

O/860/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003543174

IN THE NAME OF MOTO GB LIMITED

FOR THE FOLLOWING TRADE MARK:



IN CLASS 12

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 424336 BY

DORNA SPORTS, S.L.

BACKGROUND AND PLEADINGS

1. On 12 October 2020, Moto GB Limited applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”) for the following goods:

Class 12: Motorized scooters; Motors and engines for land vehicles; Motors for automobiles; Motors for motorcycles; Motorscooters; Scooters; Scooters [for transportation]; Scooters [vehicles]; Mopeds; Motor cycles; Motor scooters; Motor vehicle bodies; Motor vehicles; Motorbicycles; Motorbikes; Motorcycle engines; Motorcycle frames; Motorcycle handlebars; Motorcycle swing arms; Motorcycle tires; Motorcycles; Motorcycles for motocross; Electric bicycles; Electric engines for land vehicles; Electric motor cycles; Electric motors for land vehicles; Electric vehicles; Electrically operated vehicles.

2. The applicant’s mark was published for opposition purposes on 5 February 2021 and, on 5 May 2021, it was opposed by DORNA SPORTS, S.L. (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. In respect of the 5(2)(b) ground, the opponent relies on the following mark:



EUTM: 011078706¹

Filing date 27 July 2012; registration dated 25 December 2012

¹ Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application.

Colours claimed: red, white and black

Relying on some goods, namely:

Class 12: Vehicles; Parts and accessories for vehicles in this class; Apparatus for locomotion by land, air or water; Airbags for vehicles; Anti-theft devices for vehicles; Seats for vehicles; Anti-skid devices for vehicles; Anti-dazzle devices for vehicles; Safety harnesses for vehicles; Seats and seat covers for vehicles; Shock absorbers and vehicle suspension springs; Chains for vehicles; Gear boxes and Transmission chains for vehicles; Air pumps (vehicle accessories); Golf carts, vehicle bodies and chassis; Cycle cars; Perambulators; Cars; Special cases for two-wheeled vehicles; visors for vehicles; Covers for vehicles; Bicycles and bicycle accessories; Horns for vehicles; Pushchairs; Inner tubes for tyres; Glass for windows of vehicles; Tyres and valves for vehicles; Tanks for petrol, oil and brake fluid for vehicles; Mup-flaps; Direction indicators for vehicles; Vehicles covers (shaped); motorcycle handlebars and Bicycles; Tail lifts for vehicles; Luggage racks for vehicles; Luggage nets for vehicles; Rear view mirrors; saddles and saddle covers for bicycles or motorcycles; Framework for vehicles; Caps for vehicle petrol (gas) tanks; Sidesteps for vehicles; Brakes and Brake linings; Rims and covers for vehicles; Motorbikes; Steering wheels for vehicles; Anti-theft alarms for land vehicles; Brakes for vehicles; Motorcycles; Carrier tricycles; Motorbikes; Mopeds; Scooters [vehicles]; Trailers for vehicles; Side cars; Engines for vehicles; Electric motors for vehicles; Vehicle wheel spokes; Transmissions for vehicles; Motorcycle kickstands; Handlebar grips for motorcycles and bicycles; Pannier bags for motorcycles; Starter motors for motorcycles.

3. The opponent claims that, in consideration of the similarity of the marks at issue and the identity/similarity of the goods, there is a likelihood of confusion between the marks, including a likelihood of association.
4. Under its 5(3) ground, the opponent relies on the following mark:

MOTOGP

EUTM: 004210209

Filing date 4 February 2005; registration date 3 October 2006

Relying on some services, namely:

Class 41: Organisation of events and cultural and sporting activities, education; providing of training; entertainment; organisation of trade fairs and exhibitions for cultural, sporting and educational purposes; production of audiovisual recordings; publication of books and texts, other than publicity texts; arranging and conducting of competitions, colloquiums, conferences and congresses; providing museum facilities (presentation, exhibitions); production and presentation of live performances, sports broadcasts; academies; motorcycling school; sports club services; teaching of sports using instructors and trained staff; theme parks and rides; holiday camps; providing casino facilities (gambling); organization of sports competitions; discotheques; use and rental of golf course facilities, speed circuits and sports installations of all kinds; providing cinema and games facilities.

5. The opponent claims that it has acquired a reputation in the above services and that use of the applicant's mark would result in an unfair advantage for the benefit of the applicant, be detrimental to the reputation of the opponent's mark and cause dilution of the distinctiveness of the opponents' mark which would result in a detriment to the distinctive character of the opponent's mark.

6. Lastly, under its 5(4)(a) ground, the opponent relies on the unregistered sign 'MOTOGP' that it claims to have used throughout the UK since 2002 for the following goods and services:

“Vehicles; Parts and accessories for vehicles in this class; Motorcycles; Motorbikes; Mopeds; Scooters [vehicles].

Organisation of events and cultural and sporting activities, education; providing of training; entertainment; organisation of trade fairs and exhibitions for cultural, sporting and educational purposes; production of audiovisual recordings; publication of books and texts, other than publicity texts; arranging and conducting of competitions, colloquiums, conferences and congresses; providing museum facilities (presentation, exhibitions); production and presentation of live performances, sports broadcasts; academies; motorcycling school; sports club services; teaching of sports using instructors and trained staff; theme parks and rides; holiday camps; providing casino facilities (gambling); organization of sports competitions; discotheques; use and rental of golf course facilities, speed circuits and sports installations of all kinds; providing cinema and games facilities.”

7. The opponent claims that it has been using its sign since at least 2002 in respect of the above services and at least 2005 in respect of the above goods. The use, the opponent claims, has resulted in the accrual of a goodwill in the words 'MOTOGP' which are of more than a mere local significance to the extent that the law of passing off would entitle the opponent to prohibit use of the applicant's mark.
8. The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of its marks. Further, I note that the applicant set out that it has used its mark (or variants thereof) in the UK since it was first incorporated in 2000 and that the date of first use predates the filing date of the EUTMs relied upon by the opponent and, to its knowledge, the first day of use of the opponent's claimed first use of its mark. Such an argument may have given rise to a defence that the applicant was the senior user of the sign and/or that there exists honest concurrent use. While this may be the case, I note that the applicant

did not file any evidence in these proceedings to support such a claim and I will, therefore, say no more in respect of such arguments.

9. The opponent is represented by Jenson & Son. I note that the applicant initially had legal representation in this matter, however, from 16 June 2022, the applicant was unrepresented. Only the opponent filed evidence in chief. No hearing was requested and neither party filed any written submissions in lieu. The decision is taken following careful perusal of the papers.

10. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

11. The opponent's evidence in chief came in the form of the witness statement of Enrique Aldama Orozco dated 18 April 2022. Mr Orozco is the Chief Operating Officer and Chief Financial Officer of the opponent, positions which, as at the date of the statement, he had held for 21 years. Mr Orozco's statement was accompanied by 10 exhibits, being EA01 to EA10.

12. I do not intend to reproduce the evidence in full here, however, I will refer to it below where necessary.

DECISION

Proof of use

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. The relevant statutory provisions are as follows:

“Section 6A:

(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

15. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. Given their filing dates, both of the opponent’s marks qualify as earlier trade marks under the above provisions. The opponent’s marks completed their registration processes over five years prior to the date of the application at issue and given that, as above, the applicant has put the opponent to proof of use for its marks, they are subject to a proof of use assessment in respect of all of the goods and services relied upon. On this point, it is necessary to set out that, under this section, I will only assess proof of use for the opponent’s mark that is being relied upon under the 5(2)(b) ground. For reasons that will become apparent, I will address the proof of use point in respect of the mark relied upon under the 5(3) ground when making my assessment of the existence of a reputation.

17. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009]

ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the

latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

18. In *Awareness Limited v Plymouth City Council*,² (“Plymouth Life”), Mr Daniel Alexander K.C., sitting as the Appointed Person, stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

19. And further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a

² Case BL O/236/13

much narrower range should be critically considered in any draft evidence proposed to be submitted.”

20. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s mark is the 5-year period ending with the date of the application at issue, being 12 October 2020. Therefore, the relevant period for this assessment is 13 October 2015 to 12 October 2020.

21. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark”³ is, therefore, not genuine use.

Sufficient Use

22. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁴

23. While the majority of the evidence focuses on the MotoGP races themselves, there is some evidence that focuses on the licencing of the opponent’s mark on a wide range of goods. The evidence sets out that there are over 70 MotoGP licensees (many of which are long-term partners) that cater for a wide and varied fan base with a large range of product categories.⁵ While I do not propose to set out an exhaustive list of the goods shown, I do note the presence of t-shirts, watches, motor oil, suitcases, clothing, computer games, motorcycle helmets, handle bar grips, calendars, toys, exhausts, protective clothing and padding for motorcyclists, tyres, air pumps and brake systems. All of these goods are displayed as bearing the opponent’s mark. I also note the presence of a motorcycle and a moped in the

³ *Jumpman* BL O/222/16

⁴ *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

⁵ Page 57 of Exhibit EA02

evidence and while I note that these bear the opponent's mark, they also bear third-party trade marks, namely BMW and Yamaha, respectively.⁶

24. It is necessary to point out that a lot of the goods shown in the evidence are goods which do not fall within the list of goods upon which the opponent relies. While that may be the case for a number of the goods, there are several other examples of the opponent's mark displayed on goods that do fall within the opponent's specification, namely goods that fall within the categories of "parts and accessories for vehicles in this class" (being Class 12), "tyres", "oil and brake fluid for vehicles", "brakes", "vehicle covers (shaped)", "motorbikes" and "handlebar grips for motor cycles". While the presence of these goods in the evidence is noted, I have nothing further regarding the opponent's use of the mark on these goods. For example, I have no evidence of turnover or any level of sales that can be attributed to the opponent's use of its mark on these goods. Further, while the products are shown in yearly reviews for 2019 and 2020⁷ and in what the opponent refers to as 'brochure licensing' documents from 2020,⁸ no evidence of the goods being marketed or promoted has been provided, neither is there any indication of the reach of these documents and who they were distributed to, for example, were they to investors or potential customers? In addition to this point, there is no evidence as to marketing/advertising expenditure. Lastly, there is no evidence as to geographical extent of the use of the mark on these goods and neither is there any evidence as to the scale and frequency of the use.

25. As confirmed by both Section 100 of the Act and the *Plymouth Life* case (reproduced above), the burden to prove use is on the opponent. While the evidence showing the goods is noted, I am of the view that further evidence supporting such use (such as sales figures or marketing expenditure) would have been particularly well known and readily accessible to the opponent. In the absence of such supporting evidence, I am of the view that the evidence provided (being made up solely of the mark displayed on various goods) is insufficiently solid and is not capable of pointing to genuine use of the opponent's mark for any of the

⁶ Pages 208 and 209 of Exhibit EA10

⁷ Exhibit EA02

⁸ Exhibit EA03

goods at issue. As a result, the opponent has failed to provide proof of use for its mark and, therefore, it is not permitted to rely on it as the basis of its 5(2)(b) opposition. Given that this is the only mark relied upon under this ground, the opponent's reliance upon the 5(2)(b) ground fails in its entirety.

26. I will now move to consider the 5(3) ground.

Section 5(3)

27. Section 5(3) of the Act states:

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

28. The relevant case law can be found in the following judgments of the Court of Justice of the European Union (“CJEU”): Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a

characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

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

29. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the opponent must also show that its mark has achieved a level of knowledge, or reputation, amongst a significant part of the public. The opponent must also establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

30. The relevant date for the assessment under the section 5(3) ground is the date of the application at issue, being 12 October 2020.

Reputation

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

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

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

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

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

32. As I have set out above, this opposition is being decided on the basis of the law, as it stood, prior to IP Completion Day, being 31 December 2020. This means that, as the opponent's mark is EUTM, the relevant territory is the European Community and the trade mark must have a reputation in a substantial part of that territory. On this point, I bear in mind that a territory of a Member State of the EU may be considered a substantial part of the territory of the Community⁹ and that the UK (As a Member State prior to IP Completion Day) can, therefore, be regarded as a substantial part of the Community with or without the addition of evidence of reputation in other territories.¹⁰

33. Under the 5(3) ground, the opponent relies on the word only mark 'MOTOGP' and relies upon those services listed at paragraph 4 above. For the sake of completeness, those services are as follows:

⁹ *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07

¹⁰ *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC)

Class 41: Organisation of events and cultural and sporting activities, education; providing of training; entertainment; organisation of trade fairs and exhibitions for cultural, sporting and educational purposes; production of audiovisual recordings; publication of books and texts, other than publicity texts; arranging and conducting of competitions, colloquiums, conferences and congresses; providing museum facilities (presentation, exhibitions); production and presentation of live performances, sports broadcasts; academies; motorcycling school; sports club services; teaching of sports using instructors and trained staff; theme parks and rides; holiday camps; providing casino facilities (gambling); organization of sports competitions; discotheques; use and rental of golf course facilities, speed circuits and sports installations of all kinds; providing cinema and games facilities.

34. As set out above, the applicant's proof of use request also applies to the mark relied upon under the 5(3) ground. I am of the view that this issue can be addressed relatively briefly.

35. In order for an opposition under section 5(3) of the Act to succeed, any mark relied upon must be found to enjoy a reputation in respect of at least some of the goods and services relied on. Any reputation that exists in the opponent's mark is as a result of the use made of it by the opponent. I remind myself that the test for establishing a reputation is more rigorous than the proof of use requirements (which are set out in full above). If I go on to find that the opponent's mark enjoys a reputation in at least some of the services relied upon, it follows that there has been genuine use of the same. I do not consider this to be a controversial approach on the basis that the relevant period for proof of use spans from 13 October 2015 to 12 October 2020 and the majority of the evidence provided in relation to the services of the opponent is from between 2018 and 2020. Alternatively, if no such reputation exists, the fact that there may or may not have been genuine use of the

mark is of no consequence and the ground will fail on the basis that no reputation exists.

36. The opponent's evidence sets out that, since 1991, it has been the organiser of the FIM Road Roving World Championship Grand Prix, also known as the MotoGP. In addition, the opponent is the exclusive commercial and television rights holder of the event. The opponent has provided a Wikipedia print-out¹¹ that sets out that 'MotoGP' is the premier class of motorcycle road racing event that is held on road circuits and is sanctioned by the Fédération Internationale de Motocyclisme ("FIM"). While the FIM races have been held since 1929, the current top division has been known as 'MotoGP' since 2002. I note that this information comes from a Wikipedia article dated after the relevant date, however, I have no reason to doubt the accuracy or relevance of its historical content. Further, the applicant has not sought to raise any challenge to the accuracy of this evidence.

37. The opponent has provided information regarding the racing events by way of a number of yearly reviews.¹² These reviews include information such as data from the World Championships, the locations of the events, attendees at the races and information with regard to television viewership of the same. I note that the information in these reviews is in relation to the global audience, such as, for example, the amount of countries the events reach via television (207 in 2018 and 'more than 200' in both 2019 and 2020) and global followers/fans on social media.

38. In terms of attendees at the races, the evidence provides figures for these, however, these figures are not broken down specifically to EU or UK numbers but are, instead, broken down to the attendees at the 'circuit' at which the race took place. The issue with this is that only the name of the Grand Prix itself and the circuit names are given so it is not immediately clear where some of the circuits are located. I appreciate that some Grand Prix names are named after the country where they took place, such as 'Grand Prix of Qatar' and 'Gran Premio Red Bull de Espana'. However, some do not, such as 'Motul TT Assen'. Where it is possible for

¹¹ Exhibit EA04

¹² Exhibit EA02

me to decipher whether the event took place in the UK or the EU, then I will consider those figures, however, where the events are outside the UK or EU or where it is not clear where they are located, I will not consider them. I note that the figures are as follows:

- a. The Spanish Grand Prix had 144,771 attendees in 2018 and 151,513 in 2019;
- b. The Barcelona Grand Prix had 155,401 attendees in 2018 and 157,827 in 2019;
- c. The Czech Republic Grand Prix had 187,348 attendees in 2018 and 186,793 in 2019;
- d. The Austrian Grand Prix had 206,746 attendees in 2018 and 197,315 in 2019;
- e. The French Grand Prix had 206,617 attendees in 2018 and 206,323 in 2019;
- f. The Italian Grand Prix had 150,129 attendees in 2018 and 139,329 in 2019;
- g. The German Grand Prix had 193,355 attendees in 2018 and 201,162 in 2019;
and
- h. The UK Grand Prix had 125,434 attendees in 2018 and 114,607 in 2019.

39. While a report for 2020 is provided, it contains no breakdown of attendees at the racing events.

40. Turning now to consider the television viewership figures, I note that the yearly reports for 2018, 2019 and 2020 all say what television channel the events were broadcast on. For the UK, the events were broadcast on Sky, BT Sport and Channel 5. There are a number of additional channels referenced from outside the UK such as Eurosport in France, Germany, Benelux and Romania, TV8 in Italy and TDP in Spain, amongst others. As for viewership figures, the only information available pertains to Sweden, Switzerland and the UK. I do not intend to reproduce this in full as it has the individual viewership figures for the qualifying practices, the race itself, highlights, sport programmes and news programmes for each of the 19 races held. That being said, I note that the viewing figures from 2018 for all of the races themselves is well in excess of 10,000,000 viewers whereas the highlight shows attracted an excess of 30,000,000 viewers for the entire season. Having reviewed the figures for 2019 also, it appears that the viewing figures are roughly the same as 2018. As for the 2020 report, no such figures are provided.

41. A number of press articles from both UK and international press are provided.¹³ Of the UK press articles, some are dated after the relevant date, however, the majority of them are dated between 22 August 2017 and 25 August 2019. I will not reproduce their content in full but note that they are mostly previews, recaps and discussions surrounding the MotoGP UK Grand Prix. Some of the publications are more specialist motorcycle magazines but I note some are extracts from UK-wide publications such as BBC News, i, The Sun, Sunday Mirror, Sunday Express and The Times. As for the international press coverage, this is extensive and spans over 100 pages and includes articles from a wide variety of locations such as America, Europe and Asia. While the European publications may be relevant to the issue of there being a reputation, the evidence from outside of the EU is not. On this point, I have no evidence to suggest that either UK or EU consumers accessed, or had access to, the international articles. Therefore, I do not consider that they are relevant to the present proceedings.

42. The evidence is clear in that the opponent, under its MotoGP branding, operates a global motorbike racing championship. I also note that the evidence confirms that the opponent itself operates the media production aspect of the races. For example, it provides coverage of each Grand Prix throughout the season from the production to the distribution of the same. Further, it states that, for each Grand Prix, it produces over 18 hours of live programming as well as fully producing the daily news and highlight feeds which is distributed after the final session of each race.¹⁴

43. While the viewing and attendee figures are significant, my main issue with the evidence is that it only provides figures for two years, being 2018 and 2019. Any use evidenced by the opponent is, therefore, not particularly longstanding. In the present circumstances, I do not consider that this is an issue that is fatal to the opponent's case. For example, the evidence confirms that the 'MotoGP' race circuit has been in operation since 2002 and, on this basis, I consider it reasonable to

¹³ Exhibits EA06, EA07 and EA08

¹⁴ Page 53 of Exhibit EA02

infer that the activities of the opponent were somewhat longstanding prior to 2018. Further, the size of the figures for the 2018 and 2019 seasons indicate the existence of a significant fan base that would not, in my view, have simply occurred overnight. While the fanbase is unlikely to have been as large for the entire duration of the opponent's activities since 2002 (for the early years of the events, for example), it is reasonable to infer that it has been significant for at least a number of years prior to 2018. On this point, I consider it necessary to discuss the fact that no figures for 2020 have been provided. Firstly, I note that the evidence sets out that the British Grand Prix was cancelled as a result of the COVID-19 pandemic¹⁵ meaning that there would have been no in-person events in the UK in 2020. Secondly, I note the presence of a 2020 yearly review which, while not showing any viewing or attendee figures, does point toward an ongoing operation of the organisation, production and broadcast of races. For example, I note that it confirms that, during that year, live coverage of races was provided to over 200 countries.¹⁶ While there is no cogent evidence of views or attendees in 2020, I consider it reasonable to infer that a similar level of significant views and attendees (where in-person events were permitted during the ongoing COVID-19 pandemic) would have continued to exist.

44. Taking the evidence as a whole, I am satisfied that it points to the opponent enjoying a fairly sizable reputation within the UK and across the EU as at the relevant date. While that may be the case for some services, I do not consider that the evidence points towards there being a reputation in the opponent's mark for all of the services relied upon. As a result, I will make an assessment in respect of each of the services at issue.

45. As above, I accept that the opponent organises a series of motorcycle races, which are sporting events. However, I do not consider that any reputation stemming from the organisation of these races covers the term "organisation of events and cultural and sporting activities" as a whole. Firstly, I do not consider that a motorcycle race is a cultural activity. Secondly, while it is a sporting activity, this is the only type of sporting activity the opponent organises so it is not appropriate to consider that the

¹⁵ Paragraph 8 of the witness statement of Enrique Aldama Orozco

¹⁶ Page 51 of Exhibit EAO2

reputation extends to sporting activities as a whole. Instead, the reputation shown by the evidence is in the service, “organisation of events and sporting activities, namely motorbike races”. On this point, I note that the same outcome applies to the terms “organization of sports competitions” and “arranging and conducting of competitions” meaning that any reputation in these services is limited to “organization of sports competitions, namely motorbike races” and “arranging and conducting of competitions, namely motorbike races”, respectively

46. As for “organisation of trade fairs and exhibitions for cultural, sporting and educational purposes”, I do not consider that the evidence points to use of the services as a whole. There is nothing that demonstrates any operations of a trade fair for any purposes. As for sporting exhibitions, I make the same finding here as I have above in that this should be limited to motorbike races meaning that the reputation would only extend to “organisation of exhibitions for sporting purposes, namely motorbike races”.

47. I have set out above that the evidence points to the broadcasting and production of the events of the opponent being provided for by the opponent itself. Given the size of the audience for these productions and broadcasts and the range of nationwide television broadcasters across the EU that show the opponent’s events, I am satisfied that the opponent also enjoys a reputation in “production of audiovisual recordings” and “production and presentation of sports broadcasts”. However, as with those services I have already discussed above, the evidence only points to use of these services specifically in relation to motorbike races. Therefore, I consider that any reputation lying in these services is limited to “production of audiovisual recordings, namely in relation to motorbike race broadcasts” and “production and presentation of motorbike race broadcasts”.

48. While I appreciate that the services discussed at paragraph 47 above are types of entertainment services, I am of the view that the evidence is insufficient to point towards a reputation in the term “entertainment” at large. This is on the basis that the evidence shows that the only entertainment services that the opponent undertakes are the production and broadcasting services in relation to the motorbike races it operates. Any reputation in “entertainment” as a whole will be

limited to those types of services already provided for at paragraph 47 above. On that basis, I do not consider it necessary to assess this term in any further detail.

49. Having considered the evidence in full, I am of the view that there is nothing in the evidence whatsoever that points towards a reputation in the following services:

Education; providing of training; organisation of trade fairs and exhibitions for cultural [...] and educational purposes; publication of books and texts, other than publicity texts; arranging and conducting of [...] colloquiums, conferences and congresses; providing museum facilities (presentation, exhibitions); production and presentation of live performances, academies; motorcycling school; sports club services; teaching of sports using instructors and trained staff; theme parks and rides; holiday camps; providing casino facilities (gambling); discotheques; use and rental of golf course facilities; providing cinema and games facilities.

50. To conclude, I consider that the opponent enjoys a fairly sizable reputation in the following services:


Class 41: Organisation of events and sporting activities, namely motorbike races; organization of sports competitions, namely motorbike races; arranging and conducting of competitions, namely motorbike races; organisation of exhibitions for sporting purposes, namely motorbike races; production of audiovisual recordings, namely in relation to motorbike race broadcasts; production and presentation of motorbike race broadcasts.

Link

51. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

52. The marks at issue are as follows:

The opponent's mark	The applicant's mark
MOTOGP	

53. The opponent's mark is a word only mark displayed in upper case letters. The overall impression of the mark lies in the word itself. The applicant's mark is a figurative word mark consisting of the word 'motogb' with the letters 'moto' being displayed in a standard silver typeface with the letters 'gb' being displayed in the same typeface and presented in the colours of the Union Jack. The word is displayed on a black square background. The overall impression of the applicant's mark is dominated by the word 'motogb' with the colour element playing a lesser role. In my view, the use of a black square as a background will be seen as banal and is, therefore, likely to be overlooked.

54. Visually, the marks are each dominated by a six letter word, of which, the first five letters are the same with only the last letter being different. While the words are displayed in different typefaces and case, the opponent's mark is registered as a word only mark meaning that it may be used in any standard typeface and in any case, be that upper, lower or any customary combination of the two. As a result, I consider that the opponent's mark may be used in the same typeface (or at least one highly similar) to that of the applicant's mark. As a black and white mark, the opponent's mark is capable of being used in any colour, however, while I am of the view that this extends to the silver used in the letters 'moto' in the applicant's mark, it does not extend to contrived colour splits like the one used in the letters 'gb' in

the applicant's mark. Taking all of this into account, I am of the view that the marks are visually similar to a high degree.

55. Aurally, the opponent's mark consists of four syllables that will be pronounced as 'MOE-TOE-GEE-PEE' whereas the applicant's mark, also consisting of four syllables, will be pronounced 'MOE-TOE-GEE-BEE'. The first three syllables are identical and while the same cannot be said for the marks' last syllables, they still share a similar sound in that they are both pronounced with a 'long e' sound. Overall, I consider that the marks are aurally similar to a very high degree.

56. I am of the view that the average consumer, when confronted with both marks, will break them down into two elements, being 'MOTO' and 'GP' for the opponent's mark and 'MOTO' and 'GB' for the applicant's mark. 'MOTO' will, in my view, be understood as a reference to 'motor vehicle'. This will apply to both marks. As for the letters 'GP' in the opponent's mark, I am of the view that, in the context of the mark as a whole (being a reference to motor vehicles), this will be understood as standing for 'Grand Prix'. Turning to the letters 'GB' in the applicant's mark, this will be understood as standing for 'Great Britain', particularly given the use of the Union Jack flag in the colour scheme for those letters. Overall, the concept conveyed by 'MOTO' in both marks is identical, however, the letters 'GP' and 'GB' convey different meanings. Taking into account the points of difference, I am of the view that the shared concept of motor vehicles across both marks is sufficient to warrant a finding that the marks are conceptually similar to a medium degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

57. The services for which I have found the opponent to enjoy a reputation in are set out at paragraph 50 above. These are class 41 services. I remind myself that the applicant's goods are as follows:

"Motorized scooters; Motors and engines for land vehicles; Motors for automobiles; Motors for motorcycles; Motorscooters; Scooters; Scooters [for

transportation]; Scooters [vehicles]; Mopeds; Motor cycles; Motor scooters; Motor vehicle bodies; Motor vehicles; Motorbicycles; Motorbikes; Motorcycle engines; Motorcycle frames; Motorcycle handlebars; Motorcycle swing arms; Motorcycle tires; Motorcycles; Motorcycles for motocross; Electric bicycles; Electric engines for land vehicles; Electric motor cycles; Electric motors for land vehicles; Electric vehicles; Electrically operated vehicles.”

58. In comparing the goods and services, I bear in mind the relevant factors that were set out in the cases of *Canon*, Case C-39/97 and *Treat*, [1996] R.P.C. 281. These include consideration as to whether there is any overlap in the nature, intended purpose, method of use, users and trade channels of the goods and services and also whether they are in competition or complementary. Having considered these factors, I do not consider that the organisation of racing events or competitions, the production and presentation of racing broadcasts in the opponent’s specification share any overlap with the range of goods in the applicant’s specification. While the races that the opponent organises/broadcasts may be races involving motorbikes, being goods in the applicant’s specification, this alone is not sufficient to give rise to a level of similarity. For example, the nature, method of use and purpose of the goods and services all differ. As for trade channels, it may be that motorbike producers may wish to organise races, however, I have no evidence to suggest that this is common in the trade. Lastly, while a motorbike is likely to be important and/or indispensable to the organisation of a motorbike race, I do not consider that the average consumer will consider that such goods and services emanate from the same undertaking. It is, in my view, a common understanding that motorbike manufacturers are not the ones organising the race, or vice versa. Lastly, I accept that there may be some overlap in users on the basis that someone who buys the applicant’s class 12 goods, being members of the general public, are also likely to be the end consumers who watch the motorcycle races organised, produced and broadcast by the opponent. However, such an overlap is, in my view, superficial on the basis that the average consumer base is so broad. Without anything further, this overlap in user is not sufficient to give rise to a finding of similarity between the goods and services. Therefore, I find that the parties’ goods and services are dissimilar.

59. In respect of the distance between the goods and services, I am of the view that the applicant's term "electric bicycles" is different to the opponent's services to the point where the goods and services are significantly distant from one another. This is because electric bicycles are bicycles that have been adapted with an electric motor. I fail to see how the average consumers of either parties' goods and services would consider them to share any degree of closeness.

60. I turn now to consider the degree of closeness between the opponent's services and the remaining goods in the applicant's specification. I note that the applicant's goods are all motor vehicles or parts and fittings thereof and all of these can include motorbikes (either specifically or through encapsulation of a broader term, such as "motor vehicles" or "motors and engines for land vehicles", for example). The opponent's services are for organisation and production/broadcast services surrounding motorbike races. While these are all dissimilar, the fact they all consist of terms that relate to motorbikes means that they are not entirely distant from each other and, as a result, I consider that there is some degree of closeness between them. I make this finding on the basis that motorbike races will undoubtedly feature motorbikes within them. It is, therefore, plausible that a member of the general public who purchases the applicant's goods and, ultimately, is the end consumer watching the opponent's services will be confronted with various motorbike brands during the television production, for example. While I am conscious not to assume my own understanding is more widespread than it is, I do not consider it a point of serious dispute to suggest that motorsports are commonly entered by racers who are backed and supported by different vehicle manufacturers.¹⁷ This is a fact that is commonly understood by the relevant public that views such races, with various marks belonging to those manufacturers frequently featuring on television broadcasts or at in-person events. As a result, it is entirely plausible to suggest that the race events organised by the opponent may feature the applicant's goods and while the average consumer will understand the difference between the goods and the services at issue, this results in a degree of closeness between them.

¹⁷ *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08

The strength of the earlier mark's reputation

61. I have found that the opponent enjoys a fairly sizable reputation across a significant part of the relevant public.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

62. Inherently, I consider that the opponent's mark is not particularly distinctive. This is on the basis that, as I have set out above, 'MOTO' will be understood as a reference to 'motor vehicles' and 'GP' will be understood as 'Grand Prix'. While it is my understanding that this is a French term, it is one that is widely understood by the average consumer in the UK as being a motor vehicle race. In the context of the services for which the opponent enjoys a reputation, 'motor vehicles' will be understood as being motorbikes and the opponent's mark will, as a whole, be understood as a reference to a motorbike race. Given the services for which the reputation exists, the opponent's mark is only distinctive to a low degree.

63. Turning now to consider the position in respect of distinctiveness through use, I have summarised the relevant evidence above. In assessing the evidence as a whole and following the same reasoning discussed at paragraphs 36 to 44 above, I have no hesitation in finding that the use shown is sufficient to enhance the distinctive character of the opponent's mark in relation to the services for which a reputation has been found. That being said, I consider that due to the fact that the inherent level of distinctiveness is low, the evidence is only sufficient to enhance the distinctiveness of the mark to a medium degree.

Whether there is a likelihood of confusion

64. In respect of there being a likelihood of confusion between the marks, I am reminded by the case of *eSure Insurance v Direct Line Insurance*¹⁸ wherein Lady

¹⁸ [2008] ETMR 77 CA

Justice Arden set out that if there is no level of similarity between goods and services, there is no likelihood of confusion to be considered. This means that, in the present case, the goods and services being dissimilar means that there can be no likelihood of confusion between the marks.

65. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's mark to mind when confronted with the applicant's mark, thereby creating the necessary link. Even though I have found there to be no likelihood of confusion, this does not preclude me from finding the necessary link between the marks. In making this assessment, I have particular regard to the fact that the goods and services are dissimilar. However, as above, there is no need for the goods and services to be similar as their relative distance is a factor. On this point, I note that, for the reasons discussed at paragraph 60 above, there is some degree of closeness between the goods and services due to each parties' close associations with motorbikes, be that in their manufacture or organisation of races involving them. While the degree of closeness is not particularly strong, it is an important factor, especially when combined with the fairly sizable reputation of the opponent, the similarities between the marks at issue and the distinctiveness of the opponent's mark which, while not high, has still been enhanced through use. Overall, I am satisfied that use of the applicant's mark is liable to bring the opponent's mark to mind, thereby creating the necessary link between them by at least a significant part of the relevant public in the UK. Having said that, for the reasons discussed at paragraph 59, I do not consider that the link applies to "electric bicycles" on the basis that there is no degree of closeness between that term and the opponent's services. Therefore, the opposition against "electric bicycles" under 5(3) fails.

Damage

66. The opponent has pleaded that use of the applicant's mark would take unfair advantage of the reputation of its marks, that it would, without due cause, prove to be detrimental to the reputation of the opponent and the distinctive character of the opponent's mark. I will begin with unfair advantage.

Unfair Advantage

67. I bear in mind that unfair advantage has no effect on the consumers of the opponent's marks' goods and services. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

68. I have found above that the opponent has demonstrated that its marks have obtained a reputation for various services in class 41, being those reproduced at paragraph 50. This is, in my view, the sort of reputation that would result in the applicant's mark benefiting from an enhanced level of recognition due to the link between the marks in the minds of the relevant public. In my view, the similarity of the parties' marks are sufficient to result in an unfair advantage being taken of the opponent's marks' reputation. While I appreciate that the goods and services are dissimilar, their degree of closeness will overcome this issue. In my view, using a mark that is visually similar to a high degree and aurally similar to a very high degree with that of the opponent, the applicant would achieve instant familiarity in

the eyes of average consumers, thereby securing a commercial advantage and benefitting from the opponent's reputation without paying financial compensation. I consider that this is particularly the case given that the opponent's reputation lies in the organisation and production/broadcast of motorbike races and that the applicant's mark will be viewed on a range of motorbikes (or parts and fittings of the same). In my view, when an average consumer is confronted by the applicant's mark, the link to the reputed mark of the opponent would result in the aforesaid commercial advantage to the applicant on the basis that the consumer will believe that the applicant's mark is associated with the reputed services of the opponent. Such commercial advantage would not exist were it not for the reputation of the opponent's mark. Lastly, the opponent's mark conveys an image associated with high speed racing which is, in my view, an attractive image for motorbike manufacturers and one that they would readily pursue. By using a similar mark to that of the opponent, I am of the view that the applicant is likely to benefit from the transfer of this image in the minds of the average consumer. This beneficial transfer of image would not exist were it not for the reputation of the opponent. Taking all of the above into account, I find it likely that the applicant's mark takes unfair advantage of the opponent's mark.

69. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. I will now move to consider the opponent's 5(4)(a) ground.

Section 5(4)(a)

70. Section 5(4)(a) of the Act reads as follows:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

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

71. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

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

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

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

73. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

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

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

Relevant Date

74. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander K.C., as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

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

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

75. The applicant’s mark does not have a priority date, and neither is there any evidence of use of the applicant’s mark that is capable of pointing towards the beginning of the behaviour complained of. Therefore, the relevant date for assessment of the opponent’s claim under section 5(4)(a) of the Act is the date of the application for registration, being 12 October 2020.

Goodwill

76. The first hurdle for the opponent is that it needs to show that it had the necessary goodwill in its sign at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

77. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the

prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

78. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

79. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not

acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

80. I remind myself that under its 5(4)(a) ground, the opponent relies on the unregistered sign ‘MOTOGP’ for the following goods and services:

“Vehicles; Parts and accessories for vehicles in this class; Motorcycles; Motorbikes; Mopeds; Scooters [vehicles].

Organisation of events and cultural and sporting activities, education; providing of training; entertainment; organisation of trade fairs and exhibitions for cultural, sporting and educational purposes; production of audiovisual recordings; publication of books and texts, other than publicity texts; arranging and conducting of competitions, colloquiums, conferences and congresses; providing museum facilities (presentation, exhibitions); production and presentation of live performances, sports broadcasts; academies; motorcycling school; sports club services; teaching of sports using instructors and trained staff; theme parks and rides; holiday camps; providing casino facilities (gambling); organization of sports competitions; discotheques; use and rental of golf course facilities, speed circuits and sports installations of all kinds; providing cinema and games facilities.”

81. The goods listed above are some of the goods upon which the opponent sought to rely on under its 5(2)(b) ground. In my evidence summary at paragraphs 23 to 25 above, I found that the opponent had not shown use for any of these goods. Goodwill arises as a result of trading activities and given that the evidence does not point to any trading activities in respect of these goods, there can be no goodwill. Therefore, the opponent’s reliance upon these goods is of no assistance to its 5(4)(a) claim.

82. As for the services, those relied upon under the present ground are identical to those relied upon under the 5(3) ground. I have discussed the evidence in relation to these services in detail at paragraphs 36 to 49 above. For the same reasons

discussed under that assessment, the evidence only points to use of the following services:

“Organisation of events and sporting activities, namely motorbike races; organization of sports competitions, namely motorbike races; arranging and conducting of competitions, namely motorbike races; organisation of exhibitions for sporting purposes, namely motorbike races; production of audiovisual recordings, namely in relation to motorbike race broadcasts; production and presentation of motorbike race broadcasts.”

83. While my reasoning set out at paragraph 36 to 49 above discussed the issue of reputation, I am satisfied that the same reasoning applies here and am content to find that that the opponent’s business has obtained a protectable level of goodwill in its business for those services listed above and that the opponent’s sign is associated with or distinctive of that business. I am of the view that the goodwill in the opponent’s business is fairly large. The opponent’s 5(4)(a) ground may proceed in respect of those services only.

Misrepresentation and damage

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

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

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

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville*

Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

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

85. I am reminded of the case of *Marks and Spencer PLC v Interflora*¹⁹ wherein Lewison L.J. found that although the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely that the difference between the legal tests will produce different outcomes. While the 5(2)(b) ground did not require an assessment of likelihood of confusion, the 5(3) ground did. Under that ground I found there to be no likelihood of confusion on the basis that the goods and services at issue are dissimilar. While the same could be said to apply here, I am reminded of the case of *Harrods Limited v Harrodian School Limited*²⁰ which set out that it is not essential under the law of passing off for the parties to be engaged in the same fields of business activity. However, I also note the case of *Stringfellow v. McCain Foods (G.B.) Ltd*²¹ wherein Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that:

¹⁹ [2012] EWCA (Civ) 1501

²⁰ [1996] RPC 697 (CA).

²¹ [1984] R.P.C. 501

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

86. In the same case Stephenson L.J. said at page 547:

“...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.”

87. While I appreciate that both the opponent and applicant are involved in motorbikes, one party is involved in production of the motorbikes themselves whereas the other is involved the organisation, production and broadcasting of motorbike races. The fact that both involve motorbikes does not mean that the parties operate in the same field of business activity. Taking this into account and even acknowledging that the opponent enjoys a fairly strong level of goodwill in its business, I do not consider that the opponent is able to overcome the heavy burden imposed upon it in the case law cited above. On this point, I am unconvinced that there is clear and cogent proof of there being a misrepresentation resulting from use of the applicant's mark on the goods at issue. As a result, I do not consider that there is misrepresentation and the opponent's reliance upon the 5(4)(a) ground fails in its entirety.

CONCLUSION

88. The opposition has succeeded under the 5(3) ground in respect of all but one of the goods against which it was aimed. The application is hereby refused for the following goods:

Class 12: Motorized scooters; Motors and engines for land vehicles; Motors for automobiles; Motors for motorcycles; Motorscooters; Scooters; Scooters [for transportation]; Scooters [vehicles]; Mopeds; Motor cycles; Motor scooters; Motor vehicle bodies; Motor vehicles; Motorbicycles; Motorbikes; Motorcycle engines; Motorcycle frames; Motorcycle handlebars; Motorcycle swing arms; Motorcycle tires; Motorcycles; Motorcycles for motocross; Electric engines for land vehicles; Electric motor cycles; Electric motors for land vehicles; Electric vehicles; Electrically operated vehicles.

89. The application may, however, proceed to registration for the following good, being the good against which the opposition was unsuccessful:

Class 12: Electric bicycles

COSTS

90. As the opponent has enjoyed a greater degree of success, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. However, given that the applicant has successfully defended one good, I consider it sufficient to warrant a £50 reduction of the cost award. In the circumstances, I award the opponent the sum of **£850** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and reviewing the counterstatement:	£200
Preparing evidence:	£500
Official Fees:	£200
<u>Sub-Total</u>	<u>£900</u>
<i>Reduction</i>	<i>-£50</i>
Total	£850

91. I therefore order Moto GB Limited to pay DORNA SPORTS, S.L. the sum of £850. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 5th day of October 2022

A COOPER
For the Registrar