

## **TRADE MARKS ACT 1994**

**IN THE MATTER of Application No 2121001  
by Dakar Cars Limited**

**and**

**IN THE MATTER of Opposition thereto under No 49860  
by Societe TSO.**

### **Background**

1. On 16 January 1997, Dakar Cars Limited applied under the Trade Marks Act 1994 to register a series of trade marks. The application was amended and proceeded for the trade mark **DAKAR 4x4** for a specification of goods which following amendment reads:

Class 12:

Four wheel drive vehicles for sale in kit form for self-assembly: parts and fittings for all the aforesaid goods.

2. The application was accepted and allowed to proceed to publication on the basis of distinctiveness acquired through use and honest concurrent use with application number 2027442 for the trade mark DAKAR (stylised) and device shown below. On 7 June 1999 Societe TSO, the applicants for this mark, filed notice of opposition on Form TM7 together with the appropriate fee.



3. The statement of grounds accompanying the notice of opposition set out numerous grounds of opposition these can be summarised as follows:

- (a) under section 3(6) of the Trade Marks Act 1994 in that the application was made in bad faith;
- (b) under section 5 of the Act in that the mark the subject of the application is similar to the opponents' earlier application for a trade mark and is to be registered for goods which are similar or identical to those for which the

opponents' earlier trade mark seeks protection;

- (c) under section 5 of the Act in that the opponents have used the trade mark to such an extent that the mark has a reputation in the United Kingdom and use of the trade mark the subject of the application would take unfair advantage of or be detrimental to the distinctive character of the earlier mark;
- (d) under section 5 of the Act, having regard to the opponents' use of the mark DAKAR, use of the trade mark the subject of the application is liable to be prevented by the law of passing off; and
- (e) under section 5 of the Act in that the trade mark DAKAR is a famous trade mark under the Paris Convention.

4. The applicants filed a counterstatement denying the grounds of opposition. Evidence was filed by the opponents. The applicants were set a period of time within which to file evidence. The period was extended but no evidence was filed. The matter came to be heard before me on 30 April 2002. During the early part of the proceedings the applicants had been represented by fJ Cleveland, however, on 31 July 2001, Dakar Cars Limited informed the Office that they would be acting as address for service. At the hearing, the applicants were represented by Mr Chantler, their Managing Director. The opponents were represented by Mr Robson of Reddie & Grose.

5. In addition to this opposition between the parties, the opponents in this case, TSO, are the applicants for the trade mark DAKAR (stylised) and device number 2027441A. This application is opposed by Dakar Cars Limited in opposition proceedings 47959. Both proceedings came to a hearing before me on the same day and opposition proceedings 47959 are the subject of a decision of even date. In reaching a decision on the opposition in suit I have taken into account my findings in respect of opposition 47959.

## **Evidence**

### Opponents' Evidence

6. This consists of two statutory declarations. The first, dated 27 July 2000, is by Alain Krzentowski, President of Societe TSO, the applicants.

7. Mr Krzentowski states that his company is the organiser of the Paris Dakar Rally which has been held every year since 1978 and has been accompanied by worldwide publicity. Competitors from many countries participate in the rally which is very strenuous for both vehicles and competitors. He goes on to say that his company has used the mark DAKAR on a wide range of merchandising and products associated with the Paris Dakar Rally and accordingly applied to register the trade mark DAKAR and device in the United Kingdom. He notes that registration of the mark DAKAR and device has been obtained in the United Kingdom in classes 4, 9, 25, 28 and 41 and the mark is under opposition in so far as it covers goods in class 12.

8. He states that the mark has been publicised in connection with the Paris Dakar Rally on a worldwide scale and registrations have been obtained worldwide. At AK1 he exhibits a schedule of the registrations owned by his company. He notes that these registrations include registrations in class 12. At AK2 he exhibits a selection of press releases for the Paris Dakar Rally showing use of the mark. Included in this exhibit is a sheet showing worldwide media coverage in November 1997 and he states that the rally is televised in a very wide number of countries. He states that his has risen from 49 networks in 105 countries in 1995 to 76 networks covering a total of 160 countries in 1997.

9. At exhibit AK3, Mr Krzentowski exhibits details of the TV broadcasting throughout the world of the Paris Dakar Rally in 1994, 1995, 1996, 1997 and 1998. The schedules include the time for which details were broadcast in each country. He notes that it includes channel Eurosport which has been available in the United Kingdom since at least 1994, a table showing the ratings for Eurosport in the United Kingdom for 1998 is produced and shown marked exhibit AK4.

10. At AK5, he exhibits a selection of articles concerning the Paris Dakar Rally extracted from English publications and magazines. Details of merchandising under the trade mark DAKAR are shown in this company's merchandising catalogue "La Boutique Dakar". Catalogues for the years 1995 - 1997, are exhibited at AK6 along with details of sales of merchandising during the year 2000 in French Francs. The catalogues are in French but the details of sales figures do show sales to the United Kingdom. At AK7 he exhibits a printout from his company's website, also in French, which was created on 7 November 1995 and which he states also shows use of the mark DAKAR and device. Mr Krzentowski concludes by stating that the name DAKAR has become associated with his company and members of the public seeing the mark DAKAR will automatically associate it with the Paris Dakar Rally and hence his company.

11. The second declaration is by Mr Graham Robinson and is dated 11 September 2000. Mr Robinson is a private investigator working for a company called Farncombe International Limited. He states that he regularly undertakes investigations into the usage of trade marks and the companies using those trade marks.

12. Mr Robinson states that in July 2000 he was instructed by Reddie & Grose to conduct a trade mark usage search into a company called, Dakar Cars Limited. He states that he duly compiled a report on his investigations and a copy is exhibited at GR1. The report is very comprehensive. It confirms that Dakar Cars Limited has been in operation since 1991. It is a small business whose activities are the manufacture and supply of kits for the conversion of Range Rovers into "Dakar 4x4's" and the supply of spare parts for and servicing of Range Rovers. The report states at paragraph 3.3:

"The kit cars manufactured by Dakar Cars Limited are well-known by motoring enthusiasts. The Dakar 4x4 has its own UK enthusiast club called DODO (Dakar Owner and Drivers Organisation), which also produces merchandise bearing the Dakar name and logo. The Dakar 4x4 has been featured in several car magazines since its launch in 1991, and the cars often appear at UK kit car trade fairs and events. In addition, the car has been exported to France, Switzerland and the Middle East, and

the company has an agent in Holland.”

13. The applicants did not file any evidence in support of their application so that completes my summary of the evidence in these proceedings. I should mention that at the hearing, Mr Robson sought to refer to a disclaimer which he said was now shown on the applicants’ website. Mr Chantler sought to refer to a computer game which he said was sanctioned by the opponents and which he claimed infringed his trade mark. Neither point was in evidence before me and I declined to take submissions on them or take them into account.

## Decision

14. At the start of the hearing, I asked Mr Robson whether he intended to pursue all the grounds of opposition. He stated that he was under instructions to maintain all the grounds of opposition, however, he accepted that in respect of some of the pleaded grounds he faced some difficulty. The grounds of opposition refer to sections 5 and 3(6) of the Trade Marks Act 1994. The relevant provisions read as follows:

“3.-(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

“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.

(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, or
- (b) .....

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

15. Section 6 of the Act is also relevant, it reads:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

16. I will consider each ground in turn.

Section 5(2)(b)

17. In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all

relevant factors; *Sabel BV v. Puma AG* page 224;

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly 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; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

18. Under section 5(2), the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind I proceed to consider the opponents' case under section 5(2)(b).

#### The earlier trade mark

19. The trade marks on which the opponents seek to rely, are application number 2027442A

and registration 2027442B. Although the former is an application, it is, subject to it being registered, an earlier trade mark within the definition of section 6 of the Act. For the purposes of section 5(2)(b) it was common ground that the opponents' application number 2027442A represented their best case. For ease of reference I reproduce the applicants' and opponents' trade marks below:

Applicants' trade mark

Opponents' trade mark

**DAKAR 4 x 4**



Class 12:

Four wheel drive vehicles for sale in kit form for self-assembly; parts and fittings for all the aforesaid goods.

Class 12:

Vehicles, but not including automobiles or any goods similar to automobiles; motorbikes; bicycles; parts and fittings for all the aforesaid goods.

20. The specification for the opponents' application set out above, takes into account the effect of my decision in the opposition to that application by the applicants in this case. To the extent that my decision may be appealed and found to be wrong, I will also go on and consider the opponents' specification as filed, that reads:

Class 12

Vehicles; automobiles; motorbikes; bicycles; parts and fittings for all the aforesaid goods.

#### Reputation/Inherent distinctiveness of the earlier trade mark

21. The opponents' earlier trade mark is made up of the word DAKAR in a stylised script together with the device of a headdress. It seems to me to have a degree of inherent distinctive character. The case law set out above, indicates that there is a greater likelihood of confusion where the mark is highly distinctive per se or because of the use that has been made of it. As such, the distinctiveness of the opponents' mark becomes one of the factors to take into account when reaching a decision under this section of the Act.

22. Mr Robson also argued that the opponents' trade mark had been used extensively and so benefited from an enhanced reputation. I pointed out to Mr Robson that the opponents had not shown any use of the trade mark on any goods falling within class 12. Mr Robson accepted this but referred to the use shown in respect of the Paris Dakar Rally and also the use on merchandising such as clothing. These along with other goods and services are

covered by the opponents' trade mark 2027442B. Leaving aside the question of whether such services and goods would be considered similar to the goods in question in class 12, Mr Robson in my view faces a more fundamental problem. The opponents filed evidence to support their claim to use of their trade mark and to support a number of their grounds of opposition. Can that use assist them in claiming an enhanced level of recognition for their mark? Does the evidence show use of the opponents' trade mark?

23. It is important to remember that the relevant date in these proceedings is the date of application, 16 January 1997. The opponents filed various exhibits to support their claim to use of the mark. Exhibit AK2 relates to press releases and media coverage. Apart from an editorial dated December 1996 concerning the 1997 rally, these are all after the relevant date. Exhibit AK3 sets out television coverage for 1994, 1995 and 1996. The information is in French, but appears to show coverage on Eurosport. I do not know whether the coverage included use of the opponents' trade mark, nor do I know the extent to which the programmes were shown in the UK. Exhibit AK4 which shows the ratings of Eurosport in the UK is for 1998, after the relevant date.

24. Exhibit AK5 consists of press articles reviewing the Paris Dakar rally. It should be noted that these fall into two groups. There is a more recent group of cuttings, the earliest of which is December 1997. Some of these do show the opponents' trade mark DAKAR (stylised) and device, but they are all well after the relevant date in these proceedings. The others date from March 1980 and March 1981; two articles in AUTOCAR recount the journey in the Paris Dakar event, and an extract from the "Kent & Sussex Courier" of 3 January 1986 is about two local enthusiasts taking part in the Paris Dakar rally. Although all three are before the relevant date, none show use of the opponents' trade mark.

25. Exhibit AK6 consists of merchandising catalogues for 1995, 1996, and 1997. Whilst they show use of the mark on a range of merchandise, they are entirely in French. I do not know how many, if any, were circulated in the United Kingdom. I have sales figures for 1.11.99 to May 2000, well after the relevant date and some 6 invoices for products to addresses in the United Kingdom prior to the relevant date. I am also informed that the opponents have a website which has been active since November 1995. The example shown in the evidence is again entirely in French. There is no indication as to how the site appeared in 1995 or how many visitors it has received from the United Kingdom.

26. Mr Robson argued that the Paris Dakar rally was so famous that as in *Imperial Tobacco v. Berry Bros & Rudd (Cutty Sark Trade Mark)* (unreported 31 October 2001), I could, given its fame and reputation coupled with use abroad, assume spill over into the United Kingdom. Whilst the fact that there is rally, which takes place between Paris and Dakar may be well-known, that does not mean that the mark the opponents seek to rely on has an enhanced reputation. Therefore, I conclude that, having regard to the evidence before me, I cannot find that the opponents' trade mark enjoyed an enhanced level of recognition at the relevant date.

#### Comparison of the Trade Marks

27. I will now consider the visual, aural and conceptual similarities between the trade marks by reference to the overall impression created by the marks but taking into account their

distinctive and dominant components. In making a comparison of the marks I must also take into account the fact that the average consumer rarely has an opportunity to make a direct comparison between the trade marks; so called imperfect recollection. However, balanced against that is the fact that the question must be assessed through the eyes of the average consumer for the goods in question. It seems to me that in relation to goods covered by both the applicants' and opponents' specifications, the average consumer will take some time and care in making their selection. Goods falling within the term vehicles, as covered by the applicants' and opponents' specifications, motorbikes and bicycles are all relatively expensive purchases and the consumer is likely to take more care and attention when purchasing such goods; *Lancer Trade Mark* [1987] R.P.C. 303.

28. Visually, the opponents' earlier trade mark is DAKAR (stylised) and device. It seems to me that whilst the device of the headdress appeals to the eye, the way in which the word DAKAR is presented, also appeals to the eye and is, visually, a prominent element of the mark. The applicants' mark is DAKAR 4x4. As such, there is a high degree of visual similarity between the marks.

29. In oral use, the opponents' trade mark is the word DAKAR, the applicants' DAKAR 4x4. Given the descriptive nature of the element 4x4 in relation to the goods, the marks have a very high degree of aural similarity. Conceptually, the headdress and DAKAR elements of the opponents' trade mark bring to mind arab/African influences and the city DAKAR. The applicants' trade mark also uses the same element DAKAR. As such, there is a high degree of conceptual similarity between the trade marks.

30. To conclude, I find, that visually and conceptually, there is a high degree of similarity between the opponents' and applicants' marks. There is a very high degree of aural similarity.

#### Similarity of the Goods

31. Whilst I have found a very high degree of aural and a high degree of visual and conceptual similarity between the marks, for a finding under section 5(2)(b), I must find that there is some similarity between the goods for which the opponents' trade mark is to be registered and the goods for which the applicants seek protection. In particular in *Canon* at paragraph 22 the court stated:

“22. It is however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

32. Mr Hobbs Q.C., sitting as the Appointed Person in *Raleigh International* [2001] R.P.C. 11 has stated:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between

marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.”

33. The applicants’ trade mark covers a very narrow range of goods, “Four wheel drive vehicles for sale in kit form for self-assembly....”. From the opponents’ evidence, it is clear that these are the goods the applicants trade in. The opponents’ application, as amended, covers motorbikes and bicycles and also ‘vehicles but not including automobiles or goods similar to automobiles’. It seems to me that even with the limitation on vehicles which would exclude any goods similar to automobiles and would therefore take it outside the provisions of section 5(2)(b), the remaining goods for example motorbikes would cover goods where there would be a degree of similarity. Both are used as a means of road transport and the users could be the same, although physically a car and motorbike are different. Further, although there is no evidence on this point, I know from my own experience that the trade channels for motorbikes and cars are different and the two are not competitive.

34. Therefore, I conclude that in so far as the opponents’ application covers motorbikes, there is some, albeit a low, degree of similarity between the goods in question. Clearly, if my decision of today’s date in opposition proceedings 47959 against the opponents’ trade mark application is shown to be wrong then the opponents’ application as filed, covers goods identical to those for which the applicants seek protection.

#### Conclusions under section 5(2)(b)

35. Together with my finding in relation to the inherent distinctiveness of the opponents’ mark, how do my findings in respect of the similarities of the marks and the similarities of the goods come together under section 5(2)(b)?

36. Mr Hobbs, Q.C., sitting as the Appointed Person *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows:

Are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the “earlier trade mark”, DAKAR (stylised) and device and the sign subsequently presented for registration, DAKAR 4x4, were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?

37. If my decision in opposition proceedings 47959 is correct, then, having considered the various factors, I reach the view that this question must be answered in the negative. In so finding, I have taken account of the distinctiveness of the opponents’ trade mark, the high degree of similarity between the two marks and that a lesser degree of similarity between the goods can be offset by a greater degree of similarity between the marks.

38. Taking into account my finding that the relevant consumer here will be more careful and circumspect, and that such purchases would be made after careful inspection and thought, it seems to me that this, coupled with the low degree of similarity between the goods is sufficient to offset the other factors listed above. **There is in my view no likelihood of confusion and the opposition under section 5(2)(b) is dismissed.**

39. If my decision in opposition proceedings 47959 is found to be wrong, then it seems to me that given the factors listed above, the high degree of similarity between the marks and the fact that the opponents' trade mark would cover identical goods, would lead inevitably, to a finding of likelihood of confusion even taking into account the nature of the consumer in question. However, that is not an end to the matter, as the application was allowed to proceed to registration on the basis of honest concurrent use. Can that assist the applicant?

#### Honest Concurrent Use

40. The provisions relating to 'honest concurrent use' are set out in section 7 of the Act. Where, as here, the owner of the earlier right opposes the application, the provisions of section 7 have no part to play in the opposition proceedings; section 7(2). However, where two marks can be shown to have co-existed in the market place, such parallel use may be one factor in the global appreciation under section 5(2); see *Codas* (SRIS 0/372/00). However, it seems to me that this cannot assist the applicants here. Firstly, the applicants in these opposition proceedings filed no evidence. In the parallel opposition proceedings I set out the evidence that was filed in support of their opposition to the opponents' trade mark. However, none of that evidence, or the evidence that was filed before the registrar at the examination stage, to support the applicants' claim to honest concurrent use, was filed in these proceedings. As such, I have no evidence from the applicants showing use of their mark. In an unusual twist, the opponents filed their private investigators report into the applicants' use. This sets out in some detail, the use and history of use of the applicants' trade mark from 1991.

41. However, even taking account of the opponents' evidence showing use of the applicants' mark, I have a further difficulty. It is accepted that the opponents have not used the trade mark in question. As such, whilst the applicants have used the mark, there is no evidence of parallel use of the applicants' and opponents' trade marks which I could take into account when considering the question of the likelihood of confusion. Therefore, if my conclusion on the other opposition proceedings are wrong then the applicants' use cannot assist them and the opposition would be successful under this section.

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

42. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a

result of the erroneous belief engendered by the applicants' misrepresentation.

### Goodwill and Reputation

43. The onus is on the opponents to show that this ground of opposition is made out. Under section 5(2)(b) I declined, on the basis of the evidence before me, to find that the opponents' mark DAKAR (stylised) and device enjoyed a reputation in the United Kingdom. The opponents seek to rely on their reputation and goodwill in the mark DAKAR, however, it seems to me the same criticisms of the opponents' evidence apply here. There is no evidence of use of the trade mark DAKAR on identical goods or other goods that would fall in Class 12. As for the claim to a goodwill and reputation in the mark for merchandise and as organisers of the Paris Dakar Rally, for the reasons set out above there seems to me to be insufficient evidence to base a claim to a goodwill and reputation in the mark for those goods or services. There is little if any evidence of use of the mark DAKAR in the United Kingdom prior to the relevant date. Absent such evidence, I cannot in my view find the necessary goodwill and reputation. **The opponents' ground of opposition under section 5(4)(a) fails at the first hurdle and is dismissed.**

### Section 5(3)

44. For an opponent to succeed under this head of opposition, they must first show that their earlier trade mark has a reputation in the United Kingdom, or in the case of a Community Registration, in the European Community. The opponents' opposition is based on their registration 2027442, this mark was divided and I have assumed that the opponents wish to rely on both 2027442A and 2027442B.

45. Again, for the reasons set out in my consideration of section 5(2)(b) and 5(4)(a), it seems to me that the opponents' ground under section 5(3) falls at the first hurdle. They have failed to show that their earlier trade mark has a reputation in the United Kingdom. **This ground of opposition is dismissed.**

### Section 3(6) Bad Faith

46. The opponents' statement of grounds makes the bald assertion that the mark, "was applied for in bad faith". It does not particularise the claim in any way or explain how the application is said to have been made in bad faith. It has been stated many times that bad faith is a serious allegation and one that must be properly pleaded and proved. I see nothing in the actions of the applicants in applying for a mark which, on the opponents' own evidence, they have been using since 1991 that could be considered bad faith. **This ground is dismissed.**

### Well-Known Trade Mark

47. The opponents also claim that their trade mark **DAKAR** is entitled to protection as a well-known trade mark under the Paris Convention. As set out in section 6(1)(c), the term "earlier trade mark" in section 5 includes a trade mark which at the date of application was entitled to protection under the Paris Convention or WTO agreement. Section 56 of the Act

provides:

“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.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.”

48. Article 6bis of the Paris Convention is also relevant, this reads:

“(1) The countries of the Union undertake, either administratively if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration and to prohibit use of a trade mark which constitutes a reproduction, imitation or 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 the present Convention and used for identical or similar goods.....”

49. It seems to me clear from these provisions that there are a number of requirements before an opponent can seek to rely on the provisions of the Paris Convention. Applying those requirements to the facts in this case, I note there is a requirement for identical or similar goods. This provision is mirrored in so far as it concerns injunctions, in section 56(2) of the Act. Regardless of whether the mark DAKAR could be considered to be a “well-known trade mark” within the meaning of Article 6bis, the opponents have failed, in my view, to show that their mark is well-known for goods or services identical or similar to “Four wheel drive vehicles for sale in kit form for self-assembly: parts and fittings for all the aforesaid goods”.

**As such, I dismiss this ground of opposition.**

### Consequences of Decision

50. All the opponents' grounds of opposition have been dismissed. The application will be allowed to proceed to registration.

### Costs

51. The applicants have succeeded and are entitled to a contribution towards their costs. I order that the opponents pay the applicants the sum of £550-00. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 14<sup>TH</sup> day of August 2002**

**S P Rowan  
For the Registrar  
the Comptroller General**