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Jaguar prowls to victory in their opposition to the registration of an EUTM

Julius Stobbs, Amelia Sainsbury (Stobbs IP) · Thursday, November 2nd, 2023

The Opposition Division has partially upheld an opposition filed by Jaguar Land Rover (“**Jaguar**”)



against EUTM application no.16778672 for the figurative mark, , applied for by luxury fashion designer, Philipp Plein.

Jaguar based its opposition on earlier EUTM registrations covering several variations of its logo,



as well as unregistered rights in these marks. These earlier registrations covered a range of classes including classes 9 (for hardware / software), 12 (for vehicles) 14 (for jewellery / watches), 18 (for leather / bags), 25 (for clothing / footwear), 37 (for maintenance / repair of vehicles) and 40 (for automobile customisation).

Jaguar invoked Articles 8(1)(b) and 8(5) EUTMR in relation to its earlier EUTMs (“**Earlier Marks**”) and Article 8(4) EUTMR in relation to its UK non-registered trade marks, which it claimed to have been used in the course of trade of more than mere local significance.

Reputation

Interestingly within these proceedings, the Opposition Division chose to depart from the normal order of things and commented on reputation first.

Jaguar provided extensive evidence demonstrating the reputation owned in its Earlier Marks. This included website screenshots obtained through Wayback machine, brochures, independent articles, sales data, details of awards won, and screenshots from social media. It also included an earlier



opposition decision confirming that its EUTM No.26658 has acquired a particularly high degree of distinctiveness in “motor land vehicles” within the EU.

This evidence was found to show that Jaguar held a consolidated position in the market. The fact that the Earlier Marks had been used in licensing deals with third parties was considered a strong indicator that they possessed a high degree of attractiveness and important economic value.

The Opposition Division, therefore, concluded the Earlier Marks enjoyed a reputation in, “vehicles, motor vehicles, apparatus for locomotion by land, motor land vehicles; land vehicles”.

Similarity

To the extent that they contained an image of a feline predator’s head baring its teeth, with pointed angular ears, the signs were held to be visually similar to an average degree and conceptually similar to at least an above-average degree. As the signs are purely figurative, an aural assessment could not be carried out.

Link

Although some of the contested goods and services were different from those covered by the Earlier Marks, it was considered common knowledge that consumers buying luxury cars are likely to also seek out expensive and exclusive goods, such as cosmetics, perfumery and electronic devices, as well as services connected to these goods.

Due to Jaguar’s reputation, it was concluded that consumers would make a connection between the reputed Earlier Marks and the applicant’s mark covering goods in classes 3, 9, 14, 18, 24, 25 and 28 and connected retail services in class 35. No such link was found, however, in relation to goods listed in class 26 (brooches, feathers, etc) and the remaining contested services in class 35. These were considered to belong to totally different, unrelated market sectors and to have a different nature, function and purpose to the earlier goods for which reputation had been acknowledged.

Risk of Injury

The Opposition Division concluded that through its “undeniable similarity” the contested sign would attract more consumers to purchase its goods and services and, as such, would benefit from the reputation of the Earlier Marks, taking unfair advantage of the investment and goodwill built up by Jaguar.

As the applicant did not claim any form of due cause in defence of the opposition, it was assumed none existed. The opposition was held successful under Article 8(5) EUTMR for all goods in classes 3, 9, 14, 18, 24, 25 and 28 and retail services connected with these goods in class 35.

Likelihood of Confusion

Whether or not a likelihood of confusion exists under Article 8(1)(b) EUTMR was considered for the remaining contested goods and services. Since the remaining goods and services were clearly

dissimilar to those covered by the Earlier Marks, the opposition was held unsuccessful under this ground.

Unregistered Trade Marks

Following the UK's withdrawal from the EU, it was considered that the UK non-registered trade marks no longer constituted a valid basis for opposition at the time the decision was taken and, as such, the opposition was rejected as far as it was based on these earlier rights.

Conclusion

This is the second time that Philipp Plein has sought to ride off the coattails of a luxury car brand, coming off the back of Ferrari's successful case against him for infringement of their IP in advertisements, which they claimed unlawfully appropriated their goodwill. This is a useful transfer of image case, demonstrating the reach of luxury brands who can support their reputation through persuasive evidence from an early stage.

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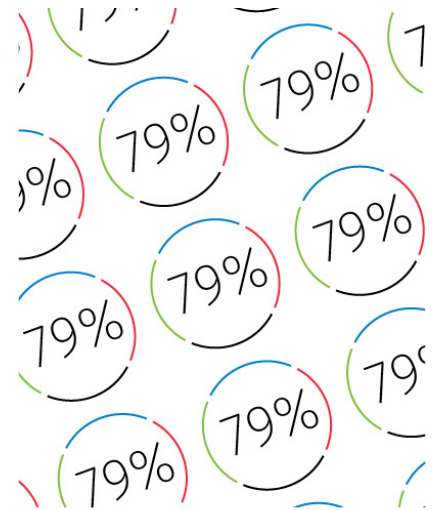
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