O/0401/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003989296
BY BYD COMPANY LIMITED
TO REGISTER:

BYD DOLPHIN MINI

AS A TRADE MARK IN CLASS 12

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 446515
BY BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT

BACKGROUND AND PLEADINGS

1. On 08 December 2023, BYD Company Limited ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 22 December 2023 in respect of the following goods:

> **Class 12:** *Automobiles; motor cars; cars; motor coaches; trucks; lorries; motor buses; forklift trucks; automobile bodies; automobile chassis; motors, electric, for land vehicles; brake pads for automobiles; driverless cars [autonomous cars]; self-driving cars.*

2. On 20 March 2024, the application was opposed in full by Bayerische Motoren Werke Aktiengesellschaft ("the opponent") based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. Under both Sections 5(2)(b) and 5(3), the opponent relies upon the following trade marks and some of the goods covered by the same, as shown below:

UK00900143909 ("the first earlier mark")[1] MINI Filing date: 01 April 1996[2] Registration date: 08 December 1999 Under both Section 5(2)(b) and Section 5(3), the opponent opposes the application in its entirety relying upon (and claiming reputation for) some of the goods for which the mark is registered, namely *Land vehicles and their engines; parts, components and accessories for all the aforesaid goods* (class 12)
UK00001506697 ("the second earlier mark")

[1] Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's earlier mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.
[2] The official records show that the mark benefits from two seniority dates of 11 July 1992 and 05 January 1971.

MINI Filing date: 11 July 1992 Registration date: 25 March 1994 Under both Section 5(2)(b) and Section 5(3), the opponent relies upon all of the registered goods namely *Motor land vehicles and parts and fittings therefor; all included in Class 12* (class 12).

4. By virtue of their earlier filing dates, the trade marks relied upon by the opponent are "earlier marks" in accordance with Section 6 of the Act. Both earlier marks had been registered for five years or more at the filing date of the contested mark and, as such, are subject to the use conditions under Section 6A of the Act.

5. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion because the goods are identical or highly similar, and the marks are highly similar. The opponent also claims that the earlier marks benefit from enhanced distinctive character by reason of their extensive use. Lastly, the opponent states that the average consumer is likely to think that the opposed mark denoted a sub-brand of 'MINI', a new business venture or a business collaboration involving 'MINI' or some other association with 'MINI' and that there is a likelihood of indirect confusion on the part of the public.

6. Under Section 5(3), the opponent claims that its earlier marks enjoy a reputation in relation to the goods identified above (*Land vehicles and their engines; parts, components and accessories for all the aforesaid goods* under the first earlier mark and *Motor land vehicles and parts and fittings therefor; all included in Class 12* under the second earlier mark).

7. In particular, the opponent claims that given the high level of similarity between the marks, the relevant public will assume a link between them and/or their respective owners resulting in the contested mark taking unfair advantage of, or being detrimental to, the distinctive character or the repute of the opponent's earlier marks.

8. Under Section 5(4)(a), the opponent relies upon the unregistered sign 'MINI' which it is said has been used throughout the UK since 1970 in relation to the goods for which the two earlier marks are registered, namely: *Land vehicles and their engines; parts, components and accessories for all the aforesaid goods* and *Motor land vehicles and parts and fittings therefor.* In particular, the opponent claims that it has acquired a significant reputation and goodwill in the sign in connection with the relevant goods and that given the high level of similarity between the marks and the identity or similarity between the goods, use of the contested mark would give rise to misrepresentation and damage. In addition, the opponent states that *"notional and fair use of the mark would include use for vehicles and vehicle related goods, in respect of which the word MINI is highly distinctive."*

9. The applicant filed a defence and counterstatement, denying the opponent's claims and putting the opponent to proof of use for the goods relied upon.

10. The opponent is represented by Palmer Biggs IP, Solicitors, and the applicant is represented by Haseltine Lake Kempner LLP.

11. Both parties filed evidence in chief, with the opponent also filing evidence in reply. A hearing was arranged pursuant to a request by the opponent and took place before me on 4 February 2026 by video conference. Mr Jonathan Moss KC appeared for the applicant instructed by Haseltine Lake Kempner LLP. Mr Gwilym Harbottle of counsel appeared for the opponent instructed by Palmer Biggs IP, Solicitors.

Relevance of EU Law

12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

MY APPROACH

13. At the hearing both parties agreed that the Section 5(4)(a) ground adds nothing to the opponent's case. Hence, I will say no more about it.

EVIDENCE

14. The opponent's evidence came in the form of two witness statements from Harald Frey dated 9 August 2024 and 16 December 2024. Mr Frey's first witness statement is accompanied by 25 exhibits (being those labelled HF1-HF25) and his second witness statement is accompanied by six further exhibits (HF26-HF32). Mr Frey is Legal Counsel in the Intellectual Property Law, Trademarks, Designs department of the opponent in Germany, a position he has held since March 2023. His evidence is aimed at showing use of the earlier mark by the opponent in order to support the claims based on use and reputation.

15. The applicant's evidence came in the form of a witness statement from Laura Robyn dated 28 October 2024. Ms Robyn's witness statement is accompanied by eight exhibits (being those labelled LR1-LR8). Ms Robyn is a Chartered Trade Mark Attorney at Haseltine Lake Kempner LLP, and her evidence is aimed at showing use of the word 'MINI' by other traders in relation to cars.

16. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof Of Use

17. Although the applicant initially requested proof of use, the applicant's skeleton argument contained a number of admissions, including that the opponent's mark 'MINI'

has a reputation in the UK in relation to automobiles.[3] This would imply a concession that there has been genuine use of the same mark in relation to the same goods.

18. Although the applicant's concession appears to relate to some of the goods relied upon (the specifications of the earlier marks being broader), having discussed the issue of proof of use at the hearing, Mr Moss, on behalf of the applicant, confirmed that I do not need to address the proof of use in this case, and I can proceed on the basis that the opponent has shown genuine use in relation to all of the goods relied upon.

Section 5(2)(b)

19. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a) …
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

20. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

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

[3] Paragraph 31 of the applicant skeleton argument states: *"It is undisputed that the Opponent's Marks have a reputation in the UK in relation to automobiles".*

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and
(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

21. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC stated that:

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

22. The competing goods are as follows:

The applicant's goods	**The opponent's goods**
Class 12: *Automobiles; motor cars; cars; motor coaches; trucks; lorries; motor buses; forklift trucks; automobile bodies; automobile chassis; motors, electric, for land vehicles; brake pads for automobiles; driverless cars [autonomous cars]; self-driving cars.*	**Class 12:** *Land vehicles and their engines; parts, components and accessories for all the aforesaid goods* **Class 12:** *Motor land vehicles and parts and fittings therefor; all included in Class 12*.

23. In its skeleton argument, the applicant stated that "*it is accepted that the goods in issue in the contested mark are similar or identical to those in the opponent's marks in class 12".* All of the applied-for goods fall within the opponent's broad terms *Land vehicles and their engines; parts, components and accessories for all the aforesaid goods* and *Motor land vehicles and parts and fittings therefor; all included in Class 12*. These goods are identical on the principle outlined in *Meric.*

Average consumer

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

25. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
>
> (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

26. The average consumer of the parties' goods in class 12 will be a member of the general public, or a professional in the vehicle industry, including garages, repairers and specialist suppliers.

27. The goods are likely to be selected from authorised car dealers, from sellers of vehicles or from websites. The average consumer will encounter the marks on some of the goods themselves – such as cars and other vehicles. For all the goods at issue the average consumer will also encounter the marks in advertising or promotional materials. Consequently, visual considerations will dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

28. The goods will be carefully considered purchases, made infrequently, with a high degree of attention. In particular, when choosing a car or a land vehicle the average consumer will consider factors such as budget, needs, safety, fuel efficiency, vehicle type, and comfort features.[4] Parts and fittings for the same will entail a medium level of care to ensure compatibility.

[4] *Ruiz Picasso V OHIM, DaimlerChrysler* AG C-361/04 P

Comparison of marks

29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

The applied-for mark	**The opponent's earlier mark**
BYD DOLPHIN MINI	MINI

31. The opponent's mark is a word-only mark consisting of the word 'MINI' presented in upper-case letters. There are no other elements that contribute to the overall impression, which lies in the word itself.

32. The applied-for mark consists of the sequence 'BYD' followed by the words 'DOLPHIN' and 'MINI'. The crux of the parties' arguments is whether the shared identical verbal element 'MINI' is distinctive (the opponent's case being centred on acquired enhanced distinctiveness) or whether it is descriptive of a characteristic of vehicles, in particular of the size of automobiles. The question was very clearly put by Mr Harbottle, on behalf of the opponent, in summarising the issue which he expressed as follows:

> *"I would like to respond briefly to the allegation made by The Applicant in paragraph 15 of The Applicant's skeleton where it is said "what this opposition is, it is a significant attempt to overreach by The Opponent to monopolise the descriptive meaning of a common, ordinary, English word", so this opposition is an attack on the English language, no less. I just want to make clear that this is not what my client intends at all. The word 'mini' does not have a purely descriptive meaning in terms of vehicles in the UK. This is not about the use of 'mini' [in] a descriptive sense anyway but rather about the use of 'mini' as a trade mark. My client has legitimate concerns and wants to prevent use which gives Mini's customers an erroneous impression of some kind of collaboration or otherwise dilutes the distinctiveness of its mark. My submission has a perfectly legitimate approach and there is no attack on the descriptive use of the word 'mini' in the English language at all, this is [a] trade mark case…."*

33. In its skeleton argument Mr Moss, on behalf of the applicant, stated that the contested mark *"comprises of three independent blocks".* He also stated that the contested mark "*is dominated by "BYD DOLPHIN", which is the source of its distinctive character"*, because (a) *"the average consumer generally pays greater attention to the beginning of a mark than to the end"* and (b) that rule is applicable in this case because *"the first two words comprise an acronym and a word that is totally foreign to use in relation to cars or automobiles – namely dolphin"* whereas the word 'MINI' is descriptive. Lastly, the applicant's case is that *"given the descriptive nature of the word 'MINI', the average consumer is likely to understand 'BYD DOLPHIN' as the brand name, and 'MINI' as merely being either the series of the model or just describing a smaller version of the 'BYD Dolphin'".*

34. In addition, Mr Moss argued that the applicant's evidence shows that the word 'MINI' is used to describe smaller vehicles within the automobile industry. He also argued that car manufacturers use the word 'MINI' in conjunction with the manufacture's name as a descriptor, and that car manufacturers use sub-brands whereby the brand name is followed by the name of the sub-brand or a descriptor. In particular, Mr Moss referred to the following evidence:

- Examples of the word "mini" being used to describe the small size of a vehicle. Such usages include "mini-MPV", "mini-buses", "superminis".

  In relation to this evidence, I note that an online article from April 2014 titled "*Top 10 best superminis 2024. The best superminis have evolved from small yet practical cars to ones with real dynamic prowess and versatility*" lists 10 models, including Renault Clio, Seat Ibiza, Skoda Fabia, Volkswagen Polo, Hyundai i20, Dacia Sandero, Toyota Yaris, Peugeot 208, Audi A1, and Mini Electric; however, the only model which include the word 'MINI' within the car's name is the opponent's one, i.e. Mini Electric.[5] Likewise, an article which talks about "FORD SMALL CARS", lists a number of models none of which contain the word 'MINI' (i.e. Ford KA, Ford B-Max, Ford Eco-Sport). Other example of use of 'MINI' in cars' names are 'Toyota Land Cruiser Mini'[6] and 'Suzuki Splash Mini MPV';[7] whilst the relevant articles are dated after the relevant date, Ms Robyn produces evidence that the second one was available since 2016.[8]

- Another example of use of the word 'MINI' in a descriptive manner in conjunction with the company's name is "Mazda's mini" (2015), however, although 'Mazda mini' appears to be used colloquially in an online article which talks about that car model, the official name of the car is 'MAZDA 2'.[9]

[5] Exhibits LR1, LR3, LR5, LR6, LR8.
[6] Exhibit LR2
[7] Exhibit LR6
[8] Exhibit LR7
[9] Exhibit LR8

- Examples of automobile manufacturers using sub-brands whereby the brand name comes first, followed by the name of the sub-brand or the descriptor of what it is, i.e. ‘Ford SYNC 3’, ‘Ford Ecoboost’, ‘Ford Puma’.[10]

35. The way I understand the applicant’s case is that the inherent descriptiveness/weak distinctiveness of the word ‘MINI’ in the applicant’s mark is reinforced by the structure of the mark. Such structure, the applicant alleges, adopts the same construction which is commonly used in the automotive sector, whereby the name of the car manufacturer (in this case ‘BYD’) is followed by the name of the car model (in this case ‘DOLPHIN’) and the word ‘MINI’ is used as a descriptor to denote the small size of the car or vehicle (as in the ‘Suzuki Splash Mini MPV’ example).

36. Although most of the applicant’s evidence is dated after the relevant date, it is consistent with my experience that, in the automotive industry, car manufacturers use sub-brands which generally identify a particular model of vehicle; as regards the structure of sub-brands, I accept that there is no general rule but that the average consumer is accustomed to see sub-brands which include the name of the car manufacturer followed by the name of the car model which can be either distinctive (i.e. as in some of the examples shown in evidence, such as Renault Clio, Skoda Fabia, Volkswagen Polo, Hyundai i20, Dacia Sandero, Toyota Yaris, Peugeot 208, Audi A1) or descriptive/allusive of a characteristic of the car (as in Ford Eco-Sport, Ford Ecoboost). Among the latter, the evidence shows use of the word ‘MINI’ as a descriptor in two instances, namely ‘Toyota Land Cruiser Mini’ and ‘Suzuki Splash Mini MPV’ whereby the word ‘MINI’ qualifies the nouns ‘cruiser’ and ‘MPV’ rspectively.

37. I also bear in mind that one point on which the parties agree is that the word ‘MINI’ retains its own independent role within the applicant’s mark. The same goes for the other two elements of the mark, namely the sequence ‘BYD’ and the word ‘DOLPHIN’, which are inherently and independently distinctive because (a) they are neither descriptive nor allusive in relation to the goods the mark seeks registration for, which are vehicles or parts of vehicles and (b) do not form a unit. Lastly, at the hearing Mr Harbottle seemed to concede that ‘MINI’ is inherently not very distinctive, though he

[10] Exhibit LR3

said that this would not make any difference because the opponent's case is centred on acquired distinctiveness.[11]

38. Admittedly, whilst the acquired distinctiveness and reputation of the earlier mark might be relevant when assessing the likelihood of confusion (and the opponent's claim under Section 5(3)), it cannot have an impact on the assessment of the overall impression of the applicant's mark and the distinctiveness of the word 'MINI' within the same mark. Accordingly, bearing in mind what I have discussed above, I consider that the average consumer will perceive each element of the mark 'BYD DOLPHIN MINI' independently. Further, given their positioning, length and inherent distinctiveness, the words 'BYD' and 'DOLPHIN' will be perceived as having more weight than the element 'MINI'.

39. For the sake of completeness I should say that whilst notional and fair use of the applied-for goods includes goods of different sizes, it would be artificial to consider the present opposition as based on a scenario whereby the applied-for mark is used in relation to larger versions of the applied-for goods (i.e. for which the word 'MINI' would be more distinctive), because that would be both deceptive and unrealistic.

Visual and aural similarity

40. Visually and aurally, the respective marks coincide in the word 'MINI' which represents the entirety of the earlier mark and the last verbal element of the applied-for mark. The marks differ in the presence, in the applied-for mark, of the distinctive words 'BYD' and 'DOLPHIN'. Even bearing in mind the applicant's concession that the earlier mark 'MINI' has a reputation and is distinctive (by virtue of acquired distinctiveness) this does not come into the comparison of the marks. In this connection, in *Ravensburger AG v OHIM*, Case T-243/08, the GC held that:

> "27. It is appropriate at the outset to reject that complaint as unfounded. The reputation of an earlier mark or its particular distinctive character must be taken

[11] See page 4 of the transcript where Mr Harbottle stated; "Turning to the significance of 'mini', we accept there would be arguments about inherent distinctiveness but that does not matter as our case is centred on acquired distinctiveness."

into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway* v *OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51)."

41. On further appeal the CJEU held in *Gateway* v *OHIM,* Case C58/08 P, that it was not necessary for the GC to make apparent the degree of renown of the earlier mark because it was not relevant in circumstances where the marks as a whole were not similar. Overall, I find that the marks are visually similar to a low degree.

Conceptual similarity

42. Conceptually, the applicant states that the sequence 'BYD' stands for 'BUILD YOUR DREAM' however the average consumer will not be able to decipher that meaning from the initials 'BYD' and will perceive it as an acronym with no conceptual meaning. The word 'DOLPHIN' will convey the concept of *"a mammal that lives in the sea"* (Collins English dictionary) which is distinctive in the context of the goods at issue and has no counterpart in the earlier mark. Lastly, the word 'MINI' will be perceived independently in the applied-for mark and will convey the same meaning as that conveyed in the earlier mark (of which it is the only element), namely that of "*something smaller than the standard size"* (Collins online dictionary). Insofar as the meaning conveyed by the word 'MINI' is common to both marks but bearing in mind the conceptual difference created by the word 'DOLPHIN' in the applied-for mark, the marks are conceptually similar to a medium degree.

Distinctive character of the earlier mark

43. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV,* Case C-342/97, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

44. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words, which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

45. In his skeleton argument Mr Moss stated that *"…the descriptive quality of the English word "MINI" gives it a low inherent distinctive character, especially considering the fact that the word "MINI" is commonly used to describe small cars in general as set out above."* Notably, although Mr Moss argued that 'MINI' is descriptive, in that passage he did not say that it has no distinctiveness, but rather that it has a low degree of distinctiveness. However, in other parts of his skeleton argument, Mr Moss referred to the lack of distinctiveness of the opponent's mark.

46. Whether the starting point of the opponent's mark 'MINI' was no distinctiveness or low distinctiveness, it does not really matter given the applicant's concession that *"it is*

undisputed that the opponent's marks have a reputation in the UK in relation to automobiles". Nevertheless, the strength of the earlier mark's reputation and its degree of distinctiveness is still a matter to be taken into account in my assessment, given that there is a direct correlation between how distinctive the earlier mark is and whether its independently distinctive presence in the applied-for mark might give rise to confusion.

47. With this in mind, I now turn to the opponent's evidence.

48. The opponent's evidence establishes that 'MINI' is a brand owned by the well-known car manufacturer 'BMW'. Whilst part of the opponent's evidence is about the success of the brand 'BMW', I am not going to address that evidence here because it is not relevant for the purpose of this opposition, the mark 'BMW' not being part of the opponent's case. Further, as the distinctiveness of the earlier mark must be assessed from the perspective of the relevant consumer in the UK, I will focus on the evidence specifically related to the UK territory. The most pertinent evidence relating to the brand 'MINI' is as follows:

- The first 'MINI' car was launched in 1959 by the British Motor Corporation. Cars have been sold under the trade mark 'MINI' around the world and in the UK continuously for over 60 years, since 1959.

- During the 1970s and 1980s ownership of the brand changed hands and in 1994 the opponent acquired the Rover Group, which owned the 'MINI' brand at that time. The Rover Group was broken up, and BMW retained the 'MINI' brand, continuing production of the original 'MINI' until 2000.

- Development of a modern successor to the 'MINI' began in 1995 and in 2001 BMW launched an entirely new 'MINI' model. As at the relevant date of 08 December 2023, the 'MINI' range included the 'MINI Cooper', the 'MINI Convertible', the 'MINI Clubman', the 'MINI Countryman', and the 'Mini Concept Aceman'. Since the start of production of the first 'MINI' car, there have been

more than 70 different ‘MINI’ models. Copies of a BMW online product catalogue shows the historic ‘MINI’ models from 1950s to 2000s.[12]

- The ‘MINI Cooper’ (three and five door versions and Convertible) and the ‘MINI Clubman’ models are assembled at BMW Group's Plant in Cowley, Oxford. As at the relevant date, up to 1000 ‘MINIs’ were being manufactured there every day, and the plant had a capacity of around to 200,000 ‘MINI’ vehicles per year. In 2011, to mark 10 years since the start of production of the modern ‘MINIs’ at the Oxford plant, the UK Prime Minister at the time, David Cameron, drove the two millionth ‘MINI’ off the production line. In 2023, BMW Group announced an investment of more than £600 million in the ‘MINI’ plants at Oxford and Swindon. With this new investment BMW Group will develop the plant for production of the new generation of electric MINIs. In 2022 ‘MINI’ introduced the ‘MINI Concept Aceman vehicle’ to demonstrate MINI’s intention to invest on electric cars. New edition models of the MINI 3-door, the MINI 5-door and the MINI Convertible were also presented in 2022 and in 2023, prior to the relevant date.

- BMW works closely with over 100 authorised ‘MINI’ distributors and mechanics across the UK.[13]

- Between January 2018 and July 2024 more than 1.2 million ‘MINI’ vehicles were produced for sale in the UK. Since the launch of the first modern ‘MINI’ in 2001, over 4.4 million ‘MINIs’ have been produced in the UK - including 150,000 ‘MINI’ electric models which were built between 2019 and 2023.

- Copies of brochures from 2021 to 2023 show the current product range sold under the ‘MINI’ mark and how the mark is used in relation to cars. The mark appears on the goods themselves in the following form (at the front and back of the car), notably without the brand BMW:[14]

[12] HF1
[13] HF3
[14] HF2 and 5


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In addition, the mark ‘MINI’ appears throughout the brochure and in the names of the car models, i.e. ‘The MINI Clubman’, ‘The MINI Convertible’, ‘The MINI Countryman’, ‘The MINI Electric.’

- In terms of production figures, the approximate production numbers in the UK of vehicles bearing the ‘MINI’ sign between 2018 and 2023 are as follows:

Year	UK Production Numbers
2018	over 234,000
2019	over 221,000
2020	over 175,000
2021	over 186,000
2022	over 186,000
2023	over 184,000

- In terms of sales, the approximate number of vehicles sold (retail) in the UK under the trade mark 'MINI' and the revenue derived from such sales between 2013 and 2023 are as follows:

Year	Numbers	Revenue
2013	over 53,000	£867m
2014	over 54,000	£924m
2015	over 63,000	£1,102m
2016	over 69,000	£1,194m
2017	over 68,000	£1,181m
2018	over 65,000	£1,202m
2019	over 65,000	£1,323m
2020	over 45,000	£981m
2021	over 46,000	£1,023m
2022	over 46,000	£1,103m
2023	over 47,000	£1,256m

- In terms of market share, data published by the Society of Motor Manufacturers & Traders (the SMMT),[15] one of the largest UK automotive trade associations, show that 'MINI' cars have been constantly ranked among the top 10 best-selling cars in the UK since 2018. In 2018, 'MINI' was ranked as the 7th bestselling car in the UK, in 2019 as 8th, in 2020 as 7th, in 2021 as 3rd, in 2022 as 5th, and again in 2023 as 7th in the list of best-selling cars in the UK. According to the data of the SMMT annual reports, the market shares for 'MINI' cars were as follows:

[15] HF4

Year	Number of MINI registrations in the UK	UK Market share in %	MINI's relative rank of market share compared to the market share of the other car brands in the reports
2017	68,166	2.68	15th out of 43
2018	67,021	2.83	14th out of 43
2019	64,884	2.81	15th out of 41
2020	46,109	2.83	15th out of 42
2021	45,756	2.78	15th out of 41
2022	45,854	2.84	15th out of 43
2023	47,594	2.50	17th out of 47

Mr Frey points out that while the market share percentages referenced above do not initially seem high, it should be noted that in each year indicated, the figures have been calculated taking into account 'MINI''s market share in comparison to over 40 different car brands overall from 2017 to 2023. For example, of the 43 car brands listed for 2017 in the report, 'MINI' had the 15th highest market share percentage in the UK. Mr Frey also states that in relation to the number of new 'MINI' registrations in the UK per year listed above, the annual total number of new car registrations in the UK range from 1.6 to over 2 million units per year.

Mr Frey further states that if one takes into account the market share of 'MINI' vehicles in the premium segment (i.e. including brands such as Mercedes, Audi, Bentley, Aston Martin, Jaguar, Porsche, Lexus, Maserati etc.) only in which the opponent operates, the relevant market share data in the UK are even considerably higher as follows:

Year	UK Market share in %
2018	9.91
2019	9.50
2020	9.20
2021	9.12
2022	9.53
2023	8.81

- Between 2012 and 2023, BMW spent the following approximate sums on marketing vehicles and associated goods under the trade mark 'MINI' in the UK:

Year	Spend
2012	£19m
2013	£20m
2014	£26m
2015	£32m
2016	£35m
2017	£29m
2018	£27m
2019	£26m
2020	£24m
2021	£26m
2022	£23m
2023	£22m

- The 'MINI' brand has featured in the Best Global Brands list regularly since 2015 where it debuted at no. 98. In both 2018 and 2019 'MINI' was listed as no. 90 and in 2022 it was listed as 99.[16] Mr Frey states that the inclusion of the 'MINI' brand on the Best Global Brand list highlights the strong reputation of this trade mark and its global recognition directly reflects the high level of recognition of the mark in the UK, particularly since this is where the brand originates from.

[16] HF16

The strength of the brand 'MINI' has also been recognised by YouGov, a global public opinion and data company. In 2018 the brand 'MINI' featured at no. 4 on the YouGov list of 'Most Popular Cars in the UK'.[17] In 2021, 'MINI' featured in Clarivate's 'Top 100 Best Protected Global brands' in the UK.[18] The brand has also been recognised by independent third-parties, including an article dated October 2018[19] titled "*Best of British brands: Mini. Leading UK marketers celebrate the most iconic British brands from the past five decades"* which states as follows: "*There are few brands that have stood the test of time for almost 60 years, yet Mini has passed through six different owners and still retained a quintessentially British feel…"*

- The trade mark 'MINI' has been recognised as a well-known trade mark and as a trade mark with a high reputation and thus with an enhanced distinctiveness in several EU jurisdictions, including in the following decision by the EUIPO Opposition Division:

    - EUIPO Opposition Division, Opposition No B 2 412 917, decision dated 23/11/2017 where the EUIPO held: '*Having examined the material listed above, the Opposition Division concludes that the earlier trade marks have acquired enhanced distinctiveness through their use on the market. The evidence as a whole clearly demonstrates the long-standing recognition of the 'Mini' brand, in particular in Germany and United Kingdom, and it shows significant sales figures, advertising expenditures, marketing efforts and, as a consequence of all these investments, a high public awareness.'*

49. Based on the above evidence, including (a) the length of use (over 60 years, since 1959), (b) the UK production figures (which have been just under or just above 200,00 vehicles a year in the six years preceding the relevant date), (c) sales figures (which have increased from over £800million to £1.2 billion a year in the 10 years prior to the relevant date with the number of cars being sold ranging between 45,000 to 69,000 a

[17] HF17
[18] HF18
[19] HF19

year), (d) market share (which is nearly 3% of the overall market and around 10% of the premium segment market), and (e) marketing figures (which ranged between £19million to £35million between 2012 and 2023) as well as (f) the ranking from the various sources, I have no doubt that, as at the relevant date, the mark 'MINI' enjoyed a very strong reputation in the UK in relation to cars, and its distinctiveness had been enhanced to a high degree in relation to cars as a result of the use made.

Likelihood of confusion

50. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

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

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

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

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

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

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

52. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in Cheeky Italian Ltd v Sutaria (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

53. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

54. Earlier in this decision I found that:

- The parties' goods in class 12 are identical.

- The average consumer of the goods is a member of the general public, or a professional in the vehicle industry, who will select the goods mainly visually with a medium or high degree of attention.

- The marks are visually and aurally similar to a low degree, and conceptually similar to a medium degree.

- The earlier mark 'MINI' is inherently descriptive in relation to vehicles as it is apt to denote the small size of a vehicle. However, as a result of the use made, the mark 'MINI' has become distinctive to a high degree in relation to a specific car (including various models of the same) manufactured by the opponent and it is likely to be perceived as a well-known trade mark identifying the origin of the goods.

55. The opponent's case is based on the likelihood of indirect confusion. Conversely, the applicant's case is based on the argument that confusion will be prevented by the descriptiveness of the word 'MINI' within the applied-for mark.

56. Before I delve into these arguments, I will address Mr Harbottle's point that *"notional fair use would include use where the word 'MINI' was highlighted in the mark by being in larger text than the rest, being in coloured text where the rest of the mark was in black and white or being placed on a separate line. Any such use would further reduce any descriptive message given by the use of MINI".* I reject this approach. In BL-O/0227/26, Mr Phillip Johnson sitting as the Appointed Person, stated that whilst word marks are protected in all typefaces and fonts, it is inappropriate to hypothesise a way of styling the later mark so as to be as close as possible to the stylisation of the earlier mark. The same principle would, in my view, prevent the scenario suggested by Mr Harbottle, whereby the applicant's word-only mark is presented in a way that

might highlight the word ‘MINI’ increasing the similarity between the marks and the distinctiveness of that element within the applied-for mark.

57. Turning to the opponent’s argument as to how indirect confusion would happen, the opponent contends that there will be indirect confusion of the first type identified in *LA Sugar*, namely the type of confusion whereby the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. Alternatively, the opponent contends, the average consumer would perceive the use of the word ‘MINI’ as indicating that ‘MINI’ had engaged in a commercial connection of some kind with a new market entrant who was unknown to the consumer: a joint venture, licensing agreement or co-branding agreement. In this connection, the opponent states that although there is no evidence that ‘MINI’ has ever engaged in such a joint venture in relation to vehicles or part of vehicles, it has a history of engaging in collaborations with others.

58. As the applicant correctly pointed out, the collaborations to which the opponent refers are (1) London 2012 Olympics - In 2012, MINI was an official partner of “Team GB” and “Paralympics GB”; (2) Dogs Trust UK – In August 2021 MINI partnered with Dogs Trust in a campaign to position itself as a dog-friendly car brand with the aim of educating people on the best practice for car journeys with dogs and (3) Crayola – In September 2023 Crayola and ‘MINI’ announced they had joined forces for the ‘MINI Minds…with Crayola’ competition which was aimed at tapping into the imaginative potential of children to envision the future design of a ‘MINI’ Electric. Although these events are marketing campaigns, none of them involve brands collaboration in a true sense whereby partnerships have produced unique co-branded cars/vehicles sold under a mark which incorporate the memorable brand ‘MINI’ as well as another brand. Accordingly, this part of the opponent’s evidence does not assist its case.

59. The applicant further argues that the average consumers will select some of the goods (i.e. cars and vehicles) with a high degree of attention and that it is highly unlikely that they will buy a ‘BYD Dolphin Mini’ car thinking that they had bought a ‘BMW Mini’. However, that is not the correct test either. As I have outlined above, the

brand ‘BMW’ is not part of the opponent’s case, so it cannot be brought into the equation.

60. Likewise, the opponent’s claim that “*the present case would not be any different if the Applicant had included the famous manufacturer mark “BMW” in the application, for example “BYD DOLPHIN BMW”*”, is neither here nor there because ‘BMW’ is an acronym with no meaning, whilst the word ‘MINI’ is an English word with an inherently descriptive meaning for cars.

61. This leads me to the applicant’s next point, that is to say that at point (b) *LA Sugar* refers to ‘MINI’ adding a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or a brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.). This, the applicant argues, means that ‘MINI’ will be perceived as a descriptive element in the application and cannot give rise to a likelihood of confusion. Whilst it is true that *LA Sugar* refers to the word ‘MINI’ as a non-distinctive element, that does not assist the applicant’s case here because it merely confirms something that the opponent has already conceded, namely that ‘MINI’ is inherently descriptive in relation to vehicles. However, as I have already pointed out, the opponent’s case is based on acquired enhanced distinctiveness and use of ‘MINI’ as a trade mark, as opposed to use of the same word in a descriptive manner, i.e. as in the word ‘minibus’ or ‘mini-MPV’ (MPV standing for multi-purpose vehicle). Further, contrary to the present case, in the *LA Sugar* example, ‘MINI’ is not the shared element. Accordingly, point (b) of *LA Sugar* does not assist the applicant.

62. Lastly, the applicant states that with the exception of the ‘AUSTIN MINI’ none of the ‘MINI’ models of car produced in evidence feature the word ‘MINI’ at the end, ‘MINI’ being typically the first and second word.

63. I agree with the parties that the crux of the issue here is whether an average consumer who is familiar with the earlier mark ‘MINI’ being used to denote the origin of an iconic British car, will think that the mark ‘BYD DOLPHIN MINI’ indicate a particular model of the ‘MINI’ car or a joint venture, licensing agreement or co-branding agreement between the user of the trade mark ‘MINI’ and another trader.

64. Collins online dictionary contains the following definition:

> *"Mini- is used before nouns to form nouns which refer to something which is a smaller version of something else.*
> *Provisions may be purchased from the mini-market.*
> *We were playing mini-golf."*

65. The first thing to note in this case is that 'MINI' in 'BYD DOLPHIN MINI' is not followed by a noun such as, for example, 'MPV' as in the example of 'Suzuki Splash Mini MPV' – if that was the case, the average consumer would be likely to perceive 'MINI' as descriptive (rather than as an independently distinctive element capable of denoting origin). In addition, I bear in mind that the evidence contains another example of 'MINI' used descriptively in 'Toyota Land Cruiser Mini', however, although 'MINI' is placed at the end of the mark, it still functions as an adjective because it refers to the word 'Cruiser'.

66. I also bear in mind that in most of the examples of 'MINI' models shown in evidence 'MINI' is placed at the beginning of the mark, i.e. 'MINI Cooper', the 'MINI Convertible', the 'MINI Clubman', the 'MINI Countryman', and the 'Mini Concept Aceman' with the exception, as the applicant noted, of 'AUSTIN MINI'. Nevertheless, I do not think this is fatal for the opponent's case. I say this because (a) the opponent did not rely on a family of marks argument and (b) whilst there is only one example of 'MINI' being used by the opponent at the end of the mark in one of the 'MINI' car models, this is likely to be down to a marketing strategy which involves a comprehensive approach to brand identity, and does not mean that use of 'MINI' at the end of a trade mark necessarily removes the acquired distinctiveness of that element as shown by the 'AUSTIN MINI' example, or that the opponent cannot change its marketing strategy. In addition, since the mark 'MINI' has not been used in conjunction with the brand 'BMW', the absence of the brand 'BMW' in the application will not be capable of preventing confusion.

67. In my view, whilst it is plausible that a part of the relevant public will see 'MINI' in 'BYD DOLPHIN MINI' as referring to the size of the car, an equally significant part of the relevant public will see it as an independently distinctive element denoting the origin of the goods, i.e. the opponent's cars. This is all the more so since notional and

fair use of the applied-for goods includes goods which are identical to those for which 'MINI' has acquired an enhanced degree of distinctiveness, namely cars, which also include cars of a similar style/appearance. I am also of the view that this conclusion extends to the goods which consists of parts of cars. However, I am not persuaded that there is a likelihood of confusion in relation to goods other than cars because the average consumer is not familiar with 'MINI' being used as a trade mark in relation to these goods. As the Appointed Person stated in *ROJA DOVE*, BL-O/016/10:

> "…It seems to me that any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation inevitably diminishes as one moves away from the core products in relation to which the mark has been used. Particularly with marks which are not fanciful or invented words, the "trigger" which creates an association in the mind of the public between a mark and its proprietor is not simply familiarity with the mark, but familiarity with the mark in a particular context".

68. Accordingly, the opposition is successful in relation to the following goods:

> **Class 12:** *Automobiles; motor cars; cars; automobile bodies; automobile chassis; motors, electric, for land vehicles; brake pads for automobiles; driverless cars [autonomous cars]; self-driving cars.*

69. But fails in relation to the following goods:

> **Class 12:** *motor coaches; trucks; lorries; motor buses; forklift trucks.*

Section 5(3)

70. Section 5(3) states:

> "(3) A trade mark which-
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom

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".

71. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

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

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

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

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

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel,* paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is

clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

72. In *General Motors,* Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

73. As it will be recalled I have found that the distinctiveness of the opponent's earlier mark has been materially increased to a high degree in relation to the opponent's cars. I also found that the opponent's earlier mark enjoys a strong reputation in relation to the same goods.

The Link

74. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

- The degree of similarity between the conflicting marks. The marks are visually and aurally similar to a low degree, and conceptually similar to a medium degree.

- The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public. The goods in relation to which I have found that there is a likelihood of confusion are either identical or similar to the goods for which the opponent's mark enjoys a reputation. The goods for which I found that there is no likelihood of confusion are in my view dissimilar or at best similar to a low degree having a different nature, purpose and relevant public.

- The strength of the earlier mark's reputation. The earlier mark has a strong reputation for cars.

- The degree of the earlier mark's distinctive character, whether inherent or acquired through use. The earlier mark 'MINI' is inherently descriptive in relation to vehicles as it is apt to denote the small size of a vehicle. However, as a result of the use made, the mark 'MINI' has become distinctive to a high degree in relation to a specific car (including various models of the same) manufactured by the opponent and it is likely to be perceived as a well-known trade mark identifying the origin of the goods.

- Whether there is a likelihood of confusion. I have found that there is a likelihood of confusion in relation to goods which are identical or closely similar to the goods for which the earlier mark has acquired an enhanced degree of distinctiveness.

Conclusions on Link

75. Bearing in mind all of the above, I find that a link will be made in the mind of the consumers but only in relation to the same goods for which the consumers will be confused, namely cars and parts of cars. However, I find that no link will be made in relation to the other goods, namely *motor coaches; trucks; lorries; motor buses; forklift trucks.* This is because, as per the guidance given by the AP in *ROJA DOVE*, 'MINI' is a dictionary word with a meaning which is potentially descriptive for the goods at issue, and whilst the consumer is familiar with 'MINI' having been used as a trade mark by the opponent in relation to cars, the different nature of these goods is such that it will not bring the opponent's mark to mind and the element 'MINI' in the application is more likely to be perceived as descriptive in the context of these goods (as opposed to having trade mark significance).

76. Accordingly, I find that in relation to the goods for which link is made out, damage in the form of unfair advantage will follow and the opposition succeeds.

77. For the other goods, I find that even if a link will be made it will be so fleeting as not to cause any damage.

OUTCOME

78. The opposition has been partially successful. The applicant's mark is refused in relation to the following goods which will not be registered:

> **Class 12:** *Automobiles; motor cars; cars; automobile bodies; automobile chassis; motors, electric, for land vehicles; brake pads for automobiles; driverless cars [autonomous cars]; self-driving cars.*

79. However, the opposition has been unsuccessful in relation to the following goods for which the mark can proceed to registration:

> **Class 12:** *motor coaches; trucks; lorries; motor buses; forklift trucks.*

COSTS

80. As both parties have achieved a measure of success, I order that each party bear their own costs.

81. For the sake of completeness, I should mention that at the hearing Mr Harbottle made a request for costs off the scale on behalf of the opponent based on the allegation that it was unreasonable for the applicant to put the opponent to proof of use or reputation given that "*one only has to walk the streets of any city to see Mini is being used on a daily basis and on those circumstances, to put [his] client to the cost of going to a huge amount of trouble finding out how many sales there have been and how it has been promoted was unreasonable"*. Nevertheless, Mr Harbottle accepted that the applicant was entitled to do that, but said that *"the question is whether they reasonably exercised that entitlement*" and in his submission they did not.

82. As I have explained at the hearing, I am not persuaded by Mr Harbottle's argument. This is because, if I were to apply Mr Harbottle's approach, all of the big players in the market would be exonerated from proving a substantial part of their case. Further, the TMA does not contain any exception to the rules governing proof of use and reputation (insofar as any claimant must prove their case) and I have not been provided with any case-law supporting a different conclusion. Accordingly, I reject the opponent's request.

Dated this 11th day of May 2026

TERESA PINTO
For the Registrar