

O/0152/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3616408

BY

BELONG GAMING LLC

TO REGISTER THE FOLLOWING TRADE MARK

IN CLASSES 9, 25, 38 AND 41



AND OPPOSITION THERETO UNDER NUMBER 426649

BY

JAGUAR LAND ROVER LIMITED

Background and Pleadings

1. On 25 September 2020, Belong Gaming LLC (“the Applicant”) applied to register in the UK the trade mark as seen on the front cover page for goods and services in classes 9, 25, 38 and 41, set out in full in the annex attached hereto.¹ It was accepted and published in the Trade Marks Journal on 4 June 2021.

2. On 6 September 2021, Jaguar Land Rover Limited (“the Opponent”) filed opposition proceedings against all the goods and services of the contested mark as applied for, under section 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b), it relies on the following trade marks:

(i) EUTM no. 015433436

DEFENDER

Filed: 12 May 2016

Registered: 17 January 2019

Whilst registered in a number of different classes it only relies on those goods and services in classes 9, 25 and 28 as set out in full in the annex hereto.

(“first earlier mark”)

(ii) EUTM no.16481988

DEFENDER CHALLENGE

Filed: 19 March 2017

Registered: 21 July 2017

It relies on the services in class 41 for which its mark is registered as set out in full in the annex attached hereto.

(“second earlier mark”)

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 59 of the Withdrawal Agreement between the UK and EU, applications for EUTMs made before the end of the transition period that had received a filing date can form the basis of a UK application retaining the same filing date as the corresponding EUTM, provided they were filed within 9 months of the end of the transition period. The Applicant’s corresponding EUTM was filed at the EUIPO on 25 September 2020, whereas its UK application was filed on 25 March 2021. Accordingly, the UK application was given the same filing date as its EUTM.

3. For the purposes of its claim brought under section 5(3) it relies on the following mark:

UKTM no. 1399593

DEFENDER

Filed: 18 September 1989

Registered: 3 April 1992

Class 12: Motor land vehicles

("third earlier mark")

4. The Opponent claims under section 5(2)(b) of the Act that the element BIRMINGHAM in the contested mark is non-distinctive, whereas the mark is dominated by the word DEFENDERS which bar the addition of the letter 's' is identical to the first earlier mark, and the first word of the second earlier mark. Furthermore it is claimed that the respective goods and services are either identical or similar. As a result of these similarities the Opponent argues that there exists a likelihood of confusion on the part of the public to include a likelihood of association between the respective marks.

5. Under section 5(3) it is claimed that as a result of the third earlier mark enjoying a long standing reputation in the UK, the similarities that exist between them will lead the relevant public to think that the marks originate from the same undertaking or that there is an economic connection between the parties. Furthermore as a result of the Opponent being a globally renowned manufacturer of automobiles based in the UK, it contends that a mark which is similar to it will feed off the reputation acquired through use, making the advertising and marketing much easier involving less risk to the Applicant in introducing a new product or service onto the UK market gaining an unfair advantage. It is said that use of the later mark will lead to a dilution and blurring of the identity of the earlier mark and that the strong image of the DEFENDER mark or the characteristics it projects in terms of quality, durability, manufacturing expertise and world famous market success, are transferred onto the goods/services of the contested mark (image transfer). It claims that the distinctive character of the earlier mark will be damaged as a result. The Applicant would also unfairly benefit from the established selling power of the DEFENDER products. Since it considers that the

vehicles it makes and sells under the mark are considered legendary in the automotive industry, the Opponent claims that use of a similar mark by others would dilute the exclusivity and pulling power of the earlier mark, tarnishing its reputation and impairing its guarantee function.

6. The Applicant filed a defence and counterstatement denying each ground of opposition. Furthermore the Applicant puts the Opponent to strict proof of use of its goods in class 12 in relation to its third earlier mark for which it claims a reputation. In relation to the similarity between the respective marks, it denies similarity given the additional elements present in its application. It also claims that in so far as there is similarity between the broader goods and services contained within class 9, 25 and 41 and the goods and services covered by the first and second earlier mark, similarity is denied where the goods and services have been directed towards a particular sector, for example vehicles in class 9. It denies the ground of opposition under section 5(3) and puts the Opponent to strict proof of its each and every claim under this ground.

7. The Opponent is represented by Reddie & Grose LLP and the Applicant is represented by Lane IP Limited. Both parties filed evidence during the evidence rounds. In addition the Applicant's evidence was accompanied by submissions. The Opponent requested a hearing which took place before me on 27 October 2022 by telephone conference. Ms Victoria Jones (counsel) instructed by Reddie & Grose LLP, appeared on behalf of the Opponent. Neither the Applicant nor its representative appeared at the hearing, however, it filed submissions in lieu of hearing. Prior to the hearing the Opponent filed skeleton arguments.

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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

Opponent's marks

9. In these proceedings, the Opponent is relying upon its UK and EU trade marks as shown above, which, given their filing dates, qualify as earlier trade marks under

section 6 of the Act. As its first and second earlier mark have been registered within the five-year period ending on the date of filing of the Applicant's mark, they are not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all the goods and services of these registrations without having to establish genuine use. The Opponent's third earlier mark, relied upon to support its claim under section 5(3), has been registered for more than five years ending on the filing date of the application and therefore for the Opponent to rely upon this mark it must meet the use condition for the goods under class 12 upon which it relies.

My approach

10. Given that the Opponent's claim under section 5(2)(b) relies on marks which are not subject to proof of use and which relate to goods and services in completely different classes for which it claims a reputation, I shall proceed initially by assessing the opposition under section 5(2)(b). I will then move on to consider the opposition based on section 5(3) dealing with the evidence and proof of use provisions at that stage.

Section 5(2)(b)

11. Section 5(2)(b) of the Act states 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 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.

12. Section 5A states:

“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.”

13. The following principles are gleaned from the decisions of the EU courts 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.

The principles:

(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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison on the goods and services

14. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

15. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, 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 Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

17. The Applicant submitted the following in relation to the goods and services comparison:

“In relation to the goods and services applied for and opposed, whilst there is similarity between the broader goods/services applied for in classes 9, 25 and 41, there is, however, no similarity when these goods/services have been

limited to cover a certain sector, for example the Opponent's goods and services are directed towards motor vehicles - this results in the goods/services having a different intended purpose, nature, as well as differing trade channels. As a result, they should not be considered to be similar. Additionally, the class 38 services are not similar to, nor have been proven to be similar to any of goods and services covered by the Opponent's Marks. To that end, per *Sun Site v The Sun's Football Football* Opposition No. 46861 (2002) applying the hearing officer's statement at paragraph 45: "*while communication services and computer and Internet communication services obviously utilise computers, computer software and computerised information, it does not follow that the services are similar to computer hardware or software or database management services.*"

18. At the hearing Ms Jones went through in some detail the identity/similarity of the goods/service in question in line with her skeleton argument and the annex accompanying those arguments.

19. I shall consider the terms in turn grouping together those terms where appropriate.²

Class 9

Computer software; game software; computer game software; video game software; computer game software for use on mobile and cellular phones; electronic game software for mobile phones; computer games programs downloaded via the internet [software]; application software for mobile phones; computer game software for computers, mobile phones and tablet computers; computer software for the management, transmission, storage and sharing of computer games and video games; downloadable information relating to games and gaming; interactive computer game and video game software; virtual reality computer game and video game software; interactive electronic computer game and video game software; computer game and video game programs; electronic computer game and video game programs; interactive computer game and video game programs; virtual reality computer game and video game programs; downloadable computer and video game

² *Separode Trade Mark* BL O-399-10 (AP)

software and programs; downloadable electronic computer game and video game software and programs; downloadable interactive computer game and video game software and programs; downloadable virtual reality computer game and video game software and programs; interactive multimedia computer game and video game programs and software; software for social networking; software for sending and receiving electronic messages, graphics, images, audio and audio visual content via the internet and communications networks; software for wireless content, data and information delivery; downloadable software to enable uploading, creating, posting, showing, displaying, blogging, sharing and otherwise providing electronic media or information over the internet and other communications networks; downloadable software in the nature of a mobile application for social and personal networking; downloadable software in the nature of a mobile application for creating, sharing, disseminating and posting photos, videos, personal and general information for the purposes of social, personal and professional networking; application programming interface (api) for computer software which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; software allowing users to post questions with answer options; software allowing users to join discussions and post comments about opinion polls, questions and answers; software allowing users to give compliments and positive feedback; software for creating, managing, and interacting with an online community; software for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing or otherwise providing electronic media or information via computer and communication networks; software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; software for sending and receiving electronic message alerts, notifications and reminders; software for remote communication; messaging software; software for recording, playing and transmitting videos; video sharing software; downloadable videos; mobile application software for recording, playing and transmitting videos, films and pictures; software for recording time in computer games and video games; software for displaying in-game data and

scores; software for recording computer game and video game footage; software for taking screenshots of computer games and video games; software for computer game and video game enhancers; computer software for the administration and distribution of on-line games and gaming; computer software to enable peer-to-peer networking and file sharing; computer software for the management, transmission, storage and sharing of computer game programs and electronically stored information across computer networks to users, for downloading and use of games by users; Electronic software updates, namely, downloadable computer software and associated data files for updating computer software in the field of games, provided by computer and communication network; telecommunications software; computer software for providing help, support and strategies for computer games; social networking software and computer game software for finding and matching computer game players; computer software for providing news and information in relation to computer games, video games, gaming and social networks; computer software for real-time voice communication between users; computer software for analysing and improving network and internet connectivity; computer e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network.

20. Ms Jones submitted that the Applicant's goods in class 9 in so far as they relate to computer software, hardware, game software, computer game software are either identical due to the identical words being used or are identical in accordance with *Meric* being encompassed within the Opponent's broader category of goods in its specification, namely *computer hardware; computer software; downloadable mobile applications; computer games, and computer games software.*

21. I agree. The Opponent's broad term *computer software* in the first earlier mark's specification, encompasses all of the Applicant's goods in class 9 as outlined above, as they are all categories of computer software and therefore are identical either self-evidently or in accordance with *Meric*:

computer hardware

22. The term computer hardware is contained in both parties' specification they are self-evidently identical.

video game cartridges; video recorders; video screens; information technology and audio-visual equipment; audio-visual headsets for playing video games;

23. Given that all these goods would be regarded as the physical components of a computer, or ancillary devices which either attach externally to a computer or something which is used in connection with a computer, they would be covered by the Opponent's broad category *computer hardware* as they all include the physical devices, components and apparatus of computer equipment. These goods are identical in accordance with *Meric*.

electronic publications, downloadable, relating to games and gaming; instructional manuals in electronic format; downloadable electronic publications; electronic bulletin boards;

24. These goods are the electronic version of traditional publications such as magazines, newsletters, brochures and instruction manuals and would include electronic information boards and blogs where information is imparted or shared to the user. The viewing of these publications via electronic means is facilitated by the software in so far as it is common to distribute these publications via electronic devices by means of software applications and programmes. On this basis I consider that they are similar to a medium degree to the Opponent's broad term *computer software* given that there exists a complementary relationship between the respective goods, overlapping in distribution channels and relevant public and may overlap in producer.

Class 25

25. Neither parties' specifications in class 25 could be argued as being solely directed at the motor vehicle sector since they are specified in such broad terms. Since all of the Opponent's goods in class 25 are items of clothing, footwear and headgear they

will be encompassed within the Applicant's broad category of goods in the same class and thus are identical either self-evidently or in accordance with the principles in *Meric*.

Class 38

Telecommunications; television broadcasting; communications by computer terminals, video, wire, satellite, microwave and cable; broadcasting of cartoon films and animated films; streaming of video content namely cartoons, via a global computer network; transmission of digital files; wireless broadcasting; providing voice chat services; electronic transmission of computer software via the internet and other computer and electronic communication networks; transmission and distribution of data or audio-visual images via a global computer network of the internet; provision of connectivity services and access to electronic communications networks for transmission or reception of computer software; communications via a global computer network or the internet; streaming of video content via a global computer network; multi-media telecommunication services; interactive telecommunications; transmission of data and of information by electronic means, mobile, computer, cable, communications satellite or electronic communication means; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; broadcasting or transmission of television programmes; provision of telecommunications connections to electronic communication networks, for transmission or reception of audio, video or multimedia content; providing user access to the internet (service providers); provision of access and connection to server centres, database server centres, worldwide communication networks or private or restricted access networks; electronic data exchange; providing access to gaming websites; transmission of computer games, video games, electronic games and interactive games via the internet, computer networks, and electronic computer networks; transmitting information electronically including web pages, computer programs, text and other data; provision of access to on-line chat rooms and bulletin boards; providing online facilities for real-time interaction with other computer users; web-streaming being the transmission of data, information and audio-visual data via the Internet or other computer network; direct and on-demand streaming video audio and video material, interactive content, video games and applications over Local Area, wireless and global computer networks; providing networking services for establishing multiple-user access to a Wide Area Network and Local Area Network; transmission

of written and digital communications; leasing and rental services in connection with telecommunications apparatus, equipment and computer databases; operation of chat rooms; transmission of news and news information via a computer network and/or the Internet; remote data access services; online instant messaging; provision of access to computer databases and directories via the Internet and global computer networks; rental of access time to computer apparatus and database server centre; telecommunication of information (including web pages), computer programs and any other data; video broadcasting, broadcasting pre-recorded videos featuring music and entertainment, television programs, cartoons, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via a global computer network, computer and other communications networks; streaming of video material on the internet; broadcasting of audio and video content and programming over the internet; electronic transmission and streaming of digital media content for others via global and local computer networks and via mobile electronic devices; telecommunication services, namely, transmission and streaming of voice, data, images, audio, video, real-time news, entertainment content, or information by means of telecommunications networks, wireless communication networks, and the internet; broadcasting services; broadcasting and transmission of interactive television, interactive games, interactive entertainment and interactive competitions; providing access to computer networks for the playing of games and access to competitions for those games via a global computer network, wireless networks or interactive television; chatroom services for social networking; streaming of audio and video material on the internet; provision of online forums; information, advisory and consultancy services relating to all the aforesaid.

26. The Applicant submits that its class 38 services are not similar to nor have been proven to be similar to any goods/services covered by the earlier marks. The Opponent disagrees and has set out in some detail in the annex attached to Ms Jones' skeleton argument that it considers the class 38 services to be similar to both the Opponent's computer software and hardware arguing that as they are aimed at the same public, distributed through the same channels of trade, are complementary and serve the same purpose. Ms Jones argues that there is a close connection between the goods and the provision of the services.

27. Absent any specific submissions from the Applicant to my mind telecommunication services (which is a broad term encapsulating the Applicant's services as listed above) is such a broad term that it covers all sorts of communication services allowing users to talk with one another and transmit messages to each other via electronic means, directly via computer networks or through other mediums. The means by which the messages/communications are communicated, transmitted or broadcast would be via computer networks facilitated through software.

28. The Opponent's term *computer software* in class 9 is such a broad term that it could reasonably cover telecommunications software and communication networking and social networking software. Furthermore, streaming services are now predominantly offered via mobile and computer networks and therefore the providers not only provide the service but they could also (and many do) provide the software to facilitate the communication. Gaming network service providers also provide and facilitate chat rooms which enable users to communicate via electronic means. On this basis I consider that the Applicant's services are similar to a medium degree to the Opponent's *computer software* in class 9 sharing in purpose, coinciding in relevant public and distribution channels and they are complementary.

Class 41

Education; providing of training; arranging and conducting of workshops [training];

29. These services are self-evidently identical or identical in accordance with *Meric* to the Opponent's *Education services*.

entertainment; video game entertainment services; providing entertainment via computer networks; entertainment services, namely, providing temporary use of non-downloadable computer games; television entertainment;

30. The same would apply to these services they are identical either self-evidently or in accordance with *Meric* to the Opponent's broad term *Entertainment services*.

arranging and conducting of conferences; arranging and organising of computer gaming events, competitions and tournaments; arranging and organising of on-line

gaming events, competitions and tournaments; hosting of gaming leagues; provision of computer and video game arenas; organisation of parties and events in respect of computer and video gaming; organisation of parties and events in a computer and video game arena; organisation, arranging and provision of conventions; organisation, arranging and provision of conventions in respect of computer and video games, gaming, online gaming, virtual reality gaming; organization of competitions [education or entertainment]; arranging and conducting competitions for video game players and computer game players; entertainment in the nature of contests, competition and games; organising of games; interactive games, interactive entertainment, interactive competitions and interactive quizzes

31. These services are identical to the Opponent's *organizing and conducting competitions, sports events, entertainment events, motor vehicle events, races, rallies and exhibitions; arranging and conducting shows, concerts, shows, contests, games and tours; arranging competitions and tournaments relating to driving and car racing;* the one being encompassed in the other's broader category or vice versa. The organising of events, competitions and conferences is broad enough to cover all manner of activities including gaming events.

providing information relating to computer games and computer enhancements for games; providing information to game players about ranking and scores in respect of gaming; provision of online information in the field of computer games; electronic desktop publishing; entertainment information; providing online information on computer and video game strategies; providing a web site through which people locate information about tournaments, events, and competitions in the video and computer game field; help, advice and support services relating to computer games, namely, consulting relating to how to play the computer games and strategies for winning computer game; providing on-line electronic publications, not downloadable; publication of books; publication of electronic books and journals on-line; providing information on video games and computer games; publishing and providing of computer games; information, advisory and consultancy services relating to all the aforesaid.

32. Publishing services in the Opponent's specification is such a broad term that it would include the provision and publication of information, instruction manuals, guides and magazines etc via electronic means or otherwise. These services are therefore identical to the Opponent's services namely *publishing; publishing of books and journals; electronic publishing; electronic publishing of magazines, fanzines, stories, motorsports information; publication of posters, greetings cards, flyers, pamphlets, promotional literature*. Furthermore the provision of information is self-evidently identical to *information, consultancy and advice relating to any of the aforesaid services*.

film production, other than advertising films; production of music; production of radio and television programmes; scriptwriting services; rental of video and computer games;

33. These are identical either self-evidently or in accordance with *Meric* to the Opponent's *production, presentation, syndication, distribution and rental of audio recordings, video recordings, music, interactive games, films, digital content relating to entertainment, television and radio programmes, audio book recordings, whether downloadable or not*.

movie studios

34. Those providing services relating to producing and presenting of films would invariably provide the facilities/venue to enable the films/movies to be produced. On this basis I consider that they overlap in provider, purpose, trade channels and end user. These services are similar to a medium degree to the Opponent's *production...and...distribution offilms, digital content relating to entertainment, televisionwhether downloadable or not*.

games equipment rental;

35. The terms *rental of sports equipment...* (Opponent's specification) and *games equipment rental* in the application, are clearly different in so far as the former relates to traditional sporting equipment and the latter relates to video gaming. On a high level of generality they may target the same end user but I do not consider that they would

be provided by the same service provider, be in competition with each other or have a complementary relationship in accordance with the caselaw. However given that the nature and the purpose of the rental services are nevertheless similar in that both relate to the provision of equipment for hire, albeit that the nature of the actual goods being rented differ, I consider that the Applicant's services are similar to a low degree to the Opponent's *rental of sports equipment, not vehicles*.

Video game services; provision of on-line computer games, video games, electronic computer and video games, interactive computer and video games, virtual reality computer and video games, multiple player computer and video games; gaming services; on-line gaming services; computer gaming services; arranging of on-line gaming; video game arcade services; internet games; provision of online computer games; provision of online video games; provision of online interactive computer and video games; conducting multiple player games; provision of online interactive computer games; game services provided online from a computer network; electronic games services in the nature of computer games provided online of by means of a computer network; providing interactive multi-player computer games via the internet and electronic communication networks; interactive gaming and multiplayer gaming; game services provided on-line from a computer network; providing online games; providing computer games and video games that can be accessed, played and downloaded over computer networks and global communications networks; provision of multimedia entertainment content via computer networks; electronic games services provided from a computer database or by means of the internet; electronic games services, including provision of computer games on line or by means of a global computer network; providing an online computer game

36. These services are identical to the Opponent's *entertainment in the form of computer games; interactive computer game services; arcade game services* either self-evidently or in accordance with *Meric*.

Average Consumer

37. When considering the opposing trade marks I must determine first of all who the average consumer is for the goods and services and the method of selecting these

goods and services. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.

38. 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 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

39. Ms Jones submitted in her skeleton argument and at the hearing that the goods and services are purchased by a number of different average consumers being either a member of the general public or potentially a professional for some of the services particularly those in class 38. She submitted that the degree of attention would therefore vary between normal and high. Given that the likelihood of confusion must be judged in light of the lowest level of attention she argued that this would mean the average consumer overall is likely to be the member of the general public paying a normal degree of attention.³

40. The Applicant did not advance any counter argument and therefore I agree with those submission put forward by Ms Jones. In relation to the respective goods and the majority of the services these will predominantly be directed at the public at large as they include computer related software, hardware, apps and programmes in relation to gaming or the provision of the services relating thereto. Considerations such as price, entertainment value and ease of use will be taken into account in the selection process dominated by visual considerations following printed matter/televised advertisements and searches on the internet. I do not discount aural considerations, however, following word of mouth recommendations. It is unlikely that these goods will

³ Case T-105/18, *Andre Deray v EUIPO* EU:T:2019:194 at [39]

be purchased daily but they are nevertheless fairly frequent purchases. Taking all these factors into account I find that the level of attention would be average for such goods and services, no higher or lower than the norm. For those services directed towards the professional public for example telecommunication services where a business user may wish to access the internet and telephony services for his/her own business, for example, then a slightly higher than average level of attention will be undertaken, but not considerably so.


Comparison of the marks

41. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....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.”

42. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider the distinctive and dominant components of the marks 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.

43. The comparison of the marks are as set out below:

Applicant's mark	Opponent's marks
	<p data-bbox="810 347 1054 414">First earlier mark DEFENDER</p> <p data-bbox="810 495 1193 562">Second earlier mark DEFENDER CHALLENGE</p>

44. Both parties have submitted lengthy submissions as to the similarities and differences between the respective marks. Suffice to say their positions are polarised. I have taken each into account in my deliberations.

Overall Impression

45. The first earlier mark is for the word DEFENDER presented in standard font. The overall impression resides in the totality of the word itself. The Opponent's second earlier mark consists of the two words DEFENDER and CHALLENGE. Neither word dominates the other, and both words play equal roles in the overall impression of the mark, despite the word DEFENDER being longer in length.

46. The contested mark is a complex mark consisting of a number of elements. It includes a device depicting the image of a knight and shield overlaid by the words BIRMINGHAM DEFENDERS. The word DEFENDERS sits underneath the word BIRMINGHAM and is larger in size presented in a stylised, emboldened font which naturally draws the eye. Despite this, all three elements contribute to the overall impression of the mark. The word BIRMINGHAM is less distinctive, and plays a slightly lesser role than the other two elements given its size and position, in comparison with the other two elements and its role as a geographical indicator, but nevertheless contributes to the overall impression conveyed by the mark.

Visual Comparison

47. The marks only coincide to the extent that each includes the word DEFENDER. This word is presented in its plural form in the contested mark with the addition of the letter S at the end. The contested mark also includes additional elements namely the stylisation of the words, the inclusion of a knight and shield device and the additional word BIRMINGHAM there being no counterpart in the first earlier mark. Weighing up the similarities and the differences I consider that the marks are visually similar to a low degree.

48. In relation to the second earlier mark it also includes the additional word CHALLENGE there being no counterpart in the contested mark. This is another point of visual difference, rendering the marks visually similar to a very low degree.

Aural Comparison

49. Given that the word DEFENDER/S is an ordinary dictionary word it will be given its normal pronunciation. The same applies to the word CHALLENGE. The knight and the shield device will not be articulated in the contested mark it being referred to by the verbal elements which again will be given their ordinary English pronunciations. The word BIRMINGHAM being a well-known English city will also be given its ordinary pronunciation. Verbally the differences arise from the additional letter S at the end of the word DEFENDER in the contested mark and the inclusion/absence of the words BIRMINGHAM and CHALLENGE (in the second earlier mark) respectively. Weighing up the differences and the similarities as a result of the common element DEFENDER in each, the first earlier mark is aurally similar to a medium degree to the contested mark and the second mark is aurally similar to a low to medium degree.

Conceptual Comparison

50. The meaning of 'BIRMINGHAM', 'DEFENDER/S' and 'CHALLENGE' are obvious. The word DEFENDER refers to "a person who defends something or someone". In a sporting sense it refers to a player with a specific role and position, namely tasked with

trying to prevent the other side scoring.⁴ BIRMINGHAM will, to the average consumer in the UK, relate to the well-known city, located in the Midlands. The word CHALLENGE will mean either a task to be undertaken that is difficult or requires effort or to question the truth.

51. The word DEFENDER in its singular form will be regarded as relating to an individual as per these definitions. In combination with the word CHALLENGE the Opponent submits that “it will be perceived as meaning a competition or game involving the protection of someone or something with DEFENDERS”. The way in which the words in the second earlier mark are constructed (in that in combination they are a bit odd grammatically) I consider that it will be perceived as a task or quest where the purpose is to defend, meaning that the emphasis is on the task/game/competition and not the participants. The word DEFENDER qualifies the word CHALLENGE in this context.

52. The contested mark will be perceived as relating to a team or group of defenders located or associated with Birmingham. Given that the words are encased within a device depicting a knight and a shield, it gives the impression of a badge of allegiance and a reference to a sports team or games team from Birmingham called the DEFENDERS. The word BIRMINGHAM qualifies the word DEFENDERS in this instance. In so far that each mark shares a reference the word DEFENDER (although in the plural in relation to the contested mark) they are conceptually highly similar in this regard. They are dissimilar, however, to the extent that the contested mark gives rise to the concept of a team hailing from Birmingham, whereas the first earlier mark relates to an individual protector and the second earlier mark a quest/task that is defence related. Consequently, I consider that overall, conceptually, the first earlier mark is similar to the contested mark to between a low to medium degree and the second earlier mark to a low degree.

⁴ www.collinsdictionary.com

Distinctive character of the earlier marks

53. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, 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).”

54. Registered trade marks possess varying degrees of inherent distinctive character; descriptive words tend to have a low level of inherent distinctiveness, whereas invented words are regarded as possessing a high level of distinctive character and dictionary words that are neither descriptive nor allusive are somewhere in the middle. 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 and the stronger it measures the marks' identity with its goods and services.

55. At the hearing Ms Jones confirmed that the Opponent was not claiming an enhanced degree of distinctiveness in relation to the first and second earlier marks and was happy for me to proceed on the basis of inherent characteristics only.

56. In this regard Ms Jones argues “neither of the earlier marks have a meaning for any of the goods or services in question. Therefore they have a high level of inherent distinctiveness.” I disagree. Although both the first and second earlier marks consist of words that have no descriptive or allusive qualities to the goods/services in question, they are ordinary English dictionary words, and as such, they are inherently less distinctive than invented words. I consider that both marks possess a medium degree of inherent distinctive character.

Likelihood of confusion

57. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first 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 or services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider 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 he has retained in his mind.

58. Earlier in my decision I found the parties’ goods and services to be identical or similar ranging between a low and medium degree. In relation to the first earlier mark the marks have a low degree of visual similarity, a medium degree of aural similarity and conceptually a low to medium degree of similarity. The second earlier mark is similar to a very low degree visually, aurally similar to a low to medium degree and conceptually similar a low degree. I found that the average consumer of the goods and services to be primarily a member of the general public but for the services may also include business consumers. I found the level of attention paid in the selection/purchasing process to be average/slightly higher than average, with the

purchase/selection being primarily a visual one, though I did not rule out aural considerations following word of mouth recommendations. The earlier marks both have a medium degree of inherent distinctive character.

59. Confusion may be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The Opponent argues that as a result of the shared common element DEFENDER which is presented in its plural form within the contested mark and given that the word Birmingham is non-distinctive acting as a geographical descriptor, then it is the words DEFENDER that will be remembered in the minds of the public. I disagree. I consider that the additional elements present in the contested mark; particularly the stylisation, the device (the knight and shield) and the word BIRMINGHAM will not go unnoticed by the average consumer and therefore it is unlikely that the marks will be misremembered one for the other.

60. The differences I have outlined between the contested mark and the earlier marks are too great for there to be direct confusion. I do not find that the average consumer will mistake or imperfectly recall one mark for the other. There is no likelihood of direct confusion.

61. Moving on to indirect confusion this occurs where the similarities between the marks lead the consumer to believe that the respective goods/services originate from the same or related source.

62. The concept of indirect confusion was explained by Mr Iain Purvis K.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*,⁵ as follows:

“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 recognised 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,

⁵ BL O/375/10

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, 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).”

63. I remind myself that in *Duebros Limited v Heirler Cenovis GmbH*,⁶ James Mellor K.C., as the Appointed Person, held that the assessment must be made on the basis of how the marks are perceived on first impressions and from the perspective of the consumer’s immediate and instinctive reaction to the marks on first encounter. Furthermore, for indirect confusion to arise the average consumer notices the differences between the marks but nevertheless concludes that there is a connection between them and that responsibility for the goods and services originate from the same or economically linked undertakings. In *Duebros*, Mr Mellor stressed that a finding of indirect confusion should not be made simply because two marks share a common element. Furthermore, referring to the comments of Mr Mellor in *Cheeky*

⁶ BL O/547/17

*Italian Ltd v Sutaria*⁷ 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 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.⁸

64. It is important for me to note, therefore, not only the common element but also the aspects of any additional elements present within the respective marks and the part they play. It is not sufficient for a mark to merely call to mind another mark, this is association and not indirect confusion.

65. In this assessment I bear in mind not only the level of distinctiveness of the earlier marks as wholes but also the distinctiveness of the common element. I also accept that the examples as set out in *L.A. Sugar* are not exhaustive and that they are only intended to be illustrative of the general approach.

66. In relation to the ‘common element’ in *Kurt Geiger v A-List Corporate Limited*,⁹ Mr Iain Purvis K.C., as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be

⁷ O/219/16

⁸ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

⁹ BL O/075/13,

confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

67. In other words it is not enough to simply consider the level of distinctive character possessed by the earlier mark. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

68. The first earlier mark DEFENDER has only one element and clearly this is where the distinctiveness of the mark resides. The contested mark is a complex mark consisting of a number of elements. Whilst the word DEFENDERS draws the eye, due to its size and position, the mark is equally dominated by the figurative elements the knight and shield device, which in combination alludes to a badge of allegiance of a sports or gaming team. Both the device and the words contribute to and play dominant roles within the contested mark and although to a lesser degree since it is a geographical indicator, the word Birmingham. The additional elements in the contested mark, beyond the word DEFENDERS, are not negligible or non-distinctive elements such that they will not be disregarded or ignored by the average consumer particularly given that the goods/services will be selected/purchased via visual means paying at least an average degree of attention. Even accounting for the interdependency principle the identity/similarity between the respective goods/services are insufficient to counteract the conceptual and visual differences arising from the inclusion particularly of the device and the word Birmingham. These differences impact sufficiently for a distinction to be made between the respective marks.

69. In combination with the word BIRMINGHAM, the word DEFENDERS forms a unit which together with the device gives the impression of a team or club hailing from Birmingham. To me the word DEFENDER in isolation is an ordinary dictionary word which would not be brought to mind or even give rise to an association.

70. There is no logical reason for consumers to conclude that the undertakings are connected, such that would give rise to a likelihood of indirect confusion, merely because the two marks share the word DEFENDER (presented in its plural form in the

contested mark). At best, the contested mark will bring the other to mind, but this is not sufficient, by itself, to give rise to a likelihood of indirect confusion.

71. In terms of the second earlier mark the addition of the word CHALLENGE places the respective marks even further away in terms of similarity and a likelihood of confusion is even less likely.

72. Taking account of the global assessment of all relevant factors, I do not find that there would be either direct or indirect confusion.

73. The opposition under section 5(2)(b) of the Act fails.

74. I will now move on to consider the position under the remaining ground of opposition under sections 5(3).

Section 5(3)

75. The Opponent's third mark relied upon for the purposes its ground of opposition under section 5(3) is subject to Proof of Use. Before I consider whether and to what extent the grounds under section 5(3) are made out, I must first of all consider whether the evidence filed by the Opponent has sufficiently demonstrated genuine use of its third earlier mark during the relevant period for *motor land vehicles* in class 12.

Evidence

The Opponent's evidence

76. The Opponent's evidence consists of two witness statements of Amanda Jane Beaton. The first is dated 28 March 2022 and is accompanied by 26 exhibits marked AJB1-AJB26. The second statement in reply is dated 27 July 2022 accompanied by 10 exhibits marked AJB27-AJB37. The purpose of these statements is to demonstrate the use the Opponent has made of its mark for the purposes of its claim under section 5(3) and to demonstrate the extensive reputation it claims to hold in relation to *motor land vehicles* in class 12.

First Witness statement of Amanda Beaton dated 28 March 2022

77. Ms Beaton holds the position of Global IP counsel for the Opponent. Her statement is made from information provided to her and taken from company records or publicly available documents and she states that the information is true to the best of her knowledge and belief.

78. Whilst I have considered the evidence in its entirety, the main points emerging from her statement can be summarised as follows:

- Background details are provided as to establishment of the Opponent and its relationship with Tata Motors, having been acquired by the latter in 2008. Furthermore the history of the DEFENDER mark is produced, including details of its original launch date, purpose, and the Opponent's connection to the Royal Family securing three Royal warrants.¹⁰ It is said that the Queen and other members of the Royal family have regularly used a wide variety of Jaguar Land Rover vehicles over the years.
- The Opponent is a globally renowned automotive manufacturer with vehicle assembly plants worldwide including the UK, operating from core sites near Birmingham.
- In 2019 the business sold 557,706 vehicles in 127 countries.
- A table is produced consisting of the Opponent's global revenue figures, number of vehicles sold and number of employees employed worldwide for the years immediately predating the filing date of the contested mark.
- The global revenue figures are in excess of £22 billion for the years 2015/2016; £24 billion for 2016/2017; £25.5 billion for 2017/2018 and £24 billion for 2018/2019
- The global number of vehicles sold between the years 2015/2016 and 2018/2019 is in excess of 521,000 at its lowest and 614,000 at its highest.
- The original LAND ROVER vehicle was re branded in 1990 and given the new name 'DEFENDER' which was displayed on both the front grille of the vehicles, on some vehicles' side doors and on matting. Undated photographs are produced of the earlier generation vehicles as described.

¹⁰ Paragraph 8

- The DEFENDER vehicle has been used by many of the world’s military forces including the British Army and SAS during the two Gulf wars and in Afghanistan. It is also used by a number of professions to include for example mountain rescue, fire departments, police and emergency services as well as by civilians as an everyday road vehicle or for use as a farm vehicle.
- The DEFENDER mark has been badged to the vehicle in the UK ever since 1990 with its position becoming more prominent over time.
- An all-new DEFENDER model was launched at the Frankfurt Motor Show in September 2019. This new model is badged with the DEFENDER mark, which appears prominently across the front of the vehicle, the vehicle cabin and on the steering wheel. Undated stock photographs are produced of images of the ‘new model’.¹¹
- A table consisting of the gross vehicle revenue figures for the DEFENDER model in the UK are produced between 2015 and 2020.¹²

Date	Revenue in excess of
2015	£180 million
2016	£160 million
2017	£5 million
2018	£1 million
2019	£100,000
2020	£4 million

- A table is produced of the Opponent’s unit sales figures for the DEFENDER model in the UK between 1994 and 2020.¹³ I have reproduced below only those figures within the relevant period.

¹¹ See Paragraph 13

¹² The figures have been rounded down so the actual figures are in excess of the numbers produced.

¹³ It is said that the figures have been rounded down to the nearest 10 for 2017-2019 and in other years to the nearest 1,000. The actual figures are in excess of the number appearing in the table.

2015	8,000
2016	2,000
2017	10
2018	<10
2019	<10
2020	4,000

- The figures 2016-2019 reflect the period between the old and new generation model. It is said that during this period there was still much interest in the DEFENDER vehicle as supported by the press reports (accessible and taken from various UK motor related websites such as Top Gear, Autocar, Motor1) produced in anticipation of the arrival of the new model.¹⁴
- Twenty seven invoices are produced showing sales of DEFENDER vehicles in the UK. The vehicles are described as DEFENDER models and appear to be sales to dealers rather than consumers. Some of the invoices predate September 2015 and others relate to used vehicle sales.¹⁵
- There is a network of over 150 LAND ROVER retailers operating in the UK. A screenshot is provided taken from the LAND ROVER UK website showing a list of LAND ROVER retailers in the UK. It is accepted that the website extract is undated but it is said it was filed in unrelated EU proceedings in October 2020 and is therefore indicative of the position at the filing date of the opposed application. The retailers are franchisees who promote the vehicles through their showrooms, in local press, business directories, websites, over the internet and on local radio. All of the vehicles available through the retailers feature the LAND ROVER trade mark.
- The global LAND ROVER website www.landrover.com has been operational since 1998 and customers can “find out about the DEFENDER” via its global website or in the UK via its country specific main UK website www.landrover.co.uk/index.html. Archived screenshots of the front page of the

¹⁴ AJB03

¹⁵ AJB04

Opponent's UK website www.landrover.co.uk during the relevant period are produced.¹⁶ The DEFENDER mark and images of vehicles are displayed in the top left corner of each front page and the vehicles themselves.

- The Opponent distributes promotional literature by way of brochures and pricelists. It is said that brochures are handed out to the public via its retailers at trade fairs, through the post or by downloads from the Opponent's websites. No details are provided however as to the number distributed or downloaded. The example produced is dated October 2021.¹⁷
- The Opponent offers a vehicle configuration platform via its websites. It is said that this facility "has been available since well before the relevant date in these proceedings". An archived screenshot dated 21 September 2020 is produced "showing access to the DEFENDER vehicle on the configuration platform".¹⁸ No information is provided as to the number of customers who used this facility or over what period.
- The Opponent has set up "Experience LAND ROVER Centres" including in the UK to allow the public the opportunity to drive vehicles from the range of LAND ROVER models including the DEFENDER. Archived webpage extracts from www.landroverexperience.co.uk are produced showing images of the DEFENDER vehicle.¹⁹
- The Opponent operates a number of social media platforms to include accounts with YouTube, Facebook, Instagram and Twitter under the handles "@LandRover", "@landrover" and "#LandRover_UK" which were launched between 2007 and 2013.²⁰ No specific details are provided as to which platform was launched during which year. Screenshots of posts and videos taken from these platforms are produced. The YouTube channel shows stills of videos dated between 1 year ago and 7 years ago from 21 March 2022 with the views for each video ranges between 20,000 and 212,000. The Opponent's Twitter account shows that it has 862.9k twitter followers but very few of the posts produced make any reference to the DEFENDER mark. In any event the posts themselves show little interaction with its consumers - between 2 and 42

¹⁶ AJB06

¹⁷ AJB07

¹⁸ AJB08

¹⁹ AJB09

²⁰ AJB10

tweets/retweets and between 39 and 177 likes. Its Instagram account shows that it has 8.9 million followers but that it has only made 2,450 posts. The posts do not appear to make reference to the DEFENDER mark. A similar picture emerges for its Facebook account with little of its posts or videos generating comments or likes.

- The Opponent uses its 'branding and large family of vehicles' to sponsor sporting events and rugby teams, to include the Rugby World Cup and International Rugby Tours over the last 20 years and London Wasps and Bath teams.²¹ It was the official sponsor for the Rugby World Cup competitions in 2011, 2015 and 2019. A special edition DEFENDER vehicle was designed for the 100 day Rugby World cup Trophy Tour across the UK and Ireland ahead of the 2015 World Cup. Articles are produced dated May 2015 from various publications discussing the sponsorship and how the DEFENDER was featured.²²
- The DEFENDER vehicle has won a number of awards. In 2015 the DEFENDER vehicle became the first car to be inducted into the Auto Express Hall of Fame. In 2020 it was awarded the accolade Car of the Year and Unstoppable Force in the TopGear.com Awards. Press coverage of these awards are produced dated Jun 2015 and December 2020.²³
- A press release from the Opponent refers to the new DEFENDER having received over 30 global accolades.²⁴ It is said that in 2021 the DEFENDER was named World Car Design Of The Year. An article dated April 2021 published in www.autoevolution.com explains that the award was a trade industry award awarded by a jury of 82 international automotive journalists. The DEFENDER is said to have been "launched in 2019 and has been met with universal acclaim by both the public and the automotive press".
- It is said that the DEFENDER vehicle has appeared in a number of films and television programmes since 1960 said to be available to the UK public.²⁵ A list of these films/programmes is produced taken from the Internet Movie Cars

²¹ AJB26

²² AJB11

²³ AJB12

²⁴ AJB12

²⁵ AJB15

Database. No viewing figures are produced or further details as to the consumer's exposure to the mark.

- The DEFENDER vehicle has featured in a number of James Bond films, to include No Time to Die, Skyfall and Spectre. The Opponent's special vehicle department constructed a bespoke DEFENDER vehicle for the Spectre film. The vehicles have been used by characters in the film or in car chase scenes. A press release with an access date of 21/11/2017 is produced taken from www.landrover.com referring to this partnership.²⁶
- In May 2015 the two millionth DEFENDER vehicle was built and later sold at auction for charity. An article published in Autocar dated 15 December 2015 is produced making reference to the event.²⁷
- The DEFENDER vehicle is recognised and promoted through online fan clubs based in the UK. Screenshots taken from three Facebook accounts are produced under the names "LAND ROVER DEFENDER ...OWNERS CLUB", "Land Rover Defender Lover's" and "Land Rover Defender". They show membership numbers ranging between 34,000 and 90,000. The screenshots do not show the proportion of members that are geographically based in the UK. A post, dated 12 September 2017, refers to its collaboration with the Barbour clothing brand. It generated 83 likes.²⁸
- A number of articles are produced published in the general press and automotive magazines which refer to production of the DEFENDER vehicle ending in January 2016 and the relaunch in 2019.²⁹
- Due to the longevity of the design a number of vehicles remain on the road and are resold. The Opponent set up a new LAND ROVER REBORN department to enable original vehicles to be restored. AJB21 includes a screenshot taken from the Opponent's website. Other than the presence of the facility the screenshot includes no meaningful information as it does not relate specifically to the DEFENDER mark.
- The remainder of the evidence relates to merchandise and video games licencing agreements relating to the DEFENDER vehicle with products being

²⁶ AJB16

²⁷ AJB17

²⁸ AJB18 and AJB19

²⁹ AJB20

sold by various licensees. No details are provided as to the expenditure, royalties or income received through these agreements, as the invoices exhibited at AJB 23 have been redacted. In relation to the video games the Opponent licences the DEFENDER image to video game companies where a computer generated image of the vehicle is used as part of the game.³⁰

- The Opponent organises events and competitions. The DEFENDER CHALLENGE rally series has been taking place since 2014. The DEFENDER vehicle is exclusively used in this series of races.

The Applicant's Evidence and Observations in reply

79. The Applicant's evidence consists of the witness statement of Michael Green dated 27 May 2022 accompanied by six exhibits marked 01MG - 06MG. The Applicant also filed observations in reply of the same date.

80. Mr Green is a Senior Associate in the employ of Lane IP and provides his statement to supplement the submissions and observations filed by the Applicant. A summary of the evidence is as follows:

- the Applicant provides e-sports experiences to consumers since 2016.
- Figures relating to the sales prices of Defender vehicles are produced said to show that the starting price for the vehicle is circa £41,000.³¹
- Results of internet searches for the total number of cars sold in the UK in 2020 are produced.³²
- Sales figures for other types of passenger cars such as Nissan Juke and Ford Focus are produced, which is said to show a significantly higher number of cars being sold during the relevant period.³³
- Sales figures for other video games released during the relevant period are produced said to show a much higher number of sales in the UK when

³⁰ AJB21-24.

³¹ MG02

³² MG03

³³ MG04

compared to the sales of video games in which the Land Rover Defender is included.³⁴

- In relation to the Opponent's sponsorship deal with Wasps RFC an article is produced said to show that the sponsorship only relates to LAND ROVER and not the DEFENDER.

Applicant's Observations in Reply

81. The purpose of these observations is to respond to and rebut a number of claims made by Ms Beaton in her evidence. In particular the Applicant disputes the following:

- Given the size of the UK car market the Opponent has not demonstrated it has a sufficient reputation in the mark DEFENDER.
- Insufficient evidence has been filed to demonstrate market share and intensity of use during the relevant period.
- No evidence has been provided to support the broad claim that the Opponent is 'globally renowned' or is 'the largest automotive manufacturer by volume'.
- The table of figures appearing at paragraph 7 are global figures and do not represent figures for the UK.
- The evidence shows use and longevity for the LAND ROVER mark and not the DEFENDER mark as claimed. Overall the evidence does not show use solely for the DEFENDER mark but in conjunction with its LAND ROVER mark.
- The revenue figures produced at paragraph 14, whilst appearing high, should be read in the context that the individual units are priced at circa £41,000 or higher. These figures are starting prices and do not include add-ons.³⁵ Taking these figures into account the revenue figures produced by Ms Beaton in reality only show that 121 cars were sold in 2017, 24 cars were sold in 2018, 2 cars were sold in 2019 and 97 in 2020.
- The sales figures and the revenue figures in the respective tables don't align and therefore should be deemed unreliable. Taking a unit price of £41,000

³⁴ Exhibit 05MG

³⁵ Exhibit 02MG

without add-ons, if 4,000 units had been sold in 2020, then one would expect the revenue figure to be over £160 million and not £4 million as claimed.

- The figures produced only show a low market share in the motor vehicles industry when taking a comparison with other types of cars sold in the market. In 2020 the total number of cars in the UK was 32.7 million and a significantly higher number of other car types were sold during the same period when compared to the number of DEFENDERS sold.
- Whilst a number of magazine and online articles are dated within the relevant period many are outside and do not show circulation figures in the UK nor the actual number of people who had read the articles. No indication is given of the extent that the public is aware of the awards and accolades referred to in these articles. The press releases are taken from the Opponent's own website with no data as to the number of views.
- Given that sales are made by the franchisees and dealers, no evidence is produced to demonstrate that the Opponent has accrued goodwill. No evidence of promotional material, business directories, websites, webpages and radio adverts undertaken by the Opponent's franchisees have been produced to demonstrate use of the DEFENDER mark.
- No evidence has been produced to demonstrate the investment made by either the Opponent or the franchisees in promoting the Land Rover Defender.
- The evidence relating to domain names and web addresses under the name LAND ROVER do not prove the repute of the DEFENDER mark.
- The price list and brochure at exhibit AJB07 is dated outside the relevant period and no figures are produced to show the number of brochures and price lists that were printed or distributed to UK consumers or downloaded from the Opponent's website within the UK nor the cost of producing the same.
- In relation to the configuration platform no evidence is produced as to the number of consumers who have used this programme in the UK or whether the UK public are aware of its availability. No details are given as to when this facility became available other than "well before the relevant date". It is accepted that the configuration platform exists and did exist during the relevant period but without further information as to the extent of use by consumers it is of little value in demonstrating use.

- Evidence of the Experience days (AJB09) are taken from the Opponent's own website. No information is produced as to the number of consumers who participated in these experiences days and how many chose to drive the Land Rover Defender. The Experience is referred to as the Land Rover Experience and not the Defender Experience and therefore does not show reputation for the mark Defender.
- Disputes that the Opponent has an active social media presence. The screenshots do not demonstrate an awareness in the brand by a significant number of UK public or repute in the mark DEFENDER given that the handles for these platforms are under the name LAND ROVER and not DEFENDER. No details are provided as to the proportion of followers which are based in the UK.
- It is accepted that James Bond films have been watched by millions of people in the UK but there is no evidence that the car type would be recognised by viewers no evidence has been provided to show the mark in use.
- The reference to sales figures and units do not align and do not demonstrate sales specific to UK. The evidence that relates to the fan club in the form of screen shots does not show the location of the club and does not demonstrate awareness of the mark in the UK. The fan club membership figures are not significant amounting to a little more than 1% of the relevant car purchasing public. The number of likes in comparison to the number of followers is limited.
- No details are provided as to the number of DEFENDER vehicles that have been restored or repaired.

Second Witness statement of Amanda Beaton dated 27 July 2022

82. In answer to some of the criticisms raised by the Applicant, Ms Beaton provides the following additional information and material:

- A collection of screenshots from annual reports published by the Society of Motor Manufacturers and Traders between 2017 and 2022 showing that the

Opponent was the UK's largest automotive manufacturer in 5 of those years.³⁶

- A further table of UK revenue figures and number of vehicles sold per calendar year between January 2015 and December 2020 is produced relating to all vehicles sold by the Opponent including the DEFENDER model.
- A further table of the gross vehicle revenue figures and number of vehicles sold under the DEFENDER mark in the UK is produced between 2015 and 2020 (reproduced below). It is said that the figures prior to FY20 reflect the previous generation DEFENDER vehicles before the launch of the updated model in 2020. Between the end of mass production of the old generation DEFENDER in 2016 and the model relaunch in 2020 high valued and bespoke versions of the DEFENDER were still on offer. The 110 works v8 model for example was priced at over £150,000 per vehicle.

	CY15	CY16	CY17	CY18	CY19	CY20
Units Sales	In excess of 8,000 vehicles	In excess of 2,000 vehicles	In excess of 10 vehicles	Less than 10 vehicles	Less than 10 vehicles	In excess of 4,000 vehicles

	FY15	FY16	FY17	FY18	FY19	FY20	FY21
Gross Vehicle Revenue (GBP)	In excess of 150 million	In excess of 150 million	In excess of 5 million	In excess of 1 million	In excess of 100,000	In excess of 3 million	In excess of 300 million
Units Sales						In excess of 100 vehicles	In excess of 5,000 vehicles

³⁶ AJB27

- Details of the number of employees employed by the Opponent in the UK between January 2017 and January 2020.
- Details and screenshots taken from its own and third party websites of the historic and contemporary use of the DEFENDER vehicles by the British Armed Forces, mountain rescue teams, charitable organisations, emergency services and off road competitions.
- In the financial years 2020 and 2021 the Opponent's media investment advertising spend for the DEFENDER mark in the UK, was in excess of £300,000 and £2 million respectively.
- A list of franchise retailers in the UK is produced as well as screenshots showing their websites and how they promote the mark.
- Screenshots of the availability of downloadable DEFENDER brochures are produced using the Archive WayBack Machine website from May 2020 and an extract of the 2019 brochure.
- Further articles issued by the UK automotive trade press referring to the configuration platform and awards won by the DEFENDER vehicle.
- An undated article/blog taken from www.conceptcarcredit.co.uk discussing the 7 best car magazines in the UK. It refers to a number of publications such as Top Gear, Autocar and Auto Express and provides details of the number of subscribers and circulation figures for the magazines.³⁷
- You Tube video stills of the promotional rehearsal footage of the film No Time to Die showing the DEFENDER, which generated between 2 and 4 million views.
- Screenshots of other automotive social media accounts showing comparable subscriber numbers.
- An article referencing the Nissan Juke and Ford Focus vehicles costing under £25,000 in contrast to the base price of the new DEFENDER which is over £50,000 considered a premium vehicle.³⁸
- Consumer reviews of the Land Rover Experience making reference to the DEFENDER.

³⁷ AJB35

³⁸ AJB36

83. This concludes the summary of the evidence and observations in reply in so far as it is relevant.

Proof of Use

84. The relevant statutory provisions are set out in section 6A of the Act, which states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

mark in the variant form is also registered in the name of the proprietor),
and

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

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

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

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

85. 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.”

Relevant Period

86. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the third earlier mark is the five-year period ending with the date of priority claimed by the contested mark namely the date retained as its original EU filing date, i.e. 21 September 2015 to 20 September 2020.

Genuine Use

87. What constitutes genuine use has been the subject of a number of judgements. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the

goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide;

and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

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

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them;
- e. The geographical extent of the use shown.

89. Use does not need to be quantitatively significant in order to be genuine, however, 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 market for the goods or services protected by the mark” is not genuine use.³⁹

Form of the mark

90. Where the Opponent has used the earlier mark in the form in which it is registered, namely in its word only format, then clearly this will be use upon which the Opponent may rely. The Applicant raises a number of criticisms that the mark DEFENDER does not appear solus, but rather throughout the evidence it is shown in combination with other marks/words, for example, as LAND ROVER DEFENDER and CLASSIC DEFENDER. On this basis it argues that the evidence of use should be dismissed. This is not a particularly strong or persuasive argument since it is settled caselaw that a mark may be used with another mark and still retain trade mark significance.⁴⁰ It matters not therefore whether the mark is used solus or in combination with a different mark provided it does not alter the distinctive character of the mark. In the decision in suit the distinctiveness of the word DEFENDER would be unaffected by its use with other words/marks and I do not consider it would impair its ability to indicate trade origin.

Assessment of the evidence and conclusion

91. Ms Beaton’s evidence in chief and evidence in reply sets out the Opponent’s position regarding the use it has made of the mark during the relevant period but also serves as providing evidence of its reputation. At the hearing Ms Jones dealt with both the question of use and the Opponent’s reputation together. However the evidence filed is extensive and a number of the documents produced for the purposes of the genuine use requirements fall outside the relevant period or do not relate to the mark in question. Therefore putting to one side the assessment of the Opponent’s reputation of the mark for the time being, the matter for me to consider initially is whether and to

³⁹ *Nike Innovate CV v Intermar Simanto (Jumpman) O/222/16* Daniel Alexander sitting as the Appointed Person on appeal

⁴⁰ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 at [31] to [35]

what extent the Opponent has shown that it has genuinely used the third earlier mark for *motor land vehicles* during the relevant period.

92. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, where Mr Daniel Alexander K.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.”

93. Furthermore in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs K.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.”

94. At the outset I accept the criticism raised by the Applicant as to the content of Ms Beaton's statements. I accept that a great deal of the evidence relates to material that is either undated or dated outside the relevant period for the purposes of the use assessment.

95. The revenue figures produced in the various tables, relate to global worldwide figures, for the company as a whole and for its whole fleet of vehicles. Those tables that specifically relate to vehicles sold under the DEFENDER mark in the UK, are contradictory and as argued by the Applicant, appear to conflict with each other. For example Ms Beaton states that in excess of 4,000 vehicles were sold in the calendar year 2020, but the gross vehicle revenue figures for the same financial year, shows revenue "in excess of £3 million". Given that the Opponent accepts its vehicles retail at approximately £50,000, the figures do not align. The Applicant also submits that given the market share of the automobile industry, the figures are insufficient to demonstrate anything other than a very low market share. At the hearing Ms Jones offered an explanation as to how to interpret the revenue/sales unit figures and what periods the calendar years and financial years related to. She explained the inconsistencies by stating that part of the unit sales for the calendar year 2020 were recorded in both the 2019 and 2020 financial years i.e. that the periods overlapped.

96. It is accepted by the Opponent that the DEFENDER vehicle ceased production in May 2016 only to be relaunched in Germany in 2019. I am unclear exactly when production restarted and when and in what month sales actually took place in the UK thereafter, only that sales appeared to have recommenced in 2020. I am not told whether this was for the whole year or covered a period half way through, however there appears to have been a period where during this time the Opponent was relying on second hand sales and bespoke personalised orders (invoices at exhibit AJB04 and paragraph 7 of Ms Beaton's second statement). Very limited information is given as to the actual or total volume of used cars sold in the UK. It is clear from the caselaw that sales by the proprietor, or with his consent, of used goods marketed under the trade mark may in principle count as genuine use of the mark. It has been found that where a proprietor uses the mark in accordance with its essential function which is to guarantee the identity of the origin of the goods for which it was registered this is capable of constituting genuine use. The principle of exhaustion of rights does not

prevent a proprietor from putting to use, goods already put on the market under the trade mark.⁴¹

97. The evidential burden of satisfying the tribunal as to whether genuine use of the mark at issue has been shown, falls with the Opponent. It is clear that no particular document is required for that purpose nor is there a minimum threshold, sometimes even minimal use is sufficient in order for it to be deemed genuine.⁴² I must assess the evidence globally, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.

98. Notwithstanding the criticisms, I take particular note that the new DEFENDER model vehicle was relaunched in 2019 after production had ceased for a number of years and that by 2020 sales had recommenced. This tells me that there was still a demand for the vehicle during that hiatus. In 2015 the revenue was £180 million and although it had dropped considerably in the years 2017 to 2019 sales were still taking place, increasing to £4 million in 2020. During this same period over £300,000 was expended in advertising the mark in the UK in 2020, which coincides with the relaunch date. In relation to market share, I accept that the DEFENDER vehicle is not a budget car and that the market share for such vehicles would be lower than for cars in a less premium price bracket.

99. The Opponent has shown that over 100 retailers and franchisees sell its goods and although it is clear that they will not solely be dealing with DEFENDER vehicles at least some of the sales will be attributed to this mark. The accessibility of brochures being available to download, does not show me how many were in fact distributed or downloaded by consumers nor how many were converted into sales, but does show that the vehicle was being actively marketed which is certainly true for at least 2019 and 2020 and the period of the relaunch. I note that the mark has been promoted in high profile films particularly in the James Bond franchise and through its sponsorship of sporting events and rugby teams. These examples demonstrate its commitment to marketing the DEFENDER mark. Its social media presence and fan club evidence is

⁴¹ Joined Cases C-720/18 & C-721/18, EU:C:2020:854, *Ferrari SpA v DU*

⁴² *Naazneen Investments Ltd v OHIM*, Case T-250/13

modest and no information is provided as to the geographical location of the users, but I accept that the fan clubs are based in the UK and therefore it is reasonable to conclude that at least a reasonable proportion would be UK members.

100. Taking all this into account and looking at the evidence as a whole and accepting that the evidence is not without its faults, overall, I consider that the Opponent has crossed the necessary hurdle to sufficiently demonstrate use of its third earlier mark for motor land vehicles.

101. Having established that the Opponent has satisfied the proof of use requirements I shall move on to consider the ground of opposition under section 5(3).

Section 5(3)

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

“A trade mark which-

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

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

103. The relevant case law can be found in the following judgements of CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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

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

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

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

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

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

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such

a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

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

104. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier marks are similar to the Applicants' mark. Secondly, that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage will be suffered. It is unnecessary for the purposes of section 5(3) for the goods and services to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between them. For the purposes of section 5(3) the relevant date for the assessment is the date of filing of the application in the EU namely 25 September 2020.

Similarity of the marks

105. Given that the third earlier mark is for the word DEFENDER, which is identical to the first earlier mark, my considerations as to the similarities between the respective

marks under section 5(2)(b) would apply equally here. For the reasons outlined in paragraphs 47-52, I found the marks to be visually similar to a low degree, aurally similar to a medium degree and conceptually between a low to medium degree of similarity. In so far as the overall similarity, therefore, this first condition is met.

Reputation

106. In assessing whether the earlier mark has a reputation for a significant number of consumers I must assess the evidence in terms of the extent it demonstrates “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”⁴³

107. The position in relation to its reputation is different to the proof of use requirements, given that the reputation must be established as at the relevant date namely 25 September 2020. The evidence is not restricted to the constraints of the five preceding years required for the proof of use considerations, as the evidence prior to the relevant date may cast light backwards and therefore may be relevant. The evidence in this regard is significant as to the average consumers’ awareness of the brand. This is supported by the awards in well-known UK automotive magazines and the high regard the vehicle is held by the public. Whilst the revenue and unit sales figures diminished after production ceased in 2016 it is clear that sales recommenced in 2019/2020 after its relaunch. High profile campaigns, sponsorship deals as well as licensing agreements with popular video game franchises support the Opponent’s visibility and reputation with consumers. In light of my assessment of the evidence, I am satisfied that the Opponent has demonstrated a significant reputation in its DEFENDER mark due to its longevity of use and the recognition in the brand by UK consumers. I am satisfied that the Opponent has demonstrated that the DEFENDER is famed for its durability and reliability which is why it is used by a number of professionals including the armed forces, emergency services and search and rescue teams. I am satisfied that the earlier mark was known by a significant part of the public as at the relevant date. The DEFENDER mark has been demonstrated to have a significant reputation.

⁴³ *General Motors* para 28

Link

108. Having found a reputation I must now go on to consider whether the public will make the required mental link between the respective marks taking account of all the relevant factors. For the goods and services under consideration, the relevant public is the public at large and for some of the services the business user, who are deemed to be reasonably informed and reasonably observant and circumspect. The factors to be taken into account are those as set out in *Intel*.⁴⁴ Taking each of these factors in turn.

The degree of similarity between the conflicting marks

109. In *Adidas-Salomon*, the CJEU held that the similarity of signs must be assessed in the same way for section 5(2)(b) and 5(3) of the Act. Accordingly, my findings at paragraphs 47 to 52, apply equally here and I adopt those findings.

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

110. The assessment undertaken for the ground of opposition under section 5(2)(b) related to different goods and services than the one to be undertaken for its claim under section 5(3). The Opponent relies upon motor land vehicles in class 12. The Opponent accepts that the Applicant's goods and services in class 38 relate broadly to the transmission distribution and provision of access to computer/video games and digital content and in relation to class 41 entertainment, education and the organisation of competitions and events. Those goods in class 9 are computer and game related hardware and software and clothing, headgear and footwear in class 25.

111. I see no obvious similarity between these goods and services and the Opponent's motor land vehicles in class 12. They differ in nature, serve different needs, have different purposes and methods of use and do not share the same distribution channels. They are neither complementary nor in competition. Accepting that there

⁴⁴ *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU)

will be components of a modern motor vehicle that include computer related software and that the Opponent being a car manufacturer will have suppliers that supply it with parts, components and computer related elements for the finished product, the general public will understand that the final product incorporates a number of components sourced from third parties but assembled by the car manufacturer. The finished product will undoubtedly include computer systems integrated into the vehicle but these goods and services are not commonly produced by the car manufacturer. They will generally be provided by a computer or software specialist. Whilst it may be argued that they are complementary in so far as being indispensable, I do not consider that they are in accordance with the caselaw. I do not find the arguments put forward that use of a computer generated image of the Opponent's DEFENDER motor vehicle within a video game is sufficient to find similarity between the goods and services at issue. The respective goods and services are dissimilar.

The strength of the earlier marks' reputation

112. I have found that based upon the evidence filed, the Opponent has a significant reputation for its motor land vehicle goods.

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

113. The distinctive character of the earlier mark resides in its word DEFENDER. It did not claim an enhanced degree of distinctive character for its claim under section 5(2)(b). I found that being an ordinary dictionary word the inherent distinctive character of the mark was medium. It follows having found a reputation in the third earlier mark that as a result of the use made of it for motor land vehicles, given that the evidence for both overlaps, it would have enhanced that distinctive character from a medium degree to higher than medium degree but not significantly so.

Whether there is a likelihood of confusion

114. For the reasons outlined above I did not find that there was a likelihood of confusion under section 5(2)(b).

115. Noting that the level of similarity required for the public to make the necessary link between the marks for the purposes of 5(3), is less than the level of similarity required to create a likelihood of confusion, it is not fatal to the Opponent's case that I did not find a likelihood of confusion under section 5(2)(b). However, it does, nevertheless, require the relevant section of the public to make a connection between those marks in order for the types of injury to arise.⁴⁵

116. For a link to be found the burden is on the Opponent to show enough of a reputation which can overcome the differences between the marks and any dissimilarity between the goods/services which would cause the earlier mark to be brought to mind by the later mark. Whilst a lesser degree of similarity between the marks may be sufficient for the public to make a connection between them, to my mind the visual and conceptual differences between the marks are not overcome by the Opponent's reputation which I remind myself is solely in motor land vehicles. Although the earlier mark has achieved a higher than medium degree of distinctive character (through use), the word itself (the common element) is an ordinary dictionary word and I remind myself that the its reputation is also in a completely different field.

117. Ms Jones argues that the relevant public will make a link due to the high degree of similarity between the marks, its reputation and the connection between Birmingham and the DEFENDER vehicle and brand (being manufactured in and around Birmingham) and the use and notoriety of the DEFENDER mark in the video/computer games industry. I do not find this to be the case. The historic connection between the Opponent as a car manufacturer and the city of Birmingham is unlikely to be at the forefront of consumers' minds upon first impression when coming across the contested mark, due to the device element upon which the word DEFENDERS is presented which is an equally dominant element of the mark. Furthermore, consumers would not consider a connection between the respective marks, because the video game happens to feature a computer image of the DEFENDER vehicle in the game itself. Consumers will not consider that the game exclusively relates to this vehicle or that the undertakings are related. There are clear visual differences between the respective marks. I do not envisage consumers, when

⁴⁵ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P

seeing the contested mark on computer related goods or clothing for example or for video game services, making a link between this mark and DEFENDER which purely has a reputation for motor land vehicles. Consumers will not solely focus on the word DEFENDERS in the contested mark. The bringing to mind as described in my conclusion under the section 5(2)(b) ground would be fleeting at best and certainly insufficient to lead to any of the heads of damage arising. Taking all the factors into consideration I conclude that the relevant public will not make a link between the marks.

118. The opposition under section 5(3) also fails.

Conclusion

119. Based on these findings the opposition fails in its entirety and subject to any successful appeal, the application may proceed to registration.

Costs

120. As the Applicant has been successful it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Taking this into account and applying the guidance, I award costs to the Applicant on the following basis:

Considering the notice of opposition and preparing a defence and counterstatement:	£300
Preparing evidence and considering and commenting on the Opponent's evidence:	£1000
Preparing submissions in lieu of hearing:	£400
Total	£1700

121. I order Jaguar Land Rover Limited to pay Belong Gaming LLC the sum of £1700 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry

of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 9th day of February 2023

Leisa Davies
For the Registrar

Annex

Trade Mark Application 3616408 List of Goods /Services

Class 9: Computer software; computer hardware; game software; computer game software; video game software; video game cartridges; video recorders; video screens; computer game software for use on mobile and cellular phones; electronic game software for mobile phones; computer games programs downloaded via the internet [software]; application software for mobile phones; computer game software for computers, mobile phones and tablet computers; computer software for the management, transmission, storage and sharing of computer games and video games; downloadable information relating to games and gaming; interactive computer game and video game software; virtual reality computer game and video game software; interactive electronic computer game and video game software; computer game and video game programs; electronic computer game and video game programs; interactive computer game and video game programs; virtual reality computer game and video game programs; downloadable computer and video game software and programs; downloadable electronic computer game and video game software and programs; downloadable interactive computer game and video game software and programs; downloadable virtual reality computer game and video game software and programs; interactive multimedia computer game and video game programs and software; electronic publications, downloadable, relating to games and gaming; instructional manuals in electronic format; audio-visual headsets for playing video games; software for social networking; software for sending and receiving electronic messages, graphics, images, audio and audio visual content via the internet and communications networks; software for wireless content, data and information delivery; downloadable software to enable uploading, creating, posting, showing, displaying, blogging, sharing and otherwise providing electronic media or information over the internet and other communications networks; downloadable software in the nature of a mobile application for social and personal networking; downloadable software in the nature of a mobile application

for creating, sharing, disseminating and posting photos, videos, personal and general information for the purposes of social, personal and professional networking; application programming interface (api) for computer software which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; downloadable electronic publications; information technology and audio-visual equipment; software allowing users to post questions with answer options; software allowing users to join discussions and post comments about opinion polls, questions and answers; software allowing users to give compliments and positive feedback; software for creating, managing, and interacting with an online community; software for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing or otherwise providing electronic media or information via computer and communication networks; software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; software for sending and receiving electronic message alerts, notifications and reminders; software for remote communication; messaging software; software for recording, playing and transmitting videos; video sharing software; downloadable videos; mobile application software for recording, playing and transmitting videos, films and pictures; software for recording time in computer games and video games; software for displaying in-game data and scores; software for recording computer game and video game footage; software for taking screenshots of computer games and video games; software for computer game and video game enhancers; computer software for the administration and distribution of on-line games and gaming; computer software to enable peer-to-peer networking and file sharing; computer software for the management, transmission, storage and sharing of computer game programs and electronically stored information across computer networks to users, for downloading and use of games by users; Electronic software updates, namely, downloadable computer software and associated data files for updating computer

software in the field of games, provided by computer and communication network; telecommunications software; electronic bulletin boards; computer software for providing help, support and strategies for computer games; social networking software and computer game software for finding and matching computer game players; computer software for providing news and information in relation to computer games, video games, gaming and social networks; computer software for real-time voice communication between users; computer software for analysing and improving network and internet connectivity; computer e-commerce software to allow users to conduct electronic business transactions in online marketplaces via a global computer network.

Class 25: Clothing; footwear; headgear.

Class 38: Telecommunications; television broadcasting; communications by computer terminals, video, wire, satellite, microwave and cable; broadcasting of cartoon films and animated films; streaming of video content namely cartoons, via a global computer network; transmission of digital files; wireless broadcasting; providing voice chat services; electronic transmission of computer software via the internet and other computer and electronic communication networks; transmission and distribution of data or audio-visual images via a global computer network of the internet; provision of connectivity services and access to electronic communications networks for transmission or reception of computer software; communications via a global computer network or the internet; streaming of video content via a global computer network; multi-media telecommunication services; interactive telecommunications; transmission of data and of information by electronic means, mobile, computer, cable, communications satellite or electronic communication means; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; broadcasting or transmission of television programmes; provision of telecommunications connections to electronic communication networks, for transmission or reception of audio, video or multimedia content; providing user access to the internet (service providers); provision of access and connection to server centres, database server centres, worldwide communication networks or private or restricted access networks; electronic data

exchange; providing access to gaming websites; transmission of computer games, video games, electronic games and interactive games via the internet, computer networks, and electronic computer networks; transmitting information electronically including web pages, computer programs, text and other data; provision of access to on-line chat rooms and bulletin boards; providing online facilities for real-time interaction with other computer users; web-streaming being the transmission of data, information and audio-visual data via the Internet or other computer network; direct and on-demand streaming video audio and video material, interactive content, video games and applications over Local Area, wireless and global computer networks; providing networking services for establishing multiple-user access to a Wide Area Network and Local Area Network; transmission of written and digital communications; leasing and rental services in connection with telecommunications apparatus, equipment and computer databases; operation of chat rooms; transmission of news and news information via a computer network and/or the Internet; remote data access services; online instant messaging; provision of access to computer databases and directories via the Internet and global computer networks; rental of access time to computer apparatus and database server centre; telecommunication of information (including web pages), computer programs and any other data; video broadcasting, broadcasting pre-recorded videos featuring music and entertainment, television programs, cartoons, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via a global computer network, computer and other communications networks; streaming of video material on the internet; broadcasting of audio and video content and programming over the internet; electronic transmission and streaming of digital media content for others via global and local computer networks and via mobile electronic devices; telecommunication services, namely, transmission and streaming of voice, data, images, audio, video, real-time news, entertainment content, or information by means of telecommunications networks, wireless communication networks, and the internet; broadcasting services; broadcasting and transmission of interactive television, interactive games, interactive entertainment and interactive competitions; providing access to computer networks for the playing of games and access to competitions for those games via a global computer network, wireless networks or interactive television; chatroom services for social

networking; streaming of audio and video material on the internet; provision of online forums; information, advisory and consultancy services relating to all the aforesaid.

Class 41: Education; providing of training; entertainment; video game services; arranging and conducting of conferences; arranging and conducting of workshops [training]; provision of on-line computer games, video games, electronic computer and video games, interactive computer and video games, virtual reality computer and video games, multiple player computer and video games; gaming services; on-line gaming services; computer gaming services; arranging of on-line gaming; arranging and organising of computer gaming events, competitions and tournaments; arranging and organising of on-line gaming events, competitions and tournaments; video game entertainment services; video game arcade services; internet games; rental of video and computer games; provision of online computer games; provision of online video games; provision of online interactive computer and video games; conducting multiple player games; provision of online interactive computer games; providing information relating to computer games and computer enhancements for games; providing information to game players about ranking and scores in respect of gaming; hosting of gaming leagues; game services provided online from a computer network; providing online information on computer and video game strategies; electronic games services in the nature of computer games provided online of by means of a computer network; provision of online information in the field of computer games; providing interactive multi-player computer games via the internet and electronic communication networks; provision of computer and video game arenas; organisation of parties and events in respect of computer and video gaming; organisation of parties and events in a computer and video game arena; organisation, arranging and provision of conventions; organisation, arranging and provision of conventions in respect of computer and video games, gaming, online gaming, virtual reality gaming; interactive gaming and multiplayer gaming; electronic desktop publishing; entertainment information; film production, other than advertising films; game services provided on-line from a computer network; games equipment rental; movie studios; organization of competitions [education or entertainment]; production of music; production of radio and television programmes; providing on-line electronic publications, not downloadable; publication of books;

publication of electronic books and journals on-line; scriptwriting services; television entertainment; providing online games; providing computer games and video games that can be accessed, played and downloaded over computer networks and global communications networks; providing entertainment via computer networks; arranging and conducting competitions for video game players and computer game players; entertainment in the nature of contests, competition and games; organising of games; interactive games, interactive entertainment, interactive competitions and interactive quizzes; providing information on video games and computer games; provision of multimedia entertainment content via computer networks; publishing and providing of computer games; electronic games services provided from a computer database or by means of the internet; electronic games services, including provision of computer games on line or by means of a global computer network; entertainment services, namely, providing temporary use of non-downloadable computer games; providing an online computer game; providing a web site through which people locate information about tournaments, events, and competitions in the video and computer game field; help, advice and support services relating to computer games, namely, consulting relating to how to play the computer games and strategies for winning computer game; information, advisory and consultancy services relating to all the aforesaid.

Opponent's list of goods and services

Opponent's EUTM 15433436

Class 9: Computer hardware; on-board computers for vehicles; computers for autonomous-driving; on board electronic systems for providing driving and parking assistance; cruise control systems for vehicles; vehicle speed control apparatus; computer software; automotive computer software and hardware; computer software for use in relation to vehicles; telemetry devices for motor vehicle and engine applications; downloadable mobile applications; Global positioning system (GPS); navigational systems, comprising electronic transmitters, receivers, circuitry, microprocessors, cellular telephone and computer software all for use in navigation and all integrated into a motor vehicle; downloadable electronic maps; electric control panels; electronic control apparatus, instruments and displays; sensors; integrated electronic safety systems for land vehicles; safety and driving assistant systems; lasers for use in relation to vehicles; cameras for vehicles; onboard cameras; action cameras; parking sensors and rear-view cameras for vehicles; automotive measuring instruments; electronic apparatus for collecting measurements and receiving data; wireless transmission and receiving equipment; interactive multimedia software; electric connections; anti-theft warning devices; alarm sensors; gauges; instrument panels and clusters; odometers; speedometers;

tachometers; temperature sensors; voltmeters; ammeters; testing apparatus; proximity meters; electric circuit breakers; commutators; electric condensers; electric connections; electric cables; electric fuses; electric fuse boxes; electric control apparatus and instruments for motor vehicles and engines; electrical sensors; fire extinguishing apparatus; gauges; lenses for lamps; printed electrical circuits; electric relays; electric switches; electric wiring harnesses; testing apparatus; Apparatus for recording, transmission or reproduction of sound and images; mechanical remote controls for motors; remote control starters for vehicles; emergency warning lights; emergency notification system; Wireless controllers to remotely monitor and control the function and status of other electrical, electronic, signaling systems and mechanical devices for use in connection with vehicles and engines for vehicles; computer software, mobile applications and wireless transmission and receiving equipment for use in connection with autonomous and hands-free driving, automobile safety features and warning or alarm functions, accident prevention and traffic alerts; communications apparatus to transmit and receive communications via vehicles; charging stations for charging electric vehicles; apparatus and cables for use in charging electric vehicles; batteries for vehicles; electric accumulators, voltage regulators, aerials, electric batteries and mountings; Computer hardware and software for tracking driver behaviour; sensors, computers and wireless transceivers to provide connectivity within the vehicle, between vehicles, with cell phones, and with data centers; computer hardware, software and electrical apparatus to provide tactile, audible and visual interfaces to interact with occupants of the vehicle; Wireless transmission and receiving equipment for use in connection with remote computers for use in automobiles for tracking, monitoring and diagnosing maintenance for vehicles and for providing information to drivers; Computer application software for use by drivers and passengers of vehicles for accessing, viewing, and interacting with and downloading information and entertainment content; Downloadable software and on-board computer software that provides users with remote and in-vehicle access to motor vehicle functions and functions relating to driver safety, convenience, communication, entertainment, and navigation; diagnostic apparatus consisting of sensors for use in testing vehicle function and in diagnosing vehicle electrical and mechanical problems; software and software applications to allow users to track and locate stolen vehicles, charge electronics, and store and synchronize collected personalized user and vehicle information; electronic interface modules sold as an integral part of a vehicle; display panels for vehicles; electronic interface modules for wired and wireless interface of mobile phones and electronic media players with an automotive electrical system; integrated electronic automated systems for vehicles; audio, audiovisual or telecommunications equipment; Radio apparatus; in-car entertainment systems; sound reproducing equipment; televisions; radios; CD players; loud speakers; Personal Digital Assistants; tablet computers; multimedia devices; MP3 or MP4 apparatus and equipment; mobile hard drives; Universal Serial Bus drives; cases for mobile phones, smartphones, computers, personal digital assistants, laptops, notebook computers; chargers for mobile phones, smartphones, laptop and tablet computers; telephones; mobile telephones; mobile phone and tablet computer headsets and accessories; straps and charms for telephone handsets; screensavers for phones and tablets; car telephone installations; computer games, computer games software; recording media; storage boxes for recording media; highway emergency warning equipment; thermometers; compasses; calculators; electronic instructional and teaching apparatus and

instruments; electrical and scientific apparatus for use in the repair and servicing of vehicles; magnets; tape measures; eyewear, glasses, sunglasses, driving glasses, skiing goggles; cases for eyeglasses, sunglasses or skiing goggles; drivers helmets; racing driver protective clothing; apparatus, gloves and clothing, all for use in protection against accident or injury; parts and fittings for any of the aforesaid goods.

Class 25: Clothing, footwear, headgear; outerwear; leisurewear; T-shirts, tops, polo shirts, sweatshirts, hooded tops, hooded pullovers, shirts, fleece pullovers, fleece jackets, sweaters; suits, coats, dresses, skirts, jackets, vests, blazers, anoraks; sweatpants, trousers, shorts; overalls, coveralls, uniforms, smocks; underclothing, pajamas, sleep masks, pocket squares, swimwear, bathing suits, bathing trunks; scarves, bandanas, sashes for wear; hosiery, socks, stockings; cloth bibs; costumes; fancy dress costumes; aprons; belts; gloves, mittens, driving gloves; ties; headgear, hats, caps, head scarves, head wraps, headbands, visors, ear muffs, knitted beanies; footwear, shoes, boots, slippers, drivers shoes, sandals; childrens clothes; babies clothes; sports teams club shirts; sports teams scarves; sports teams training kit; sports teams replica kit; sports teams supporters clothing, headgear and footwear.

Class 28: Toys, games, and playthings; Scale models and toy models, all of motor land vehicles, all sold complete or in kit form; remote control toy vehicles; rideable toy vehicles; ride-on toy vehicles; fairground rides; coin-operated toy vehicles; handheld computer games; computer games equipment adapted for use with TV receivers; computer controlled toys; computer controlled toy-vehicles; computer controlled scale model vehicles; Sports equipment;

Opponent's EUTM 16481988
DEFENDER CHALLENGE

Class 41: Education services; Entertainment services; sporting activity services; training, educational and entertainment services relating to motor vehicles; Vehicle driving and off-road driving instruction and tuition; vehicle racing training and instruction; education in four-wheel and racing driving techniques, land motor vehicle mechanics, map-reading, driving safety, and environmental responsibility; driving academy services; providing a web site featuring on-line courses of instruction in driving high performance automobiles; instruction and training services in the fields of automotive sales, maintenance and repair; training, educational and entertainment services relating to bicycles, scooters, go-karts, motorbikes, off road vehicles, childrens ride on toys, skateboarding, hoverboarding, water sports, aerial sports, horse riding; training, education and entertainment services relating to remote controlled vehicles, drones, remote controlled cars; engineering training services; organisation of competitions for engineering projects; education and training in the field of automotive engineering; teaching school children in the field of automotive engineering; organizing and conducting competitions, sports events, entertainment events, motor vehicle events, races, rallies and exhibitions; rental of sports equipment, not vehicles; Entertainment services provided at a sports event; arranging and conducting shows, concerts, shows, contests, games and tours; arranging competitions and tournaments relating to driving and car racing;

entertainment services, namely, participation in sports car races; entertainment services, namely, performing and competing in motor sports events; providing various facilities for an array of automotive sporting events, competitions and awards programmes; timing and time recording for sporting events; Entertainment services provided at a motor racing circuit; ticket reservation and booking services for entertainment, sporting and cultural events; corporate hospitality [entertainment]; corporate entertainment services; automotive club services; fan clubs; social club services, namely, arranging, organizing, and hosting social events, get-togethers, and parties for club members; special event planning for social entertainment purposes; Conducting guided tours of motor vehicle facilities and driving courses; organizing, arranging and conducting motor vehicle riding events for entertainment and recreational purposes; Sports camp services; hire of sports facilities; hire of motor driving facilities; entertainment in the form of computer games; interactive computer game services; arcade game services; Multimedia publishing; Publishing; publishing of books and journals; electronic publishing; electronic publishing of magazines, fanzines, stories, motorsports information; publication of posters, greetings cards, flyers, pamphlets, promotional literature; production, presentation, syndication, distribution and rental of audio recordings, video recordings, music, interactive games, films, digital content relating to entertainment, television and radio programmes, audio book recordings, whether downloadable or not; production, presentation, syndication, distribution and rental of digital content relating to education; production, presentation, syndication, distribution and rental of digital content relating to sporting activity; library services; lottery and gaming services; photographic reporting; Interviewing of contemporary figures for entertainment purposes; News reporting; publishing of reviews; provision of information relating to sports events, motor racing events, live performances, road shows, live stage events, theatrical performances, live music concerts and audience participation in such events; providing an Internet website portal in the field of entertainment, cultural and sporting events; Providing an online website featuring news, photographs, schedules, results, videos and timing data in the field of motor sport; information, consultancy and advice relating to any of the aforesaid services.