

IN THE MATTER OF APPLICATION NO. 2214076 IN THE NAME OF LE MANS  
AUTOPARTS LIMITED

AND IN THE MATTER OF OPPOSITION NO. 90792 THERETO BY  
AUTOMOBILE CLUB DE L'OUEST DE LA FRANCE (ACO)

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DECISION

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Introduction

1. On 12 November 1999 Le Mans Autoparts Ltd applied to register the trade mark LE MANS in respect of the following goods in Classes 6, 7, 9 and 12:

Class 6: Articles of common metals or their alloys, all for use with motor land vehicles; adaptors, T-pieces, pipelines, boot and bonnet fastenings, pull cables, petrol pipes, oil pipes, joiners, P-clips, hose clips, braided hose, overbraid, cable protectors, gear knobs, valve caps, door lock pins, nuts and bolts, dashpot covers, grille buttons and rampipes; all made wholly or principally of common metals or their alloys.

Class 7: Parts and fitting for engines and motors for land vehicles; turbo dump valves and parts and fittings therefore; electric fans for engines and motors; air filters and oil filters for engines and motors.

Class 9: Electrical apparatus and instruments, all for use with motor land vehicles; gauges, electrical toggle switches, fuse boxes, battery cut-out switches, push-button switches, alarm-security switches, electrical relays, fire extinguishers.

Class 12: Horns for motor land vehicles; safety belts, safety straps, harnesses and parts and fittings therefore; all for use in motor land vehicles; steering wheels and steering wheel bosses.

2. Subsequently the application was opposed by Automobile Club de l'Ouest de la France (ACO) on grounds raised under section 3(1)(b), 3(1)(c), 3(3)(b), 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994. In a written decision dated 6 May 2004 (BL O/130/04) Dr Trott acting for the Registrar rejected all the grounds of objection and dismissed the opposition. The opponent now appeals against that decision.
3. On the appeal the objection under section 3(3)(b) was not pursued, and the objection under section 5(3) was confined to one of the two bases pleaded in the opponent's statement of case. Furthermore, counsel for the opponent explained that the opponent primarily opposed the application on relative grounds and that it only relied upon the remaining absolute grounds to block certain arguments that might otherwise be raised by the applicant.
4. The applicant did not attend the hearing or file written submissions. I understand its position to be that the hearing officer's decision was correct in all respects.
5. In these circumstances I conclude that it is only necessary to consider the opponent's relative grounds.

Relevant provisions of the Trade Marks Act 1994

6. Sections 1, 3, 5, 6, 55 and 56 of the Trade Mark Act 1994 as they stood at the relevant times provided in relevant parts as follows:
  - 1.(1) In this Act a 'trade mark' means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.
  - 3.(1) The following shall not be registered-
    - (a) signs which do not satisfy the requirements of section 1(1),
    - (b) trade marks which are devoid of any distinctive character...

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

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

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

(3) A trade mark which-

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

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

(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....

6.(1) In this Act an 'earlier trade mark' means –

...

- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

55.(1) In this Act –

- (a) 'the Paris Convention' means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised or amended from time to time,
- (aa) 'the WTO agreement' means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15 April 1994, and

- (b) a 'Convention country' means a country, other than the United Kingdom, which is a party to that Convention.

56.(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement 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-

- (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,

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.

#### Relevant provisions of the Directive

7. Article 2, 3 and 4 of Council Directive 89/104/EC of 21 December 1998 to approximate the laws of the Member States relating to trade marks provide in relevant parts:

2. A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

3.(1) The following shall not be registered, or if registered shall be liable to be declared invalid:

- (a) signs which cannot constitute a trade mark;
- (b) trade marks which are devoid of distinctive character...

4.(1) A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

...

- (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(2) 'Earlier trade marks' within the meaning of paragraph 1 means:

...

- (d) trade marks which, on the date of application for registration of the trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the trade mark, are well known in a Member State, in the sense in which the words “well-known” are used in Article 6bis of the Paris Convention.

#### Relevant provisions of the Paris Convention and TRIPs

8. Article 6bis of the Paris Convention as last revised at Stockholm in 1967 provides in relevant part:

- (1) The countries of the Union undertake, *ex officio* if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

9. The Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPs”) contained in Annex 1C to the WTO Agreement forms an integral part of the WTO Agreement binding on all Members (Article II(2) of the WTO Agreement). Article 16 of TRIPs provides in relevant part:

- (2) Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is well known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.
- (3) Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use.

The opponent's statement of case

10. In its statement of case the opponent pleaded as follows with regard to its relative grounds of objection:

1. The Opponent is a French 'Association loi de 1901'<sup>1</sup> incorporated in 1906 by the organizers of the French Le Mans motor racing event, otherwise known as 24 Heures du Mans, primarily for the purpose of managing the event itself, but also since 1978, to hold and exploit the intellectual property rights arising from the Le Mans event. The Opponent is accordingly the owner of the following trade mark applications and registrations with effect in the UK:

International Registration (UK) No. 709878 LE MANS & Device, with the UK designation date of 18 February 1999 ... for 'bleaching preparations and other substances for laundry use in connection with motor vehicles and their accessories; cleaning, polishing, grease removing, scouring and abrasive preparations for use in connection with motor vehicles and their accessories; soaps; perfumery, essential oils, cosmetics, hair and lotions, dentifrices' in Class 3;

International Registration (UK) No. 712233 24 HEURES DU MANS (stylized) with the UK designation date of 19 February 1999 ... for 'bleaching preparations and other substances for laundry use in connection with motor vehicles and their accessories; cleaning, polishing, grease removing, scouring and abrasive preparations for use in connection with motor vehicles and their accessories; soaps; perfumery, essential oils, cosmetics, hair and lotions, dentifrices' in Class 3;

UK registration no. B1336594 24 HEURES DU MANS registered as of 25 February 1998 ... for 'toys, games and playthings; sporting articles; parts and fittings for all of the aforesaid goods; all included in Class 28 and all relating to motor sport' in Class 28;

UK registration no. B1336597 LE MANS registered as of 25 February 1998 ... for 'toys, games and playthings; sporting articles; parts and fittings for all of the aforesaid goods; all included in Class 28' in Class 28. ('The Opponent's Marks')...

2. The LE MANS trade mark has been used by the Opponent since 1906 in relation to the organisation and management of an annual motor racing event. The Opponent's LE MANS trade mark has acquired an international reputation in relation to the organisation and management of the said event, and is accordingly entitled to protection under the Paris Convention as a well-known trade mark. Accordingly, the

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<sup>1</sup> It appears from the evidence that that this means an incorporated non-profit-making association.

Opponent's LE MANS trade mark qualifies as an 'earlier trade mark' for the purpose of this opposition, by virtue of Section 6(1)(c) Trade Marks Act 1994.

3. As a result of the strong reputation of the Le Mans event, and the use of the Opponent's Marks in the United Kingdom by the Opponent, the Opponent has acquired a reputation and goodwill in its trade marks in the United Kingdom which are protectable under the law of passing off.
  8. The Applicant's Mark is identical to the Opponent's LE MANS trade mark and covers goods which are similar to the services for which the Opponent's LE MANS trade mark is well-known. The Opponent requests that registration of the Applicant's Mark be refused pursuant to Section 5(2)(a) Trade Marks Act 1994.
  9. Alternatively, the Applicant's Mark is identical to the Opponent's LE MANS trade mark and covers goods are dissimilar to the services for which the Opponent's LE MANS mark is well known. The Opponent requests that the Applicant's Mark be refused registration pursuant to Section 5(3) Trade Marks Act 1994 on the grounds that the use of the Applicant's Mark would take unfair advantage of, or would be detrimental to the distinctive character or the repute of the Opponent's LE MANS trade mark.
  10. The Applicant's Mark is similar to the Opponent's Marks and covers goods are dissimilar to the Opponent's goods and services. The Opponent accordingly requests that the Applicant's Mark be refused registration pursuant to Section 5(3) Trade Marks Act 1994 on the grounds that the use of the Applicant's Mark would take unfair advantage of, or would be detrimental to the distinctive character or the repute of the Opponent's Marks.
  11. The Opponent requests that the Applicant's Mark be refused registration pursuant to Section 5(4)(a) Trade Marks Act 1994 on the ground that the Applicant's use of its mark in the United Kingdom is liable to be prevented by the Opponent under the law of passing off.
11. The objection pleaded in paragraph 10 is not pursued on this appeal.

#### The hearing officer's decision

12. The hearing officer's decision is a long and detailed decision running to 74 paragraphs. The salient points for present purposes may be summarised as follows.

13. First, the hearing officer made a number of criticisms of the opponent's evidence.

14. Secondly, in paragraphs 37-39 of his decision the hearing officer made the following findings as to the significance of the term LE MANS in the United Kingdom (emphasis in the original):

37. However, there is enough information from UK publications – see the citations above – conclude that the name is, as I say, known in the UK. Nevertheless, on the basis of the evidence I have seen I do not believe that the name is *well* known in the UK. There is no material showing that the name has a currency beyond the 'motorsport fans' mentioned in the Times article quoted above. – In my view, the opponent has not *proved* that the name has a reputation like 'The Grand National' has for horse racing, which extends beyond the mere enthusiast to consumers at large. The opponent's evidence, I believe, fails even in this respect. Despite this conclusion, I think, were I pressed, I would take judicial notice of the fact that the name LE MANS is famous for a race, as a 'notorious fact'; one would have to be living in a cave in the UK not to have heard of it in that context. I think this conclusion can also be inferred from Mr Cumming's<sup>2</sup> statement, where he says (Cumming, paragraph 7):

'The evidence shows that "Le Mans" has become a colloquialism or a generic term for a race which takes place in the town of Le Mans...'

38. In summary, LE MANS has a well-known significance as the name of a place at which an annual motor racing event occurs – it is indicative [of] a race in a place – but there is nothing to show that there is any belief that it has commercial import in the minds of the UK public in general – which is the *sine qua non* that must be shown of a famous mark. In particular the opponent has not shown it is famous in the name in the UK as race organiser.

39. In my view, the name LE MANS will not be seen as a trade mark in the UK. The opponent has not filed any independent evidence to assist their case. Even accepting the term is well-known, if has acquired a secondary meaning as a brand, there is insufficient evidence to conclude that this is now the principal signification, and it is likely that most consumers, particularly outside the immediate field of motor racing enthusiasts, would see it mainly or exclusively as a name of a race. The opponent has not provided evidence to show that the public regard the term as a trade mark. In my view, the following extract, from Tab 3 [of SCB1], sums this up:

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<sup>2</sup> The applicant's managing director and one of its witnesses.

‘Le Mans is a word which conjures up motor racing in the minds of people all over the world, and it is a city that we are proud to live in.

Indeed, I note that Ms Bristow herself stated that ‘the only real draw of Le Mans as a town is the car race itself’. This is my conclusion from the opponent’s evidence.

15. Thirdly, the hearing officer concluded that none of the opponent’s registered trade marks pleaded in paragraph 2 of its statement of case was identical to the trade mark applied for. On this basis, he dismissed the objection under section 5(2)(a).
16. Fourthly, the hearing officer concluded that the opponent’s mark had no reputation in the United Kingdom with regard to the goods specified in its registrations and accordingly there could no advantage taken from, or detriment to, the opponent’s registrations. On this basis, he dismissed the objection under section 5(3).
17. Fifthly, in paragraphs 66 and 68 of his decision the hearing officer made the following findings as to goodwill owned by the opponent:
  66. From my analysis of the evidence, I believe that it is a reasonable conclusion to find that the opponent has no goodwill in the UK at the relevant date. If (as I believe) the name LE MANS is famous as the appellation of a race, such that any other likely significance it has is swamped, it cannot be the ‘cypher’ of goodwill under the name, then this ground fails at the first hurdle. With no goodwill, there can be misrepresentation and no damage to the opponent’s property.
  68. Taking this date [sc. the application date] as the relevant date for the purposes of passing off, I do not believe this is the end of the matter. Tab 7 [of exhibit SCB1 to Ms Bristow’s statement] shows that the opponent charges spectators for entry to the race. Though this material is after the relevant date, I think it reasonable to believe that this practice was in place before that time. If one assumes that it has continued for some years, and make the further assumption that, at least, a significant proportion of UK fans were aware of the ACO as race organizers (neither assumption is shown by the evidence), in the context of the large numbers of UK enthusiasts who attend the race regularly, one may come to the conclusion that the opponent has a goodwill that might fall under ‘entertainment’ in Class 41, that is, as

the organizer of the Le Mans race. Mr Cumming appeared to concede that the opponent had such goodwill, if not in the name LE MANS, but:

‘I am quite prepared to acknowledge that someone – possibly Ms Bristow’s Clients – have established a reputation for organizing races under the names ‘24 Heures du Mans’ and ‘Le Mans 24 Hours’ at the town of Le Mans.’

This is almost an admission against interest, and somewhat peculiar. If I am to accept that the opponent has a goodwill under the name LE MANS 24 HOURS this, it seems to me, is still rather close to LE MANS *per se* and thus the applicant’s mark.

On the assumption that the opponent<sup>3</sup> had some goodwill as a race organiser, the hearing officer went on to conclude that the applicant’s use of the mark applied for would not give rise to a misrepresentation. On this basis, he dismissed the objection under section 5(4)(a).

#### Standard of review

18. This appeal is a review of the hearing officer’s decision. In my judgment the hearing officer’s decisions with regard to section 5(2)(a), 5(3) and 5(4)(a) each involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

#### Grounds of appeal

19. The opponent’s principal grounds of appeal are as follows. First and foremost, the hearing officer simply did not deal with the objections pleaded in paragraphs 8 and 9 of its statement of case. Indeed, so far as section 5(2)(a) is concerned, the hearing officer dismissed a case based on the opponent’s

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<sup>3</sup> The decision actually says “applicant” at this point, but it is clear that opponent is meant.

registered trade marks which the opponent had never advanced. Secondly, some of the hearing officer's criticisms of its evidence were not justified. Thirdly, the hearing officer erred in law in concluding that LE MANS did not function as a trade because it was merely the name of a race. Fourthly, the hearing officer erred in concluding that use of the applicant's mark did not give rise to any misrepresentation.

#### Standing of the opponent

20. Before considering these grounds of appeal, I should deal with the standing of the opponent to bring this opposition. As set out above, the opponent's pleaded case is that (a) it is and has since 1906 been the organiser and manager of an annual motor racing event known as 24 HEURES DU MANS and as LE MANS and (b) it has since 1978 held and exploited the intellectual property rights arising from the event.

21. The opponent's own evidence is that, while the opponent was established in 1906, the event in question was first held in 1923. More importantly, one of the opponent's witnesses, John Reddington of its solicitors, exhibits a judgment of the commercial court of Nanterre dated 21 December 2002 together with an English translation thereof and states:

2. Under the heading 'The Facts', the court acknowledges that the Automobile Club de l'Ouest de la France created an automobile race in 1923 called the 24 Heures du Mans or LE MANS, which is organised annually by its affiliated company Association Sportive Automobile de Automobile Club de l'Ouest des 24 Heures du Mans (ASAACO). It will be apparent that the letters ACO which are sometimes used in conjunction with the opponent's name are in fact an acronym for Automobile Club de l'Ouest.

3. The judgment also records the fact that as between these related companies, ASAACO holds the rights to commercially exploit the sporting event, whereas ACO is the owner of the trade marks LE MANS, 24 HEURES DU MANS and 24 HEURES.

22. The applicant has not suggested that the opponent does not have standing to advance its relative objections because ASAACO is and has since an

unspecified point in time been the organiser and commercial exploiter of the racing event. No doubt the applicant's advisors have borne in mind that it is well established that, whether under section 5(2), 5(3) or 5(4), it is not necessary for the opponent itself to be owner of the earlier trade mark or earlier right relied upon: see e.g. *WILD CHILD Trade Mark* [1998] RPC 455 at 458-459 and *BALMORAL Trade Mark* [1999] RPC 297 at 299. Thus, even if ASAACO is the owner of the relevant rights rather than the opponent, the opponent can still rely upon those rights as founding its grounds of objection. In these circumstances the only objection that the applicant could advance would be that it was not open to the opponent to rely upon any rights owned by ASAACO having regard to the opponent's statement of case. Given that the two are related companies, however, that would not be a point of any merit. I shall therefore treat the opponent and ASAACO as one.

#### What is the race called?

23. It is convenient next to dispose of a point that was raised by the applicant below, namely the correct title of the annual motor race organised by the opponent. It seems clear from the evidence that the correct title of the race in French is, and has for many years been, 24 HEURES DU MANS. As the hearing officer found, however, in the United Kingdom the race is commonly referred to simply as LE MANS, although it appears from the evidence that it is sometimes referred to by names such as LE MANS 24 HOURS or THE LE MANS 24 HOUR RACE.

#### Failure to deal with pleaded objections

24. The opponent's first ground of appeal is well founded. The hearing officer treated the opponent's objections under section 5(2)(a) and section 5(3) as being based solely upon its registrations, whereas in fact the section 5(2)(a) case and the primary section 5(3) case were not based upon the opponent's registrations but upon its claim to a well-known mark. It follows that I must consider either remit the matter to the hearing officer to consider these objections or consider them myself. In the interests of procedural economy I

shall take the latter course. Before doing so, it is necessary to consider the second and third grounds of appeal.

### The opponent's evidence

25. The opponent's evidence in chief consisted of a witness statement of Sophia Clare Bristow of its solicitors and its evidence in reply consisted of Mr Reddington's witness statement. The purpose of these statements, particularly that of Ms Bristow, was primarily to exhibit a large volume of documentary evidence relied upon by the Opponent in support of its case.
26. The hearing officer was very critical of this evidence, pointing out that a considerable number of the exhibits suffered from one or more of the following defects: (1) the documents dated from after the application date, (2) the documents were in a foreign language and (save in the case of the court decision referred to above) no translation had been provided, (3) the documents related to the reputation of the opponent in countries other than the United Kingdom or (4) the documents were of no evidential value since no evidence had been provided as to such matters as whether they had been circulated within the United Kingdom or otherwise brought to the attention of United Kingdom consumers or if so the extent of any circulation etc. As he put it, the opponent's approach appeared to have been "based on the principle of 'never mind the quality feel the width'". He might have added that Ms Bristow's statement contained a number of statements which could not be within her own knowledge but without explicitly identifying the source of the information she related.
27. On the appeal the opponent accepted that some of these criticisms were justified, but nevertheless submitted that the hearing officer had gone too far in three respects.
28. First, the opponent submitted that the mere fact that a document is dated after the application does not necessarily mean that it is inadmissible or of no evidential weight: as the hearing officer himself recognised in paragraph 68 of

his decision, such a document may nevertheless shed light backwards with regard to the position as at the relevant date. In my judgment this submission is well founded.

29. Secondly, the opponent submitted that some limited assistance could be gained from the untranslated documents in a foreign language, for example where the subject-matter was obvious even without knowledge of the language in question. This question I have found more difficult because the documents in question are in French, and I have some knowledge of French. This means that I have been tempted to read the documents relying upon my own knowledge of French. I consider, however, that this temptation must be resisted. The question cannot sensibly depend upon the language skills of the tribunal. If the documents were in (say) Mandarin, I would be wholly unable to read them. Even though they are in French, if I were to rely upon my own knowledge of that language, there would be an obvious risk that I would mistranslate them. Furthermore, the parties would have no opportunity of scrutinising the accuracy of my translations and correcting them where wrong.

30. Rule 72 of the Trade Marks 2000 provides:

- (1) Where any document or part thereof which is in a language other than English is filed or sent to the registrar in pursuance of the Act or these Rules, the registrar may require that there be furnished a translation into English of the document or that part, verified to the satisfaction of the registrar as corresponding to the original text.
- (2) The registrar may refuse to accept any translation which is in her opinion inaccurate and thereupon another translation of the document in question verified as aforesaid shall be furnished.

In the present case the Registrar did not exercise the power conferred by rule 72(1) to require translations of the documents in question to be filed. In my judgment, however, that does not excuse the opponent's failure to supply translations or affect the admissibility of the untranslated documents.

31. *Halsbury's Laws* (4<sup>th</sup> edition re-issue), volume 13, paragraph 200 states (omitting footnotes and adding emphasis):

The construction of a foreign document by the application to it of the foreign law, when ascertained, is for the judge, and not for the witness. Where a written contract is made in a foreign country, and in a foreign language, evidence is admissible to show what is the corresponding meaning in English. *Accordingly, the court, in order to interpret it, must first obtain a translation of the instrument*; secondly, an explanation of the terms of art (if it contains any); thirdly, evidence of any foreign law applicable to the case; and fourthly, evidence of any peculiar rules of construction, if any such rules, by the foreign law. With this assistance, the court itself must interpret the contract on ordinary principles of construction.

32. The sentence I have italicised is supported by at least the following authorities: *Shore v Wilson* (1842) 9 Cl & Fin 355 at 511 (Erskine J) and 566 (Tindal CJ); *Di Sora v Phillipps* (1863) 10 HL Cas 624 at 633 (Lord Cranworth); and *Chatenay v The Brazilian Submarine Telegraph Co Ltd* [1891] 1 QB 89. In *Chatenay*, a case concerning a power of attorney written in Portuguese in Brazil, Lord Esher MR said at 82:

Now, this writing was a business document, written in Brazil in the Brazilian language, and with the formalities necessary according to the Brazilian law and custom, by a man of business carrying on business in Brazil. An English Court has to construe it, and the first thing, therefore, that the English Court has to do is to get a translation of the language used in the document. Making a translation is not a mere question of trying to find out in a dictionary the words which are given as the equivalent of the words in the document; a true translation is the putting into English that which is the exact effect of the language used under the circumstances. To get at this in the present case you must get the words in English which in business have the equivalent meaning of the words in Brazilian, as used in Brazil, under the circumstances. Therefore you would want a competent translator, competent to translate in that way...

Similarly, Lindley LJ said at 85:

The document is in Portuguese. The Court cannot take judicial notice of the Portuguese language, and it must have recourse to the assistance of those who understand it. Recourse must therefore be had to translators....

33. I therefore conclude that the untranslated documents are inadmissible. The matter does not end there, however. In certain cases, particularly a number of

licence agreements entered into by the opponent, Ms Bristow states the effect of the documents in her witness statement. While Ms Bristow gives no evidence as to her competence in French, I consider it is legitimate to infer that she has sufficient competence to provide the summaries that she gives. Furthermore, the applicant did not suggest that Ms Bristow's summaries were inaccurate in its evidence in answer. In these circumstances I consider that Ms Bristow's summaries are admissible even though the underlying documents are not.

34. Thirdly, the opponent submitted that it was relevant to its claim that LE MANS was a well-known mark to show that it had an international reputation, and not merely (say) a reputation which spilled over from France into the United Kingdom. For reasons that will become clear when I come to discuss the opponent's claim below, I consider that this submission too is well founded.
35. It follows that there are number of aspects of the opponent's evidence that the hearing officer regarded as inadmissible, or at least gave no weight to, which I consider do have some weight. It follows that I must reconsider the effect of that evidence. Before doing so, however, there is a more fundamental question to address.

Is LE MANS a trade mark at all?

36. The opponent's case is that as at the application date LE MANS was a well-known trade mark for the services of organising and managing motor racing events. The hearing officer did not directly address the question of whether LE MANS was entitled to such protection or not. Counsel for the opponent acknowledged, however, that, had the hearing officer done so, it is clear that he would have concluded that it was not, because his view was that LE MANS did not function as a trade mark at all in relation to such services. This is despite the fact that he found that "the name LE MANS is famous for a race" (paragraph 38) and "most consumers ... would see it mainly or exclusively as a name of a race" (paragraph 39).

37. The reasoning which led the hearing officer to this conclusion appears most clearly from paragraph 7 of his decision where he said:

It seems to me that the opponent has to prove, in relation to his own rights under the name, that LE MANS is an indication in the UK that is recognised as a trade mark. In other words, the average consumer in this country sees it [as] an instrument, a brand indicative representative of business activity.

Thus the hearing officer proceeded on the basis that the opponent had to prove that LE MANS was recognised by the average consumer as a trade mark. It was on this basis that he concluded in paragraph 39 of his decision that “LE MANS will not be seen as a trade mark in the UK” as distinct from “a name of a race”.

38. The opponent contends that in proceeding on this basis the hearing officer erred in law. It submits that it is sufficient for it to prove that at the relevant date the term LE MANS was perceived by consumers in a manner which meant that it was in fact functioning as a trade mark, that is to say as an indication of trade origin; it does not have to go further and prove that consumers appreciated that the term was a trade mark; still less does it have to prove that consumers knew the identity of the supplier of the services designated by that term.
39. In my judgment these submissions are well founded. It is clear from section 1(1) of the 1994 Act and Article 2 of the Directive that the essential requirement of a trade mark is that the sign in question be capable of distinguishing goods or services of one undertaking from those of other undertakings. It appears from the jurisprudence of the Court of Justice of the European Communities that Article 2 merely requires that the sign be generally capable of distinguishing in the abstract without reference to any particular goods or services, whereas Article 3(1)(b) (corresponding to section 3(1)(b) of the 1994 Act) requires that the mark be capable of distinguishing (i.e. able to distinguish) with regard to the particular goods or services in question: see Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2002] ECR I-5475, paragraphs 32-40, Case C-363/99

*Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ETMR 57, paragraphs 33, 80-82 and paragraph 17 of the Opinion of the Advocate General in Case C-329/02P *SAT.1 Satellitenfernsehen GmbH v Office for Harmonisation in the Internal Market* [2004] ETMR 80. Even for the purposes of Article 3(1)(b), it is sufficient that the sign should be perceived by the average consumer (or at least a significant proportion of the relevant class of persons: *Philips*, paragraphs 59-61) in a manner which means that it does in fact serve to distinguish the goods or services of one undertaking from those of other undertakings. There is no additional requirement that the average consumer should appreciate that the sign is a trade mark (although if it is shown that consumers do appreciate that the sign is a trade mark that will obviously be relevant to the assessment of distinctive character). The position can be no different when considering relative grounds of objection to registration.

40. This was also the position under the Trade Marks Act 1938 and remains the position at common law. So far as the 1938 Act is concerned, section 68(1) defined “trade mark” as meaning, except in relation to a certification trade mark (emphasis added):

a mark used or proposed to be used in relation to goods for the purpose of indicating, *or so as to indicate*, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person.

As the italicised words made clear, it was sufficient that the mark did in fact indicate a connection in the course of trade whether or not that it was the purpose for which it was used. Equally, if the mark did in fact indicate such a connection, it mattered not whether the public appreciated that it was a trade mark. The same is true in the law of passing off. For example, in the famous cases of *William Edge & Sons Ltd v William Niccolls & Sons Ltd* [1911] AC 693 and *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491 the plaintiffs succeeded in claims for passing off by proving that their get-ups (bags with a protruding stick for washing blue and plastic lemon-shaped

containers for lemon juice respectively) were distinctive of their goods without having to prove that the public regarded those get-ups as trade marks or brands. While it cannot be assumed that the law under the 1994 Act and the Directive is the same as under either the 1938 or the common law of England and Wales, this is a fundamental point regarding the nature of a trade mark and if the law was intended to be different I would expect to find clear wording in the 1994 Act or the Directive which showed this. I cannot find anything in the 1994 Act or the Directive which would lead to this conclusion, and I know of no case law which supports it either.

41. Equally, it is immaterial whether the public knows of the identity of the supplier of the goods or services in question. It was held by the House of Lords in *The Birmingham Vinegar Brewery Co Ltd v Powell* [1897] AC 710 that it was immaterial to a claim in passing off that the customer did not know or care who the manufacturer of goods denoted by a particular sign was provided that the customer wanted goods from a particular source. This principle was reflected in the definition of “trade mark” in section 68(1) of the 1938 Act quoted above, and I have no doubt that it remains the law under the 1994 Act and the Directive. Equally I have no doubt that it applies to services just as it does to goods.
  
42. In the present case I consider that at the relevant date the term LE MANS did function as a trade mark for the services of organising and managing motor racing events, and thereby providing entertainment in the form of motor racing, in that it served to distinguish services provided by the opponent from services provided by other undertakings in the perception of United Kingdom consumers. As the hearing officer himself found, LE MANS had become famous in the United Kingdom as the name of a motor race. Indeed, as he noted, the applicant’s managing director Mr Cumming conceded in his evidence that LE MANS had become a “colloquialism” for a race and that someone had established a reputation for organising races under the name LE MANS 24 HOURS. It is implicit in the hearing officer’s findings that this signification had entirely swamped the original purely geographical significance of the term LE MANS.

43. The position may be tested in this way. Suppose a person unconnected with the opponent, and not authorised by it, were to organise another motor race under and by reference to the name LE MANS. In such circumstances I think it is inevitable that consumers in the United Kingdom would think that the organiser was the same as, or at least economically-linked with, the organiser of the well-known LE MANS race. This conclusion is consistent with the conclusion to which I come below that the opponent is the owner of goodwill in the United Kingdom connected with the name LE MANS.

44. Finally before leaving this question I should deal with one other point made by the hearing officer. Referring to certain print-outs from websites exhibited by Ms Bristow, the hearing officer said in paragraph 25 of his decision:

More significantly, the fact that an ‘unofficial’ website (Tab 43) uses the name LE MANS – and, freely, LE MANS 24 HRS – suggests that both are regarded as descriptive, and not a brand. The opponent claims no attempt to protect its trade mark by injuncting the owner the owner of the website in the UK to stop this activity; which is surprising in that they appear to be involved in similar commercial enterprises themselves (see Tab 7).

45. The website in question is called LE MANS 24HRS.INFO and subtitled “The Definitive Independent Le Mans Travel Guide”. The home page states under the heading “Welcome”:

Two Hundred and fifty thousand people make the pilgrimage, to a fairly small industrial city on the banks of the La Sarthe river in [the] northern part of central France, each year to witness [what] has rightly been acknowledged a[s] one of the worlds top motorsports event[s], The 24hrs of Le Mans.

If you are planning a trip in 2002 then you have come to the right place...

I have to say that I do not regard this as descriptive use of the term LE MANS. LE MANS is being used here in two ways.

46. First, there is the use of LE MANS and THE 24HRS OF LE MANS to refer to the motor race. For the reasons I have given above, this is trade mark use. It

would not be an infringement of any trade mark rights of the opponent because the use is in relation to the services provided by the opponent. In the same way, a reference in a newspaper to someone drinking COCA-COLA is non-infringing trade mark use because it relates to the genuine goods.

47. Secondly, there is the use of LE MANS 24HRS.INFO as the title of the website. This again is trade mark use, since it denotes the trade origin of the information service provided by the website in the same way as the title of a newspaper or magazine (as opposed to a single book title, which generally does not function as a trade mark: see *SCIENCE AND HEALTH Trade Mark* [1968] RPC 402). I express no opinion as to whether or not this would infringe any trade mark rights of the opponent, but I observe that the mere fact that the opponent has not taken action against the website does not necessarily mean that it does not object still less than it would not have grounds upon which to do so. Ms Bristow does not state whether or not the opponent objects. No inference can be drawn from her silence on this topic, since her purpose in exhibiting the print out was simply to show that such websites capitalise upon the fame of LE MANS, and thereby support the opponent's claim to protection for a well-known mark. In my judgment such evidence does indeed support the opponent's claim. It is to the question whether that claim is made out that I shall now turn.

Interrelationship of the relevant provisions of the 1994 Act, the Directive, the Paris Convention and TRIPs.

48. Sections 5(2), 5(3) and 6(1)(c) of the 1994 Act implement Articles 4(1) and 4(2)(d) of the Directive and therefore must so far as possible be construed in accordance with them: Case C-106/89 *Marleasing SA v La Comercial Internacional de Alimentation SA* [1990] I-ECR 4135 and *Webb v EMO Air Cargo (UK) Ltd* [1993] 1 WLR 49. For reasons that I shall endeavour to explain, however, it is difficult to construe section 6(1)(c) consistently with Article 4(2)(d) of the Directive.

49. The scheme of the Directive is that trade marks which at the relevant date are well known qualify as “earlier trade marks” within Article 4(2)(d) and hence receive the protection that is available under Article 4(1) to all earlier trade marks. This is so regardless of whether the mark in question would be protected under Article 6*bis* of the Paris Convention. Thus it is immaterial that the mark would not be protected under Article 6*bis* e.g. because it is only well known in respect of services. The scheme of Community Regulation 40/94 of 20 December 1993 on the Community trade mark, Article 8(2)(c) of which corresponds to Article 4(1)(d) of the Directive, is the same. It follows that the Directive and Regulation are consistent with Article 16(2) and 16(3) of the TRIPs even though they both pre-date TRIPs, but this is because they provide protection as extensive as that available under TRIPs and not because they give effect to TRIPs itself (although the Court of Justice has held that Community legislation in the field of trade mark must be construed consistently with TRIPs so far as possible: Case C-89/99 *Schieving-Nijstad NOV v Groeneveld* [2001] ECR I-5851, paragraph 35, Case C-49/01 *Heidelberger Bauchemie GmbH* (24 June 2004), paragraphs 19-21).
50. The first problem with section 6(1)(c) is that it has been amended by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999 No. 1899, regulation 13 to incorporate a reference to the WTO Agreement, which has no counterpart in either the Directive or the Regulation for the reason I have just given. Corresponding amendments were made to sections 55 and 56 (although it may be noted that the amendment to section 55 is poorly drafted, since the definition of “Convention country” in section 55(1)(b) was left unchanged).
51. Secondly, and more importantly, section 6(1)(c) refers to a mark which at relevant date was “entitled to protection ... as a well known trade mark”. By virtue of section 56(1), this means that the mark must be well known “as being the mark of a person who” etc. By contrast, Article 4(2)(d) of the Directive and Article 8(2)(c) of the Regulation merely refer to marks which at the relevant date are “well known in the sense ... used in Article 6*bis*”.

52. Thus sections 6(1)(c) and 56(1) appear to be drafted upon the understanding that protection is to be conferred upon a well-known mark under section 5 only if and to the extent that the mark would be protected under either Article 6*bis* of the Paris Convention or Article 16(2) or (3) of TRIPs. As I have explained, however, this is not what the Directive requires, which is that the protection available under Article 4(1) should be conferred on any earlier mark which is sufficiently well known, whether or not it would be protected under Article 6*bis* of the Paris Convention or even Article 16(2) or (3) of TRIPs.
53. In *CUTTY SARK Trade Mark* (BL O/281/01) an objection was raised in opposition proceedings under section 56(1). It appears that what the opponent meant by this was that it sought to rely upon a mark claimed to be well known within sections 6(1)(c) and 56(1) as founding an objection under section 5. The Registrar's hearing officer Mr Foley held, however, that, by virtue of section 55(1)(b), section 56(1) could not be invoked in respect of a well-known mark by a person who was a national of, or domiciled or established in, the United Kingdom. Mr Foley rejected the submission that the Act should be construed in accordance with the Directive pursuant to the *Marleasing* principle on the ground that this would amount to re-writing of the Act. On appeal Jacob J merely observed that this might require consideration on a subsequent occasion: *Imperial Tobacco Ltd v Berry Bros & Rudd Ltd* (unreported, 31 October 2001). It is not necessary for me to express any view on this question, since it is not material to the present case, but it does illustrate the difficulties which arise.
54. Given the approach taken by the hearing officer to the significance of the term LE MANS, and my rejection of it above, I should deal with the effect of the inclusion in section 56(1) (but not in Article 4(2)(d)) of the words "well known ... as being the mark of a person...". These words, which derive from Article 6*bis* of the Paris Convention, might be thought to suggest that, at least in the context of a consideration of whether a mark qualifies as a well-known mark for the purposes of section 6(1)(c), it is necessary for an opponent to show that the mark is well known (i) as being a trade mark and (ii) as

belonging to it. In my judgment, however, such an interpretation would be contrary to the purpose of Article 6bis, and provisions based upon it, which is to protect trade marks which have become well known in one country through use in another country (or other countries) but have not been registered or possibly even used in the first country (and hence cannot be protected by more conventional legal remedies): see Mostert, *Famous and Well-Known Marks* (Butterworths, 1997) at 1-32. I consider that the purpose of the words “as being the mark of a person” in Article 6bis and section 56(1) is merely to limit protection to trade mark owners who are entitled to the benefits of the Convention (or now TRIPs, in the case of section 56(1)).

Does LE MANS qualify for protection as a well-known mark?

55. There is very little case law in the UK as to what must be shown for a mark to qualify for protection as a well-known mark within section 56(1). (There is some case law regarding defensive registration of well-known marks under section 27 of the 1938 Act, but in my judgment this is of little assistance with regard to the present question.) Counsel for the opponent was unable to find any reported decision in this jurisdiction, and instead referred me to *Pfizer Inc v Monaco Télématique en Abrégé MC Tel* [2001] ETMT 16, in which the Monaco Court of First Instance held that VIAGRA was a well-known mark, and *Christian Dior Couture SA v Liage International Inc* [2000] ETMR 773, in which a WIPO Administrative Panel held that CHRISTIAN DIOR and DIOR were well-known marks. As counsel pointed out, in both these cases the defendant did not contest the proposition, and so I do not derive any assistance from these decisions.
56. Since the hearing I have come across *PACO/PACO LIFE IN COLOUR Trade marks* [2000] RPC 451. In that case the Registrar’s hearing officer Mr James held that (a) a trade mark could only be well known in respect of the goods or services in respect of which it has been used, and (b) accordingly PACO RABANNE was not a well-known trade mark for clothing even though it had a reputation in relation to perfume. Conclusion (a) is a commonsense

proposition of law which counsel for the opponent in the present case accepted.

57. In reaching conclusion (b) Mr James referred to paragraph 31 of the Opinion of Advocate General Jacobs in Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421. Although it is primarily concerned with Articles 4(4)(a) and 5(2) of the Directive, I think it is worth quoting the relevant section of the Opinion in full:

30. Both in the proceedings before the Court, and in general debate on the issue, attention has focused on the relationship between ‘marks with a reputation’ in Article 4(4)(a) and Article 5(2) of the Directive and well-known marks in the sense used in Article 6*bis* of the Paris Convention for the Protection of Industrial Property. Well-known marks in that sense are referred to in Article 4(2)(d) of the Directive.

31. General Motors, the Belgian and Netherlands Governments and the Commission submit that the condition in the Directive that a mark should have a ‘reputation’ is a less stringent requirement than the requirement of being well known. That also appears to be the view taken in the 1995 WIPO Memorandum on well-known marks.

32. In order to understand the relationship between the two terms, it is useful to consider the terms and purpose of the protection afforded to well-known marks under the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Article 6*bis* of the Paris Convention provides that well-known marks are to be protected against the registration or use of a ‘reproduction, an imitation, or a translation, liable to create confusion’ in respect of identical or similar goods. That protection is extended by Article 16(3) of TRIPs to goods or services which are not similar to those in respect of which the mark is registered, provided that use of the mark would ‘indicate a connection between those goods or services and the owners of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use’. The purpose of the protection afforded to well-known marks under those provisions appears to have been to provide special protection for well-known marks against exploitation in countries where they are not yet registered.

33. The protection of well-known marks under the Paris Convention and TRIPs is accordingly an exceptional type of protection afforded even to unregistered marks. It would not be surprising therefore if the requirement of being well-known imposed a relatively high standard for a mark to benefit from such exceptional protection. There is no such consideration in the case of marks with a reputation. Indeed as I

shall suggest later, there is no need to impose such a high standard to satisfy the requirements of marks with a reputation in Article 5(2) of the Directive.

34. The view is supported by at least some language versions of the Directive. In the German text, for example, the marks referred to in Article 6*bis* of the Paris Convention are described as ‘notorisch bekannt’, whereas the marks referred to in Article 4(4)(a) and Article 5(2) are described simply as ‘bekannt’. The two terms in Dutch are similarly ‘algemeen bekend’ and ‘bekend’ respectively.
  35. The French, Spanish, and Italian texts, however, are slightly less clear since they employ respectively the terms ‘notoirement connues’, ‘notoriamente conocidas’, and ‘notoriamente conosciuti’ in relation to marks referred to in Article 6*bis* of the Paris Convention, and the terms ‘jouit d’une renommée’, ‘goce de renombre’, and ‘gode di notorietà’ in Article 4(4)(a) and Article 5(2) of the Directive.
  36. There is also ambiguity in the English version. The term ‘well known’ in Article 6*bis* of the Paris Convention has a quantitative connotation (the *Concise Oxford Dictionary* defines ‘well known’ as ‘known to many’) whereas the term ‘reputation’ in Article 4(4)(a) and Article 5(2) might arguably involve qualitative criteria. The *Concise Oxford Dictionary* defines reputation as ‘(1) what is generally said or believed about a person’s or thing’s character or standing...; (2) the state of being well thought of; distinction; respectability;...(3) credit, fame, or notoriety’. Indeed it has been suggested that there is a discrepancy between the German text compared with the English and French texts on the grounds that the ‘reputation’ of a trade mark is not a quantitative concept but simply the independent attractiveness of a mark which gives it an advertising value.
  37. Whether a mark with a reputation is a quantitative or qualitative concept, or both, it is possible to conclude in my view that, although the concept of a well-known mark is itself not clearly defined, a mark with a ‘reputation’ need not be as well known as a well-known mark.
58. The Advocate General refers in one of his footnotes to Mostert. Mostert at 8-17 suggests the following criteria derived from a number of sources for assessing whether a mark is well-known:
- (i) the degree of recognition of the mark;
  - (ii) the extent to which the mark is used and the duration of the use;
  - (iii) the extent and duration of advertising and publicity accorded to the mark;
  - (iv) the extent to which the mark is recognised, used, advertised, registered and enforced geographically or, if applicable, other relevant factors

that may determine the mark's geographical reach locally, regionally and worldwide;

- (v) the degree of inherent or acquired distinctiveness of the mark;
- (vi) the degree of exclusivity of the mark and the nature and extent of use of the same or a similar mark by third parties;
- (vii) the nature of the goods or services and the channels of trade for the goods or services which bear the mark;
- (viii) the degree to which the reputation of the mark symbolises quality goods;
- (ix) the extent of the commercial value attributed to the mark.

59. In September 1999 the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organisation (WIPO) adopted a Joint Recommendation concerning Provision on the Protection of Well-Known Marks. Article 2 of the Joint Recommendation provides:

- (1)(a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.
- (b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:
  - 1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
  - 2. the duration, extent and geographical area of any use of the mark;
  - 3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
  - 4. the duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;

5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
  6. the value associated with the mark.
- (c) The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching the determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factor listed in subparagraph (b), above.
- (2)(a) Relevant sectors of the public shall include, but shall not necessarily be limited to:
- (i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;
  - (ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;
  - (iii) business circles dealing with the type of goods and/or services to which the mark applies.
- (b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.
- (c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.
- (d) A Member State may determine that a mark is a well-known mark, even if the mark is not well-known or, if the Member State applies subparagraph (c), known, in any relevant sector of the public of the Member State.
- (3)(a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:
- (i) that the mark has been in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;

- (ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or
    - (iii) that the mark is well known by the public at large in the Member State.
  - (b) Notwithstanding subparagraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.
60. Two points of interest emerge from Article 2 of the Joint Recommendation. The first is that the list of six criteria contained in Article 2(1)(b) is not inflexible, but provides as it were a basic framework for assessment. The second is that *prima facie* the relevant sector of the public consists of consumers of and traders in the goods or services for which the mark is said to be well known.
61. I understand that the Office for Harmonisation in the Internal Market (OHIM) generally follows the criteria listed in Article 2(1)(b) of the Joint Recommendation when assessing whether a mark is well known for the purposes of Article 8(2)(c) of the Regulation. Although there have been a number of cases in which attempts by opponents to invoke Article 8(2)(c) have been rejected by OHIM Boards of Appeal (e.g. Case R377/2002-1 *Kohler & Co v Friedrich Grohe AG & Co KG* (First Board of Appeal, 2 March 2004) and Case R0682/2001-4 *Gaspar v Escoval* (Fourth Board of Appeal, 17 March 2004)), these decisions shed little light on the circumstances in which a claim that a mark is well known will be accepted. I have not been able to find any case in which an OHIM Board of Appeal has upheld a claim under Article 8(2)(c), although in Case R91/2002-3 *McDonald's International Property Co Ltd v Aydemir* (Third Board of Appeal, 5 March 2003) the Board apparently accepted that the McDonald's golden arches sign was well known in the context of an opposition based upon registrations of that sign.

62. Turning to the facts of the present case, the opponent naturally relies upon the hearing officer's finding in paragraph 37 that "the name LE MANS is famous for a race", so famous that "one would have to be living in a cave in the UK not to have heard it" and so famous that he could take judicial notice of this as a "notorious fact" even though it was not proved by the opponent's evidence. Although this obviously forms a promising basis for the submission that LE MANS qualifies as a well-known mark, counsel for the opponent recognised, rightly in my view, that it remains necessary to assess whether the evidence demonstrates that LE MANS satisfied the relevant criteria at the relevant date, particularly since it appears from his decision that the hearing officer would not have been satisfied of this had he considered it. I shall consider the six criteria set out in Article 2(1)(b) of the Joint Recommendation.

*Degree of knowledge or recognition*

63. In the first instance the relevant sector of the public is consumers of, and traders in, services of organising and managing motor racing events. These divide into two basic groups: companies, firms and individuals who participate in motor racing and spectators who watch motor races. In the present context the second group further divides into those who attend the race in person and those who watch it on television. While those who watch it on television are not direct consumers of the opponent's services, they can be regarded as indirect consumers since broadcasters pay for the right to broadcast motor races on the strength of their interest. (In principle the same would be true of radio broadcasts, but there is no evidence of radio coverage in the present case.)
64. The matter does not stop there, however, since the opponent claims that LE MANS is also a well-known trade mark amongst the public at large.
65. I am satisfied that the evidence demonstrates a high degree of knowledge and recognition of LE MANS in both these sectors. By way of example only I refer to the following:

- (1) In paragraph 39 of his decision the hearing officer quoted from the Preface to a yearbook published by a licensee of the opponent in English to commemorate the 1984 race, and apparently accepted, a statement by the President of the opponent that “Le Mans is a word that conjures up motor racing in the minds of people all over the world”. Similarly a book published by a licensee of the opponent in English to celebrate the 70<sup>th</sup> anniversary of the race in 1992 contains a short history of the race by an individual who I assume is associated with the opponent which concludes:

The effect of the magic words ‘Le Mans’ are easily recognisable when one travels abroad. All one has to be is mention them and people’s faces light up with instant recognition and also ... a touch of envy!

These could be criticised as self-serving statements, but they were made long before the present dispute was contemplated.

- (2) It appears that *Autosport* magazine regularly publishes supplements covering the race. Extracts from the 1996, 1997, 1998, 2000 and 2001 supplements are in evidence which repeatedly refer to the race simply as LE MANS. An article in the 1996 supplement states:

During the middle weekend of June the little city of Le Mans becomes the second capital of England as 50,000 odd fans make their annual pilgrimage to the world’s greatest 24 hour event...

An article on the contents page of the 1997 supplement states:

There are three races that the man in the street recognises instantly: the Monaco Grand Prix, the Indianapolis 500 and the Le Mans 24 Hours.

The covers of the 2000 and 2001 supplements are headed “Your guide to the world’s greatest race”. These are after the relevant date, but they are consistent with the coverage from before that date.

- (3) On 16 June 2001 *The Times* published two articles about the race. One began “For many motorsport fans, Le Mans is quite simply the greatest race on Earth.” The other was headlined “24 hours in the life of the greatest race”. These articles are again after the relevant date, but I have no doubt that they reflect the position as at the relevant date. Similar articles from *The Daily Telegraph* are also in evidence.
- (4) An article posted on a website called CLUB ARNAGE, “The original independent guide to the Le Mans 24 Hours” on 11 June 2002 states:

Le Mans is reputed to be the biggest event in the British sporting calendar with more British spectators at Le Mans than any other event. This year there are more British entries than we have [had] for several years...

Again this is after the relevant date, but plainly reflects the position before.

- (5) As I have already recorded, the hearing officer noted Mr Cumming’s acceptance that LE MANS was a “colloquialism” for the race. A colloquialism is “a colloquial expression”, that is, an expression “belonging to familiar speech and writing” (*Shorter Oxford English Dictionary*, 5<sup>th</sup> edition).

#### *Duration etc of use*

66. Mr Cumming in his evidence argued that the opponent itself had made very little, if any, use of the term LE MANS even as the name of the race even in France (as opposed to, for example, 24 HEURES DU MANS), and that it was rather other people who were in the habit of referring to the race as LE MANS. In my judgment this would be irrelevant even if correct. If a sign functions as a trade mark for a trader’s goods or services, it is immaterial that it was coined by the trader’s customers rather than by the trader himself. Thus in *Siegert v Findlater* (1878) 7 Ch D the plaintiff had manufactured in the town of Angostura a flavouring which he sold under the name AROMATIC

BITTERS but which was popularly known as ANGOSTURA BITTERS. The defendant was restrained from using the latter name on the grounds of passing off. After the defendant had commenced doing so, the plaintiff started calling his product ANGOSTURA BITTERS, but this was immaterial to his success. I would add that, as discussed above, the whole point of protecting well-known marks is that they may have become well-known otherwise than by use by their owners in the country in question.

67. In any event, as can be seen from paragraph 65(1) above, the opponent does use the term LE MANS to denote the race, particularly in English-language communications. The hearing officer observed that there is no evidence as to the UK circulation figures for such publications, but in my judgment this misses the point. The opponent does not rely upon such publications as having themselves generated the reputation of its mark but as reflecting its existing fame. What those publications show is a belief on the part of the opponent that the race is famous in English-speaking countries under the name LE MANS, and the consequent use of that appellation when addressing that audience.
68. It is unclear from the evidence precisely how long the term LE MANS has been used to denote the race, but it appears that the race has been known by this name in United Kingdom for many years. There are a number of pieces of evidence that indicate that the race has been popular with both British competitors and British spectators ever since the 1920s when Bentley won four races.
69. As to the extent of use of the term, some indication of this is given by the materials I have already referred to. It is clear that the race has also received extensive coverage in the UK media down the years. Thus in 1983 the race received over 2 hours television coverage, although the channel and reach is unspecified. In 1999 the race received 21 hours television coverage, over half of which was live, on the Eurosport channel with a reach of 6,450,000 viewers; and nearly an hour's highlights were broadcast on the BBC with a reach of 23,758,588 viewers. In addition, a number of pieces of evidence state that by the late 1990s around 50,000 British spectators annually attended the

race in person (although the figure quoted by Ms Bristow for 2001 is about 23,000).

70. As for the geographical area of use of the mark, while it is recognition of the mark in the country in question that is of primary importance, I consider it is relevant for a party claiming protection for a well-known to show that its mark is known internationally, because this increased the probability that its repute transcends national boundaries. I am satisfied that LE MANS is such a mark. Ms Bristow gives evidence of press coverage of the race in Brazil, France, Germany, Japan, Luxembourg, Portugal, and USA. More significantly, perhaps, in 1999 there was television coverage of the race in 175 territories in addition to the United Kingdom with a combined reach of hundreds of millions of viewers.

*Duration etc of promotion*

71. There is little evidence of promotion or advertising of LE MANS in the United Kingdom. Nor is there much evidence of promotion or advertising of LE MANS in France or other countries that might be expected to have a spill over effect here, other than the media coverage to which I have already referred, and some rather unsatisfactory evidence about posters used to promote the race.

*Duration etc of registrations*

72. The opponent put in evidence of a considerable number of registered trade marks around the world. The registrations effective in the United Kingdom as at the relevant date were the four pleaded in paragraph 1 of the opponent's statement of case. These do not seem to me to reflect use or recognition of the mark, however.

*Record of enforcement etc*

73. There is no evidence of successful enforcement of the mark or recognition by competent authorities in the United Kingdom. Nor is there evidence of the mark having been successfully enforced in France, although it does appear that the opponent successfully sued a French publisher for publishing a book entitled *Le Mans 2002 – 70<sup>th</sup> edition* on unfair competition grounds (this is the judgment of the commercial court of Nanterre referred to above).

*Value associated with the mark*

74. Ms Bristows gives evidence of a number of licence agreements for use of marks including LE MANS in a variety of fields. In some cases she does not specify the territory or territories covered by such agreements, but those which cover the United Kingdom include: (a) a 1990 agreement with Renault to produce a model of motor car badged LE MANS; (b) a 1993 agreement with Peugeot for the production of three models of motor car badged LE MANS; (c) a 1989 agreement with Dunlop for use of mark on tyres; (d) a 1996 agreement with La Société Motul SA for use of the mark on motor oil; (e) a 1997 agreement with Sega Enterprises Ltd for the marketing of video and arcade games under the mark (the agreement is in French and Ms Bristow does not specify the territory, but the exhibit includes royalty statements and promotional material in English which make it clear that the licence covered the United Kingdom); and (f) a 2000 agreement with Infogames UK Ltd for the marketing of computer games under the mark. Ms Bristow also gives evidence that in 2001 Bentley sold two models of car badged LE MANS in the UK and elsewhere and states that the opponent is in the process of negotiating a licence agreement for such use. She also produces evidence that in 1980/81 Porsche sold a model of car badged LE MANS in the UK and elsewhere.
75. The hearing officer observed that in relation to some of these licences there was no evidence of the extent of any exploitation in the United Kingdom, and that in the case of others the extent of exploitation, particularly before the application date, was relatively modest. Again, in my judgment this misses the

point. What these licence agreements demonstrate is a recognition on the part of licensees that LE MANS is a term which has a commercial magnetism that is worth both exploiting for commercial advantage and paying for.

### *Conclusion*

76. I have no hesitation in concluding, as at November 1999, LE MANS was a well-known trade mark in the United Kingdom for the services of organising and managing motor racing events, both among consumers of, and traders in, such services and among the public at large.

### Section 5(2)(a)

77. The likelihood of confusion must be assessed in accordance with the guidance given by the Court of Justice in Case C-251/95 *Sabel BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Moda CV v Adidas AG* [2000] ECR I-4881. For this purpose I shall apply the Registry's standard summary of the relevant 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/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;
- (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 therefore be based on the overall impressions created by the marks bearing in mind their distinctive and dominant components;
- (e) a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the goods, and vice versa;

- (f) 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;
- (g) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of section 5(2);
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (i) but if the association between the marks causes the public wrongly to believe that the respective goods come from the same or economically-linked undertakings, there is a likelihood of confusion within the meaning of the section.

78. The mark sought to be registered is identical to the opponent's well-known mark. It is sought to be registered in respect of a variety of goods that I will summarise as parts and accessories for motor cars. In my judgment such goods have some degree of similarity with the services for which the opponent's mark is well-known by virtue of the connection with motor cars. The consumers of such goods include large traders (such as motor car manufacturers), small traders (such as garage proprietors and mechanics) and end consumers (particularly car enthusiasts engaged in repairing, modifying or enhancing their vehicles). While the goods are slightly specialist items, there are nevertheless fairly common ones and one that may be fairly inexpensive, and accordingly no special care would be taken in their selection. Bearing in mind the distinctive character of the opponent's mark and the interdependency principle, I conclude that the average consumer of such goods might well think that the applicant's goods came from a source that was at least economically-linked to the source of the opponent's services.

79. This conclusion is fortified by the evidence as to the manner in which the applicant has used the mark. Ms Bristow exhibits two instances of this. The first consists of an advertisement for its goods placed by the applicant under its then name of LE MANS MOTORSPORT in the 2001 *Autosport* LE MANS special supplement. I believe that at least some readers of this advertisement would be likely to conclude that such goods were connected with the organiser of the race at least the extent of being approved or endorsed or licensed by the

organiser. The second is a print-out from the applicant's website dated 28 August 2002 showing that the applicant (a) has sponsored a series of motor racing events which are referred to as both the AUTO-ITALIA series and the LE MANS AUTO-ITALIA series and (b) has or has sponsored a racing team whose cars are prominently emblazoned LE MANS MOTORSPORT. This type of use seems to me to be almost bound to cause confusion, particularly the reference to the LE MANS AUTO-ITALIA series of races.

80. This evidence post-dates the application date, but it is well established that the manner in which an applicant actually uses his mark will generally be taken as falling within the scope of normal and fair use of the mark as at the application date.
81. The applicant argued before the hearing officer that there was no evidence of confusion, but again it is well established that this is not determinative, since the absence of evidence of confusion may be explicable for a variety of other reasons. In the present case, a possible explanation is that consumers have not appreciated that the applicant is not connected to the opponent.
82. Finally, I would add that the applicant has provided no explanation for its adoption of the mark to rebut the obvious inference that it intends to take advantage of the commercial magnetism associated with it.
83. I therefore conclude that the opponent has established a likelihood of confusion within section 5(2)(a).

#### Section 5(3)

84. On the appeal the opponent initially sought to argue that the application was objectionable under section 5(3) insofar as it related to similar goods, in accordance with Case C-292/00 *Davidoff v Gofkid* [2003] ECR I-329 and Case C-408/01 *Adidas-Salomon AG v Fitness World Trading Ltd* [2004] ETMR 10. In the course of argument, however, counsel for the opponent accepted that this argument was not open to the opponent on its statement of

case: *Mastercard International Inc v Hitachi Credit (UK) plc* [2004] EWHC 1623 (Ch) at [20]-[22]. He therefore put the case in the hitherto conventional manner: if the applicant's goods are similar to the opponent's services there is a likelihood of confusion, alternatively if they are not similar there is an objection under section 5(3). I have concluded that the goods are sufficiently similar for there to be a likelihood of confusion. Accordingly, it is unnecessary to consider the alternative case under section 5(3).

#### Section 5(4)(a)

85. In view of my conclusion with regard to section 5(2)(a), it is unnecessary to consider section 5(4)(a). Nevertheless I shall do so, because in my view the section 5(4)(a) objection is also made out and this confirms the conclusion I have reached with regard to the significance of the term LE MANS.

86. Counsel for the opponent summarised the opponent's claim to goodwill in the United Kingdom connected with name LE MANS as follows:

- \* The Le Mans race is an extremely famous event in the United Kingdom
- \* The likelihood of bringing in custom to the event, i.e. attracting spectators, advertisers, TV coverage and so on, is dependent upon the quality of organisation of the event
- \* Consequently there is goodwill in the business of organising the event and that goodwill is associated with the name LE MANS
- \* Such goodwill exists in England because the business has customers in England both in the form of the 50,000 who cross the channel each year and the many millions who watch it on television (see *Pete Waterman v CBS* [1993] EMLR 27 for the proposition that goodwill exists in England in relation to a business carried on abroad if there are customers in England)
- \* The goodwill is owned by the person responsible for the quality of the organisational services in running the event i.e. ACO
- \* It does not matter whether or not the relevant UK public could identify who the organiser is (*The Birmingham Vinegar Brewery Co v Powell* [1897] AC 710).

87. I accept these submissions. I would only add that, as the hearing officer recognised in paragraph 68 of his decision, the evidence confirms that, as is obvious, the opponent charges spectators for admission to the race.
88. The hearing officer concluded that, even assuming that the opponent owned such goodwill, the use of the mark by the applicant would not give rise to a misrepresentation. His reasoning for reaching this conclusion was the applicant's goods were insufficiently closely related to the opponent's service for confusion to be likely. I am unable to agree with this: to my mind there is an obvious connection between parts for motor cars (particularly given that the parts that the applicant sells are mainly the sort of parts used by enthusiasts to modify or enhance their vehicles) and organising motor races. This is why the applicant sponsors a series of races and a motor racing team, as I have noted above. In these circumstances, I consider that a substantial number of consumers would believe that the applicant's goods were approved or endorsed or licensed by the opponent: cf. *Irvine v TalkSport Ltd* [2003] EWCA Civ 423, [2003] EMLR 26.

### Conclusion

89. For these reasons the appeal is allowed and the opposition upheld.

### Costs

90. The hearing officer ordered the opponent to pay the applicant the sum of £2000 as a contribution to its costs. I shall reverse that order and award the opponent the same sum in respect of the appeal, making a total of £4000.

8 November 2004

RICHARD ARNOLD QC

Richard Hacon, instructed by Jones Day, appeared for the opponent.

The applicant did not appear and was not represented.