

BL O/0168/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NUMBER 3693718
BY CAR & COMMERCIAL SOLUTIONS LTD
TO REGISTER THE TRADE MARK:**

A stylized, bold, black lowercase logo consisting of the letters 'a' and 'l' joined together. The 'a' is a simple circle with a vertical stem, and the 'l' is a vertical stem with a horizontal base.

OVERLANDER

IN CLASS 12

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 431731
BY JAGUAR LAND ROVER LIMITED**

Background and Pleadings

1. On 13 September 2021, Car & Commercial Solutions Ltd (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision, under number 3693718 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 10 December 2021, in respect of the following goods:

Class 12: Camper vans; Vans [vehicles]; Motor vans; Campers [recreational vehicles]; Structural parts for vans.

2. On 10 March 2022, Jaguar Land Rover Limited (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Within its Form TM7, the opponent indicated that the opposition is directed against all the goods in the application.

3. The opponent relies upon the following comparable United Kingdom Trade Mark (“UKTM”):¹

No. 00914797997 for the trade mark ‘LANDER’ which was applied for on 16 November 2015, and which was entered in the register on 16 January 2020, in respect of goods in Classes 9, 12 and 37. For the purpose of these proceedings, the opponent relies upon all the goods in Class 12.²

4. On 23 May 2022, the applicant filed a notice of defence and counterstatement (TM8). Within its form TM8, the applicant indicated their intention to file invalidity proceedings against the opponent’s mark under section 47(2)(b) and/or 5(4)(a), and as such, the applicant requested that this opposition and the cancellation action be consolidated. However, the Registry notes that the applicant has not filed invalidity

¹ On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number 014797997 being registered at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, have the same legal status as if it had been applied for and registered under UK law, and the original EUTM filing dates remain.

² These will be listed in the goods comparison.

proceedings against the opponent's registration. Accordingly, the opposition will proceed.

5. The opponent essentially claims that the marks at issue are similar and cover identical goods, and as such there is a likelihood of confusion. In its counterstatement, the applicant denies any likelihood of confusion between the marks and disagrees that the respective goods are sufficiently similar for confusion to be caused.

6. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

7. Neither party filed evidence. The opponent is represented by Reddie & Grose LLP; the applicant is represented by JMW Solicitors LLP. Both parties were given the option of an oral hearing but neither requested to be heard on this matter. Only the opponent chose to file written submissions in lieu. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

8. 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

DECISION

Section 5(2)(b)

9. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

[...]

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

10. I am guided by the following principles which are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods

11. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

12. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

13. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p>Class 12 Motor land vehicles; parts and fittings for vehicles; engines for motor land vehicles; wheels for vehicles; alloy wheels; wheel trims; wheel rims; hub caps for wheels; hub centre caps; wheel covers; wheel sprockets; arm rests for vehicle seats; luggage bags specially adapted for fitting in the boot of vehicles; car interior organizer bags, nets and trays specially adapted for fitting in vehicles; head-rests for vehicle seats; vehicle head rest covers; wing mirror protective and vanity covers; car seat covers; covers for vehicle steering wheels; fitted covers for vehicles; spoilers for vehicles; covers for vehicles; seats for vehicles; safety harnesses for vehicles; radiator grilles for vehicles; trim panels for vehicle bodies; baby, infant and child seats for vehicles; not including motorcycles or their parts.</p>	<p>Class 12 Camper vans; Vans [vehicles]; Motor vans; Campers [recreational vehicles]; Structural parts for vans.</p>

14. With regard to the similarity of the goods, in its counterstatement, the applicant states the following:

“It is accepted that the Opponents earlier goods, which include “Motor land vehicles” are similar in nature and purpose to the Applicant’s goods insofar as they include “Camper vans; Vans [vehicles]; Motor vans; Campers [recreational vehicles]”. However, for the reasons further set out below the similarity is very low.

The Applicant specialises in converted campervans, which function not only as vehicles to enable its user to travel between places, but also to function as a space to temporarily reside in. Features of the Applicant’s campervans include pull out beds, dining tables, kitchen facilities (sink, fridge, gas stove, power supply) a portable toilet and an internal shower, heating systems,

awnings. Similarly, the Applicants “campers” in the form of converted micropods are portable spaces which can be towed and occupied as a temporary habitable space. By contrast the Applicant’s [sic] goods concerns vehicles designed to be driven and for travelling from A to B. As such the physical nature of the goods are different and so are the respective consumers. A consumer of the Applicant’s campervans would be looking for a vehicle to drive (or for micropods, tow) and reside in, typically on camping expeditions; whereas a consumer of the Opponent’s vehicles would seek a vehicle for transportation purposes.

The Opponent’s Mark then proceeds to cover a wide range of vehicle parts, which are mainly accessories. By contrast, the Applicant’s Mark covers “Structural parts for vans”.

[...]

The Applicant’s goods are therefore different in nature and purpose to the Opponent’s and are not in competition with one another. The Applicant therefore submits that under the principles established in Canon, the goods are neither similar nor identical.”

15. With regard to the similarity of the goods, the opponent states the following:³

“The Earlier Mark designates the general category of “Motor land vehicles”. The Application Mark covers goods included in that general category, including “Camper vans; Vans [vehicles]; Motor vans; Campers [recreational vehicles]”. These goods must therefore be identical to the goods designated by the Earlier Mark. Any unique features of the Applicant’s business which would separate their vehicles from the general category, laid out in the Applicant’s counterstatement, must be disregarded.

The Earlier Mark also designates the general category of “parts and fittings for vehicles”. The Application Mark covers the goods “Structural Parts for vans”. These goods are clearly identical, as a) there is no limitation in the specification

³ Written submissions in lieu.

of the Earlier Mark as to the purpose of the parts and b) vans are undeniably vehicles.

It is submitted that all the goods covered by the Application Mark are identically contained in the specification of the Earlier Mark.”

Camper vans; Vans [vehicles]; Motor vans; Campers [recreational vehicles]

16. The above contested goods are included in the broad term *motor land vehicles* contained in the opponent’s goods and therefore are considered identical in line with the principle set out in *Meric*.

Structural parts for vans.

17. The above contested goods are included in the broad term *parts and fittings for vehicles* contained in the opponent’s goods and therefore are considered identical in line with the principle set out in *Meric*.

The average consumer and the nature of the purchasing act

18. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

19. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively

by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

20. The average consumer for the goods will be a member of the general public or a business user. The price of the goods are likely to vary from relatively inexpensive to expensive. However, even for those goods that are of relatively low cost (such as parts and fittings), various factors will still be taken into consideration such as suitability, etc. I consider that at least a medium degree of attention will be paid during the purchasing process. For those goods that may have an impact upon the overall performance or reliability of the vehicle in which they are fitted (such as parts and fittings), or those goods that are expensive and purchased infrequently (such as vehicles), a high degree of attention will be paid. The goods are likely to be purchased from specialist retail outlets or an online or catalogue equivalent. Accordingly, visual considerations are likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.


Comparison of the marks

21. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

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

22. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

23. The trade marks to be compared are as follows:

Opponent's mark	Applicant's mark
LANDER	

24. With regard to the similarity of the marks, in its counterstatement the applicant states the following:

“The Applicant’s Mark includes the additional text “OL OVER”, which is missing from the Opponent’s Marks. This additional text is highly relevant in terms of assessing similarity between the marks.

The Applicant’s Mark includes the interlocking and stylisation of the letters “OL” which is featured above the words “OVERLANDER,” which includes stylised text. These artistic features are missing from the Opponent’s Mark. By contrast, the Opponent’s Mark is for the word mark “LANDER” in a conventional typeface, without any additional text or stylisation.”

25. With regard to the similarity of the marks, the opponent states:⁴

“In the Applicant’s counterstatement, the elements of the Applicant’s mark are identified as a) “OVERLANDER” in stylised lettering” and b) “interlocking and stylisation of the letters “OL”. The Opponent disputes the Applicant’s characterisation of the second element. It is not immediately apparent that the

⁴ Written submissions in lieu.

relevant consumers would perceive the black figurative element as being a very highly stylised representation of the letters “OL”. Consumers accustomed to writing in English expect two identifiable letters to be separated in some manner, whether by placing a gap between the letters or featuring a line joining the letters, as shown with the OVERLANDER element below. The absence of any such gap or joining line in the black figurative element, described by the Applicant as being “interlocking”, creates the impression of a single object.

The Opponent submits that the relevant consumers would not recognize the black figurative element as being a word element, but instead an abstract logo with no widely understood verbal component or recognized meaning.

Alternatively, in a scenario where the black figurative element is recognized as a word element, the Opponent argues that it is equally likely that the consumer would perceive the component as a lowercase letter “a” as the capital letters “OL”. This uncertainty could result in greater reliance on the OVERLANDER element by the relevant public, as that element is clearly recognisable and so all of the relevant public would understand a reference to “OVERLANDER” as relating to the Application Mark.

While the Opponent accepts that the OVERLANDER element features some stylisation, the word element does not feature a high degree of stylisation. The OVERLANDER letters are clearly legible and discernible. The degree of stylisation for the OVERLANDER word element is low.

[...]

The “OVERLANDER” component is clearly legible and will be recognized by the relevant consumer as a word element. Therefore, the OVERLANDER word element will have a stronger impact on consumers than the black figurative element and will visually dominate the overall sign.”

Overall impression

26. The opponent's mark consists of the word 'LANDER' presented in standard capital letters with no stylisation. There are no other elements that contribute to the overall impression of the mark which lies in the word itself.

27. The contested mark is a figurative mark comprising the letters 'OL' joined together in a stylised form. Due to its stylisation, I am of the opinion that the joined letters may also be perceived as a stylised lower-case letter 'a' or simply as a figurative device element representing a particular design. These letters are presented in very large, black, bold text. Directly below these letters, in smaller text, is the word 'OVERLANDER' presented in black stylised, upper-case letters. Certain aspects of some of the letters contained in this word have been omitted, namely small sections or lines from part of the letters 'R' and 'A'. Nonetheless, despite this stylisation, I am of the opinion that the word will be correctly identified as 'OVERLANDER'.

28. The opponent submits that the 'OVERLANDER' word element in the contested mark will have a stronger impact on consumers than the black figurative element and will therefore, visually dominate the overall sign. I keep in mind that where a mark consists of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, with the figurative elements being perceived more as decorative elements.⁵ Given the prominent size of the 'OL' figurative element, I consider it to be as dominant in the mark as the word 'OVERLANDER' with both components playing an equal role in the overall impression.

Visual comparison

29. With regard to the visual similarity of the marks, in its counterstatement the applicant states:⁶

⁵ *MigrosGenossenschafts-Bund v EUIPO*, T-68/17

⁶ Written submissions in lieu.

In comparing the two marks, the average consumer will note the visual differences. The Applicant therefore submits that there is no, or (at the most) very low visual similarity between the two marks.”

30. With regard to the visual similarity of the marks, the opponent states:⁷

“The Earlier Mark consists solely of the word “LANDER”. This word is entirely contained in the “OVERLANDER” element of the Application Mark and comprises the majority of the letters.

The fact that the OVERLANDER word element will have a stronger impact on consumers than the black figurative element, the Application Mark is visually similar to the Earlier Mark to at least an average degree.”

31. Visually, the opponents mark ‘LANDER’ is contained in the last six letters of the contested mark. The points of difference between the marks are the first four letters of the contested mark, namely ‘OVER-’, which are absent from the opponent’s mark. This difference appears at the beginning of the word ‘LANDER’, being where consumers tend to focus.⁸ The figurative ‘OL’ element in the contested mark creates a further visual difference. Accordingly, despite the presence of the identical element ‘LANDER’, keeping in mind what I have said regarding the marks’ overall impressions, I find that the marks are visually similar to a low degree.

Aural comparison

32. With regard to the aural similarity of the marks, in its counterstatement the applicant states:

“The additional words “OL OVER” has a very significant impact on the aural comparison of the marks (“OL OVERLANDER” v “LANDER”). For example, rather than the trade mark consisting of two syllables, it consists of at least four (“OVER LANDER”), and the addition of the word “OL” and/or “OVER” gives

⁷ Written submissions in lieu.

⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

rise to more dissimilarities. The Applicant therefore submits that there is no, or (at the most) very low aural similarity between the two marks.”

33. With regard to the aural similarity of the marks, the opponent states:⁹

“The Application Mark will be pronounced “OVER LANDER” and consist of four syllables. In the Applicant’s counterstatement the Applicant recognizes this pronunciation. Although the pronunciation of this mark differs to that of the earlier mark in that the sound of the word ‘OVER’ has no counterpart in the earlier mark, two of the four syllables of the Application mark will still be identical to those of the Earlier Mark.

[...]

The relevant public will not understand the black figurative element as possessing any verbal component and thus it will not be considered when making an aural comparison.

Take the above factors into account, the Application Mark is aurally similar to the Earlier Mark to at least an average degree.”

34. Aurally, the opponent’s mark will be articulated in two syllables, i.e. ‘LAND-ER’, whereas the contested mark will be articulated in four syllables, i.e. ‘O-VER-LAND-ER’. The competing marks share an identical pair of syllables in the same sequence (‘LAND-ER’), albeit in different positions within the respective marks. Whilst the figurative ‘OL’ element in the contested mark is capable of being pronounced, I do not consider that it will be, as I feel it is unlikely that that the average consumer would pronounce the contested mark as ‘OL OVERLANDER’. Instead, it will simply be pronounced as ‘OVERLANDER’. Taking everything into account, I find the mark to be aurally similar to a medium degree.

Conceptual comparison

⁹ Written submissions in lieu.

35. With regard to the conceptual similarity of the marks, in its counterstatement, the applicant states:

“The Applicant submits that the Opponent’s mark does not have any clear conceptual message. However, it should be noted that the word “LANDER” is defined in the Cambridge Dictionary as “a spacecraft designed to land on the surface of a planet or moon”. Conceptually the Opponent’s Mark could therefore allude to goods which can land on the earth.

By contrast, the Applicant’s Mark is for “OVERLANDER”, which includes the additional word “OVER”, therefore creating a coined word. As such, the Applicant contends that its mark does not have a clear conceptual message. The most likely conceptual message is goods which are designed to go “OVER LAND”. As such it is submitted that the marks are conceptually dissimilar.”

36. With regard to the conceptual similarity of the marks, the opponent states the following:¹⁰

“The “OVERLANDER” element of the Application Mark will have no recognised meaning when taken as a whole. In the Applicant’s counterstatement, the Applicant admits that the mark does not have a clear conceptual message. The Applicant goes on to claim a conceptual meaning relating to the words “OVER LAND”, recognizing that “OVER” will possess a conceptual meaning understood separately from the rest of the word element.

The Opponent does not accept that the definition of the common element LANDER given in the Applicant’s counterstatement, will be widely understood by the relevant consumers. However, if any meaning is given to the common LANDER element, this conceptual meaning will be shared between the Application Mark and the Earlier Mark.

The relevant public will not understand the black figurative element as possessing any conceptual meaning and thus it will not be considered when making an [sic] conceptual comparison.

¹⁰ Written submissions in lieu.

Take the above factors into account, the Application Mark is conceptually similar to the Earlier Mark to at least an average degree.”

37. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

38. The opponent’s mark, consisting solely of the word ‘LANDER’, will either be perceived as an invented word, or for the part of the public who are aware of the dictionary reference, the word will be understood as *a space vehicle designed to land on a celestial body, such as the moon or a planet*.¹¹ This reference has no obvious connection to the goods in the opponent’s specification. Similarly, for the contested mark, the word ‘OVERLANDER’ will either be perceived as an invented word, or for the part of the public who are aware of the dictionary reference, the word will be understood as *one who travels over lands or countries; one who travels overland*.¹² Whilst this word may allude to the function of some of the goods at issue, there is no direct connection.

39. As for the figurative device element contained in the contested mark, it is reasonable to acknowledge that a proportion of consumers will correctly perceive this element as the letters ‘OL’ and may assume that they represent the letters ‘O’ and ‘L’ in ‘OVERLANDER’. However, for others who do not see this connection, the figurative device may be perceived as a lower-case ‘a’ or will simply be understood as representing a particular design, that has no clear relationship with the word ‘OVERLANDER’.

40. Whilst it is acknowledged that the opponent’s mark is wholly contained in the contested mark, for me this does not result in a conceptual overlap. I am of the view that on seeing the contested mark ‘OVERLANDER’, consumers will perceive it as one word and will not seek to break the word into ‘OVER’ and ‘LANDER’, therefore

¹¹ www.thefreedictionary.com/Overlander

¹² www.thefreedictionary.com/lander

they will not see 'LANDER' as an individual element with a shared concept to the opponent's mark. As previously stated, in my view, consumers will either see 'OVERLANDER' as an invented word, with no clear meaning or as the dictionary word relating to *one who travels over lands or countries; one who travels overland*, which has no direct meaning or obvious connection to the goods at issue.

41. Accordingly, for those consumers that perceive the words 'LANDER' and 'OVERLANDER' as invented words, the marks will be conceptually neutral, and for the proportion of consumers who are aware of the words' dictionary definitions, the marks are conceptually different.

Distinctive character of the earlier trade marks

42. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

43. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

44. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use. Consequently, I have only the inherent position to consider.

45. The opponent’s mark comprises the word ‘LANDER’. Whilst this word may be understood as reference to *a spacecraft designed to land on a planet or other body*, it has no obvious connection with the goods for which the opponent’s mark is registered. On this basis, I find that the mark is inherently distinctive to a medium degree. However, in the case where consumers are unfamiliar with the dictionary term, the mark will be considered as an invented word, therefore affording it a high degree of inherent distinctiveness.

Likelihood of confusion

46. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely

has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

48. I have found the marks to be visually similar to a low degree, aurally similar to a medium degree, and depending on the consumer's understanding of the words 'LANDER' and 'OVERLANDER', either conceptually neutral or conceptually dissimilar. I have found the goods at issue to be identical. I have identified that the average consumer for the goods will be a member of the general public or a business user who will likely pay at least a medium degree of attention during the purchasing process. However, I recognise that for some of the goods the level of attention paid will be high (where the goods are expensive or purchased infrequently, etc.). The purchasing process will be predominantly visual, although I do not discount an aural component. Furthermore, depending on the consumer's understanding of the opponent's mark, I have found its inherent distinctiveness to range from a medium to high degree.

49. I bear in mind that the beginnings of marks tend to have more visual and aural impact than the ends, and that the marks at issue have entirely different beginnings. Furthermore, whilst I acknowledge that the marks share the common word 'LANDER' I am reminded that there are other elements in the contested mark which have no counterpart in the opponent's mark, namely the figurative device element which I have found to be equally dominant in the mark, and the additional letters 'OVER-' present at the start of the mark. I am of the view that the additional letters at the start of the contested mark, along with the figurative element will not be forgotten, overlooked, or disregarded by consumers upon a visual inspection of the marks, which is of heightened importance given that I have found the purchasing process to be predominantly visual in nature. The impact of this is that when perceiving the respective marks in a dealership, retail store, catalogue or their online

equivalents, it is unlikely that consumers will mistake one mark for the other. Accordingly, even when taking into account the identical goods and the opponent's mark being perceived as an invented word thereby affording it a high degree of distinctive character, I do not consider there to be a likelihood of direct confusion.

50. Having found no likelihood of direct confusion, I now go on to consider indirect confusion.

51. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

52. These examples are not exhaustive but provide helpful focus.

53. Further, in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

54. I acknowledge that a finding of indirect confusion should not be made merely because the two marks share a common element. However, it is not sufficient that a mark merely calls to mind another mark:¹³ this is mere association not indirect confusion.

55. In order to find indirect confusion in this case, it would be necessary to conclude that the average consumer will see the word ‘LANDER’ and assume that its presence in the contested mark must mean that it is a brand of the owner of the earlier mark, or vice versa. Whilst I have found that the marks are aurally similar to a medium degree, I have found that the purchasing process will be a primarily visual one and that the average consumer will notice the additional elements in the contested mark which are not present in the opponent’s mark. Furthermore, I am of the view that the addition of ‘OVER’ at the start of the word ‘LANDER’ in the contested mark creates a completely different word, and as such, I can see no logical reason for an undertaking to extend their mark or rebrand it in this manner. Even for those

¹³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

consumers who see 'LANDER' as an invented word with a high distinctive character, I do not consider 'LANDER' to be so strikingly distinctive that consumers would assume any undertakings incorporating the word in their mark must be related. I find it more likely that consumers would put the presence of the common element 'LANDER' down to coincidence rather than economic connection. Accordingly, even for identical goods, I do not consider there to be a likelihood of indirect confusion.

Conclusion

56. The opposition under section 5(2)(b) of the Act has been unsuccessful and the contested mark may proceed to registration.

Costs

57. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice (TPN) 2/2016. In the circumstances, I award the applicant the sum of £350 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the notice of opposition and preparing the counterstatement	£250
Considering the opponent's submissions in lieu	£100
Total	£350

58. I therefore order Jaguar Land Rover Limited to pay Car & Commercial Solutions Ltd, the sum of £350. This should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the appeal proceedings.

Dated this 16th day of February 2023

Sam Congreve
For the Registrar