

## **TRADE MARKS ACT 1994**

**IN THE MATTER of Application No 2027442A**

**by Societe TSO (Societe anonyme organisee sous les lois Francaises).**

**and**

**IN THE MATTER of Opposition thereto under No 47959**

**by Dakar Cars Limited**

### **Background**

1. On 18 July 1995, Societe TSO (societe anonyme organisee sous les lois francaises), applied under the Trade Marks Act 1994 to register the trade mark shown below for a specification of goods and services which reads:

Class 04:

Industrial oils and greases; motor oils; fuels; petrol; diesel.

Class 09:

Spectacles; spectacle frames; spectacle lenses; parts and fittings for all the aforesaid goods.

Class 12:

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

Class 25:

Clothing, footwear, headgear.

Class 28:

Toys, games and playthings.

Class 41:

Education; training; entertainment; sporting and cultural activities; editing of books and magazines; lending of books; training of animals; production of shows and films; artist agencies; hire of films, photographic recordings, cinematographic apparatus and theatre set accessories; organisation of competitions for education or amusement; organising and conducting seminars, conferences and congresses; organisation of sporting competitions.



2. On 23 December 1997, Dakar Cars Limited filed notice of opposition on Form TM7 together with the appropriate fee. The statement of case accompanying the notice of opposition set out various grounds on which the application was said to be opposed. The grounds covered sections 3 and 5(4) of the Trade Marks Act 1994. At the hearing, the only grounds of opposition that were pursued can be summarised as follows:

- (a) under section 5(4)(a) of the Trade Marks Act 1994 in that the opponents, for several years preceding the date of filing of the opposed mark, marketed and sold motor vehicles and parts and fittings therefor and offered services relating to those goods under the unregistered trade mark DAKAR. That such use has established a goodwill and reputation in the mark DAKAR for these goods and services and that as such registration of the mark in suit would be contrary to the law of passing off; and
- (b) under section 3(1)(c) in that the mark consists exclusively of signs or indications which may serve in trade to designate the geographical origin of the goods in question.

3. The applicants filed a counterstatement denying the grounds of opposition. During the course of the opposition proceedings, the applicants applied to divide the trade mark. The opponents withdrew their opposition to the goods in classes 4, 9, 25, 28 and 41. They maintained their opposition to the goods falling in class 12 and the specification of the divided trade mark, number 2027442A, under opposition reads:

Class 12

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

4. Evidence was filed by both parties and the matter came to be heard before me on 30 April 2002. Throughout the proceedings, the opponents had been represented by fJ Cleveland, however, at the hearing, they were represented by Mr Chantler, their Managing Director. The applicants were represented by Mr Robson of Reddie & Grose.

5. In addition to this opposition between the parties, the opponents in this case, Dakar Cars Limited, are the applicants for the trade mark DAKAR 4x4 number 2121001. This application is opposed by TSO in opposition proceedings 49860. Both proceedings came to a hearing before me on the same day and opposition proceedings 49860 are the subject of a decision of even date.

## Evidence

### Opponents' Evidence

6. This consists of a statutory declaration dated 6 March 2000 by Mr Barry Chantler, Managing Director of Dakar Cars Limited. Mr Chantler has held this position since 1991, when he founded the company.

7. Mr Chantler states that in addition to being the company name, DAKAR is used in relation to:

- components of motor vehicles for sale as kits;
- general motor vehicle repairs and servicing; and
- the sale of second hand vehicles and motor vehicle parts and fittings originating from third parties by virtue of the use of the word DAKAR on the garage forecourt.

8. Mr Chantler says that his company has used the word DAKAR in a number of forms. For example, he states that DAKAR 4x4 is used in relation to the assembled vehicles and kit cars manufactured and sold by his company. The different derivatives all have the word DAKAR as their central element.

9. Mr Chantler states that his company has manufactured vehicles for sale in component form or ready assembled under the trade mark DAKAR 4x4 since 1991. He states that the vehicle is a four wheel drive off road vehicle based upon the mechanical components of the well known Range Rover vehicle. His company produces this model in a conversion kit allowing a purchaser to home-build it from a suitable donor Range Rover vehicle. In addition, his company manufactures and sells substantially assembled vehicles changing the precise design specification accordingly to each customer's needs.

10. Mr Chantler states that for both the assembled and conversion kits, the trade mark DAKAR 4x4 is applied to the body shell of the vehicle in a number of places. He refers to exhibits BC1 and BC2, which show:

- BC1 is a copy of a review article published in the September 1991 issue of "Which Kit?" magazine. On page 42 there are photographs of the vehicle, the word DAKAR 4x4 is shown on the front bonnet lip, the side of the vehicle and above the rear right hand light cluster. Mr Chantler states that the trade mark has been applied identically or similarly to all vehicles and kits sold up to the present time. He states that the trade mark is central to the image and marketing of the vehicle.
- BC2 is a copy of an article reviewing the DAKAR 4x4 published in "Car Builder" May 1991 issue. On page 52 there is a photograph of the vehicle. In the photograph, the wording DAKAR 4x4 can be seen on the bonnet and side of the vehicle.

11. Mr Chantler states that the fields of 4x4 vehicles and kit cars are very specialist and keen interest develops in the products available amongst the relevant general public and that to many, it is considered a very serious hobby or pastime. As a result, there are specialist magazines dedicate to this particular readership. He states that the DAKAR 4x4 has been

featured in several nationally distributed magazines specialising in the kit car and off-road vehicle market. He refers to the articles exhibited at BC1 and 2 referred to above. In addition, he mentions exhibit BC3 which is an article from "Which Kit?", February 1995, reviewing the DAKAR 4x4. At BC4, he exhibits Willings Press Guide Volume I 1997 which states that "Which Kit?", has a circulation of 25,000. As a result, Mr Chantler submits that DAKAR 4x4 is particularly well known amongst members of the trade and public concerned with off-road vehicles, home build vehicles and kit cars in general.

12. In particular, Mr Chantler draws attention to "Which Kit?" February 1995. This shows on the front cover, a picture of the DAKAR 4x4 and the headline "KING OF THE HILL - Taking a Dakar to the Limit". He states that the front cover will have been on display in newsagents for around one month and that, as a result, a significant number of browsers and purchasers of other magazines, in addition to those buying the magazine concerned, will have become aware of the DAKAR trade mark and its use in relation to the DAKAR 4x4 motor vehicle.

13. Mr Chantler says that further publicity was given to the DAKAR 4x4 when the television company Menton films bought from Dakar Cars, a complete DAKAR 4x4. This vehicle subsequently starred in the 1992, 1993 and 1994 series of the television programme, "Challenge Anneka". It acted as the personal transport of the television presenter Anneka Rice during her various challenges. Mr Chantler states that in addition to this publicity, the company has spent money on advertising and promotion. Figures for 1992 - 1998 are given. They start at around £3,500 and rise to approximately £10,000 in 1997 and 1998. In addition, Mr Chantler states that each year they have attended at least eight exhibitions and used magazine advertisements, brochures and leaflets.

14. It is stated that the company has attended the following exhibitions: The European Kit Car Show at Chatham in Kent; The National Kit Car Motor Show at Stoneleigh in Warwickshire; The Alternative Kit Car Show at Newark; The London Kit Show at Sandown Park; The London Kit Show at Kempton Park; the Great Western Kit and Sports Car Show at Exeter in Devon; The National Kit and Performance Car Show at Donnington in Derbyshire; The Land Rover International Show at Billing in Northamptonshire; The Kit Car and Replican Show at Autotron Rosmalon in Holland; the 4x4 Show at Autotron Rosmalon in Holland; The Royal Show at Stoneleigh in Warwickshire; The Town and Country Show at Stoneleigh in Warwickshire; The London Motor Show at Earls Court in London; The Dubai Motor Show in United Arab Emirates.

15. Mr Chantler states that the following sales of vehicles and vehicle kits to which the DAKAR trade mark has been applied, have been made:

Year	Number of kits/vehicles	Turnover (gross) to nearest £1000
1992	4	18,000
1993	9	22,000
1994	12	38,000
1995	16	50,000
1996	19	65,000
1997	18	58,000
1998	19	66,000

16. Mr Chantler gives figures for turnover and sales of second hand vehicles and spare parts under the trade mark DAKAR. I will not summarise these here. Mr Chantler concludes by stating that in 1994 his company became affiliated to the Association of Specialist Car Manufactures (ASCM) which is a nationwide collective body for exchange of knowledge and improvement of standards in the specialist car and kit-car industry. He regularly attends their meetings and seminars which are well attended by the members of the kit-car and specialist vehicle industry. As the representative of his company at these meetings, he has discussed the DAKAR 4x4 product with a significant number of people in the trade.

#### Applicants' Evidence

17. This consists of a statutory declaration dated 27 July 2000 by Alain Krzentowski, President of Societe TSO, the applicants.

18. 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.

19. 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. 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.

20. 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.

21. 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.

22. The opponents did not file any evidence in reply and so that completes my summary of the evidence in these proceedings.

## Decision

23. The grounds of opposition refer to sections 3(1)(c) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

“3.-(1) The following shall not be registered -

- (a) .....
- (b) .....
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) .....

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

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

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) .....

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.”

24. As noted in the introduction to this decision, the statement of grounds as originally filed, contained various grounds of opposition. At the start of the hearing, Mr Chantler stated that, having looked at the sections of the Act concerned, he did not wish to pursue the grounds of objection under section 3(1)(b) (that the mark is devoid of any distinctive character) or under section 3(6), (that the application was filed in bad faith). In his view, neither section applied to the facts of this case. I agree and should state that it was both sensible and helpful for Mr Chantler to adopt this approach. Further, during the course of his submissions, Mr Chantler referred to the ground of opposition pleaded under section 32(3), that the applicants lacked any intention to use the trade mark on the goods in question. I believe that Mr Chantler’s initial view was that the applicants could not intend to use the mark themselves on the goods

in question, vehicles etc, as they were not in the motor or vehicle trade. I took Mr Chantler to the wording of section 32(3) which reads:

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

25. This implies that to satisfy the requirements of section 32(3), the use of, or *bona fide* intention to use, the mark need not be by the applicant himself but can be use with the applicant’s consent. Having considered the matter further, Mr Chantler decided that the evidence did not show such a lack of intention on the part of the applicant and so withdrew this ground of opposition. Again, on the facts, I think that he was right to do so. Therefore, I will go on to consider the two remaining grounds of opposition.

#### Section 3(1)(c)

26. Applying the provisions of this section to the mark in suite, it prevents registration of trade marks which **consist exclusively of signs or indications which may serve in trade to designate the geographical origin of the goods**. Recent guidance on the interpretation of Article 7(1)(c) of the Regulation (the equivalent of section 3(1)(c) of the Trade Marks Act 1994) has been given by the European Court of Justice in *Procter & Gamble v. OHIM (BABY-DRY)* Case C-383/99P.

27. In *BABY-DRY*, the findings of the Court are set out in paragraph 35 et seq of the judgment. The ECJ stated that the provisions in Article 7(1) of the Regulation (section 3 of the Trade Marks Act 1994) and those in Article 12 (section 11 of the Trade Marks Act 1994), taken together prevent registration as trade marks, signs which are no different from the usual way of designating the relevant goods or services or their characteristics; paragraph 37. Thus, the ECJ concluded that the provision of Article 7(1)(c), (section 3(1)(c)) excluded signs which may serve in normal usage from a consumer’s point of view to designate an essential characteristic of the goods or services concerned. Registration should not be refused unless it comprises no other sign or indication; paragraph 39.

28. Further, the Court found that in relation to trade marks composed of words, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form; paragraph 40.

29. In considering whether a mark consists exclusively of matter covered by the provisions of section 3(1)(c), the ECJ indicated that any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumer to designate the goods or services or their essential characteristic is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark; paragraph 40.

30. Dakar is the capital and chief port of Senegal, however, it seems to me that I need not consider whether the mark DAKAR (on its own) should be refused registration under section 3(1)(c) as a sign which may serve in trade to designate the geographical origin of the goods. The applicants’ mark consists of the word DAKAR in a stylised script together with a device

of a headdress. It seems to me that on any view, the applicants' trade mark cannot be said to consist **exclusively** of words or signs which may serve in trade to designate the geographical origin of the goods. **As such, I find that the opponents have not made out their ground of objection under section 3(1)(c) and this ground of opposition is dismissed.**

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

33. 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.

34. Assuming notional and fair use, I must assess whether use of the applicants' mark, DAKAR (stylised) and device, was as at the date of application, liable to be prevented by the law of passing off. The onus is on the opponents to show that their ground of opposition is made out.

#### Goodwill and Reputation

35. The first requirement set out above, is that the opponents' goods or services have acquired a goodwill or reputation. During the hearing, Mr Chantler suggested that there were various articles in magazines and features on television programmes concerning his company's DAKAR 4x4 vehicle that supported his claim to a goodwill and reputation in the name. I explained to Mr Chantler that I could only base my decision on the evidence that had been filed in the proceedings. I must determine, on the basis of that evidence whether the opponents have shown the necessary goodwill and reputation. Mr Chantler accepted this and confined his submissions to the evidence that was before me. Mr Chantler was further hampered by the fact that he was unfamiliar with the evidence that had been filed by the applicants. Nevertheless, he made submissions to me based on his own evidence and also made comments in reply to the applicants' submissions.

36. The issue of evidence before the registrar in proceedings under section 5(4)(a) has recently been the subject of comment in an appeal to the High Court. Mr Justice Pumfrey in *South Cone Inc v. Jack Bessant and others (t/a Reef)* [2002] R.P.C. 19 stated:

“12.....As Mr Hobbs QC said in *Wild Child TM* [1998] R.P.C. 455, the registrar is often required to act upon evidence that might be regarded as less than perfect when

judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?

13. There is one major problem in assessing a passing off claim on paper, as will normally happen in the registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *Bali* [1969] RPC 472. Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

14. Evidence of reputation comes primarily from the trade and the public and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.....”

37. Mr Robson's primary submission was that the opponents' evidence was insufficient for me to find the necessary goodwill and reputation. He pointed out the very low level of turnover prior to the relevant date of 16 January 1997. The evidence shows that between 1992 and 1994, some 25 kits or vehicles bearing the DAKAR 4x4 trade mark had been sold. In his submission, this represented a very low level of turnover even in the specialised field of kit cars. To counter that submission, Mr Chantler asserted that this was a high turnover and that his company was a relatively large producer of kit cars. Neither party filed evidence showing the relative size of the kit car market and so I can give no weight to either of the submissions made to me. On the evidence before me, I have no way of knowing the market share these figures represent.

38. What I do know is that the opponents' business was established in 1991 and that since at least 1992, they have provided figures showing a small but steady growth in the number of sales of vehicles and kits each year. They have attended a number of exhibitions, each year, these include specialised Kit Car shows and more general shows such as the London Motor Show and The Royal Show at Stoneleigh in Warwickshire. In addition, the opponents' in their evidence also exhibit press articles reviewing their DAKAR 4x4.

39. The first is a four page article in "Which Kit?" September 1991; exhibit BC1. I am informed from the evidence that this magazine has an average circulation of some 25,000; exhibit BC4. The article appears in a section headed IMPRESSIONS. It opens with a page of four photographs of the opponents' vehicle. As noted in the summary, DAKAR 4x4 appears in clear lettering on the bonnet, sides and rear of the vehicle. The article is headed "Dakar 4x4 - Big Fun For Big Kids". The review is very favourable. The opening states: "Serious off-road performance combined with on-road sophistication is something that few kit cars can offer. Ian Stent has been having some fun in the industry's best effort yet". The review also makes the following comments:

- “... one of the most imaginatively designed cars the kit industry has ever witnessed.....”
- “Driving the Dakar is fun and just getting in brings a smile.”
- “Overall, then, I was impressed. But in all honesty there seemed no reason why the Dakar shouldn’t perform well considering that it really is a rebodging exercise on a proven and very capable car.”

40. It also makes favourable comments about the engine and drive of the vehicle. The article ends promising a further review as, “‘Which Kit?’ will soon be having its own, very distinctive, Dakar 4x4 to test and examine over a period of months rather than minutes”.

41. The second article is from “Car Builder”, May 1992; exhibit BC2. The article is headed, “Plastic Surgery the art of deception, Mud-plugging in the DAKAR 4x4”. The article is written by the same writer, Ian Stent, as the “Which Kit?” article. Again it is very favourable.

42. The third and final article is again from “Which Kit?” February 1995, and is again written by Ian Stent. The Dakar 4x4 features on the front cover of the magazine and the picture takes up the whole page with the words, “KING OF THE HILL Taking the Dakar to the Limit”. The article is headed “DAKAR Domination - in case you thought Dakar 4x4s were only any good at carrying around the likes of Anneka Rice as she skips from one challenge to the next, Ian Stent has been on a number of rather manic off-road excursions which set the Dakar rather more demanding challenges”. The article is some five pages in length.

43. The opponents claim that as a result of this use and exposure, they have a reputation certainly amongst kit car enthusiasts if not the general public. Mr Robson did not concede this point but if I did find that the evidence showed a reputation and goodwill then in his view such use should be discounted because it was not legitimate use. Mr Robson submitted that as his clients were responsible for the Paris Dakar Rally, use of the mark DAKAR 4x4 by Dakar Cars would be seen as a product endorsed by the applicants and so the goodwill and reputation would be associated with them and not with the opponents.

44. In my view, whilst the turnover of the opponents appears small, their consistent presence in what appears to be a fairly specialised market, together with their exposure in the relevant magazines, would have established and maintained a goodwill and reputation in the mark DAKAR 4x4 amongst kit car enthusiasts and those interested in off-road vehicles. It should also be noted that the DAKAR 4x4 carries that mark prominently on the front, side and rear of the vehicle. As such, exposure of the mark will not be limited to the small number of purchasers of the vehicle or those who read the specialist magazines, but will be seen by the general public as the vehicles are used on the public highway. The vehicle has a very unusual and distinctive appearance and would certainly draw attention to itself when used on the public highway. No one referred me to the figures showing sales of used cars, parts or servicing. I have no evidence as to how such goods or services have been sold or provided to the public and I cannot in my view find that the opponents have a reputation and goodwill in such goods or services.

45. If Mr Robson's secondary submission is correct then my finding of a goodwill and reputation does not assist Mr Chantler because the goodwill and reputation would have accrued to Mr Robson's clients and not to the opponents. On the facts of this case I do not find that to be so. It seems to me that the press coverage and the way in which the DAKAR 4x4 is marketed, no one would be in any doubt that the source of the product is Mr Chantler himself and Dakar Cars Limited. Mr Chantler is put forward as the man behind the idea and he and his company are put forward as being responsible for the design and thinking behind the vehicle. The praise concerning the vehicle is directed to the opponents and Mr Chantler as would any complaints concerning poor performance.

**46. To conclude on this point, I find on the basis of the evidence before me, that at the relevant date, the opponents enjoyed a goodwill and reputation in the trade mark DAKAR 4x4 for a four wheeled drive vehicle sold in kit form or ready assembled. That goodwill and reputation would have been predominantly amongst those interested in kit cars and off-roading enthusiasts but there would have been some goodwill and reputation amongst the general public.**

#### Misrepresentation

47. Mr Hobbs, in the *Wild Child* case mentioned above, referred to *Halsbury's Laws Of England*. The relevant passages taken from the 4<sup>th</sup> Edition 2000 reissue at paragraphs 316-320 read as follows:

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

(1) that a name, mark or other distinctive feature used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

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

The question whether deception or confusion is likely is one for the court which will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

48. The passage notes that whilst the first two elements appear to be two separate hurdles they are in fact inter-related. It seems to me that the question that I must answer is as follows:

Having regard to the goodwill and reputation found in the trade mark DAKAR 4x4 for a four wheeled drive vehicle sold in kit form or ready assembled, predominantly amongst those interested in kit cars and off-roading enthusiasts but also amongst the general public, will those persons mistakenly infer from the applicants’ use of the mark DAKAR (stylised) and device on the goods for which registration is sought, that they are provided by the opponents or are connected?

49. I must assume notional and fair use across the specification for which registration is sought. In answering that question I take into account the factors listed above.

53. What is the nature of the reputation relied upon and what is the closeness or otherwise of the respective fields of activity? I have already decided that the opponents have a reputation in the mark but that this is for a fairly specialised product and that in the main, their goodwill and reputation will be limited to those interested in kit cars and off-road vehicles. The applicants’ specification is not limited in any way and at present would include vehicles identical to those sold under the opponents’ trade mark. It would also include other vehicles, motorbikes and bicycles.

55. Another factor to consider is the similarity of the marks in question. The opponents’ use the trade mark DAKAR 4x4. The examples of use show this in a slightly stylised italic script. The applicants seek registration for the mark DAKAR(stylised) and device as set out earlier in this decision. Mr Robson submitted that if, contrary to his submissions, I found that the opponents had a goodwill and reputation in their mark in respect of kit cars, then the headdress element of the applicants’ mark would be sufficient to avoid any confusion. It seems to me that whilst the headdress element is a prominent feature of the mark so too is the element DAKAR. In aural use the marks DAKAR and DAKAR 4x4 would be very similar.

56. I must also take into account the manner in which the applicants’ have used the mark. However, in this case, there is no evidence as to how or even whether the applicants’ trade mark has been used on the goods in question prior to the relevant date. Mr Robson in his submissions argued that the opponents could not succeed in their passing off action because

they had not shown that confusion was likely to arise or having arisen. Absent any use by the applicants then the later could not have occurred. As such, the test, is as noted above, a test assuming notional and fair use across the entire range of the applicants' specification.

#### Conclusions on the question of misrepresentation

58. Taking account of all these factors, and the fact that the marks are closely similar, it seems to me that the average consumer, aware of the name DAKAR 4x4 used in relation to kit cars sold in kit form and ready assembled on seeing the applicants' mark DAKAR (stylised) and device, used on kit cars, would believe that those goods came from the opponents or were linked to the opponents. Equally, it seems to me, that given that the opponents produce and sell a ready assembled car, the use of the mark Dakar (stylised) and device on a car, would also result in the public believing that those goods came from, or were linked to, the opponents. **Looking at the applicants' specification, I find that the second requirement, misrepresentation, has been shown in so far as the specification covers automobiles.** However, the specification also covers vehicles, motorbikes and bicycles. The term vehicles is very broad, it would cover automobiles but it would also cover other forms of vehicles such as water based vehicles where, as with motorbikes and bicycles, there is a lesser degree of similarity. Use of the applicants' marks on these goods or parts and fittings for such goods, would not result in misrepresentation.

#### Damage

60. Given my findings in respect of goodwill, reputation and misrepresentation. It seems to me that if the applicants' mark was used on certain goods within the specification damage would follow. The use of the trade mark on those goods would not be under the control of the opponents and any such use could damage their goodwill and reputation.

#### Conclusions under section 5(4)(a)

**61. Therefore, I reach the view that the requirements of section 5(4)(a) have been made out in so far as the application covers automobiles and in so far as those goods are covered by the current specification, the application is refused.**

#### Consequences of Decision

**62. The opponents' ground under section 3(1)(c) is dismissed, but they have succeeded in part in their objection under section 5(4)(a) of the Act.** The applicants should within one month of the end of the appeal period, file a Form TM21 restricting the specification to that shown below. If no Form TM21 is filed within the period set, then the application will be refused in its entirety. The application should be amended to read:

Class 12

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

## Costs

63. The opponents have succeed but only in part. It seems to me that the result in these proceedings is that both parties have had a measure of success. As such, I find that each party can bear its own costs of the proceedings and I make no order as to costs. If however, the applicants do not apply to amend their specification as set out above, and the application is refused in its entirety, then the opponents may make an application to the registrar for an appropriate order for costs at that time.

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

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