

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 1542249
IN THE NAME OF MICHAEL J BENTLEY**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 45696 IN THE NAME OF
ROVER GROUP LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF application no 1542249
in the name of Michael J Bentley to register
a trade mark in Class 12**

and

**IN THE MATTER OF opposition thereto under No 45696
in the name of Rover Group Limited**

Background

On 17 July 1993 Michael J Bentley of 173/179 Vicarage Lane, Blackpool, Lancashire, FY4 4NG applied to register a series of three trade marks shown below in Class 12



The application was originally made under the 1938 Trade Marks Act. However, on 14 November 1994 an application was made under Schedule 3, paragraph 11 of the 1994 Trade Marks Act to have the registrability of the application determined under that Act. The application for conversion was accepted by the registrar and in accordance with the provisions the effective date of filing of the application became the 31 October 1994. Following examination, the application was accepted and proceeded to publication for the second and third of the marks in the series and in respect of the following goods:

Motor land vehicles; automobiles.

On 17 October 1996, Rover Group Limited filed notice of opposition to this application. The grounds of opposition are in summary:-

- 5 **1. Under Section 3(3)** Because the opponents have a substantial reputation and goodwill in the colour burgundy such that the applicants' mark presented in the colours burgundy and white would deceive the public, for instance, as to the nature, quality or geographical origin of the goods.
- 10 **2. Under Section 3(3)(b)** Because the opponents are the proprietors of three registered trade marks that have been used extensively in the United Kingdom and have gained a considerable reputation and goodwill in relation to the goods for which they are registered. The applicants' mark so nearly resembles these marks so as to be likely to cause confusion and deceive the public..
- 15
- 20 The opponents are a subsidiary of Bayerische Motoren Werke Aktiengesellschaft (BMW) who use the denomination "M" to indicate versions of models. The applicants' mark so nearly resembles the denomination used by the parent company as to be likely to cause confusion and deceive the public.
- 25 **3. Under Section 3(4)** Because use of the applicants' mark would be prohibited by an enactment or rule of law, in particular, the law of passing off
- 30 **4. Under Section 3(6)** Because the mark was applied for in bad faith
- 35 **5. Under Section 5(2)** Because the applicants' mark is similar to the opponents' mark and is to be registered for goods identical with and similar to those for which these marks are protected such that there exists a likelihood of confusion including the likelihood of association.
- 40 **6. Under Section 5(4)** Because use of the applicants' mark in the United Kingdom, and in particular, use of the colour version is liable to be prevented by virtue of a rule of law, in particular, the law of passing off.
- 45 **7. Under Section 32(3)** Because the applicants have no bona-fide intention to use the mark in connection with the goods applied for.
- 8. Under Section 56** Because the applicants' mark is similar to an earlier trade mark of the opponents which is entitled to protection under the Paris Convention as a well known trade mark

and is sought to be registered for goods identical with or similar to those for which the opponents' earlier mark is protected and there exists a likelihood of confusion on the part of the public.

5

The opponents' registrations referred to in the grounds of opposition are as follows:

No.	Mark	Class	Journal/Page	Specification
1031424	MG	12	5154/1130	Motor cars and parts and fittings therefor included in Class 12
1284198	MG	37	5794/5671	Custom manufacture, repair and maintenance of motor vehicles and of parts and fittings therefor; all included in class 37
2006308	MGB	12	6086/5630	Land vehicles; parts and fittings for all the aforesaid goods; shaped or fitted mats and floor coverings, all for motor land vehicles; shaped covers for vehicle seats and for motor land vehicles
1570806	MGF	12	6091/7016	Motor land vehicles and parts and fittings therefor; all included in Class 12.

10

15

20

25

30

The opponents ask that the Registrar exercise his discretion and refuse the registration and for an award of costs to be made in their favour.

The applicants for registration did not file a counterstatement

35

Only the opponents have filed evidence in these proceedings. The matter came to be heard on 26 April 1999, when the applicants, Mr Michael J Bentley represented himself, the opponents were represented by Mr Philip Cooper, Head of trade Marks for Rover Group Limited.

40

Opponents' evidence

This consists of a Statutory Declaration dated 28 October 1997, executed by Philip John Cooper, Head of Trade Marks for Rover Group Limited, the opponents in these proceedings. Mr Cooper says that he has been employed by the opponents for approximately the previous four and a half years.

45

Mr Cooper begins saying that the opponents adopted and commenced using the name MG in

connection with motor cars and parts and fittings for motor cars in 1924, and that the mark has been used continuously to the present date. He refers to exhibit PJC1 which he describes as an sample of how the mark is used, and which consists of representation of the letters MG in a stylised script in the centre of a circle and surrounded by four octagons placed in a square overlapping the circle and surrounding the letters. The date and origin of the device is not given.

Mr Cooper continues saying that in 1955 the opponents sold a new sports car under the name MGA, to be succeeded in 1962 and 1967 by cars sold under the marks MGB and MGC respectively. He says that in 1995 a new range of MG sports cars were introduced under the name MGF, having been preceded by a car introduced in 1992 under the name MG RV8, a limited edition based on the MGB. Mr Cooper refers to exhibit PJC2 which is a history of the MG car company and its cars, which appears to have been produced by MG Cars Corporate Affairs. The document is credited to Anders Ditlev Clausager, an archivist with the British Motor Industry Heritage Trust. Although dated 1995 which is after the relevant date, the exhibit shows that the opponents have used the marks MG, MGA, MGB, MGC prior to the relevant date, although they did not introduce the MGF until after.

Mr Cooper goes on to refer to the MGF and MG EX-F cars, and to exhibit PJC3 which is a copy of an article that appeared in the Daily Telegraph on 30 August 1997 relating to his company's participation in races in the United States. This is dated after the relevant date and cannot be given any weight.

Mr Cooper next lists the sales under the MG mark for the years dating from 1980 to 1996, which shows substantial sales in the years to 1990, but dropping off considerably for the years 1991-1994 to a level almost de-minimis. The remaining period is after the relevant date and cannot be taken into consideration, although the figures do show a sharp increase in sales. He says that goods have been sold under the mark throughout the United Kingdom and refers to exhibit PJC4 which consists of an undated publication listing the dealerships that have sold the opponents' goods. Mr Cooper says that his company has also exported goods under the mark to a significant number of countries, some of which he lists.

He next refers to advertisements placed by his company in a number of nationally circulated publications, a number of which he lists, and refers to exhibit PJC5 which consists of a number of copies of advertisements from the publications "The Light Car and Cyclecar", "The Autocar", "Autocar" and "Motor", the remainder bearing no reference as to their origin. The earliest advertisement dates from 1929, and the exhibit as a whole shows use of the range of MG marks mentioned earlier. Mr Cooper next says that his company has circulated promotional literature and participated in motor trade exhibitions, and refers to exhibits PJC6 and PJC7, which consist of copies of promotional brochures showing the MG mark being used on the range of MG cars mentioned earlier and photographs of a car exhibition.

Mr Cooper goes on to refer to exhibit PJC8 which consists of copies of articles from various publications - "Autocar", "The Autocar" and "The Motor" - and to refer to the range of MG vehicles previously mentioned. He says that the opponents' advertising agency has confirmed that the current advertising expenditure relating to the MG mark is £750,000 per annum.

He next refers to exhibit PJC9 which consists of a copy of a brochure dating from 1977 detailing

the history of BMW, and a selection of promotional brochures relating to a particular range of BMW cars. He concludes by referring to exhibit PJC10 which consists of a collection of undated photographs of Rover company signs outside of a number of car dealerships.

5 As the applicants have not filed any evidence this concludes my review of the evidence and I turn to consider the grounds on which the opposition is based.

Decision

10 I will deal first with the ground under Section 32(2) in which the opponents claim that the applicants do not have a bona fide intention to use the mark. Section 32(3) reads as follows:

15 **32(3)** The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.

20 In my view, Section 32(3) does no more than set out a requirement in respect of an application to register a trade mark. The prescribed application form contains a statement in accordance with Section 32(3) and which has been signed by the applicant. Any allegation that this statement was made in bad faith falls to be considered under Section 3(6) of the Act, and I do not consider therefore that Section 32(3) provides a ground of opposition in this case, or any other case, and is dismissed accordingly.

25 The grounds of opposition based upon Section 3(3) and Section 3(6) I dismiss as not being substantiated. The objection under Section 3(3) has two facets, being based upon the text, and the colours in which the second mark is shown. There is no indication that the trade mark would be contrary to public policy or cause offence, or that there is anything inherent in the trade mark whether in black and white or colour which would deceive the public, and no evidence has been submitted to substantiate these grounds. Similarly, no evidence has been submitted to substantiate the ground under Section 3(6) that the mark was applied for in bad faith.

35 In the particulars of their objection under Section 3(4), the opponents have stated that “Use of the applicants' mark would be prohibited by an enactment or rule of law, in particular, the law of passing off”. The Act makes specific provision for oppositions based on the common law tort of “passing off” which properly fall to be considered under Section 5(4)(a), and which I will address later in this decision. At the hearing Mr Cooper explained that the opponent's objection under Section 3(4) was that if there is a likelihood of confusion because the applicants' mark when used on motor cars is likely to be taken as indicative of the opponents, then it cannot be distinctive of the applicants. Section 3(4) is an absolute ground which in my view is intended to prevent the registration of trade marks which would contravene the law because of some intrinsic feature of the trade mark, and is not concerned with the circular argument that the mark does not belong to the applicants or resembles someone else's trade mark and cannot therefore be distinctive of them. The question of the other parties' rights in the mark is a matter to be dealt with in considering relative grounds for refusal, and consequently, this ground of opposition is also dismissed.

45 I next turn to consider the grounds of opposition under Section 5(2) of the Act, which states:

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

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

(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.

An earlier right is defined in Section 6 the relevant parts of which state:

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

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

The opponents rely on four registrations in their name. Two, numbered 1031424 and 1284198 have a date anterior to that of the application and are therefore earlier marks within the meaning of Section 6(1) of the Act. The remaining two have a date of application which is either the same, or later to that of the application and do not therefore qualify as an earlier mark.

The two registrations which qualify as earlier marks are registered in respect of the same MG trade marks, the difference being that one, number 1031424 is registered in the same class and in respect of the same goods as those covered by the application, the other in respect of services. For convenience I propose to make the comparison based on the opponents' registration in the same class; they will be in no better position on the basis of the other registration.

The opponents' and the applicants' trade marks are clearly not identical and therefore the matter comes to be decided under Section 5(2)(b), and as the goods are self evidently the same, by a comparison of the marks themselves. For this purpose I have looked to Sabel BV v Puma AG (1998) RPC 199 in relation to Article 4(1)(b) of the First Council Directive of 21 December 1988, which corresponds directly with Section 5(2)(b), in which the European Court of Justice in dealing with the issue of comparison of marks said:

“.... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - ‘there exists a likelihood of confusion on the part of the public’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”

I also take into account the decision of the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117. In particular I take note of the following:

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

and

It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive.

Finally the court gave the following judgement on the interpretation of Article 4(1)(b):

“On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

There may be a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 89/104 even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that

the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings.”

5 In the view of Mr. Geoffrey Hobbs QC, acting as the Appointed Person, in the Balmoral case (Application No. 2003949):

10 “The tenth recital to the Directive and these observations of the Court of Justice indicate that an objection to registration under Section 5(2) of the Act should be taken to raise a single composite question: are these similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “*the earlier trade mark*” and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?”

15 The applicants have applied for a series of two marks. Both consist of the letters MGM placed above “Simply the Best” in italics and the words “Auto Group” in normal type, the difference in the marks being that first is represented in black and white, the second in burgundy and white although is not limited to colour. The letters are the dominant and only distinctive component in the mark, the other elements being an exhortation, presumably of the quality of the goods or
20 service provided, and a description related to the type of goods sold.

Marks should be considered as a whole and while the elements other than the letters cannot be disregarded, the matter primarily falls to a comparison of the letters MGM in the applicants' mark, and the opponents' MG mark. It is plain to see that the opponents' mark is the first two letters
25 of the applicants' mark and it is well established that the beginnings of words are of most importance when comparing marks, although in my view this is less so when considering two very short words where small differences in letters or presentation can have a marked impact them, and therefore, how they appear or will be viewed.

30 Neither mark is obviously pronounceable as anything other than letters which inevitably creates some phonetic similarity. The G in the applicants' mark is slightly larger and thicker than the letters M flanking it, which Mr Cooper submitted added to the likelihood of confusion. If there is an argument it must be that the difference in the size of the G serves to emphasise its separation from the other letters, and consequently lessens the visual similarity. However, the presentation
35 of the letter G does not in my view have a significant impact on the question of comparison.

In any deliberations as to the likelihood of confusion it is, I believe, appropriate to also consider the nature of the goods and the manner in which trade is carried out. Motor cars are expensive and an important purchasing decision, and great care is exercised in selecting the make and model.
40 Customers place considerable reliance on the name of the manufacturer, both as an indication of the quality and reliability of the vehicle, but also for the kudos of owning a vehicle from a “fashionable” manufacturer. This is particularly the case in respect of sports cars.

45 The evidence shows that the opponents have been manufacturing cars for many years and I have little doubt that the opponents' MG mark enjoys a long standing reputation in relation to motor cars, or more specifically what would be termed as sports cars. Although their trade in new vehicles diminished in the years leading up to the relevant date, there is, I believe, a significant

trade in second hand vehicles which would have assisted in keeping the marque alive in the minds of the public. Accordingly I come to the view that the opponents' reputation is such that a member of the public seeing the letters MGM being used in connection with motor cars would bring to mind the opponents' MG marque and I do not consider that the position would be much, if any different when account is taken of the other matter in the applicants' trade mark. I find that a significant number of persons would be likely to be confused or associate the applicants' MGM trade mark when used in connection with motor cars with the opponents, and consequently, the opposition succeeds under Section 5(2)(b).

Although my findings under Section 5(2)(b) effectively decide the matter, should I be found to be wrong I go on to consider the grounds founded under Section 5(4). In this respect I note the remarks of Geoffrey Hobbs QC sitting as the Appointed Person in the Wild Child case, (1998 RPC 455), when referring to the scope of the opposition said:

“In the interests of justice and fairness it is plainly necessary for an objection to registration under Section 5(4) to be framed in terms which: (i) specify whether the objection is raised under sub-section 4(a) or sub-section 4(b); (ii) identify the matters which are said to justify the conclusion that use of the relevant trade mark in the United Kingdom is liable to be prevented by virtue of an “earlier right” entitled to recognition and protection under the relevant sub-section; and (iii) state whether the objection is raised in respect to all or only some (and if so, which) of the goods....”

The reference to the law of passing off opponents indicated that the ground fell under sub-section (a) of Section 5(4), although at the hearing Mr Cooper confirmed that the opponents' objection was under sub-sections (a) and (b). Section 5(4) reads as follows:

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

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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

I will deal first with the matter under subsection (b) as this is most easily disposed of. There is no evidence before me to show that the opponents possess an earlier right which falls under the provisions of subsection (b). In the Wild Child trade mark case referred to earlier, Geoffrey Hobbs QC said:

“..I am not willing to regard assertions without any real substantiation as sufficient to sustain any objection under section 5(4). On my assessment of the evidence the asserted

“*earlier right*” remains unsubstantiated and the question of conflict does not arise.”

Consequently, the opposition founded under Section 5(4)(b) also fails.

5 As with the objection under Section 3(3) the opponents have two prongs to their objection under
Section 5(4)(a) based on their MG trade marks, and their association with the colour burgundy.
They contend that they would succeed in an action for passing off against the applicants should
their mark, and in particular the version in the colour burgundy be used in the United Kingdom.
A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws
10 of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with
reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden
Inc [1990] RPC 341 and Erven Warnik BV - v - J. Townsend & Sons (Hull) Ltd [1979] AC 731
is (with footnotes omitted) as follows:

15 The necessary elements of the action for passing off have been restated by the House of
Lords as being three in number:

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

30 The restatement of the elements of passing off in the form of this classical trinity has been
preferred as providing greater assistance in analysis and decision than the formulation of
the elements of the action previously expressed by the House. This latest statement, like
the House’s previous statement, should not, however, be treated as akin to a statutory
definition or as if the words used by the House constitute an exhaustive, literal definition
of “passing off”, and in particular should not be used to exclude from the ambit of the tort
35 recognised forms of the action for passing off which were not under consideration on the
facts before the House.

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing
the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

40 To establish a likelihood of deception or confusion in an action for passing off where there
has been no direct misrepresentation generally requires the presence of two factual
elements:

- 45 (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a
reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a
name, mark or other feature which is the same or sufficiently similar that the
defendant’s goods or business are from the same source or are connected.

5 While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- 10 (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- 15 (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- 20 (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

25 While a colour may come to be recognised and associated with a particular trader, in my view unless the colour appears to be more than mere decoration, the association with one trader is unlikely to be sufficiently firm to amount to recognition of the colour as a trade mark. In this case the evidence shows that the opponents have used the colour burgundy, although only as a background or in association with other more obvious trade mark matter. There is nothing to

30 substantiate their claim that the colour is recognised as a sign or trade mark with which they are associated, and I accordingly dismiss this part of the objection. This leaves the matter of the objection founded on the opponents' reputation or goodwill in their MG trade marks

35 I have previously concluded that the opponents have a long standing reputation and goodwill in their MG trade marks in relation to motor cars. While I have no evidence from the applicants to show the precise goods on which they use their trade mark, the specification of goods covered by the application would suggest that they trade in the same goods as the opponents, and consequently, I do not need to give any further consideration to the extent of the opponents' reputation.

40 In my consideration of the ground under Section 5(2)(b) I found the applicants' mark and the opponents' MG marks to be similar. The position under Section 5(4)(a) goes wider than the rights afforded by registration to take into account the scope of any earlier rights existing independently of registration. The evidence shows that prior to the relevant date the opponents have also used

45 a number of other marks, namely, MGA, MGB, MGB-GT and MGC although usually in conjunction with the opponents' stylised MG logo in an octagonal border. The opponents use the letters MG to denote the make of car that they manufacture with the suffix letters A, B (including GT version) and C appearing to be used to denote the differing models. The letters have been

used in a number of forms; conjoined (MGA), each letter separated by a full stop (M.G.A.) or with the suffix letter separated (MG 'A' or MG.A).

5 I have no evidence from the applicants to show how they use their mark. However, as the
respective goods are identical, assuming normal and fair use of the mark by the applicants I can
see no reason why they should not, or could not use their trade mark in the same fashion as the
opponents. I have previously stated that the goods are expensive items, and consequently, are
selected with care, which would seem to militate against the likelihood of customers being
10 confused or deceived. However, it is not uncommon for a car manufacturer to accept a used
vehicles in part exchange, and for this to be sold on by the manufacturer under their warranty or
with a guarantee even though the vehicle is not one of their own manufacture.

15 The opponents say that through cooperation with their parent company or by natural progression
(having already used MGA, MGB, MGC, etc) they will wish to use the suffix M in conjunction
with their MG mark. While I acknowledge that the opponents' parent company uses the letter
"M" to denote a particular model in their BMW cars, there is no evidence that they have in the
past extended this use to any other vehicles, or that they have any intention of doing so in the
future. However, based on the opponent's previous activities it is reasonable to assume that they
20 may at some time in the future produce an MG "M". I take the view that a public well used to
seeing the MG marque used in conjunction with a range of suffix letters and in connection with
motor vehicles, would, on seeing the applicants' mark incorporating the letters MGM being used
in connection with the very same goods, assume that the applicants or their goods are those of,
or are in some way connected with or recommended by the opponents. The fact that the
opponents have a reputation for motor vehicles, the same field in which the applicants wish to
25 operate; that the respective trade marks are confusingly similar is certainly likely to cause damage
to the opponents. I therefore also find the opposition is successful under Section 5(4)(a)

This leaves the ground based on the opponents claim to protection as a well known mark. Section
56 of the Act is in the following terms:-

30 **56 - (1)** References in this Act to a trade mark which is entitled to protection under the
Paris Convention as a well known trade mark are to a mark which is well-known in the
United Kingdom as being the mark of a person who-

35 (a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial
establishment in, a Convention country,

40 whether or not that person carries on business, or has any goodwill, in the United
Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

45 Section 56(1) of the Act says that for a person to qualify for protection under the Paris
Convention as the proprietor of a well known trade mark, they must either be a national of a

5 convention country, or, be domiciled in or have a commercial establishment in a convention country. Section 55(1)(b) of the Act defines a “Convention country” as a country, *other than the United Kingdom* which is a party to the Paris Convention. The opponents' address indicates that they are located in the United Kingdom, which in turn means that they do not meet the qualifying criteria set out in the Paris Convention. Consequently, the grounds based under Section 56 of the Act must fail.

10 The opponents have asked that the registrar exercise his discretion in their favour and refuse the application. Under the Trade Marks act 1994 the registrar does not have the discretion to refuse marks which are otherwise acceptable for registration. Consequently, the opposition must also fail in this respect.

15 The opposition having been successful I order that the opponent pay the applicant the sum of £700 as a contribution towards their costs.

Dated this 4 day of August 1999

20
25
**Mike Foley
for the Registrar
The Comptroller General**

5

10

15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 1542249
IN THE NAME OF MICHAEL J BENTLEY**

20

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 45696 IN THE NAME OF
ROVER GROUP LIMITED**

25

TRADE MARKS ACT 1994

**IN THE MATTER OF application no 1542249
in the name of Michael J Bentley to register
a trade mark in Class 12**

and

**IN THE MATTER OF opposition thereto under No 45696
in the name of Rover Group Limited**

SUPPLEMENTARY DECISION

My written decision in these proceedings, dated 4 August 1999, contained a clerical error. It has been brought to my attention that the opponents have been ordered to pay costs to the applicants. This is incorrect. The opponents having been successful the award should have been made for the applicants to pay costs to the opponents. The necessary power to correct this is provided I believe by Order 20 Rule 11 of the Rules of the Supreme Court which states:

"Clerical mistakes in judgments or orders, or errors arising therein from any accidental slip or omission, may at any time be corrected by the Court on motion or summons without an appeal."

I therefore correct the final paragraph of my written decision in these proceedings to read as follows:

"The opposition having been successful I order that the applicant pay the opponent the sum of £700 as a contribution towards their costs."

Dated this 9th day of August 1999

Mike Foley
For the Registrar
the Comptroller General