

TRADE MARKS ACT 1994

In the matter of application no 2165052

by Ford Motor Company

5 to register a trade mark in Class 12

DECISION AND GROUNDS OF DECISION

10 On 28 April 1998, Ford Motor Company of The American Road, Dearborn, Michigan 48121, United States of America, applied under the Trade Marks Act 1994 to register the trade mark LINCOLN in Class 12 of the register in respect of “Motor land vehicles and parts and fittings therefor”.

15 Objection was taken to the mark under Sections 3(1)(b) and (c) of the Act on the grounds that it consisted exclusively of the place name LINCOLN and was therefore devoid of any distinctive character and consisted exclusively of a sign which may serve in trade to designate the geographical origin of the goods, the subject of the application.

20 Objection was also taken to the application under Section 5(2) of the Act in respect of the following earlier marks:-

(i) 2001715 LINCOLN (stylised word)

(ii) Community application 228163 LINCOLN

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At a Hearing at which the applicants were presented by Mr J Caisley of Grant, Spencer, Caisley & Porteous the objections were maintained and following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

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Sections 3(1)(b) and (c) of the Act read as follows:-

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

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(b) trade marks which are devoid of any distinctive character

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

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.

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LINCOLN is a place name occurring eleven times in the “World Geographical Dictionary”. Only two of these references are to places in the United Kingdom:-

1. Lincoln - a county in England,
2. Lincoln - city and county borough in Lincolnshire, pop. 76,660; industry - diesel engines, automobile parts, pumps, agricultural machinery.

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In the judgement of the European Court of Justice in conjoined cases C-108/97 and C-107/97, *Windsurfing Chiemsee v Huber and Windsurfing Chiemsee v Attenberger*, the Court ruled:

10 *1. Article 3(1)(c) of the First Council Directive 89/104/EEC, [which is reproduced in Section 3(1)(c) of the Trade Marks Act 1994] is to be interpreted as meaning that:*

15 — *it does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods;*

20 — *where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods;*

25 — *in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned;*

30 — *it is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it.*

35 With this judgement in mind I find that the sign applied for may serve, in trade, to designate the geographical origin of the goods in question. Although Lincoln’s reputation is specifically for motor vehicle **parts**, it does not seem unreasonable to expect there to be other types of engineering industry in the region, including the county of Lincoln as a whole, which could include the manufacture of motor vehicles themselves. Even if this were not so, the ECJ judgement states that Section 3(1)(c) does not apply *solely where the names designate places which are currently associated with the category of goods in question*, it also applies to *geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods*. I am instructed that I “*must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods*”.

45 Lincoln is a city in England with a reputation for motor vehicle parts, therefore my assessment is that potential purchasers of motor vehicles in the United Kingdom are more likely to see the mark as a reference to the English city and thus as an indication of the geographical origin of the goods.

The applicant, by later correspondence dated 27 July 2000, offered to limit the specification of goods to “motor vehicles sold complete or in kit form”, but I do not believe such a limitation is sufficient to overcome the initial objection.

5 For these reasons I consider the mark is not acceptable, prima facie, for registration under Section 3(1)(b) or (c) of the Act.

At the very least the mark needs evidence of use in order to show that the public have been educated to see the word as a trade mark. I now go on to consider the use which has been made of the mark and whether it has in fact acquired a distinctive character as a result of such use.

10 Evidence was filed in the form of four newspaper articles published in the United Kingdom between 18 May 1996 and 16 April 1998, referring to the LINCOLN car. The articles appeared in the features or motoring pages of the relevant publications. I discount two further articles published after the date of application.

15 The evidence also referred to a number of Internet websites featuring the LINCOLN car, and a magazine called “Classic American”, though no connection was made between the magazine and the mark. The evidence finally referred to the “high media profile” of the vehicle through its appearance in various US-imported television series.

20 No evidence of sales or direct promotion of the goods in the United Kingdom was tendered.

In the judgement of the European Court of Justice in conjoined cases C-108/97 and C-107/97, Windsurfing Chiemsee v Huber and Windsurfing Chiemsee v Attenberger, the Court further ruled:

25 2. *The first sentence of Article 3(3) of the First Council Directive 89/104/EEC, [which is reproduced in the proviso to Section 3(1) of the Trade Marks Act 1994] is to be interpreted as meaning that:*

30 — *a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;*

35 — *it precludes differentiation as regards distinctiveness by reference to the perceived importance of keeping the geographical name available for use by other undertakings;*

40 — *in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;*

45 — *if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;*

— where the competent authority has particular difficulty in assessing the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment.

5 With this judgement in mind I find that the evidence has not established that a significant proportion of the relevant class of persons identify the goods as originating from the applicant because of the use made of the mark. Any distinctiveness which may have been acquired as a result of the use made of it is insufficient to displace the primary geographical meaning of the word LINCOLN in the United Kingdom.

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I therefore conclude that the applicant has failed to satisfy the proviso to Section 3 of the Act.

I turn finally to the objections raised under Section 5 of the Act, which says:-

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

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

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(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,

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

The following earlier marks were cited against this application:-

<u>Mark</u>	<u>No</u>	<u>Class</u>	<u>Specification</u>
30 LINCOLN (stylised word)	2001715	7	Cleaning, sweeping, scrubbing, buffing and burring apparatus, machines and vehicles; and parts and fittings therefor.
LINCOLN	E228163	7	Electric motors, including polyphase induction motors, (slip-ring motors), vertical motors (and back-g geared motors), motor-generator sets, electric motors, generators.

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However, I do not consider it necessary to address these objections in any detail because I believe the Section 3 objections are a sufficient barrier to the registration of this mark.

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The evidence of use of the mark applied for might have allowed the application to proceed under Section 7(2) of the Act. However, for the same reasons as I have found that the use does not assist under Section 3, I find that it does not assist under Section 7(2) either.

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In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and for the reasons given it is refused under the terms of Section 37(4) of the Act because it is debarred from registration under Sections 3(1)(b),

3(1)(c), and 5(2) of the Act.

Dated this 29th day of November 2000.

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ROGER G EVANS

For the Registrar

10 The Comptroller General