

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2005555 BY  
EMAP NATIONAL PUBLICATIONS LTD TO REGISTER A MARK  
IN CLASS 16**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 44641  
BY ROVER GROUP LIMITED**

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BY ROVER GROUP LIMITED**

**BACKGROUND**

On 17 December 1994, EMAP National Publications Ltd applied to register the following mark in Class 16:

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LANDROVER  
OWNER  
INTERNATIONAL

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The application was examined and was subsequently accepted and published on the basis of honest concurrent use for a specification of goods which read:

“Magazines and periodical publications”.

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On 24 May 1996 Rover Group Limited filed notice of opposition. The grounds of opposition are, in summary:

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(a) under sections 1(1) and 3(1) of the Act, because the opponent and their predecessors have for many years made significant use of the trade mark LAND ROVER in relation to the sale or supply of the goods covered by the application in suit and other similar or related goods and services, to the extent that the application does not consist of a sign which is capable of distinguishing goods or services of one undertaking from those of other undertakings;

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(b) under section 3(3) of the Act, as, given the use made by the opponent of the mark LAND ROVER, the mark the subject of the application is of such a nature as to deceive the public for instance as to the nature, quality or geographical origin of the goods;

(c) under section 5(4) of the Act to the extent that the use of the application is liable to be prevented by the law of passing off. Although not particularised, given the reference to passing off, this is clearly intended as an objection under section 5(4)(a) of the Act;

5 (d) under section 6(1)(c) and (by implication) section 56 of the Act, as the opponent's mark LAND ROVER is entitled to protection under the Paris Convention as a well known trade mark;

10 (e) under section 5 of the Act, because the application in suit is similar to a number of registered trade marks which are owned by the opponent and which are registered for similar goods or services. In the alternative, that the application in suit is similar to a number of registered trade marks owned by the opponent which are registered for goods and services which are not similar to the application in suit. The opponent says that use by the applicant on such dissimilar goods would without due cause take unfair advantage of or be detrimental to the distinctive character or the repute of the opponents earlier registered marks. Although not particularised, given that the opponent does not own a mark identical to the application in suit and in view of the wording of the various objections, I have taken them as referring to sections 5(2) and 5(3) of the Act;

20 (f) under section 3(6) of the Act on the grounds that the application was made in bad faith; and

25 (g) under section 7 of the Act, in that the applicant's use of the trade mark has always been subject to the opponent's license and as such, the use made of the mark does not constitute honest concurrent use within the meaning of the section.

The applicant filed a counterstatement in which the grounds of opposition are either denied or not admitted. They add that the applicant and their predecessor has made substantial and continuous use of the mark on magazines and periodical publications in the United Kingdom since 1987 and as such have built up a substantial goodwill and reputation of their own.

Both sides ask for the Registrar to award costs in their favour. Both sides filed evidence. Neither side has asked for a hearing. Acting on behalf of the Registrar and after a careful study of the papers, I give this decision.

### **OPPONENT'S EVIDENCE**

40 This consists of a statutory declaration dated 11 February 1998 by Philip Cooper. Mr Cooper explains that he is the Head of Trade Marks at Rover Group Limited, a position which he has held for the last five years. He adds that he is authorised to make his declaration on the opponent's behalf and states that the information contained in the declaration is from his own personal knowledge or is derived from the records of the opponent to which he has full access. Mr Cooper's declaration and the twenty four exhibits which accompany it contain details of the creation and development of the LAND ROVER brand name. I do not propose to summarise all of Mr Cooper's declaration, but note that the main facts emerging from it (together with the exhibits which support the various facts) are as follows:

- vehicles sold under the names LAND ROVER and LAND-ROVER were launched at the Amsterdam Motor Show in April 1948 (exhibit PJC1);

5 - a quarter of a million LAND ROVER vehicles had been produced by November 1959, half a million by April 1966 and one million by June 1976. To date over two million LAND ROVER vehicles have been sold worldwide;

10 - sales of vehicles under the LAND ROVER trade mark in the period 1992 to 1996 amounted to some 145,660 vehicles;

15 - in addition to the sale of motor vehicles, the opponent also markets spare parts and accessories for such vehicles together with merchandise such as clothing, luggage watches, pens, books, stationery and other consumer products under the LAND ROVER trade mark. Sales of such spare parts accessories and merchandise sold in and exported from the United Kingdom currently exceeds £130m. The opponent has been selling a range of merchandise under the LAND ROVER trade mark since at least as early as 1984-85 and the extent of the range has expanded over the years (exhibits PJC 10-14B);

20 - the goods mentioned above are sold through a network of franchised dealers (exhibit PJC5A) who also provide repair and maintenance services (exhibit PJC5B);

25 - in the period 1993 to 1996 the opponent spent approximately £13.5m in the United Kingdom advertising vehicles sold under the LAND ROVER trade mark. Further the opponent advertises its business under the LAND ROVER trade mark by the production and distribution of promotional literature to both existing and potential customers (exhibits PJC6A-H) and by promotional activity at various exhibitions including the International Motor Show at the NEC in Birmingham and the London Motor Show;

30 - one example of the type of promotional literature used by the opponent is the newspaper LAND ROVER WORLD which was subsequently renamed LAND ROVER FLEET WORLD. This publication was produced by the opponent's LAND ROVER division from the Spring of 1992 to February 1996 (a copy of a 1995 edition is provided as exhibit PJC7);

35 - the opponent also promotes the LAND ROVER mark by advertising regularly in a range of publications. Copies of both historical and more recent newspaper and magazine advertisements are provided at exhibits PJC8 and PJC9. The LAND ROVER mark is also promoted by means of dealer promotions and television advertisements;

40 - in 1994 the opponent established a formal worldwide licensing programme. To date forty two such licenses have been granted (covering a wide range of disparate goods) with gross royalty income exceeding £300,000. The actual sales figure can, it is said, be obtained by multiplying the aforesaid figure by a factor of ten to fifteen;

45 - the opponent's LAND ROVER vehicles boasts two dedicated magazines which have

an international distribution. These are LAND ROVER WORLD and LAND ROVER OWNER INTERNATIONAL (the latter of which is owned by the applicant and is the application in suit). Copies of the respective magazines are provided at exhibits PJC15 and PJC16. The opponent says that they approve of and support such magazines, as they promote and advertise the LAND ROVER business and support the sales of their vehicles and also because the magazines work closely with the opponent. Mr Cooper adds the following:

*“Indeed, it has always been implicit in the relationship between Rover Group and such Land Rover World and Land Rover Owner International magazines that the latter are published with the permission and licence of Rover Group”.*

- the opponent does from time to time produce and sell books and other publications under the LAND ROVER trade mark (exhibit JPC17);

- other publishers also produce books and like publications about LAND ROVER vehicles (exhibits JPC18 and 19);

- the opponent periodically publishes and sells vehicle handbooks, service and repair manuals and parts catalogues (exhibits PJC20 and 21);

- the opponent is the proprietor of a range of trade mark registrations in Classes 12 and 16 (exhibit PJC22 and 23) and a complete list of the opponent’s trade mark registrations is provided at exhibit PJC24.

## **APPLICANT’S EVIDENCE**

This consists of a statutory declaration dated 15 February 2000 by Christine Lund-Beck. Ms Lund-Beck explains that she is a Trade Mark Attorney in the employ of Urquhart-Dykes & Lord who are the applicant’s agents. Ms Lund-Beck explains that she was responsible for the filing of the application in suit and also for drafting the statutory declaration of Mr Ian Templeton which was filed to support the application at the ex-parte examination stage. A copy of Mr Templeton’s declaration and the associated exhibits are provided as exhibit CLB1. In his declaration Mr Templeton explains that he is the Publishing Director of the applicant company, a position he has held since 1994. The information contained in his declaration comes from his own knowledge or from the records of his company to which he has full access. The main facts emerging from Mr Templeton’s declaration are as follows:

- the applicant is involved in the publishing business and has been so since 1975 and the applicant’s parent company EMAP plc began trading in 1947 as East Midlands Allied Press Limited;

- the trade mark LANDROVER OWNER INTERNATIONAL was first used in the United Kingdom in June 1987 by LRO Publications Ltd. In 1994 the title was purchased by the applicant together with all the goodwill and has been published since 1987;

- the trade mark LANDROVER OWNER INTERNATIONAL has been used on printed publications and printed matter (exhibits IT1 and 2 refer);

5 - wholesale turnover figures in the period 1987 to 1995 are said to be in excess of £7m;

10 - in the period 1988 to 1995 approximately £200,000 has been spent on promoting the mark LANDROVER OWNER INTERNATIONAL. This promotion has taken the form of national advertising in the press and poster advertising campaigns, branded marquees at county shows and other similar events, organisation of off-road motoring events and sale of branded merchandise.

That concludes my review of the evidence in so far as I think it necessary.

## 15 **DECISION**

20 In my view a number of the grounds of opposition relied upon by the opponent are either misconceived or alternatively no evidence has been filed to support them. I will deal with these first. To begin with the grounds of opposition based upon sections 1(1), 3(1) and 3(3) of the Act should relate to objections based on absolute grounds and not to conflicts with an earlier right or rights. It is clear from the wording of the opponent's objections under these various sections that they are relying on their own use and reputation in the mark LAND ROVER. Clearly this type of objection falls to be considered as an objection on relative grounds under section 5 of the Act. As such, the grounds of opposition based on sections 1(1), 3(1), and 3(3) of the Act are dismissed.

30 The opponent also claims that the trade mark LAND ROVER is entitled to protection under the Paris Convention as a well known trade mark under section 6(1)(c) (and by implication section 56 of the Trade Marks Act 1994). However to come within this provision the opponent needs to establish that the mark is well known in the United Kingdom as being the mark of a person who is (a) a national of a Convention country or (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country. A Convention country is defined in section 55(1)(b) of the Trade Marks Act 1994 as a country that is party to the Paris Convention *other than the United Kingdom* (my emphasis). Therefore only trade marks which are owned by proprietors who are domiciled or have a base in a country signatory to the Paris Convention other than the United Kingdom can claim protection under this head. The opponent does not appear to fit into that category. Consequently the opponent cannot claim protection under this provision of the Act and this ground of opposition is also dismissed.

40 Turning to the objection under section 3(6) of the Act.

Section 3(6) states:

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

In asserting that the application was made in bad faith, the onus rests with the opponents to make a prima facie case. A claim that an application was made in bad faith implies some deliberate action by the applicant which a reasonable person would consider to be unacceptable behaviour, or as put by Lindsay J in the *GROMAX* trade mark case [1999] RPC 10:

“includes some dealings which fall short of the standards of acceptable commercial behaviour”.

The opponent has filed no evidence to support this claim and as such this ground of opposition is also dismissed.

The remaining objections are based on sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

Section 5(2)(b) of the Act, reads as follows:

“5.- (2) *A trade mark shall not be registered if because -*

*(a).....*

*(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier mark is protected,*

*there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”*

An earlier right is defined in section 6 of the Act, the relevant part of which states:

“6.- (1) *In this Act an ‘earlier trade mark’ means -*

*(a) a registered trade mark, international trade mark (UK) or Community trade mark 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,*

*(b).....*

*(c).....”*

In deciding this issue I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 8, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 8, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and

observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

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(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 8, paragraph 23;

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(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 8, paragraph 23;

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(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

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(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;

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(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 9, paragraph 26;

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(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41.

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(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

The opponent is the owner of a number of registrations in Class 16 which are registered for specifications of goods which include the goods for which registration is sought. The registered marks consist either exclusively of the words LAND ROVER or include the words LAND ROVER as the essential feature of the mark.

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I do not propose to list all of the opponent's registered trade marks. I do however note (from exhibit PJC23) that registration No: 1559760 (dated 21 January 1994) is for the words LAND ROVER in block capitals in normal typeface and is registered in respect of:

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“ Printed matters, stationery, books, and printed publications; office requisites (other than furniture); instructional and teaching materials (other than apparatus); writing and drawing instruments and materials; drink mats; photographs, stickers, labels, decalcomanias, playing cards, rulers, postcards, bookmarks, paperweights, and book covers; diaries, note books, appointment books, address books, combinations of such goods, and covers therefor; business card holders, cheque book covers; and passport

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covers and holders; folders, holders and covers, all intended for or containing notebooks, notepads, paper, pens, pencils, and/or erasers; road fund and tax disc holders made of plastic film or sheet materials; toilet tissue; towels, napkins, serviettes, mats, coasters, handkerchiefs, tissues, cloths, absorbent wipes, and sanitary and hygienic materials, all made wholly or principally of paper and/or paper derivatives; wrapping and packaging materials; plastic cling film; bags and sack, all made wholly or principally of paper and/or plastic film or sheet materials; disposable covers made wholly or principally of paper or of plastic film or sheet materials; disposable paper carpet protectors; sheet materials made wholly or principally of paper and/or paper derivatives for protecting, preserving and/or for storage purposes; elasticated steering wheel and road wheel protectors (disposable) of polythene or of plastic film or sheet materials; all included in Class 16".

In my view this registration represents the opponent's best case. Given that the applicant's mark consists of the word LANDROVER together with the words OWNER and INTERNATIONAL, I have little hesitation in finding that the respective marks are prima facie confusingly similar, given that in my view the essential element of the applicant's mark is the word LANDROVER. As the goods for which registration is sought are wholly contained with the opponent's registered marks, this would ordinarily mean a finding in favour of the opponent. But in considering the matter globally as I am required to do, I cannot ignore that the applicant has filed honest concurrent use of their mark under the provisions of Section 7(1) of the Act and this is a factor which I need to bear in mind when deciding if in fact there is a likelihood of confusion.

Section 7 of the Act reads as follows:

7. - (1) This section applies where on an application for the registration of a trade mark it appears to the registrar-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purposes of this section "honest concurrent use" means such use in the United Kingdom, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of section 12(2) of the Trade Marks Act 1938.

(4) Nothing in this section affects-

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal), or

5 (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds, where no consent to registration).

(5) This section does not apply when there is an order in force under section 8 below.

10 The provisions of Section 7 of the Act were considered by the Hearing Officer in C.D.S. Computer Design Systems Ltd v Coda Ltd (0-372-00) dated 6 October 2000. In that decision the Hearing Officer said:

15 *“First of all I note that this provision of the Act does not derive from Council Directive No 89/104/EEC of 21 December 1998 to approximate the laws of the Member States relating to trade marks. It is thus a piece of home spun legislation which can only be interpreted as complementing rather than conflicting with the Directive. I say that because Article 5 of the Directive (the equivalent of Section 5 of the Trade Marks Act) requires a trade mark to be excluded from the register if it*  
20 *conflicts with an earlier trade mark or other earlier right. However, the fifth recital to the Directive gives Member States latitude as to the stage at which such relative grounds are to be taken into consideration. The fifth recital states:*

25 *Whereas Member States also remain free to fix the provisions of procedure concerning the registration, the revocation and invalidity of trade marks acquired by registration; whereas they can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or both and, if they*  
30 *allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an ex officio examination procedure or both; whereas Member States remain free to determine the effects of revocation or invalidity of trade marks;*

35 *In relation to all applications for registration under the Act, the Trade Marks Registry must examine them against the provisions of Sections 3 and 5 and undertake a search under the provisions of Section 37 for that purpose. If, and when, as a result of the search an earlier trade mark or earlier right is identified which is considered to be the same or similar in respect of both the trade mark and the specification of goods and*  
40 *services, then the Trade Marks Registry must raise an objection to the application for registration. However, if the applicant is able to show, to the satisfaction of the Trade Marks Registry, that there has been honest concurrent use of the trade mark the*  
45 *subject of the application with the earlier mark, under the provisions of Section 7, and with due regard to the fifth recital, the application may be accepted and published. Where the concurrent use has not been in respect of all of the goods or services for*  
50 *which the application is sought to be registered, the acceptance will be for those goods where there has been honest concurrent use. If there is no opposition to the application for registration either from the owner of the earlier right against which the applicant for registration claims honest concurrent use or any third party, then the application will in due course be registered. However, if opposition is filed then the registrar must determine whether the grounds for refusal upon which the opposition is*

based are made out. If the opposition is based upon Section 5 then the provisions of the appropriate subsections must be considered. The fact that honest concurrent use has been shown at the examination stage cannot overcome the objection.

5 If, for example, the trade mark the subject of the application for registration and the  
trade mark the subject of the earlier right were identical, and the specification of  
goods or services of the application was identical to the specification of the goods or  
10 services covered by the earlier trade mark, then refusal must follow under Section  
5(1), which bars absolutely the registration of identical trade marks in respect of  
identical goods or services (unless the proprietor of the earlier trade mark consents to  
the registration of the later trade mark). But in relation to Section 5(2) the respective  
trade marks or respective specifications of goods or services may only be similar and  
15 the fact that there has been actual use of the trade mark in suit concurrently with the  
earlier trade mark, may be relevant in determining whether there is a likelihood of  
confusion.

20 In the circumstances and for the reasons above I reject Mr Hacon's submission that  
because the proprietor of the earlier trade mark against which the applicant for  
registration has claimed honest concurrent use has opposed the application, the  
provisions of section 7(2) make the refusal mandatory. However, as I have already  
said, the mere fact that there has been honest concurrent use is not a defence, which  
in itself will save an application, but it is one of the "relevant" factors which should  
be taken into account in determining whether there is a likelihood of confusion.

25 From the evidence provided by the opponent it is clear that they were aware of the applicant's  
use of the mark LANDROVER OWNER INTERNATIONAL, indeed copies of the applicant's  
publication were provided by the opponent as exhibit PJC16. Of these publications Mr Cooper  
says (referring also to LAND ROVER WORLD magazine):

30 "These magazines are dedicated exclusively to the vehicles produced by our Land  
Rover division under the trade mark LAND ROVER and no other and use of the trade  
mark LAND ROVER in the titles of these magazines is therefore purely descriptive of  
their nature and character. Our Land Rover Division approves of and supports such  
35 magazines as promoting and advertising our Land Rover Division's business and  
supporting the sale of its vehicles under the trade mark LAND ROVER, and also since  
both such magazines work closely with our Land Rover Division. By this latter means,  
and also since such magazines are read regularly by employees of our Land Rover  
Division in particular and Rover Group in general, including myself, Rover Group  
40 can be assured that such magazines are, and continue to be, of a character and  
quality commensurate with the character and reputation attached to our LAND  
ROVER trade mark and the vehicles sold thereunder. Indeed, it has always been  
implicit in the relationship between Rover Group and such Land Rover World and  
Land Rover Owner International magazines that the latter are published with the  
45 permission and licence of Rover Group".

50 In so far as Mr Cooper comments that it has always been implicit that the applicant's use of the  
mark LANDROVER OWNER INTERNATIONAL has been with the permission and licence  
of Rover Group, no evidence has been filed to support such a contention. The applicant for  
their part can point to their use of the mark since 1987 with turnover under the mark in the  
period 1987 to 1995 amounting to some £7m.

As mentioned above, while the mere fact that there has been honest concurrent use of the application in suit does not constitute a defence which will in itself save the application, it is one of the relevant factors which should be taken into account in determining whether there is a likelihood of confusion. Section 7(3) makes it clear that in the context of the 1994 Trade Marks Act, "*honest concurrent use means such use in the United Kingdom, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of section 12(2) of the Trade Marks Act 1938*". The leading authority on section 12(2) under the 1938 Act was the *PIRIE* case [1933] RPC 147. In that case, Lord Tomlin identified that the main matters to be considered were:

- (i) The extent of use in time and quantity and the area of trade;
- (ii) the degree of confusion likely to ensue from the resemblance of the marks, which is, to a large extent, indicative of the measure of public inconvenience;
- (iii) the honesty of the concurrent use;
- (iv) whether any instances of confusion have been proved; and
- (v) the relative inconvenience which would be caused if the mark in suit was registered, subject if necessary to any conditions and limitations.

I am satisfied that the applicant has used the mark LANDROVER OWNER INTERNATIONAL since June 1987 in relation to the goods covered by the application. From the evidence provided, it appears that by 1993 LANDROVER OWNER INTERNATIONAL was the market leader in the United Kingdom 4x4 magazine market with a monthly print run of over 60,000 copies. Turnover and promotion under the mark in the period 1987 to 1995 amounted to some £7m and £200,000 respectively. No instances of confusion have been brought to my attention and notwithstanding the opponent's claim that the applicant's use of the mark has always been subject to the opponent's licence, no evidence to this effect has been provided. In the circumstances and given the opponent's positive endorsement of the magazine, I have no reason to doubt that the use of the mark by the applicant has been anything other than honest and of no inconvenience to the public at large. Nor would the Rover Group be inconvenienced as they have actively supported the publication in the past. Taking all the relevant factors into account, I have come to the conclusion that the likelihood of confusion has not been proven and as such the opposition based on section 5(2)(b) of the Act is dismissed.

I turn now to consider the ground of opposition based on section 5(3) of the Act.

Section 5(3) of the Act reads as follows:

5.(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
  - (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,
- shall not be registered if, or to the extent that, the earlier trade mark has a reputation

in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

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Here again I do not propose to list all of the opponent's registered marks but note (from exhibit PJC22) that the opponent owns registration No: 663199 (dated 11 October 1947) for the words LAND ROVER in block capitals in normal typeface and which is registered in respect of:

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“Land motor-vehicles and parts thereof included in Class 12”.

It is clear from the above that this mark is registered for goods which are dissimilar to the application in suit. From the evidence provided by the opponent I am satisfied that the opponent has a reputation for these dissimilar goods within the United Kingdom. The relevant cases in relation to section 5(3) of the Act are: *Sabel v Puma* [1998] RPC 199, *Premier Brands Ltd v Typhoon Europe Ltd* [2000] 23(5) IPD 23038, *Corgi* trade mark [1999] RPC 549 and *CA Sheimer (M) SDN BHD's* trade mark (the VISA trade mark) [2000] RPC 484. These cases establish that in considering matters under this head there is no need to establish likelihood of confusion. What has to be determined is that use by the applicant of the trade mark in suit is without due cause and could be termed parasitic, or in some way effect the distinctive character of the opponent's trade marks. In the event, no such evidence has been provided by the opponent. In fact evidence has been provided by the opponent to the effect that they both approve of and support the applicant's magazine. In his statutory declaration Mr Cooper says:

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*“ Our Land Rover Division approves of and supports such magazines as promoting and advertising our Land Rover Division's business and supporting the sale of its vehicles under the trade mark LAND ROVER, and also since both such magazines work closely with our Land Rover Division. By this latter means, and also since such magazines are read regularly by employees of our Land Rover Division in particular and Rover Group in general, including myself, Rover Group can be assured that such magazines are, and continue to be, of a character and quality commensurate with the character and reputation attached to our LAND ROVER trade mark and the vehicles sold thereunder”.*

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In view of the above, I do not see how the use of the mark LANDROVER OWNER INTERNATIONAL by the applicant will be detrimental to the opponent and indeed one could argue that the applicant's use of the mark has actually benefited the opponent. Consequently the opposition based on section 5(3) of the Act is dismissed.

40

The final ground of opposition is based on section 5(4)(a) of the Act.

Section 5(4)(a) reads as follows:

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5. (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, or

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(b) .....

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

5

The necessary elements of an action for passing off in terms of goodwill, misrepresentation and damage, were set out by Geoffrey Hobbs QC in *WILD CHILD* trade mark [1998] RPC 455. I do not propose to repeat the very full guidance provided but it can be found in that decision commencing at page 460 line 5 to page 461 line 22.

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In brief the necessary elements are said to be as follows:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

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While it is clear from my evidence summary above that the opponent has a considerable reputation in their LAND ROVER trade mark in relation to motor land vehicles, their involvement in the publication of instructional and promotional literature is in my view principally as an adjunct to their core business of trading in motor vehicles. That said, I do accept that from time to time the opponent is involved in the publication of newspapers and books which relate to their vehicles.

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In the context of the application in suit, I have already noted the opponent’s position in so far as the magazine of the applicant is concerned. By the time the application in suit was filed, the applicant had been using their mark LANDROVER OWNER INTERNATIONAL for some seven and a half years. As far as I am aware, at no time during that period did the opponents object to the applicant’s use of the mark, indeed the evidence mentioned above is to the contrary. Not only was the opponent aware of the applicant’s mark but they also approved of its use. In the circumstances, I do not see how the opponent can claim that there has been a misrepresentation by the applicant or that they can claim to have suffered any damage as a result of the applicant’s use of the mark LANDROVER OWNER INTERNATIONAL. Indeed given Mr Cooper’s comment in his declaration where he says:

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*“ Our Land Rover Division approves of and supports such magazines as promoting and advertising our Land Rover Division’s business and supporting the sale of its vehicles under the trade mark LAND ROVER, and also since both such magazines work closely with our Land Rover Division ”,*

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it appears to me to suggest that the opponent has positively benefited from the applicant’s use of the mark. In my view the opponent has no basis for a claim to passing off and the objection under section 5(4)(a) is dismissed accordingly.

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As a result of my decision above the opposition has failed. As the applicant has been successful, they are entitled to a contribution towards their costs. I direct that the opponent pay the applicant the sum of £435. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

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**Dated this 2<sup>nd</sup> day of February 2001**

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**C J BOWEN**  
**For the Registrar**  
**the Comptroller-General**

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