

O-095-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3164233
BY GEELY HOLDING GROUP CO. LIMITED
TO REGISTER THE TRADE MARK**

Lynk&CO

**IN CLASSES 12 & 37
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 407942 BY
FORD MOTOR COMPANY**

BACKGROUND

1) On 12 May 2016, Geely Holding Group Co. Ltd (hereinafter the applicant) applied to register the trade mark shown above in respect of the following, amended, goods and services:

In Class 12: Electric vehicles; Vehicles for locomotion by land, air, water or rail; Mopeds; Automobile chassis; Motorcycles; Propulsion mechanisms for land vehicles; Automobiles; Gear boxes for land vehicles; Tires for vehicle wheels; Brakes for vehicles; none of the aforesaid goods being snowmobiles, structural parts for snowmobiles or being for use with snowmobiles.

In Class 37: Construction consultancy; Construction; Masonry; Upholstering; Air conditioning apparatus installation and repair; Motor vehicle maintenance and repair none relating to snowmobiles; Vehicle breakdown repair services none relating to snowmobiles; Vehicle washing none relating to snowmobiles; Vehicle battery charging none relating to snowmobiles; Vehicle service stations [refuelling and maintenance] none relating to snowmobiles.

2) The application was examined and accepted, and subsequently published for opposition purposes on 19 August 2016 in Trade Marks Journal No.2016/034.

3) On 21 November 2016 Ford Motor Company and Ford Motor Company Ltd filed a notice of opposition. In a letter dated 29 March 2017 Ford Motor Company Ltd was removed from the joint opposition leaving Ford Motor Company as the sole opponent (hereinafter the opponent). Following a case management conference on 28 July 2017 the grounds of opposition were amended. The opponent is the proprietor of the trade mark shown below. The opponent states that phonetically the marks of the two parties are similar. It also contends that the class 12 goods applied for are identical / similar to the goods for which its mark is registered and the services applied for are similar to the goods for which its mark is registered. As such the application is alleged to offend against Section 5(2)(b) of the Act.

Mark	Number	Dates of filing and registration	Class	Specification relied upon
LINCOLN	EU 6910418	13.05.08 06.02.09	12	Passenger automobiles and parts and accessories therefor.

In addition the opponent contends that it has reputation in its mark such that use of the mark in suit would free ride on the advertising and promotion of its mark carried out by the opponent; would be detrimental to its reputation and business as its vehicles are in the prestige and luxury end of the market rather than the mass appeal vehicles sold by the applicant; and there will be dilution of its mark. It also contends that there is no due cause for the adoption of the mark by the applicant. The mark in suit therefore is alleged to offend against section 5(3) of the Trade Marks Act 1994.

4) On the 16 February 2017 the applicants filed a counterstatement, subsequently amended. They put the opponent to strict proof of use in respect of its trade mark. They deny that the marks are similar.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 18 January 2018 when Mr Edenborough of Counsel instructed by Messrs HGF Ltd represented the opponent; Mr Fiddes of Messrs Urquhart-Dykes & Lord LLP represented the applicant.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 28 August 2017, by Peter N. Tassie the Chief Trade Mark Counsel of Ford Motor Company, a position he has held for five years. He contends that although sales of Lincoln cars in the UK have been moderate their reputation extends far beyond as they are high value luxury vehicles used for special occasions such as weddings and celebrations, and feature in television programmes, books and movies. At exhibit PNT 1 & 2 he provides statistics produced by the DVLA which shows that in the years 2012-2016 inclusive there were an average of 669 Lincoln cars of various type on UK roads, most of which were clearly older cars as during the same period only 20 "new" (to the UK) Lincoln cars were registered an average of four per annum. He states that a number of Lincoln cars reach the UK via private companies who purchase new and/or second hand cars overseas and import them into the UK. An example is David Johnson Partnership in Manchester. At exhibit PNT3 he provides copies of the website for this company which shows a number of Lincoln cars for sale, but which is undated. Mr Tassie states that there has been considerable interest in the UK and EU press regarding new Lincoln cars. However, I note that the coverage provided, at exhibit PNT 4, all relates to car shows in the USA/ China and it is clear from the accompanying wording that the cars are intended for these markets only (paragraph 6 page 3). There is no indication that the cars would be sold in the UK. Indeed it is clear that the Lincoln Continental was not made at all between 2002-2015 (Paragraph 3 page 12 exhibit PNT 4) At exhibit PNT 5 is a

review by the writer Jeremy Clarkson of the Lincoln Town car, which does provide a price in UK£ but this would appear to be merely a conversion of the US dollar price not a UK price from a dealer which would include car tax and VAT. Mr Tassie states that there is a “significant” second hand market for Lincoln cars in the UK and at exhibit PNT6 he includes print outs from various websites showing Lincoln cars for sale in the UK. This exhibit shows 5 cars for sale and most of the advertisements are dated May 2017.

7) Mr Tassie states that the programme TOP GEAR is very popular in the UK with over 21 million fans worldwide on Facebook and two million followers on Twitter. A search of the TOP GEAR website revealed 57 references to Lincoln cars during the period 2006-2016. He contends that the popularity of the series means that the UK public has been exposed to the Lincoln brand. He provides a number of exhibits (PNT 7-10) but I note in particular that the modern vehicles are destined for the USA and China markets only (see PNT9 page 3 line 2). It is clear that a number of Presidents of the USA have used Lincoln cars and when they have been shot the images of them in these cars have been seen around the world. Quite how much attention was paid to the vehicle as opposed to the fact that someone had been assassinated or an attempt made on their life, is perhaps open for debate. He also contends that celebrities have been pictured in Lincoln cars; that Wikipedia has an entry about Lincoln cars; that a number of Lincoln cars are available in the UK for hire, and have featured in films and television shows, particularly those made in America. He also mentions a book which was also made into a film about a lawyer in the USA who worked out of a Lincoln. The book and film were entitled The Lincoln Lawyer. He also points out that the Lincoln brand has its own Instagram and Facebook pages, its own website and twitter account and that the company sells lots of vehicles in the USA.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The first ground of opposition is under section 5(2)(b) which reads:

“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 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.”

10) An “earlier trade mark” is defined in section 6, 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.”

11) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The applicant requested that the opponent provide proof of use. Given the interplay between the date that the opponent’s mark was registered (6 February 2009) and the date that the applicant’s mark was published (19 August 2016), the proof of use requirement bites. Section 6A states:

“Raising of relative grounds in opposition proceedings in case of non-use

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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 Union.

(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.”

12) Section 100 of the Act states that:

“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.”

13) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the application was 19 August 2016, therefore the relevant period for the proof of use is 20 August 2011 – 19 August 2016. In deciding this issue I take into account the case of *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, where Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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 or services 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]; *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].”

14) In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. 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.”

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

15) In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be

required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

16) Whether the use shown is sufficient for these purposes will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown

17) In *Reber Holding GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-355/09, the General Court found that the sale of 40-60kg per annum of specialist chocolate under a mark was insufficient to constitute genuine use of the national trade mark, which was registered in Germany. On further appeal in Case C-141/13 P, the CJEU stated, at paragraph 32 of its judgment, that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The CJEU found that “*the General Court conducted an overall assessment of that trade mark, taking into account the volume of sales of the goods protected by the trade mark, the nature and characteristics of those goods, the geographical coverage of the use of the trade mark, the advertising on the website of Paul Reber GmbH & Co. KG and the continuity of the trade mark’s use. It thus established a certain degree of interdependence*

between the factors capable of proving genuine use. The General Court therefore correctly applied the concept of 'genuine use' and did not err in law in its assessment of that use" (paragraphs 33 and 34 of the judgment of the CJEU).

18) 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 [European Union] market for the goods or services protected by the mark"* is therefore not genuine use.

19) At the hearing the opponent contended that section 100 of the Trade Marks Act says merely that it is for the proprietor to show what use has been made and that the opponent had complied with this demand in its evidence. I accept that the opponent filed evidence of what it claimed was use by third parties but one still has to consider what the evidence actually shows.

20) At the hearing I put to Mr Edenborough that the opponent does not:

- a) offer any vehicles for sale in the UK under the Lincoln mark;
- b) offer any service back-up for Lincoln vehicles in the UK;
- c) advertise or market Lincoln vehicles in the UK;
- d) import and/or register Lincoln vehicles be they new or second-hand in the UK;
- e) have any agreements with third parties for them to offer any of the above in the UK.

21) Although he did not confirm this was the case neither did he deny it. Instead he contended that provided someone was importing Lincoln vehicles into the UK and/or offering Lincoln vehicles for sale in the UK then a market for Lincoln vehicles was being created, and this was proved by the fact that people purchased Lincoln vehicles and registered them for use in the UK. Mr Edenborough acknowledged that the opponent did not have any formal links with any of the parties who had registered Lincoln cars in the UK over the previous years. He contended however, that because the opponent had not sought to prevent those parties from registering and offering for sale Lincoln vehicles, the opponent could still rely upon that activity to uphold its registration. To my mind, this is not intentional use of a mark but mere happenstance. Taking into account all of the authorities quoted earlier in this decision I do not accept that the opponent has met its obligations and has not shown genuine use of the mark upon any of the goods for which it is registered.

CONCLUSION

22) The opposition fails completely. The mark will continue to registration in respect of all the goods and services included in the application.

COSTS

23) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Considering the evidence of the applicants	£300
CMC costs awarded against the opponent	£300
Attendance at the hearing	£800
TOTAL	£1,700

24) I order Ford Motor Company to pay Geely Holding Group Co. Limited the sum of £1,700. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of February 2018

George W Salthouse
For the Registrar,
the Comptroller-General