement in July 2005 featuring a ‘Bat-signal’ type of sign (from the Batman comic and films), but instead of the Batman logo, there is the outline of the Defender (Exhibit AJB5). The message conveyed by this advertisement is that the Defender, instantly identified from its outline alone, is a ‘hero car’ that will come to your rescue in times of trouble, as Batman would upon seeing the Bat-signal.”



19. Ms Beaton submits that this advertisement was featured in The Daily Telegraph; The Independent; The Times; The Observer; The Belfast Telegraph; Scotland on

Sunday; The Sunday Telegraph; The Sunday Times; and the Radio Times. The overall media spend in relation to this newspaper advertisement was in excess of £100,000.

20. An advertisement from 2007 is described as follows:

“14.2 In July 2007, Land Rover circulated an advertisement for the new 2007 model year Defender. The advertisement shows the side profile of the vehicle pulling the edge of the paper on which it is printed. There is no badging visible on the vehicle and the advertisement uses the shape of the car to indicate that it is a Land Rover Defender.”⁸

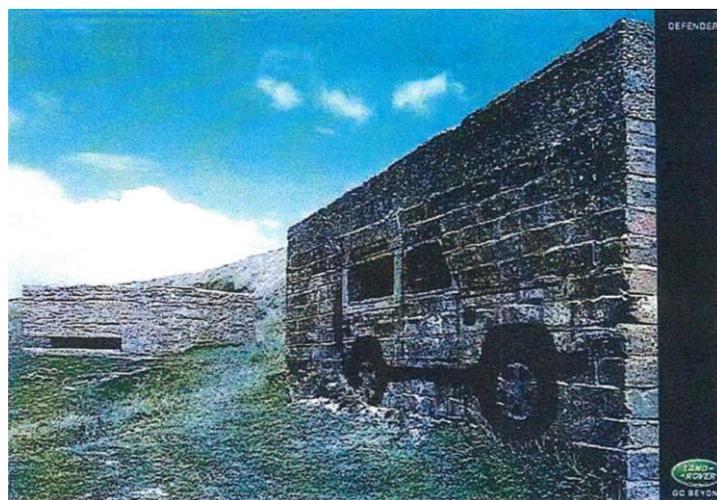
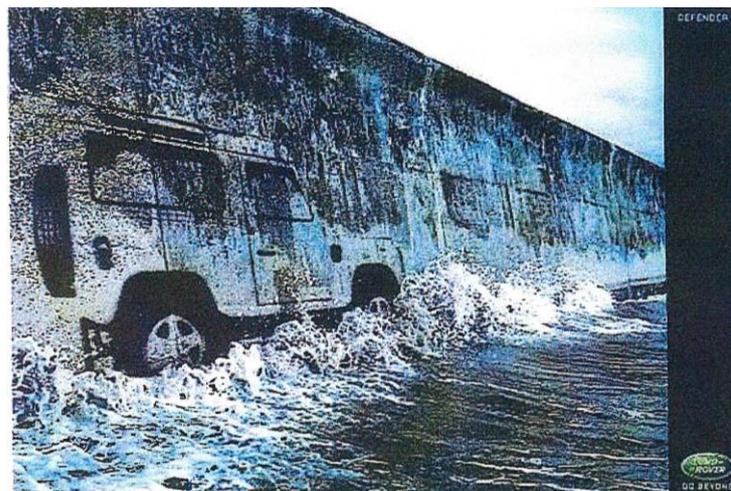


21. Ms Beaton states that this advertisement was circulated nationwide in printed publications.

⁸ See exhibit AJB6.

22. The next series of advertisements are described by Ms Beaton in the following terms:

“14.3 Between 2007 and 2008, Land Rover ran a series of advertisements featuring spray-painted, graffiti-style images of the side profile of the Defender on a sea wall, a bunker wall, and on a garage wall. In all of these images, the sole focus is on the outline of the car, which is sufficiently distinctive on its own to communicate that it is a Land Rover Defender.”⁹

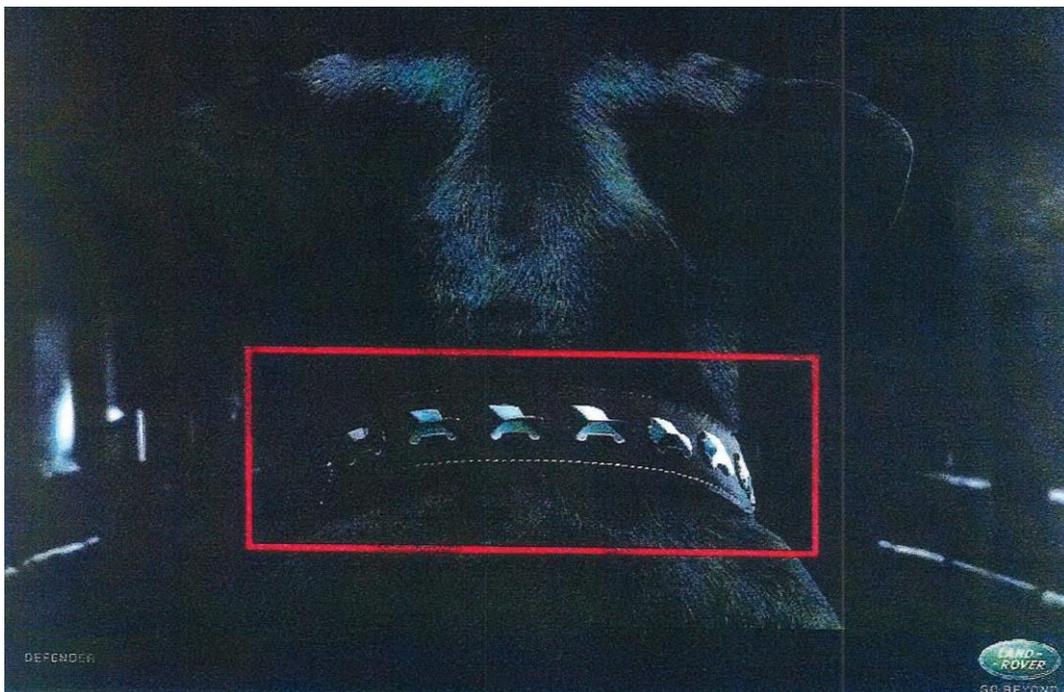


⁹ See exhibit AJB7.



23. Ms Beaton submits:

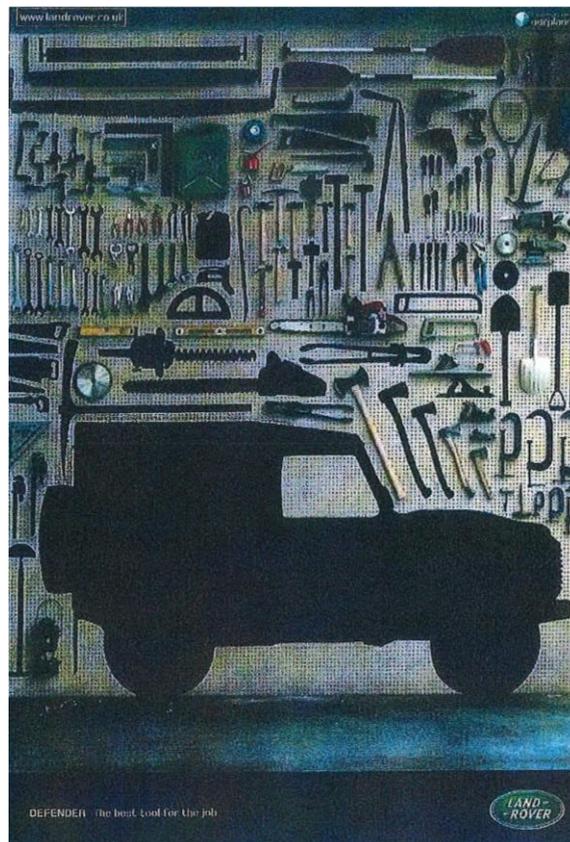
“14.4 In March 2008, Land Rover issued an advertisement depicting the back of a dog wearing a collar studded with silver badges in the shape of the Defender. This advertisement featured in magazines and newspapers. Overall the advertisement is very- dark, with the light reflecting from the studs to highlight their shape only. This shows that the vehicle's shape is operating as a badge of origin.”¹⁰



¹⁰ See exhibit AJB8.

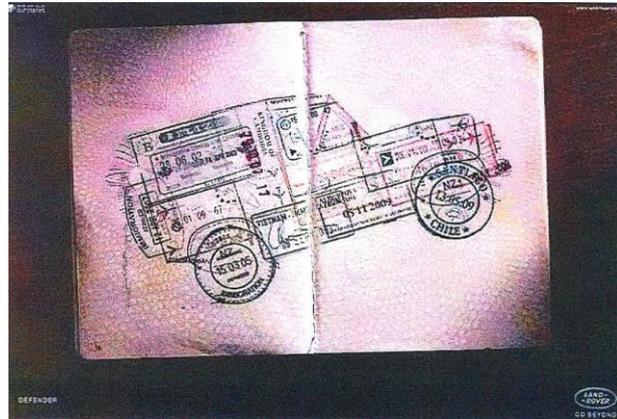
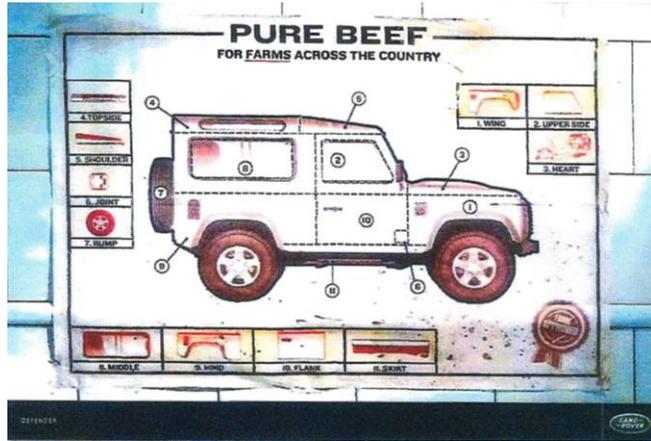
“14.5 In November 2010, Land Rover launched a marketing campaign entitled "DEFENDER The best tool for the job" (Exhibit AJB9). It featured a blacked-out side profile of a Defender on a workshop pegboard, surrounded by various other workshop tools also pinned to the board.

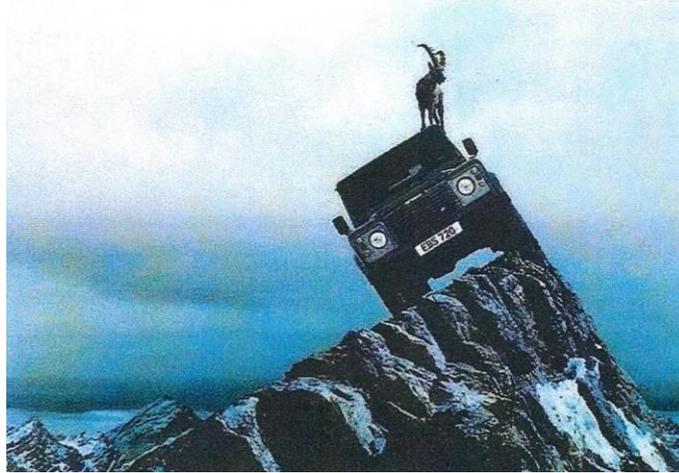
The advertisement was featured on outdoor advertising media, including billboards, posters and transport, and also in printed publications. Again the outline shape of the vehicle is the focus of the advert. This advertisement would have featured in weekly magazines including: the Veterinary Times; the Farmers Guardian; the Farmers Weekly; and Horticulture Week, and also in monthly magazines including: The Landscaper; Architecture Today; CLA Land & Business; Thoroughbred; British Farmer & Grower; NFU Countryside; and Scottish Farming Leader. In 2009/10, these publications had a combined circulation audience of approximately 350,000 readers per annum.”



24. Exhibit AJB10 to Ms Beaton’s statement includes a further selection of the opponent’s advertisements:

DEFENDER





25. Ms Beaton concludes:

“15. The dominant element of these advertisements is the shape of the vehicle which is being used to denote the origin of the vehicle. Very often, the advertisements do not incorporate a strapline. It is clear that the shape is so evocative that little else by way of words is required, as the shape speaks for itself. The striking nature of the vehicle and the simple composition of the images means that the focus of the advertisements is on the shape of the Defender. If JLR did not consider that the Land Rover brand could be identified from the shape of the Defender alone, it would not have invested in advertisements that focus so heavily on the Defender shape alone. It would defeat the purpose of the advertising.”

26. Ms Beaton submits that JLR's media investment for the Defender in the UK across magazines was in excess of £100,000 in 2005; in excess of £50,000 in 2009; and in excess of £100,000 in 2010. She further submits that she is informed that in excess of £100,000 was spent across magazines and online channels in 2007.

27. With regard to the sale of vehicles Ms Beaton submits that between 1989 and 2017, JLR has sold in excess of 600,000 Land Rover Defender vehicles. She also says that in addition to the sale of new vehicles, there is a thriving second hand market for Defenders:

“Between 2012 and September 2017, the total market retail transactions for second hand Defender vehicles of any age in the UK is 121,266. This data is recorded by MIS, a Management Information System, which covers all changes of ownership as recorded by the DVLA.”

28. Ms Beaton concludes that the trade mark applications look ‘quite different’ from most of the images of third party vehicles relied upon by the opponent:¹¹

“26. Moreover, I believe that the public will regard them as a badge of origin since they portray the essence or DNA of the vehicle without being an exact representation of the vehicle. The marks are not mere pictures of a ‘typical’ or ‘ordinary’ car. They are the type of stylised images that the public would understand to be a brand and expect to see in ‘branding positions’ on clothing and other goods and their packaging.”

Merchandise

29. Ms Beaton submits the following:

“30. Since JLR launched its first Land Rover Collection it has gone from strength to strength. JLR retails its official merchandise via its UK retailer network (authorised dealerships) who can order merchandise from JLR through the parts ordering system; on the official online Land Rover shop at www.shop.landrover.com; in its UK stores (at the Whitley and Gayden sites); and at various UK events, including: the Goodwood Festival of Speed; Goodwood Revival; Burghley Horse Trials; Donington Park; Classic Motor Show; Silverstone; and Brands Hatch. In the period from 1 May 2017 to 18 June 2018, the online Land Rover shop had over 1.3 million hits.

31. JLR also markets its merchandise via product brochures which are sent to authorised retailers and distributed at various events. Over 8,000 retailer

¹¹ Ms Beaton points out that a number of the examples provided by the opponent relate to the US. Only evidence relating to the UK has been included in this summary of relevant evidence.

brochures were produced for the 2017 collection and approximately 3,500 were produced for the 2018 collection. We have also printed approximately 27,000 'mini-brochures' for the 2018 collection.

32. The shape of the Defender has featured prominently across JLR's official merchandise since 2004, frequently in front or side view. Set out below is a summary of the way in which JLR has used the image of the Defender on a range of merchandising products over the past 14 years, not simply as mere decoration, but as an indication that the products emanate from JLR or one of its licensees. Further examples are shown in Exhibit AJB12.”

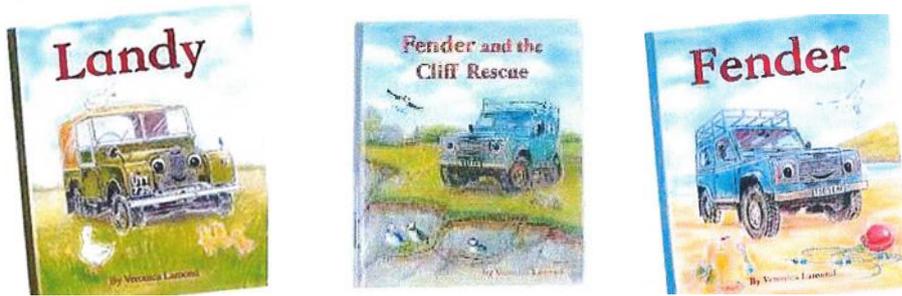
30. We have also sold merchandise in the 3D shape of the Defender as part of our branded goods collections since 2004 when the business began to focus on Defender merchandise, long before the filing date of the applications. We have used the 3D shape of the Defender prominently across our merchandise collections ever since, for toys; die-cast models; children's ride-on cars; decorative models; keyrings; and USBs.

31. Sales of such merchandise for over a decade, together with the vehicle advertising and sales, mean that the shape of the vehicle has become well-recognised for such products and the public instantly identifies the vehicle shape as a Defender.

30. A sticker book from 2018:



31. Children's books by Veronica Lamond (under licence) dated 2017 and 2018:



32. T-shirts from 2018:



33. Land Rover Defender boys & girls long sleeved t-shirt (undated):



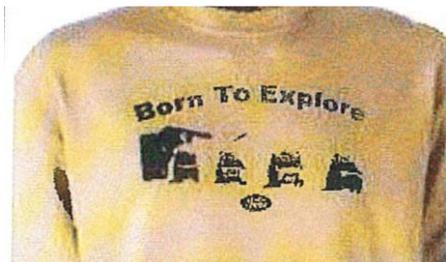
34. Heritage Overland t-shirt (2016):



35. T-shirts from 2009 titled, 'Passion', 'Art' and 'So many roads':



36. T-shirts from 2005/06 described as, 'Born to explore', 'Land Rover Expeditions' and a child's 'Defender' t-shirt:



37. A round 'logo' which appears on a number of items of clothing shown in the opponent's evidence, from approximately 2005:



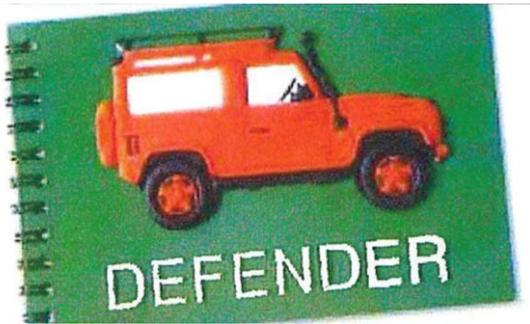
38. Land Rover Overland Heritage magnet calendar (2017):



39. Land Rover Overland Heritage enamel mug set (2016,2017):



40. Defender notebook (undated):



41. Ms Beaton refers to JLR's 'Year of Celebration' of the Defender which began in January 2015 and ended with the end of mass production of the Defender on 29 January 2016. Ms Beaton describes a collectors' edition press pack, as follows:

“33.2 To announce the year of celebration, JLR produced a collectors' edition Defender Press Pack called "The Story Of The Original Land Rover" for members of the press and media industry. The pack contained a number of books and inserts as well as six, flat-pack, cut-out Defenders from different eras which were designed to be folded and glued into 30 cardboard vehicles, which the Defender's boxy shape lent itself to perfectly. Approximately 1,500 press packs were distributed to all JLR's markets for use with their media. Packs were also handed out at media events throughout the year. Images of the press pack are attached at Exhibit AJB13.”



42. Images of defenders appeared on children's ruck sacks, lunch boxes and clothing (none appears to be the relevant trade mark(s)).

43. Ms Beaton submits that although the applicant ceased mass production of the Land Rover Defender in January 2016 this does not mean that there will not be future production of some kind. A Limited edition V8 model has been announced and in 2015 25 original series 1 Land Rovers were sourced for the Land Rover Reborn programme which restores heritage vehicles back to their original model specification using original parts and techniques.

“48. JLR's Defender Works V8 and Land Rover Reborn programmes are intended to meet continuing consumer demand for the Land Rover Defender, post-production, by selling a limited number of special edition models. The development of this business plan was conceived long-before the filing dates of the applications, and there has *never* been any intention to modify the shape of the vehicle in respect of any projects undertaken by Classic Works, since it is so integral to the Land Rover brand.”

44. Exhibit AJB14 includes copies of products bearing image of the Defender developed for launch in Sept/Oct 2018, while AJB18 includes extracts from the Land Rover Collections brochures for 2016 and 2017, 'referencing Defender-related products'. Ms Beaton concludes:

“49.4. Thus I can confirm that JLR had been using and intended to use the image of the Defender on merchandise products as at the date of filing. Indeed, for the business not to continue to use marks which portray the iconic Land Rover Defender shape which is part of JLR's illustrious heritage, and which have also acquired distinctiveness through sales and marketing of Defender merchandise prior to the filing date, would be absurd. The Applications were being considered from at least early 2016. Making the decision to seek trade mark protection for these images was a logical commercial next-step to protect these valuable business assets.

49.5. I can also confirm that JLR has been considering using the marks as badges of origin of the goods since at least early 2016, as demonstrated by the use made in the 2016, 2017 and 2018 merchandise, as well as upcoming collections and licensee collaborations.

49.6. As can be seen from the limited edition V8 Defender programme and the Land Rover Reborn programmes, the public's affection for the much-loved Defender is unwavering and demand for the vehicle continues. Land Rover's loyal consumers also continue to demand official Defender merchandise. Therefore, JLR's Branded Goods team will continue to use the vehicle's distinctive shape across future collections to meet such demand, and as a means of identifying the Land Rover brand.”

The opponent’s evidence in reply

Second witness statement by John Peacock and exhibits JBP5-JBP9

45. Mr Peacock’s second witness statement is dated 23 August 2018. As was the case with his first statement, it contains a number of submissions which I will not summarise here but will refer to as necessary throughout the remainder of this decision. The pertinent parts are as follows:

“3.9. Ms Beaton concludes her summary of the adverts in paragraph 15 of the Beaton Statement by saying "If JLR did not consider that the Land Rover brand could be identified from the shape of the Defender alone, it would not have invested in advertisements that focus so heavily on the Defender shape alone. It would defeat the purpose of the advertising" but it is submitted that there is an obvious reason why pictures of the Defender vehicle (and therefore the shape) appear in the adverts alongside suitable branding. It is because the adverts are trying to encourage consumers to purchase the vehicle which is shown in them. The adverts simply set out a depiction of the goods for sale and the associated logos and trade marks indicate the origin of those goods. This is the customary way of advertising goods for sale and, consequently, as can be seen at Exhibit JBP6, such

advertising is commonplace in the car industry. As noted above though, these goods are not even those for which registration is sought by any of the Applications.

3.10...It is submitted that the figures provided in the Beaton Statement are patchy with approximate figures only being given (and even then sometimes only in respect of specific advertising campaigns), arbitrarily, for the years 2005, 2007, 2009 and 2010 which are at most listed as being in "excess of £100,000". There is no information on advertising spend for the 5 years prior to the filing of the Applications. It seems reasonable to infer that the years selected by JLR represent the high water mark as far as advertising spend was concerned, supported by the fact that the adverts provided in the Beaton Statement are also concentrated in the years 2005 - 2010. As a result, it seems that attempts to promote the Defender itself were waning considerably by 2017 when the Applications were filed, which of course is unsurprising in the context of the vehicle ceasing to be produced.

3.11. In any event, the amounts quoted while not negligible, are very small for a company of the Applicant's size. As an article exhibited as Exhibit JBP7 points out, JLR itself has estimated total investment/spending in the UK at £50 billion over the last 5 years with plans for a further £80 billion forecast for the next 5 years and, by way of example, publicity spend (according to JLR's audited accounts - the relevant page of which is contained in Exhibit JBP8) for the financial year ending in 31 March 2010 was £328.6 million. To further put the figures in context, it is worth noting that in the London Taxi Company case, LTI's expenditure ranged from £477,000 to £600,000 between 2003 and 2007 (a similar time period to those years in which the Applicant has provided information) which as Arnold J noted at paragraph 184 in the High Court in London Taxi Company (London Taxi Company v Frazer-Nash Research Ltd [2016] EWHC 52 (Ch)) did not amount to particularly large sums. However, it is still considerably more than the "in excess of £100,000" claimed to be spent by the Applicant on advertising its Defender vehicle (assuming, which - in the absence of

any evidence to substantiate JLR's claims - is not admitted, that the figures Ms Beaton refers to are correct). Although the London Taxi Company case was about the promotion of the 3D shape of the vehicle, given the focus on promotion of the vehicle shape (rather than the Applications) in the Beaton Statement, it highlights (given that taxis will not be marketed as comprehensively as consumer vehicles) how little JLR have spent on promotion of any shape that is linked to the Defender. Moreover, there is no evidence of spend incurred in promoting the signs which are the subject of the Applications.”

Preliminary issues

46. Ms Beaton relies on the fact that the contested trade marks were accepted by the Registry’s examiner at first instance and concludes that this means they do not fall foul of section 3 grounds. Following Ms Beaton’s submission to its logical conclusion, all trade marks which have passed the examination stage and been advertised for opposition could not be successfully opposed under section 3 on absolute grounds. This is clearly not the case. These opposition proceedings are not part of the examination process, rather they are cases brought under section 38 of the Trade Marks Act 1994 by an opponent before this tribunal. They will be decided on the basis of the pleaded case and any relevant evidence and submissions, in accordance with the appropriate legislation and case law.

The decision

47. I will deal first with the grounds under section 3(1) of the Act. The relevant legislation is as follows:

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

(a) signs which do not satisfy the requirements of section 1(1),

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

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

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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

48. It must be borne in mind that these grounds are independent and serve differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(d) and/or 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*¹², the Court of Justice of the European Union ('CJEU'), stated that:¹³

“25. ...it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

¹² Case C-329/02 P

¹³ Article 7(1) of the Regulation being equivalent to section 3(1) of the Act.

The relevant public

49. The distinctive character of the trade mark applied for must be assessed, first, by reference to the goods the subject of the opposition and, secondly, by reference to the perception of those goods by the relevant public.

50. The relevant public is defined in *Matratzen Concord AG v Hukla Germany SA* – C-421/04 (CJEU):

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

51. JLR submits that the average consumer for the majority of the goods in question is the general public. These goods are not particularly high value or specialist and the level of attention paid is average. It identifies the following goods which would, ‘be expected to be aimed at an average consumer with some level of expertise and/or the average consumer would pay a higher level of attention’:

- (i) In class 6: parts and fittings for vehicles, namely containers, clips, flanges, grilles, hinges, nozzles, rivets, sealing caps, trim parts of metal, interior trim parts of metal
- (ii) The majority of goods in class 9.
- (iii) The majority of goods in class 14.

52. The relevant public for the opposed goods in classes 14, 16, 18, 21 and 25 is the general public. The relevant public for the goods in classes 6 and 9 may also include,

in addition to the general public, professional purchasers of goods, for example 'flexible tube and hose assemblies of metal' (in class 6) and 'electric wiring harnesses' (in class 9), which are more likely to be purchased by the fitters or installers of such goods, rather than by members of the general public.

The oppositions under sections 3(1)(b) and 3(1)(c)

53. The parties' primary focus in submissions and at the hearing has been the section 3(1)(b) ground. However, there is clearly some overlap with 3(1)(c) in the arguments put forward and I find it convenient to deal with these two grounds of opposition together. The provisions prevent, respectively, registration of trade marks which are "...devoid of any distinctive character" or "...consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services".

54. Even if a mark falls foul of these grounds, there is a proviso to section 3(1) which means that a registration shall not be refused if the trade mark has acquired a distinctive character through use prior to the date of the application for registration. This is something relied upon by the applicant if I were to consider that the mark is not, *prima facie*, acceptable.

55. The date at which the applicant's trade marks must be assessed is the date of the application for registration, that is, 7 June 2017. I must first make an assessment on the basis of the trade marks' inherent characteristics, and, if I find the trade marks are open to objection on that basis, I must then determine whether the trade marks have, in fact, acquired a distinctive character as a result of the use made of them, prior to 7 June 2017.

56. The principles to be applied under Article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union in Case C-265/09 P *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* [2010] ECR I-8265 as follows:

“29. ... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v. OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v. OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v. OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v. OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v. OHIM*, paragraph 25; *Henkel v. OHIM*, paragraph 35; and *Eurohypo v. OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v.* [2004] ECR I-10107, paragraph 78; *Storck v. OHIM*, paragraph 26; and *Audi v. OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different *OHIM* categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories. It could

therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P and C-474/01 P *Procter & Gamble v. OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v. Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v. OHIM*, paragraphs 36 and 38; and *Audi v. OHIM*, paragraph 37).

34. In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties which it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (see *OHIM v. Erpo Möbelwerk*, paragraph 36, and *Audi v. OHIM*, paragraph 38).

...

37. ... it should be pointed out that, even though it is apparent from the case-law cited that the Court has recognised that there are certain categories of signs which are less likely *prima facie* to have distinctive character initially, the Court, nevertheless, has not exempted the trade mark authorities from having to carry out an examination of their distinctive character based on the facts.

...

45. As is clear from the case-law of the Court, the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are not registered (see, to that effect, *Libertel*, paragraph 59, and *OHIM v. Erpo Möbelwerk*, paragraph 45).”

57. Section 3(1)(c), is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the case-law of which was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24)...

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, *inter alia*, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration

as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkuniei*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I - 2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

and

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that

it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic'

highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

Analysis and prima facie findings

58. The opponent describes the applicant’s marks in the following terms in its skeleton argument:

“2. The signs at issue comprise a 2D image of the front of a vehicle and two 2D images of the side of a vehicle (“the Signs”). They are drawn without shading in a naive or schematic style. They are the sort of drawings which could be used to illustrate a children’s story, express a design, decorate an article of clothing, a mug or a mousemat, or serve as an icon or emoji for vehicles, matters relating to vehicles or matters relating to vehicles of a particular type.”

59. In addition to the case law already referred to, the opponent relies on paragraph 50 of *Mag Instrument Inc. v Office for Harmonisation in the Internal Market* in which the CJEU stated in relation to inherent distinctiveness:¹⁴

"... in order to contribute to the assessment of the distinctiveness of a mark for the purposes of Article 7(1)(b) of Regulation No 40/94, that evidence must show that consumers did not need to become accustomed to the mark through the use made of it, but that it immediately enabled them to distinguish the goods or services bearing the mark from the goods or services of competing undertakings. As the Office rightly argues, Article 7(3) of Regulation No 40/94 would be redundant if a mark fell to be registered in accordance with Article 7(1)(b) by reason of its having become distinctive in consequence of the use made of it."

60. With regard to the number of goods contained within the applications, the opponent submits:

"9. The goods comprise 396 (for Sign 024 and Sign 025) and 453 (for Sign 028) separate types of goods across 6 of the Nice Classification classes (classes 6, 9, 14, 18, 21 and 25 for Sign 024 and Sign 025 and classes 6, 9, 14, 16, 25 and 28 for Sign 028) in relation to which no use of the Signs has ever been made. Many of those 396 and 453 types of goods are broad classes or lists of goods themselves."

61. In the skeleton argument served on behalf of Ineos, Mr Bloch broke down the objections under ss.3(1)(b) and (c) of the Act as they applied to the goods covered by the contested applications into three categories. These are, Category 1 - Goods which are specifically related to vehicles, Category 2 - Goods which may relate to things which include vehicles and Category 3 – Goods which have nothing to do with vehicles.

¹⁴ Case C-136/02

62. Given the size of the specifications at issue in these cases, the breakdown provided by Mr Bloch amounts to 54 pages, which I do not intend to reproduce in the body of this decision but attach at Annex B.

63. There are inconsistencies in these categorisations. For example, it is not clear to me why 'computer software and computer hardware' fall in category 2 (goods which relate to things which include vehicles) because they cover hardware and software which could be for vehicles, whilst 'cameras' are placed in category 3 (goods which have nothing to do with vehicles) when this term is wide enough to cover 'onboard cameras' in category 2 (goods which relate to things which include vehicles). I will therefore return to the scope of the objections under ss.3(1)(b) and (c) later.

64. The opponent's pleading is that the signs applied for lack inherent distinctive character in relation to vehicle related goods because, "...an image of a member of a class of goods may be used by those trading in such goods to indicate the nature of the goods in which they trade and the services which they offer to provide in relation to them." It provides the example that an image of a bicycle may be used by a bicycle shop to indicate that it sells and services bicycles and ancillary goods such as bicycle cameras and GPS systems.

65. With regard to goods which are not confined to vehicle related goods, the opponent submits that the applications may possess inherent distinctive character providing that the use of the signs for those goods or on those goods would not be seen as decorative. The opponent submits:

"18...For these purposes, a use is decorative if it is used in an aesthetic sense, to improve the way the goods or services appear to the customer, or serve to demonstrate that the customer is associated with a particular product or lifestyle, as opposed to use intended to show the origin of the goods or services."

66. By way of example the opponent refers to mugs, which are commonly decorated with quotations or football club badges and concludes that such goods are 'also bought by consumers who like to be associated with the type of product and lifestyle

represented by the vehicle.’ It also draws my attention to GPS systems, which its submits are commonly used in vehicles and may include use of the applied for marks in a decorative sense where, for example, an icon of a 4x4 vehicle is shown moving on the GPS map. The opponent also submits that ‘forgings’ and ‘cast parts’ can include many parts made for cars.

67. The applicant submits that the marks are inherently distinctive as they are, “...*emblematic and stylised, such that they would be seen as a badge of origin. They use bold, heavy lines (particularly in the case of the first two), are highly simplified and not decorative in nature.*”¹⁵

68. In its skeleton argument and at the hearing, the JLR submitted that these applications are not simply pictures of any vehicle, but emphasise the distinctive features of the Defender, in particular:

- (i) The highly recognisable silhouette.
- (ii) The boxy, angular lines.
- (iii) The clamshell bonnet.
- (iv) The positioning of the front grill and lights (on Application No. 3236024).
- (v) The Alpine side windows (on Application Nos. 3236025 and 3236028).¹⁶

69. The applicant concludes that the shape of the Defender is itself inherently distinctive.

70. In its skeleton argument and at the hearing JLR sought to rely on the decision of Mr Hobbs QC sitting as the Appointed Person in *NMSI Trading Ltd’s Trade Mark Application*.¹⁷ The case concerned an objection to the registration of a composite word and device mark for Flying Scotsman. It submits:

“27. The following points are particularly pertinent:

¹⁵ See the applicant’s skeleton argument, paragraph 42.

¹⁶ These features were first highlighted in Ms Beaton’s first statement, paragraphs 22-25.

¹⁷ [2012] RPC7

(i) Mr Hobbs QC analysed the reasoning in cases such as *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74 and found that the approach adopted in those decisions was applicable where (a) the potential for goods or services of the kind specified to provide consumers with imagery or information about someone or something denoted by the sign is sufficiently real and significant to be a material consideration; and (b) it is reasonable to believe that the sign will actually be recognised by the relevant class of persons as a description of the content or character of such goods or services (see [18]).

(ii) The latter requirement is not satisfied if the sign would be understood to designate content or character of a kind that the relevant average consumer would take to have come from a single economic undertaking believed or expected to be linked to the use of that sign. In that context, it is relevant to bear in mind that the beliefs and expectations of consumers are liable to be influenced by their awareness of what is typical in relation to the marketing of such goods and services. (See [18].)

(iii) On the facts before him, the question asked by Mr Hobbs QC in that regard was "Would the locomotive come to mind with connotations of trade origin that the average consumer might take to be applicable to such goods?" He answered this question in the negative, saying that "no pointers as to provenance would be provided by the content or character of the relevant goods". (See [23].)

28. He nevertheless concluded that registration should be permitted on the basis that:

"...the sign operates by attaching the made-up name for a locomotive to an image which represents the locomotive emblematically; the image is emblematic to a degree which shows that the sign is not being used simply and solely as an indication of content or character in relation to the goods concerned; moreover it personalises the sign in a manner which is apt to result in it being seen as a 'fingerprint' of

the involvement of a particular economic undertaking; the average consumer's perceptions of the sign as a whole would accordingly be origin specific even in relation to goods of the kind I am required to envisage.”

71. JLR concludes that the images of the Defender vehicle which constitute the marks applied for would individualise the goods of a particular undertaking in the minds of the average consumers.

72. The opponent submitted at the hearing that in the *Flying Scotsman* case the drawing presented above the words Flying Scotsman were described by Mr Hobbs as "possessing artistry and creative expression". Mr Bloch submitted:

“It is also to be noted that the words FLYING SCOTSMAN, or that part element of the mark, omits the definite article and uses different fonts or different type size to emphasise FLYING over SCOTSMAN. The drawings in this case lack the same sort of artistry. The marks have no word element to them, let alone a distinctive way of presenting the word element or a lack of ordinary grammatical structure, which might signal use as a trade mark. In paragraph 29 of the NMSI judgment, Mr Hobbs found FLYING SCOTSMAN was acceptable by a slender margin. This case, we say, is simply not in the same ballpark.”¹⁸

73. I must make this initial assessment based on the inherent distinctiveness of these signs and determine whether from the perspective of the relevant average consumer, the signs would serve to individualise the goods to a single economic undertaking. The signs applied for are two dimensional representations of vehicles - more specifically, utility or 4x4 type vehicles. The representations are not realistic, rather they are simple outline drawings. According to the applicant, there are several features that make these representations stand out from a ‘normal’ drawing of a car, such as, inter alia, the clam shell bonnet, the alpine windows and the particular configuration of lights on the front of the vehicle. In the applicant’s view this would enable the relevant public to

¹⁸ See page 4 of the transcript of the hearing.

recognise these marks as representing the applicant's Defender vehicle rather than being seen as a generic vehicle. I disagree. None of these features stand out in a way that would elevate a line drawing of a vehicle to a distinctive sign. I find that for the vast majority of average consumers for all of the goods in the applications, the applicant's marks will simply be seen as pictures of cars or more particularly, utility vehicles or 4x4s. In respect of goods which could be parts for vehicles and a large number of goods which could relate to vehicles these marks do not serve to identify the products as originating from a particular undertaking or distinguishing the goods from those of other undertakings. They serve to signify not the trade source but the subject matter or proposed use of those goods. These marks can be distinguished from the situation considered by Mr Hobbs QC in the Flying Scotsman case because unlike that mark, there is nothing here to act as 'a fingerprint' of a particular undertaking, they are simply outline drawings with no other element which will provide the consumer with a badge of origin.

74. In reaching this decision, I do not dispute that the applicant's Defender vehicle has a fairly small but dedicated following, the evidence indicates that to be so.¹⁹ However, that certainly does not mean that the average consumer of, inter alia, clothing, kitchen utensils, shoe brushes or bottle and can openers could be said to possess the knowledge necessary to identify a particular line drawing of a vehicle used in relation to those goods. In fact, such specialist or detailed knowledge is unlikely to be held by those in the 'average' category of purchasers of such goods. Further, even if I am wrong about that, recognising the marks as depicting a Defender land vehicle does not necessarily mean that the marks would be recognised as designating the goods of a particular undertaking. The images may still be regarded as merely decorative.

75. With regard to the third category of goods identified by the opponent, that is, those which have nothing to do with vehicles, there are some goods for which the marks may have prima facie distinctiveness, for example, diving apparatus. However, it is clear from the totality of evidence filed by both sides and from my own experience, that it is common to find a wide range of images of the type which make up these three applications used, inter alia, on the front of t-shirts, on bags and keyrings and on many

¹⁹ I will address this in more detail when considering acquired distinctiveness.

other goods which routinely feature decorative images. In my view, these marks are not any different from other pictures of vehicles which are applied to these types of goods and will simply be seen as decorative, rather than providing a badge of origin which would enable the public to distinguish the applicant's goods from those of other undertakings.

76. I find that these applications which are simple representations of a utility or 4x4 type vehicle, may serve, in trade, to designate the intended purpose of the goods set out in category 1 of Mr Bloch's skeleton argument, i.e. that they are goods for use in, or with, such vehicles. With regard to toy cars and vehicles the marks simply describe the subject matter of the goods. The contested marks are therefore prima facie excluded from registration under s.3(1)(c) of the Act in relation to those goods. Marks caught by s.3(1)(c) are necessarily also devoid of any distinctive character and prima facie unregistrable under s.3(1)(b). Therefore, I find that these objections apply prima facie to the contested marks in relation to these goods.

77. I find that the same objections apply, for the same reasons, to all of the goods in category 2 of the opponent's list, namely, goods which may relate to things which include vehicles and once again this includes toys which may include cars.

78. In addition, I find that the contested marks are prima facie excluded from registration under s.3(1)(b) of the Act in relation to goods which routinely carry images, such as pictures of cars and for which they are non-distinctive.

79. I have considered the lists of goods provided by Mr Bloch and while I am broadly in agreement with the divisions, there are inconsistencies. Furthermore, Mr Bloch has not identified the goods for which images of 4x4 or utility type vehicles would be seen simply as decorative and therefore non-distinctive. Consequently, it has been necessary for me to carry out a term by term assessment, using, for the most part, my own general knowledge. It is as follows:

80. Goods which relate to vehicles and are refused under 3(1)(b) and 3(1)(c) for the reasons provided above:

Class 6

Badges of metal for vehicles; parts and fittings for vehicles, namely containers, clips, flanges, grilles, hinges, nozzles, rivets, sealing caps, trim parts of metal, interior trim parts of metal; empty tool boxes and tool chests of metal; number plates.

Class 9

On-board computers for vehicles; computers for autonomous-driving; on board electronic systems for providing driving and parking assistance; cruise control systems for vehicles; vehicle speed control apparatus; automotive computer software and hardware; computer software for use in relation to vehicles; telemetry devices for motor vehicle and engine applications; navigational systems, comprising electronic transmitters, receivers, circuitry, microprocessors, cellular telephone and computer software all for use in navigation and all integrated into a motor vehicle; vehicle safety equipment; safety and driving assistant systems; lasers for use in relation to vehicles; cameras for vehicles; parking sensors and rear-view cameras for vehicles; automotive measuring instruments; communications apparatus to transmit and receive communications via vehicles; electric control apparatus and instruments for motor vehicles and engines; remote control starters for vehicles; Wireless controllers to remotely monitor and control the function and status of other electrical, electronic, signaling systems and mechanical devices for use in connection with vehicles and engines for vehicles; computer software, mobile applications and wireless transmission and receiving equipment for use in connection with autonomous and hands-free driving, automobile safety features and warning or alarm functions, accident prevention and traffic alerts; charging stations for charging electric vehicles; apparatus and cables for use in charging electric vehicles; batteries for vehicles; Computer hardware and software for tracking driver behaviour; sensors, computers and wireless transceivers to provide connectivity within the vehicle, between vehicles, with cell phones, and with data centers; computer hardware, software and electrical apparatus to provide tactile, audible and visual interfaces to interact with occupants of the vehicle; Wireless transmission and receiving equipment for use in connection with remote computers for use in automobiles for tracking, monitoring and diagnosing

maintenance for vehicles and for providing information to drivers; Computer application software for use by drivers and passengers of vehicles for accessing, viewing, and interacting with and downloading information and entertainment content; Downloadable software and on-board computer software that provides users with remote and in vehicle access to motor vehicle functions and functions relating to driver safety, convenience, communication, entertainment, and navigation; diagnostic apparatus consisting of sensors for use in testing vehicle function and in diagnosing vehicle electrical and mechanical problems; software and software applications to allow users to track and locate stolen vehicles, charge electronics, and store and synchronize collected personalized user and vehicle information; electronic interface modules sold as an integral part of a vehicle; display panels for vehicles; electronic interface modules for wired and wireless interface of mobile phones and electronic media players with an automotive electrical system; integrated electronic automated systems for vehicles; in-car entertainment systems; electrical and scientific apparatus for use in the repair and servicing of vehicles; driving glasses; drivers helmets; racing driver protective clothing; safety belts and harnesses for drivers and passengers.

Class 25

Driving gloves; drivers shoes.

Class 16

Disposable protectors for steering wheels and road wheels, all made of polythene or of plastic film or sheet materials.

Class 21

Car-cleaning cloths.

Class 28

Scale models and toy models, all of motor land vehicles, all sold complete or in kit form; go karts [toys]; remote control toy vehicles; rideable toy vehicles; ride-on toy vehicles; coin-operated toy vehicles; computer controlled toy-vehicles; computer controlled scale model vehicles.

81. Goods which may relate to vehicles and are refused under 3(1)(b) and 3(1)(c) for the reasons provided above:

Class 6

Small items of metal hardware; keys; keys of metal; locks and keys; metal keys for locks; key hole plates of common metal; screws; nuts; bolts; washers; connectors; fasteners; metal hardware; extrusions; panels; stampings; cast parts; forgings; hinges; non-electric locks and latches, and parts and fittings therefor; fasteners; pipes (not being boiler tubes or parts of machines) and connectors therefor; flexible tubes and hose assemblies of metal; keys and key blanks; tanks for liquids, all of common metal; identity plates of metal; non-electric cables and wires of common metal; wire for aerials; parts and fittings for any of the aforesaid goods.

Class 9

Computer hardware; computer software; Downloadable mobile applications; interactive multimedia software; Global positioning system (GPS); downloadable electronic maps; electric control panels; electronic control apparatus, instruments and displays; sensors; onboard cameras; action cameras; electronic apparatus for collecting measurements and receiving data; wireless transmission and receiving equipment; electric connections; anti-theft warning devices; alarm sensors; gauges; instrument panels and instruments therefor; odometers; speedometers; tachometers; temperature sensors; voltmeters; ammeters; testing apparatus; proximity meters; electric blowers; electric lighters; electric circuit breakers; commutators; electric condensers; electric connections; electric cables; electric fuses; electric fuse boxes; electrical sensors; lenses for lamps; printed electrical circuits; electric relays; electric switches; electric wiring harnesses; testing apparatus; cameras; Apparatus for recording, transmission or reproduction of sound and images; mechanical remote controls for motors; emergency warning lights; emergency notification system; electric accumulators, voltage regulators, aerials, electric batteries and mountings; audio, audiovisual or telecommunications equipment; Radio apparatus; sound reproducing equipment; televisions; CD players; loud speakers; multimedia devices; MP3 or MP4 apparatus and equipment; telephones; recording media; storage boxes for recording media; highway emergency warning equipment; thermometers; compasses; cameras; chargers for mobile phones, parts and fittings for any of the aforesaid goods.

Class 14

Clocks.

Class 16

Disposable paper protectors for carpets and seats; spare parts lists; maintenance manuals.

Class 21

Sponges and brushes.

Class 28

Toys, games and playthings; computer controlled toys; Outdoor toys.

82. Goods for which the applications are non-distinctive and are refused under section 3(1)(b):

83. As to the potential for decorative use of the contested marks, I accept that relevant average consumers would regard use of the contested marks in relation to some of the remaining goods as purely decorative. This is most obviously the case for goods such as t-shirts and caps, examples of which are shown in the evidence of both parties, but also extends to goods such as keyrings, which could clearly take the shape of the outline drawings which are the contested marks in these cases. This means that the objection under s.3(1)(b) succeeds in respect of:

Class 6

Key tags of common metal; signs of metal; badges of common metal; metal tins; metal boxes; metal containers; containers made wholly or principally of common metals or their alloys.

Class 9

Cases for mobile phones, smartphones, computers, personal digital assistants, laptops, notebook computers; cases for eyeglasses, sunglasses or skiing goggles; camera cases.

Class 14

Jewellery; key fobs; silver key fobs; key fobs in precious metals or coated therewith; key rings of precious metal; key fobs made of leather or leather imitations; key rings and key chains; key chain tags; key tags [trinkets or fobs]; key rings of precious metals; parts and fittings for any of the aforesaid goods; brooches; necklaces; bands; cuff links; tie pins of precious metal; tie clips of precious metal; trinkets [jewellery]; trinkets of precious metal; trinkets coated with precious metal; decorative articles [trinkets or jewellery] for personal use; mobile, smart phone and tablet computer tags; badges of precious metal; lapel badges of precious metal; metal badges for wear [precious metal].

Class 16

Printed matter; stationery; posters; maps; travel guides; books; coloring books; newspapers, periodicals, magazines; comics; catalogues; newsletters; tickets; souvenir programs; manuals; printed instructional, educational and teaching materials; photographs; photo books and annuals; brochures; children's books; children's activity books; children's story books; paper banners; paper flags; bunting of paper; stencils; writing and drawing instruments; calendars; stickers; labels; decalcomanias; temporary tattoos; sticker albums; sticker books; gift wrap, greeting cards, gift tags, gift ribbon made from paper; tissue paper; party invitations; thank you cards; place setting cards; photograph albums; scrapbooks; memento books; boxes of card or cardboard; rulers; postcards; bookmarks; bookends; erasers; paperweights; book covers; diaries; wall planners; year planners; notebooks; appointment books; address books; business card holders; cheque book covers; passport covers; folders; notebooks; notepads; art prints; pens; pencils; presentation packs and folders; pencil cases; figurines designed to sit on top of pens; staplers; hole punches; sticky tape; sticky tape dispensers; colouring materials, crayons, artists materials; children's painting sets; stamps for ink and ink pads; highlighter pens; paper towels, napkins, serviettes, mats, coasters, handkerchiefs, tissues, cloths, wipes, tablecloths, party favours, all made wholly or principally of paper and/or paper derivatives; babies bibs of paper; paper cake cases; wrapping and packing paper; paper bags and sacks; money clips; desk sets; desktop organizers; and advertising materials, all being printed publications; luggage tags of paper or card; paper and cardboard boxes; paper and

cardboard containers; paintings; prints; photographs; fine art; parts and fittings for any of the aforesaid goods.

Class 18

Leather and imitation leather bags; bags; luggage; traveling bags; vanity cases sold empty; attaché cases; document cases; suitcases; handbags; rucksacks; holdalls; overnight and weekend bags; sports bags; tote backs; shoe bags; belt bags; wallets; purses; business card cases; saddle belts; shoulder belts; leather shoulder belts; fitted belts for luggage; belt bags and hip bags; wallets for attachment to belts; shoulder belts [straps] of leather; pouches of leather for packaging; leather key holders and pouches; leather leashes; luggage tags; plastic luggage tags; metal luggage tags; rubber luggage tags; golf bag tags of leather; parasols; umbrellas.

Class 21

Glassware; porcelain; earthenware; plastic water bottles for bicycles; crockery; mugs; plates; tankards; place mats, dinner mats, beer mats; bottle and can openers; corkscrews; coasters; paper cups; dishes and plates; moneyboxes made wholly or principally of porcelain or earthenware; portable coolers and flasks; plastic water bottles, all for foodstuffs and/or beverages; small portable containers for money and/or personal possessions.

Class 25

Clothing; footwear; headwear; outerwear; leisurewear; T-shirts; tops; polo shirts; sweatshirts hooded tops; hooded pullovers; shirts; fleece pullovers; fleece jackets; sweaters; coats; dresses; skirts; jackets; vests; anoraks; sweatpants; trousers; shorts; overalls; coveralls; uniforms; smocks; underclothing; pyjamas; sleep masks; pocket squares; scarves; bandanas; sashes for wear; hosiery; socks; stockings; cloth bibs; costumes; fancy dress costumes; aprons; fabric belts; belts; gloves; mittens; ties; headgear; hats; caps; head scarves; head wraps; headbands; visors; ear muffs; knitted beanies; footwear; shoes; boots; slippers; sandals; children's clothes; babies clothes; sportswear; clothing, footwear, headwear for participating in sports, games and activities; clothing, footwear, headwear for walking and other outdoor activities; sports teams club shirts; sports teams scarves; sports teams training kit; sports teams

replica kit; sports teams supporters clothing, headgear and footwear; parts and fittings for any of the aforesaid goods.

Class 28

Playing cards; puzzles.

83. Goods which are free from objection and for which the oppositions fail are as follows:

Class 6

Metal key blanks; metal rings for keys; rings of metal for keys; woven wire mesh; metal dog tags; identification tags of common metal.²⁰

Class 9

fire extinguishing apparatus; televisions; Personal Digital Assistants; tablet computers; mobile hard drives; Universal Serial Bus drives; smartphones, laptop and tablet computers; calculators; magnets; tape measures; electronic instructional and teaching apparatus and instruments; eyewear, glasses, sunglasses, skiing goggles; apparatus, gloves and clothing, all for use in protection against accident or injury; telescopes; telescope stands; telescope cases; cinematographic apparatus; slide projectors; binoculars; binoculars cases; camera flashes; camera stands; camera lenses; cinematographic cameras; diving apparatus; diving equipment; diving suits; diving goggles; diving helmets; masks for diving; diving snorkels; rebreathers for diving; diving weights; buoyancy bladders for diving; regulators for scuba diving; goggles for scuba diving; air tanks [for scuba diving]; weight belts [for scuba diving]; weight belts for scuba diving; compressed air bailout units for diving; air tanks for use in scuba diving; security tags; electronic tags.

Class 14

²⁰ In considering this class I conclude that ‘rings of metal for keys’ and ‘metal rings for keys’ are, on plain reading of these terms, simply metal rings to which keys can be attached. I distinguish them from key fobs, tags and keyrings because, in my experience, these may be decorated and/or branded and purchased as merchandise or are given away at point of sale when a customer purchases a vehicle.

Rings; bracelets; chokers; watches; watch straps; diving watches; jewels; metal dog tags of precious metal; identification tags of precious metal.

Class 16

Office requisites (other than furniture); paper; wedding albums; philatelic items; chalk boards; chalk; whiteboards; staples; modelling clay; dressmaking patterns.

Class 18

Leather; imitation leather, walking sticks; umbrella sticks.

Class 21

Household or kitchen utensils and containers; cookware; tableware; camping grills; camping cookware; camping dishware; napkin holders and rings; trays; ornaments; brushes; toothbrushes; small domestic utensils and containers; cloths and sponges; articles and materials for cleaning purposes; moneyboxes made wholly or principally of glass; shoe brushes; drinking straws; candle sticks of metal and glass; parts and fittings for any of the aforesaid goods.

Class 25

Suits; blazers; swimwear; bathing suits; bathing trunks; leather belts; clothing, footwear, headwear for playing golf; clothing, footwear, headwear for fishing; clothing, footwear, headwear for diving.

Class 28

Fairground rides; handheld computer games; computer games equipment adapted for use with TV receivers; Sports equipment; sailing equipment [sporting articles]; horse riding equipment [sporting articles]; rugby balls and equipment for playing rugby; golf clubs, golf balls and golf bags; golf divot repair kit; stuffed toy animals; plush toys; flying discs; throwable toys; beach toys; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; Christmas decorations made of paper or card; parts and fittings for any of the aforesaid goods.

The section 3(1)(d) ground of opposition

84. The applicability of any of the exclusions in s.3(1) of the Act is sufficient to prevent the contested marks from registration *prima facie*. I therefore see no need to determine the s.3(1)(d) ground of opposition in relation to any of the goods/services for which Ineos's objections under ss.3(1)(b) and/or (c) have succeeded.

85. So far as the remaining goods in classes 6, 9, 14, 18, 21, 25 and 28 are concerned (as per paragraph 83 above), there is no evidence that any of the contested marks consists exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade. The s.3(1)(d) is therefore rejected insofar as it is directed at these goods.

The oppositions under section 3(1)(a)

86. I will consider, briefly, Ineos's case that the marks applied for are not capable of being graphically represented and/or distinguishing the goods of a particular undertaking.

87. Section 1(1) of the Act states:

"1.(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging."

88. The opponent's pleading in its statement of grounds reads:

“The Opponent contends and will show, that the trade mark applied for is not a sign that is capable of distinguishing the goods of the Applicant from those of others.²¹

Registration in suit ought therefore to be refused under the provisions of Sections 1(1) and 3(1)(a) of [the Act].”

89. The opponent has not put forward any reasons for its reliance on this ground either in evidence, submissions or at the hearing.

90. The applicant submits:

“31. It appears from the First Statement of Mr Peacock that the Opponent does not pursue the 3(1)(a) ground. In any event, it is hopeless since it is clear that each of the Marks is the type of sign that may qualify as a trade mark. Hence, applying *AD2000 [Trade Mark]*,²² registration should not be refused on this basis.”²³

91. In accordance with the case referred to by the applicant, it is not strictly necessary for me to determine the ground under section 3(1)(a). This is because, as Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person pointed out in *AD2000 Trade Mark*, s.3(1)(a) permits registration provided that the mark is ‘capable’ to the limited extent of “*not being incapable*” of distinguishing. There is clearly no merit in the view that these marks are incapable of being represented graphically. They are graphically represented on the application forms. Secondly, there is no category of mark which is capable of acquiring a distinctive character which is nevertheless excluded from registration by s.3(1)(a).²⁴ Thirdly, if registration is to be refused on policy grounds, this must be based on grounds under s.3(2) or s.3(3)(a) of the Act. Section 3(2) was not pleaded and section 3(3)(a) was struck out by the tribunal. Consequently, if I am satisfied that the mark complies with s.3(1)(b) of the Act, the ‘incapable of

²¹ The same pleading was made in respect of all three trade mark applications.

²² [1997] RPC 168 at paragraph 173.

²³ See the applicant’s skeleton argument.

²⁴ See the CJEU’s judgment in *Koninklijke Philips Electronics NV and Remington Consumer Products Ltd*, Case C-299/99.

distinguishing' objection under section 3(1)(a) is bound to fail. Alternatively, if the ground under section 3(1)(b) succeeds, the outcome under section 3(1)(a) becomes moot.

Acquired distinctiveness

92. The applicant stated throughout its pleadings, evidence and submissions at the hearing that the three marks applied for had acquired the distinctiveness necessary to satisfy the Registry that at the date of application they were capable of functioning as a trade marks.

93. The proviso included in section 3 of the Act states:

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

94. The relevant date for assessment of the trade marks in terms of acquired distinctive character is the date of application, namely, 7 June 2017.

95. Guidance on this matter is provided by the CJEU in *Windsurfing Chiemsee*²⁵ according to which:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

²⁵ Joined cases C-108 & 109/07

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

96. Mr Bloch relies on *Société des Produits Nestlé SA v Cadbury UK Ltd (No 2)*²⁶ in which Kitchin LJ explained the law in relation to acquired distinctiveness by reference to the decision of the Court of Justice in the reference in that case, C-353/03, *Société des Produits Nestlé SA v Mars UK Ltd*:

"47 Against this background, the Court turned to the acquisition of distinctive character and explained that it must be as a result of the use of the mark as a trade mark, that is to say for the purposes of the identification of the goods as originating from a particular undertaking, at para 63:

"So far as, specifically, the acquisition of distinctive character in accordance with article 3(3) of Directive 2008/95 is concerned, the expression 'use of the mark as a trade mark' must be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the goods or services as originating from a given undertaking: the Nestlé case (Case C-353/03) [2006] All ER (EC) 348, para 29."...

"83 The mark performs this function through its distinctive character. That character may be inherent or it may be acquired, but it can only be acquired through the use of the mark as a trade mark, that is to say for the purposes

²⁶ [2017] EWCA Civ 358

of the identification by consumers of the relevant goods or services as originating from a particular undertaking."

97. Mr Bloch submitted at the hearing:²⁷

"The way in which an inherently non-distinctive mark may acquire a distinctive character was elaborated upon by the CJEU in the Philips Electronics v Remington case: 'the identification, by the relevant class of persons, of the product as originating from a given undertaking must be as a result of the use of the mark as a trade mark and thus as a result of the nature and effect of it, which make it capable of distinguishing the product concerned', and there are other undertakings. That is the citation from Philips. That is developed in paragraphs 18 and 19 where Kitchin LJ observes: "This is readily understandable. An inherently non-distinctive mark can only acquire a distinctive character if the maker or supplier of the product concerned uses the mark in such a way that it comes to guarantee to consumers that the product originates from a particular undertaking."

98. Mr Bloch concluded:

"The first problem for the applicant in this case is that the evidence it has provided does not show any use of the trade marks for which registration is sought."

99. In its skeleton argument the applicant outlined JLR's evidence as to acquired distinctiveness as follows:

(i) The shape of the Defender has featured prominently on JLR merchandise since 2004, frequently in front or side view.

(ii) Prior to 2012 merchandise was sold under licence, but since then it has been sold by JLR itself through its authorised dealerships, the official online

²⁷ Official transcript, page 5.

Land Rover shop, two UK stores and various high profile UK events, including Goodwood, Burghley, Donnington, Silverstone and Brands Hatch.

(iii) By way of example the online Land Rover shop had 1.3 million hits from May 2017-June 2018 and over 8,000 retailer brochures were produced for the 2017 collection.

(iv) Since 2013 JLR has sold approximately 35,000 units of merchandise featuring the Defender shape, which have generated turnover of around £300,000.

55. Although some of the use has been in conjunction with other marks, as noted above, this does not prevent the Marks from acquiring distinctive character.”

100. The turnover figures for merchandise featuring the Defender shape amount to £300,000 since 2013. No breakdown is provided to show which goods these figures relate to. Given that these applications are made in respect of hundreds of goods I cannot begin to guess the turnover for each of them, or even categories of goods to which they relate.

101. The goods are sold through the Land Rover online shop, two UK stores and at events in the UK. The events all appear to be car/racing related events.

102. JLR does not appear to be relying on the only evidence which could be said to be from industry or trade, which is given by journalists referring to the Defender vehicle, at one time manufactured by JLR. Even if it were, the evidence does not relate to the trade marks applied for which are simple, two dimensional figurative depictions of utility/4x4 vehicles and not the vehicles themselves.

103. JLR's use of the defender shape is inconsistent and it is important to note that there is not a single example of the marks applied for being used either alone or with Land Rover or Defender branding. T-shirts and other printed items have different versions of vehicles, some in block colours, with little detail and others presented in a

highly detailed manner, in the style of technical drawings. In each case the word Land Rover, Defender, or both are evident. In the case of clothing this is often in the form of sleeve badges.

104. These goods are made available through dealerships, the JLR website or at motoring events. Clearly the goods are targeted at the car buyer, owner or fan and not at the broader relevant public for the many goods at issue in this case, for example, kitchen utensils.

105. At the hearing, relying on KitKat, Mr Bloch concluded:

“It is perfectly true that the Applicant contends that the shape of the Defender range of vehicles may be identified with it, but it would be absurd to suggest that the use of the vehicle amounts to use of the marks. A vehicle, a three-dimensional functional object, on the one hand, and a simple two-dimensional drawing of a vehicle, on the other hand, plainly differ in material elements. Therefore, any case on acquired distinctiveness does not begin to get off the ground. In the KitKat case the mark was used on a massive scale. In KitKat the mark was readily identifiable and proven so by over 80% of consumers.

In this case, the mark has simply not been used at all. In this case, there is no evidence as to the proportion of consumers of any particular category of goods who might recognise the mark as a drawing of a vehicle in the Defender range, let alone recognise the mark per se. We have Ms Beaton's expression of belief, but it falls woefully short of the sort of evidence which might establish the distinctiveness in relation to anything, let alone in relation to these particular marks.”

106. In short, I agree. The fact that JLR has not shown any use of the marks applied for is fatal to its case for acquired distinctiveness. Even if I were to conclude that all uses of images of Defender vehicles counted (which I most certainly do not), the goods are directed at car buyers, owners and fans and relate only to a very limited number of the hundreds of goods for which these marks are applied and would still fall a long

way short of showing the necessary use to satisfy the requirements of acquired distinctive character.

107. I find further support for this finding in the recent decision in *Adidas v EUIPO*²⁸ in which the GC held that in order to demonstrate that the mark at issue has acquired distinctive character, the mark being an Adidas three stripe mark, the applicant could not rely on all of the evidence which shows a mark consisting of three parallel equidistant stripes. Having found the mark not to be a pattern but to be a figurative mark, the court found that, “it follows from the answer to the first part of the plea in law that the relevant evidence is only that which shows the mark at issue in its registered form or, failing that, in forms which are broadly equivalent, which excludes forms of use where the colour scheme is reversed or which fail to respect the other essential characteristics of the mark at issue.”²⁹

108. Similarly, in this case, in order to show that the marks applied for have acquired distinctive character, it is not enough for JLR to provided examples of many different images of vehicles which it submits are the same model. It must show use of the marks applied for or, at least, marks which do not differ in their distinctive character. It has not done so and JLR’s claim to enhanced distinctive character fails.

The bad faith ground of opposition

109. Section 3(6) of the Act is as follows:

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

110. In its initial statement of grounds Ineos claimed:

“The Opponent contends, and will show, that the application in suit was applied for in bad faith because:

²⁸ T-307/17

²⁹ This case was decided after the hearing in this case, but, is included as it simply restates the existing law in a manner relevant to the issues before me.

(i) The Applicant had no intention to use the trade mark applied for, at the date of filing the application, in relation to the goods claimed; and/or

(ii) With regard to the ground mentioned at paragraph 3 above, the Applicant is endeavouring to obtain a monopoly right via a registration under the Act in a sign (shape) that is actually a design right - thus contravening the accepted legal philosophy of what should remain in the "intellectual common" for others."

111. With regard to JLR's intention to use the marks across the range of goods for which registration is sought, Ineos reproduces the following from JLR's evidence:³⁰

(1) JLR intends to produce vehicles within the Defender Range;

(2) JLR intends "to meet continuing consumer demand for official Defender merchandise";

(3) JLR is creating a collection of clothing using Land Rover Defender imagery;

(4) "I can confirm that JLR had been using and intended to use the image of the Defender on merchandise products as at the date of filing";

(5) "I can also confirm that JLR has been considering using the marks as badges of origin of the goods"; and

(6) "Land Rover's loyal consumers also continue to demand official Defender merchandise. Therefore, JLR's Branded Goods team will continue to use the vehicle's distinctive shape across future collections to meet such demand, and as a means of identifying the Land Rover brand".

³⁰ These statements are taken from paragraphs 46-49 of Ms Beaton's witness statement.

112. Mr Bloch concludes from these statements that the classes of goods for which registration is sought are far broader than the classes of goods for which Ms Beaton gives evidence. Ms Beaton does not refer to any particular goods and says that JLR intends to use 'the image of the Defender', not the signs for which these applications have been made, Ms Beaton's evidence relates to what JLR has been considering, rather than what it is intending.

113. The second point initially pleaded by Ineos, concerning its claim that the applications are in fact designs which should remain in the 'intellectual common' was not pursued at the hearing and no evidence has been filed in support of it.

114. In addition, in its evidence³¹ and skeleton argument Ineos added what appears to be an additional ground under section 3(6) under what it refers to as, 'intention to interfere with the business of a competitor'.

115. Mr Peacock inferred that *"the filing of the Applications demonstrates that the manifest intention of the Applicant was simply to attempt to disrupt the Opponent's plans"* to produce a 4x4 which would compete with those of JLR.

116. Mr Bloch concludes in his skeleton argument that:

"52. Ms Beaton does not deny that the Applications in relation to merchandising goods were made when they were with a view to disrupting INEOS's plans. Nor does Ms Beaton deny that the Applications in relation to non-merchandising goods were made with that objective. Ms Beaton must know, and her failure to do more than skirt around the issue is telling."

117. He drew my attention to *Wisniewski v Central Manchester Health Authority*³² in which Brooke LJ (with whom Roch and Aldous LJ agreed) set out principles as regards the circumstances in which it is appropriate to draw such an adverse inference from the silence of a witness, and suggested that I do the same.

³¹ Mr Peacock's first witness statement, paragraphs 7.5-7.7.

³² [1998] P.I.Q.R. P32449 at 340 (CA)

118. Ineos's claim with regard to design right is dismissed. It has not been pleaded beyond a sentence in the original statement of grounds.

119. I also dismiss the additional ground added by Mr Peacock in his evidence. At the hearing, Ms Lane for JLR, pointed out that Ms Beaton had not responded to the points raised in the skeleton argument as they were not pleaded at the outset. I agree. Had Ineos wished to add a ground it should have requested an amendment to pleadings which would have resulted in JLR being given an opportunity to amend its defence and (if it so wished) to file additional evidence in support of that defence.

120. With regard to JLR's intention to use its applied for marks, the relevant case law is found in *Sky Plc v SkyKick UK Ltd*³³ in which Arnold J provided the following:

“225. First, although there is no express requirement of an intention to use in either the Regulation or the Directive, and a registered trade mark cannot be revoked for non-use until five years have expired, the jurisprudence of the CJEU and the General Court suggests that, at least in certain circumstances, it may constitute bad faith to apply to register a trade mark without any intention to use it in relation to the specified goods or services.

226. Secondly, the case law indicates that it is not sufficient to demonstrate bad faith that the applicant has applied to register the trade mark in respect of a broad range of goods or services if the applicant has a reasonable commercial rationale for seeking for such protection having regard to his use or intended use of the trade mark. Nor is it sufficient to demonstrate bad faith that the applicant only has a contingent intention to use the trade mark in relation to certain goods or services in the future.

227. Thirdly, although the court or tribunal must exercise caution for the reasons given in the preceding paragraph, the case law suggests that, in an appropriate case, it may be possible to conclude that the applicant made

³³ [2018] EWHC (Ch) 155, currently pending the CJEU's answers to questions raised in the appeal to this case.

the application partly in good faith and partly in bad faith if the applicant had an intention to use the trade mark in relation to some of the specified goods or services, but no intention to use the trade mark in relation to other specified goods or services...

121. These applications are made in respect of goods which directly relate to cars or could relate to cars and those which are unrelated to cars. With regard to the first two categories, Ms Beaton has stated that JLR intends to sell vehicles in the Defender range and still intends to provide merchandise for that market. Ineos's case is that the trade marks applied for in this case could be used in trade to designate the intended purpose of goods which are or could be used in vehicles. This means that JLR had "a reasonable commercial rationale" for applying to register the applications for goods which are used in vehicles or for goods intended for use with vehicles.

122. So far as the applications cover goods which are parts, accessories or goods intended for use with vehicles, there is no evidence either way as to whether JLR intended to use the contested marks. Consequently, as the onus is on the opponent to show that the marks were applied for in bad faith, this ground of opposition fails in relation to the goods that have survived the lack-of-distinctiveness objections.

123. This means that the bad faith ground of opposition is rejected in full.

COSTS

124. The parties agree that costs should be assessed on the usual scale. Ineos has been about 80% successful in terms of the proportion of goods for which registration of the marks has been refused. I will also make some allowance for the fact that although Ineos was mostly successful on distinctiveness grounds, it was not successful on the other grounds that were originally pleaded and/or pursued at the hearing.

125. Taking all these factors into account I order Jaguar Land Rover Limited to pay Ineos Industries Holdings Limited the sum of £5000. This is made up of:

£600 for filing 3 notices of opposition (official fees);
£600 for completing the notices of opposition and considering JLR's counterstatements;
£2500 for filing evidence and considering JLR's evidence;
£1300 for attending a hearing and filing a skeleton argument.

126. The above sum should be paid within 21 days of the date of this decision or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order to the contrary by the appellate tribunal).

Dated this 21st day of October 2019

**Ms Al Skilton
For the Registrar,
the Comptroller-General**